

# Overview of IP Copyright & Trademark

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## 5 Basic Intellectual Property Areas

- Patent—Federal
- Copyright—Federal
- Trademark—Federal & State
- Trade Secret—State
- Rights of Publicity—State

## What Do They Protect?

- Patent
- Copyright
- Trademark
- Trade Secret
- Rights of Publicity
- Useful "Ideas"
- Art
- Source Identifiers
- Secrets with Value
- Use of "Likeness"

## Authority/Source

- Patent
- Copyright
- Trademark
- Trade Secret
- Rights of Publicity
- Constitution
- Constitution
- Commerce Clause
- UTSA/State Laws
- State Laws

## Administrative Agencies

- Patent
- Copyright
- Trademark
- Trade Secret
- Rights of Publicity
- USPTO
- Copyright Office
- USPTO or SOS
- State Laws
- State Laws

## Duration

- Patent
- Copyright
- Trademark
- Trade Secret
- Rights of Publicity
- 20 Yrs from filing\*
- Life + 70 Years\*\*
- While Used
- While a Secret
- Death + 70\*\*\*

- \* Consult Patent Attorney
- \*\* Can Vary Depending on Author, when published and other factors
- \*\*\* In CA, varies by state.

## Copyright

### Basics

- Original Work of Authorship
- Fixation
- Tangible Means of Expression
- Non-Functional
- Artistic Works
  - Beauty is subjective

### Not Protected

- Forms, titles, phrases, public domain property, governmental works

## COPYRIGHT PROSECUTION

- File it and forget it—Almost
- Filing Options
  - Paper Filing—Form Specific      Up to 1+ Years
  - Paper Filing—Generic Form      Up to 1+ Years
  - Online Filing      4 – 6 Weeks
- Amplification/Correction
  - Paper Filing      4+ Months

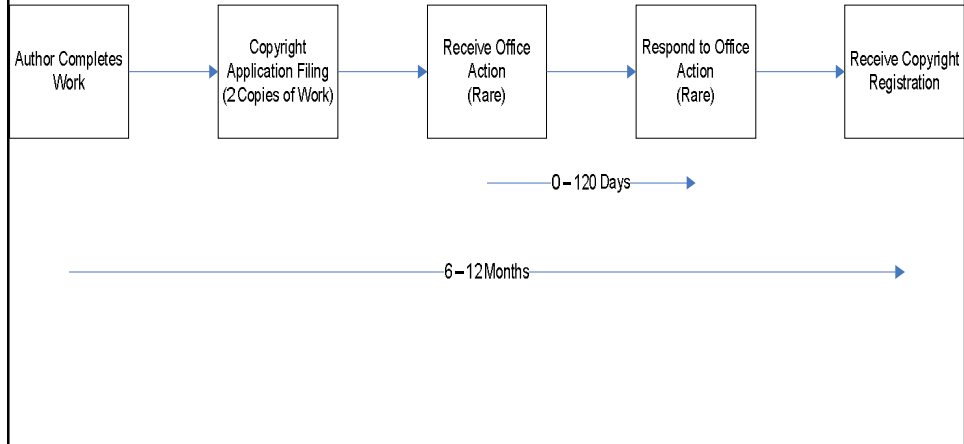
## Rights Granted

- Right to Control Copying/Reproduction
- Rights to Derivative Works
- Rights to Control Distribution
- Rights to Control Performance
- Rights to Control Display
  
- Moral Rights—in the US v. Overseas

## Why Register?

- Required to Bring Suit
  - CA—Filing is enough
  - Denial of registration also acceptable
- Statutory Damage or Actual Damages
  - \$750 - \$30k per work up to \$150k
  - Can be reduced to \$200 per work if no knowledge
- Attorney's Fees & Costs
  - MUST be registered before infringing act begins

## The Registration Process



## The Filing Process

- Paper
  - VERY SLOW process
  - Higher Fee - \$50 – 65
- Online
  - Much Faster
  - Reduced Fee - \$35

## When & What to Register

### WHEN:

- After Publication
  - Within 3 Months of 1<sup>st</sup> Publication
- Any Time, but . . .

