TRADEMARK, REGISTRATION AND COPYRIGHT

I Brief Explanation of each and what they mean

A. Trademarks protect words, phrases, graphics, symbols, letters and other advertising devises developed to brand a company, organization, merchant or service provider.

B. Copyrights protect works of creative art or authorship granted to original works of music, literature, drama, visual art, architecture, and other forms of creative expression.

C. Registration is the manner in which the works are protected.

II Trademarks can be used by for profit entities as well as nonprofit entities.

A. Trademarks can be anything used to distinguish one person or company from those of another.
B. Trademarks can be interpreted in two different ways broad and narrow.
   1. Trademark in the broader meaning indicates the whole field of protection of all forms of indication of origin, marks used on goods, service marks, collective marks and certification marks.
   2. Trademarks in the narrower meaning refers to the words and symbols used to identify and distinguish goods.
   3. "Service mark" refers to the words and symbols used to indicate the specific services. SM is used to indicate a service mark.
C. TM is used to indicate a word, graphic, etc. is being claimed by a specific company or organization as trademarked. However, without a formally approved trademark registration the claim is largely unenforceable.
   1. TM signifies common- law rights in a trademark pursuant to the Lanham Act. Unregistered trademarks should use TM which means this brand has not been registered with the United States Patent and Trademark Office.
   2. "R" with a circle around it indicates it is registered which deters imitators and helps prove ownership in the courts.
   3. A trademark can continue in perpetuity if intentional and continually used as a trademark. **Under Federal, law a federal trademark registration lasts ten years and can be renewed for additional ten-year terms until the mark is no longer in use.
   4. A "trade name" and a "d/b/a" (doing business as) can be a word or words or letters (possibly including a symbol or design) used to identify and distinguish **entities,** corporations, companies, partnerships, nonprofits and businesses. A trademark is used to identify and distinguish **goods and services** of a business.
   5. If the corporate name, company name, partnership name, trade name or d/b/a are used by themselves (and not part of the address of the entity) on goods or associated with services to distinguish the goods or services, the word(s), trade names and d/b/a will also serve as and can be registered as trademarks. Examples: "Coca-Cola", "Roto-Rooter" and "PG&E".

D. Steps to take before adopting a trademark
   1. A nonprofit should do a trademark search before registering. There might be someone using the same mark. This way the money for registering won't be wasted and there might be damages for infringing upon the rights of the prior owner of the trademark.
   2. A search on-line using popular search engines should be used, then follow with a search on the United States Patent and Trademark website. That search should identify any identical

trademarks. However, if these searches don't find any identical trademarks, a professional search service should be used. If you are not familiar with any professional search services, contact an intellectual property attorney for a recommendation.

E. Proper ways to use a trademark
   1. Present trademarks in a way that shows their significance. Use capital letters, bold face, or stylization.
   2. Trademarks should not be joined with other terms (as an example: a hyphen) or used with unapproved logos, graphics, photos, slogans, numbers, design features or symbols
   3. Trademarks should never be "made plural," never mixed with other trademarks and the spelling of a mark should never be changed.
   4. Trademarks should not be used in a possessive form.
   5. Trademarks should be properly marked to give notice that they are, in fact, trademarks (either common law or registered.)
   6. Trademarks should never be treated as a verb
   7. Use trademarks as adjectives. Companies that allow trademarks to be used as nouns risk losing rights in those trademarks.
   8. See section G, #1, d

F. Trademark Right Establishment
   1. Under common law, the first use of a mark in commerce for particular goods or services becomes the owner of the mark in the geographical area in which the mark has been used. Federal registration of the mark broadens the geographic scope of the owner's right to the entire country.
   2. Under Federal law, to establish first user priority of a trademark filing an application with the Federal Government based on a bona fide intention to use the trademark followed by an actual use in commerce.
   3. Each trademark application requires a filing fee for each class of goods or services designated. There are eleven (11) classes of services and thirty-four (34) classes of goods. At least one service in one or more of the classes of service must be chosen and/or at least one or more of the classified type of goods.
   4. You may file by paper, ($375 per class), electronically ($325 per class) or electronically by special procedure ($275 per class), in addition are attorney fees for preparing and filing the application typically in the hundreds of dollars for the first class and a reduced amount for each additional class.

      It is not recommended that you do the filing yourself. The process is complicated. The United States Patent and Trademark Office will examine the application. The process will take anywhere from 10 to 24 months after filing.

      When the application is based upon an actual use of the trademark the application must designate the date of first use in interstate commerce and submit a specimen showing how the mark is used with the goods and services in each class. When the trademark application is based upon a bona fide intent to use, the application must state an intent-to-use the trademark for the designated services or goods.
   5. State registration is similar but usually only protects the trademark in that state.

G. Loss of exclusive rights in a trademark

Rights can be lost when the trademark is no longer associated with the original trademark owner

1. The following actions can result in losing a trademark:
    a. ceasing use of trademark with intent not to resume use
    b. licensing of a trademark without quality control, causing the term or symbol to lose significance as a trademark
    c. assigning a trademark without also transferring associated goodwill (i.e., assignment in gross)
    d. the trademark falling into majority usage as a noun – examples: “escalator,” “aspirin,” “cellophane”

H. Benefits of registration

1. Federal registration of a trademark provides statutory (legal benefits under the law) benefits and recourse
    a. One of most important: from the date of the registration, the registrant has exclusive rights nationally
    b. Registration can provide evidence of:
        i- the validity of the registered trademark
        ii- registration of the mark
        iii- registrant’s ownership of the mark
        iv- the registrant’s exclusive use of the mark
    c. any owner of a registered trademark can recover from an infringer either the infringer’s profits or damages caused by the infringement

I. Protection with a non-registered trademark

1. Without registration the only protection is common law rights in the state where the trademark is registered. Another party can establish its own rights with the same or similar mark in another state.

J. Possible actions and actions that need taken to protect a trademark

1. The USPTO requires a trademark owner to some time the fifth and sixth anniversary dates of the registration to file a “Declaration of Use” stating that it is still using the registered trademark. Samples of labels, tags, or other material showing the manner in which the mark is used must accompany the Declaration. Failing to file the Declaration will result in the registration being cancelled.

2. Due diligence needs to be done to monitor any possible infringement. If infringement is found, action must be taken to stop the infringement. A cease-and-desist letter can be written to the infringer specifying the owner’s position on the infringement. An experienced intellectual property attorney should be consulted before taking any action.

K. A nonprofit can use its trademark on any type of goods or services. Trademark laws make no distinction between the goods and services that are used for revenue generation or not. Organizational documents should be checked and the requirements of its tax-exempt status to find out if such revenue generation is permitted.

L. Use of trademark to generate revenue through a third party

1. A nonprofit can license a third party to use the trademark for particular goods or services including revenue generation and the licensee’s use is credited to the nonprofit licensor.

2. The licensor can file for and obtain registration in its own name based on the use by the licensee, thus allowing the nonprofit to expand its trademark rights to cover services or goods with which the nonprofit itself does not use the trademark. The use by the licensee can be based upon compensation to the licensor as permitted by law.

M. Protecting a trademark from infringement

1. "To decide if there is infringement, the courts generally look at factors including the similarity between trademarks in the way they look, sound or in their meaning. They may also survey the amount of competition between the services or goods, how sophisticated the intended consumers are, and whether there is any confusion in the marketplace." P.#7

2. "With respect to soliciting funds, the general rule is that the use of a trademark by others can be enjoined if that use causes confusion or is likely to cause confusion with the use of the trademark by the trademark owner." P.#7

3. …" Unfortunately, there is no single bright line test. However, in general where the purpose of the fund solicitation by the user of the allegedly infringing mark is the same as the purpose of the nonprofit (e.g., both solicit funds for charitable purpose), then it comes down to the question of the similarity of the marks and whether in the mind of the targeted individuals, it could be believed that there is an association of the allegedly infringing organization with the nonprofit organization." P. #8