### WHAT:

- Basic Work
- Collections?
- Compilations?

## Marking

- 3 Elements
- 1) Copyright, Copr. or ©
- 2) Year of 1<sup>st</sup> Publication
- 3) Owner
- Notice requirements different for some items
  - Cards, Phonorecords (P)

## International Protection

- Berne Convention
  - Almost all countries worldwide
- Requirements for Action Vary by Country
  
- Grey Market Goods
  - What are they?
  - Omega v. Costco
    - First Sale Doctrine & 9<sup>th</sup> Circuit

## TRADEMARK

- Word, Phrase, Symbol
  - Color, Scent, Sound, Moving Image, Trade Dress
- Source Identifier
  - Goodwill

### Not Registerable

- |                 |                    |
|-----------------|--------------------|
| • Generic Terms | Insignia           |
| • Functional    | False/Disparaging  |
| • Ornamental    | Immoral/Scandalous |



## TRADEMARK PROSECUTION

- Federal
  - Not just a file it and forget it process
  - Typical Shortest Process—6-7 Months
  - Can Delay, in necessary, 4+ years
- State
  - Pretty Much a Rubber Stamp Process
  - In CA – 10 – 30 days typically
- Common Law
  - Just Do It.

## Rights Granted

### Rights

- Control use of Similar Marks in connection with
- Similar Goods/Services
  - Likelihood of Confusion
  - Consumer-based Test

### General Rule

- First in Use, First in Right

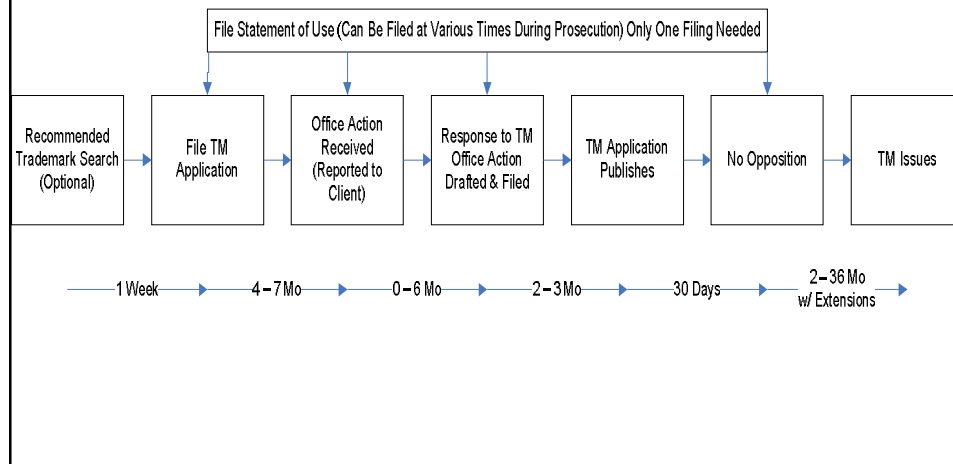
## Why Register?

- Simultaneous Use in ALL States
  - Trumps State & Common Law Marks
- Access to Federal Courts and Remedies
  - Lanham Act—15 U.S.C.
- Advantages in Domain/Cybersquatting
  - ICANN
- Expansion into International Markets
  - Madrid Protocol (use requirements)

## In Use v. Intent To Use

- 1(a) In Use Application
  - Mark is in use in INTERSTATE COMMERCE
- 1(b) Intent to Use Application
  - Mark not yet is USE
  - Mark may have been used, but not necessarily
- Migration from 1(b) → 1(a) is possible
  - Allegation/Statement of Use
  - 1(b) application takes longer depending on when use occurs.