4. "The same test of confusion or likelihood of confusion applies to the sale of goods and services." P.#8

N. Things to do when a nonprofit believes someone is infringing its trademark

1. If another party is using the exact or very similar trademark for the same or similar goods and services and it could cause confusion in the mind for the consumer, the nonprofit should immediately investigate to establish when the party first began using its trademark for its goods and services. If the infringer's use date is prior to the date of use for the nonprofit, the nonprofit then becomes the infringer. If the nonprofit is the first user, then seek an experienced trademark attorney about sending a cease-and-desist letter. If the letter is successful, the infringer would either phase out the infringing activities or become a licensee under the nonprofit's trademark. If it does not reach resolution, the remaining choice is ligation in a federal court.

O. Nonprofit response to accusation of trademark infringement

1. Try to convince the other party that the differences between the respective trademarks and associated services and /or goods won't cause confusion. Various factors are considered: sight, sound, meaning of the respective trademarks, differences in goods and services, and the channels of trade or distribution in the goods and services, as well as the sophistication of the consumer.

2. If agreement can't be reached on the above issues, the options are to agree upon the right to use a modified trademark or to enter into a licensing agreement, otherwise litigation may be the only alternative.

COPYRIGHT

III Copyrights are granted as soon as a qualifying work of creative art or authorship "is created and fixed in a tangible form that is perceptible either directly or with the aid of a machine or device." It is an automatic legal recognition of ownership granted to the original works of music, literature, drama, visual art, sculpture, architecture and other forms of creative expression. In other words, the creation is protected by copyright law as soon as it is finished without any action on the part of the creator.

B. The copyright holder is usually granted the exclusive right to perform, display or distribute the work, reproduce it and profit from it.

C. Without formal registration of the material, it is much harder to prove copyright infringement. With registration, the creator's exclusive rights generally remain active for 70 years beyond the life of the creator.

D. The copyright symbol, a small case "c" with a circle around the letter and use of the word "copyright" may be used before and after formal registration of a copyrighted work with the United States Copyright Office (U.S.C.O). Keep in mind that it is much easier to prove ownership when the work has been registered. Therefore, registration improves your chances of winning in an infringement case.

E. Things that cannot be copyrighted:

1. Ideas, copyright can only protect the particular way an idea is expressed.

2. Facts and theories are not protected

3. Short phrases, names and titles are not protected by copyright but they may be protected under trademark law.

4. U.S. government works. Any work created by a U.S. government employee or office is in the public domain as long as the work was created in that person's official capacity.

5. Copyright protection attaches at the creation of the work, once it is in a physical expression.

6. A work is copyrighted by default unless the author has explicitly dedicated it to the public domain.

F. Who owns the copyright?

1. The author or creator of the work is the original owner of the copyright.

2. Rights to copyrighted works can be assigned or transferred to other individuals or companies.

EXAMPLE: The copyright to a book can be owned by the publishing company.

G. Rights the copyright owner has:

1. The right to make copies of a protected work (reproductive rights)

2. The right to sell or otherwise distribute copies to the public (distribution rights).

3. The right to create adaptations and prepare new works based on the protected work (derivative rights).

4. The right to perform a protected work (a play, song, etc.) or to display a work in public (performance/display rights).

5. The right to sell or assign any of the rights listed above to other people or companies.

Anyone who uses a copyrighted work (for example by coping it, displaying it, distributing it or created a derivative (sequel) has infringed upon the owner's exclusive rights.

H. Patents

1. The patent laws cover inventions.

2. A patent is a grant of property rights to the inventor.

3. The inventor has the right to exclude others from making, using and selling his invention.

IV PUBLIC DOMAIN

1. Public domain refers to creative materials such as, books, songs, movies, artwork or other works that could be copyrighted but are not currently protected by copyright, patent, trademark or other intellectual property law.
2. After the time period in which the copyright owner had exclusive rights expires, the work enters the public domain. The owner no longer has any exclusive rights to the work and it is in the public domain.
3. Four ways a work can enter the public domain:
    a. Most of the time any work that is published in the U.S. before 1923 is in the public domain. When a copyright expires, the work enters the public domain.
    b. Works first published before 1964 the owner is required to file a renewal with the Copyright Office during the 28th year after publication. Failure to renew means the work entered the public domain.
    c. Works published before March 1, 1989; a copyright notice was required to be attached to the copyrighted work in order to retain copyright protection. Works with defective or missing copyright notice could enter the public domain. There were various exceptions and ways to correct the lack of a defective notice that would prevent the work from entering the public domain.
    d. The owner may deliberately put a work in the public domain (dedication). Only copyright owner can dedicate a work to the public.

B. Checking to ascertain if a work is in the public domain

1. Calculate it based upon the first date of publication. With the calculation, you can determine if the work is in the public domain or not.

2. Search the records of the Copyright Office for more information.

C. There are also several public domain resources online.

1. www.publicdomainworks.net: this is an open registry of artistic works that are in the public domain.

2. www.publicdomainsherpa.com/calculator.html :this is one of several copyright calculators online that can let you know how long a work's copyright protection will last or if it is already in the public domain.

D. If a work is publicly accessible, like a web site, does that mean it is in the public domain? NO! A work being publicly accessible doesn't mean it is publicly available for use by all.

V. Fair Use

A. Fair use is a copyright principle based on the belief that the public is entitled to freely use portions of copyrighted material for definite purposes:
   - I commentary
   - ii criticism
   - iii nonprofit educational purposes
   - iv parody and satire

B. Fair use policy recognizes that society can benefit from unauthorized use of copyrighted materials when the use furthers scholarship and education or informs the public.

C. Fair use can be used as a defense against copyright infringement. Fair use is an infringement that courts excuse due to its greater social benefit. If a copyright owner challenges someone's infringing use of a work in court and the court rules that the use is "fair use" the infringer will not face legal consequences.

D. Criteria for fair use? How will they decide?
   1. Purpose and character of the use: for commercial or nonprofit educational purposes.
      a. Has the copyrighted material taken been used to help create something (transformative) new or has it been used verbatim into another work? The more transformative the new work, the less significant the other factors become.
   2. The nature of the copyrighted work: Some types of copyrighted material are more likely to be copied, fictional and creative works such as plays, novels or visual art. These types of material are closer to the heart of protected expression than primarily factual works. Fair use is more difficult to establish when these "core" creative or fictional works are copied. Because the dissemination of facts or information benefits the public, you have more leeway to copy from factual works.
   3. The amount and substantiality of the portion used in relation to the copyrighted work as a whole.
      a. Generally, the larger the portion of the copyrighted material that is taken and used, the lower the likelihood that the use will be considered a fair use. If you take a small portion of a work, it will not be fair use if the portion taken is the "heart of the work." If the part of the material copied is an essential part of the work, the court will look at the amount of the work that is taken, but also consider the portion's quality and importance to the work as a whole.

4. The effect of the use upon the potential market for the copyrighted work.
    a. Fair use is more difficult to establish if your use deprives the copyright owner of income or takes away from a new or future market for the copyrighted work. This applies even if your use is not directly competing with the owner's use of his work. While your use may be different, it could still diminish interest in the owner's original use of the work.
    b. Ask yourself if the use of the copyrighted material could potentially affect the sales of the original work? If yes, then it most likely will not be a fair use.
    c. The four factors are only guide lines. Courts can adapt them to particular situations on a case-by-case basis.

E. Uses that are generally considered fair use:
    1. Transformative (already discussed refer to previous explanations) uses are more likely to be found to be fair use.
    2. Commentary and Criticism: If you are doing a commentary or critique of a copyrighted work, some of the work may be reproduced to reinforce purpose.
        a. Using the exact words makes the critique more effective
        b. Allowing the use of copyrighted works for purposes of commentary and criticism is based on the idea that a copywrite owner should not be able to stifle comment or critiques about his work and the public benefits from an open debate. Reviews and comments are enhanced by including some of the copyrighted material.
    3. Parody and Satire
        a. A parody ridicules another work, usually well known, by imitating it in a usually comic way. Courts understand the need for a fairly extensive use of the original work. The Supreme Court has recognized parody as a fair use, even when done for profit. It is transformative and for purpose of humorous comedy.
        b. Satire does not need to use a large amount of another work to make its broader point; the satirical point is not tied to a specific work. Therefore, it does not get the same fair use exemptions. A satirical author's idea is capable of expression without the use of the other work.

F. What if there is disagreement between the copyright owner and the author who wants to use some of the protected material?
    1. If the copyright owner disagrees with your interpretation, the dispute will have to go to court or arbitration.
    2. If the infringer has good reason to believe that the use was fair use and the copyright owner disagrees, you may be considered an "innocent infringer." Innocent infringers often don't have to pay any damages to the copyright owner, but do have to stop the infringement and sometimes must pay the owner for the reasonable commercial value of that use.

G. Common misunderstanding about fair use.

There is often confusion about what is fair and what isn't. Judges use the guidelines provided in the copyright laws, but have a lot of discretion in making their decisions. There are no hardline rules that definitely classifies what is and isn't fair use.

1. Any use that seems "fair" is fair use. WRONG. Not every use that is commonly considered "fair" in the plain sense of the word is considered "fair use" under the law.
2. It is copyrighted, so it can't be fair use. WRONG. Fair use applies only to copyrighted works, describing under what conditions copyrighted material may be used without permission. Fair use is a defense against charges of copyright infringement. If a work is not copyrighted, it is in the public domain and fair use is a moot point.
3. Using a copyrighted work for non-commercial use is always fair. WRONG. It is an important-but not a determining- factor in fair use analysis. The judge must weigh all the other factors, and these may be enough to out weigh the non-commercial use.
4. If you are selling for profit or deriving income from your use, it is not fair use. NOT NECESSARILY. A commercial use of a copyrighted work makes it harder to qualify as fair use, it is not determinative. The judge must weigh all the other factors (profit motive and actual financial benefit) before deciding if it is fair use.
5. If you quote under 300 words of a copyrighted work, that is fair use. WRONG. There is no set minimum or maximum amount of the work that can be copied or used to be considered a fair use or an infringement.
6. If you're coping an entire work, it is not fair use. NOT NECESSARILY. Copying an entire work goes against the third factor, the amount of the work used in relation to the whole, since the entire work has been taken and used. It is not determinative of the fair use analysis. Making copies of an entire work have been found to be fair use, such as making photocopies for classroom use.
7. Strict adherence to the fair use principles and factors protects you from being sued. WRONG. Fair use is a defense argument against copyright infringement. It does not stop someone from suing you, even if you believe it was fair use. The copywrite owner may not concur with your decision and file a copyright infringement suit against you. The matter is then settled by a judge in court.

H. What constitutes "nonprofit educational purposes" that may be considered fair use?

Courts have generally ruled those nonprofit educational institutions, such as elementary schools, high schools, colleges and universities, are participating in educational uses of copyrighted material when using the work as part of a curriculum. Courts have, at times, also considered libraries, museums, hospitals and other nonprofit institutions to be educational institutions when engaging in nonprofit instructional, research or scholarly activities for educational purposes. In these cases, and for the limited purposes of the seminars or training, nonprofit organizations can be considered "educators" and the attendees students.

1."Educational Purposes" have been described as:

(i) Non-commercial instruction or curriculum-based teaching by educators to students at nonprofit institutions

(ii) Planned non-commercial study or investigation directed toward making a contribution into a field of knowledge; or

(iii) Presentation of research findings at non-commercial peer conferences, workshops or seminars.

Remember that the fair use analysis remains a case-by-case inquiry. The "nonprofit educational purpose" of a use is just one factor out of the four factors considered in making the ruling. A use for nonprofit and non-commercial purposes is more likely to be considered a fair use than a for-profit commercial use.

The court will look to not only the purpose of the use but to the nature of the use as part of the fair use analysis. "The nature of the use refers to whether the copy-righted material taken has been used to help create something newer or has it just been appropriated verbatim as an exact copy of another work."

It is not necessary for a work to be transformative in order for there to be a finding of fair use. However, the more transformative the new work, the less significant the other factors that weigh against a finding of fair use become.

Questions to ask yourself to help determine if you used the copyrighted material in a transformative way:

1. Has the material I took from the original work been transformed by adding new expression or meaning?
2. Was value added to the original by creating new information, new aesthetics, new insights and understandings?
3. Did I use the work for my own personal commercial gain or to profit financially, or was there a broader benefit to the public?

LASTLY

Remember there are no absolute rules as to what use will be protected by the fair use doctrine, until that issue is decided by a judge or jury. Each use must be evaluated on a case-by-case basis.

A "fair use worksheet" can be found at: www.lib.umn.edu/copyright/FU-checklist.pdf. You can use it to help you determine if your use can be considered fair use.

Using a copyrighted work:

How can I find out if a work is copyright-protected?

1. Examine the work itself for information regarding copyright.
    a. Look for a notice of copyright- if yes then it is copyrighted. You will need to consider asking permission from the copyright owner.

What is a copyright notice?

A copyright notice should contain:

1. The word "copyright"
2. The "c" with a circle around it symbol (this is a copyright notice symbol)
3. The date of publication

4. The name of either the author or the owner of all the copyright rights in the published work. It also contains information that can be helpful in finding the copyright owner to seek permission for your use of the copyrighted work.

What if a work doesn't have a copyright notice or the "c" with a circle around it?

A work missing a copyright notice does not mean the work is in the public domain. Assume the work is protected by copyright unless you can establish it is not. Reminder: works created after March1,1989, do not need a copyright notice to be protected by copyright. Any work created after March1,1989, to be in the public domain, the author must specifically opt out of copyright.

Step two: Perform a copyright search.

Information about ownership of copyright and whether the work is still in effect can be found in copyright registrations and other related documents, such as assignments of copyright and renewals of copyright. This can be found in the records of the United States Copyright Office.

Find the information that will help you in locating the correct documents. Check the work you want to use for the following information:

Copyright notice

Title of the work

Name(s) of author(s)

The name of the copyright owner

Year of publication or registration

Title, volume or issue (if it is a serialized publication)

Underlying works or works contained within the works (like a film based on a novel)

Identifying numbers

Once you have this information ready, you can check the records at the Copyright Office. These records are not always complete or conclusive, because filing a copyright registration and copyright assignments and transfers is not required.

How to perform a search of the Copyright Office's records.

The copyright office has a web site with information about performing searches and other copyright -related issues.

The web site is www.copyright.gov .

You can request the Office to do a search for you, for a fee of $165 per hour or fraction thereof with a two-hour minimum. You can request the search by clicking on "Request a Search of Copyright Records" at the sidebar on the left.

Can I legally copy a photograph from the Internet for use on my own website?

Because the information is stored somewhere on an Internet server, it is fixed in a tangible medium and potentially qualifies for copyright protection. Whether it is protected depends upon factors that you may not know:

When it was first published

Whether it has been renewed, if necessary, because it was published before 1978

Whether the copyright owner intended to dedicate the work to the public domain.

What if my web site is not for profit?

If the Internet is the medium by which you comment, critique or educate others for non-commercial purposes, the same fair use considerations apply.

What if the website I'm copying from originally copied a copyright -protected image?

Copyright infringement is an individual charge. Taking a copyrighted image from a likely infringer does not absolve you of any liability for infringement, just because your source of the material did not obtain the image legally.

Can I get into trouble if I use a protected work without permission?

You can get into trouble if you use a protected work without permission.

Respectfully submitted
In F.C.&L.,

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