## The Registration Process



## The Search

- Search of the Federal Database is Required
- Search of State Databases are NOT Required
  - Strongly recommended if mark not yet in use
- Spelling, Foreign Language, Symbols?
- Secretary of State Generally Maintains Records
  - Westlaw
  - Lexis
  - Trademark.com – 12 Hour Search, 1 fee.

## Analysis of Results

### DuPont Factors

- 1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression.
- 2. The similarity or dissimilarity and nature of the goods . . . described in an application or registration or in connection with which a prior mark is in use.
- 3. The similarity or dissimilarity of established, likely-to-continue trade channels.
- 4. The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.
- 5. The fame of the prior mark.
- 6. The number and nature of similar marks in use on similar goods.
- 7. The nature and extent of any actual confusion.
- 8. The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.
- 9. The variety of goods on which a mark is or is not used.
- 10. The market interface between the applicant and the owner of a prior mark.
- 11. The extent to which applicant has a right to exclude others from use of its mark on its goods.
- 12. The extent of potential confusion.
- 13. Other Probative Factors

## The Filing Process

- Paper
  - Extra Fees and slower processing
- Online – TEAS
  - \$325/Class, 3 -4 Months until review
- Online – TEAS Plus
  - \$275/Class, but limited descriptions

### Remember

- NO SUBSTANTIVE MARK CHANGES
- Cannot broaden description after filing

## Principal v. Supplemental

- Arbitrary/ Fanciful
- Suggestive
- Descriptive
- Generic
- Principal
- Principal
- Supplemental-1(a)
- Not Registerable

## Opposition & Post Allowance

- Opposition & the Blackout Period
  - 30 Days from the date of Publication
  - Blackout begins with the Notice of Publication
    - Lasts 12 weeks, until the Notice of Allowance
- 1(b) Statement of Use Filing
  - Within 6 months of the notice of allowance
    - Can purchase up to 5, 6-month extensions (3 year total)
  - Must SHOW use in Interstate Commerce (Specimen)

## When & What to Register

- Client Dependent
  - Factors
    - Importance of Mark
    - Risk Averseness of Client
    - Cost
    - Likelihood of Actual Use—business plan
- ITU is great, but
  - Must have actual intent to use or may be cancelled
- In Use
  - Generally, file it.

## Post Registration Activities

- Declaration of Continued Use
  - Section 8 filing
    - 5<sup>th</sup> – 6<sup>th</sup> Year Post Registration
- Declaration of Incontestability
  - Section 15 filing
    - Any Time after 5<sup>th</sup> Year Post Registration
- Renewal Application & Declaration of Cont. Use
  - Section 8 & 9 filings
    - Between the 9<sup>th</sup> and 10<sup>th</sup> years post registration
    - Every 10 years after the first renewal

## Marking & Policing

- ® ONLY AFTER REGISTRATION
  - Early Use can result in cancellation
- TM Any Time You Intend mark as a trademark
- Must take reasonably prudent steps to protect mark
  - Business judgment rule

## International Protection

- Madrid Protocol Option
  - Within 6 Months of filing
    - Benefit of underlying filing date
  - After the 6-month period
    - Can still file
    - No Benefit of underlying filing date
      - Receive actual filing date
  - Not all Countries are members
- Paris Convention-Direct Filing
- WHY PICK ONE OVER THE OTHER?

## Domain Names

- FIRST TO REGISTER IS VALID OWNER, but:
- Trademark Laws can be used to Control Domain Name Use
- ICANN can be used if you hold a registered TM
- Lanham Act can be used if you hold a registered TM

## Cybersquatting

- 15 U.S.C. 1125
- A person shall be liable in a civil action by the owner of a mark, including a personal name which is protected as a mark under this section, if, without regard to the goods or services of the parties, that person—
  - (i) has a bad faith intent to profit from that mark, including a personal name which is protected as a mark under this section; and
  - (ii) registers, traffics in, or uses a domain name that—
    - (I) in the case of a mark that is distinctive at the time of registration of the domain name, is identical or confusingly similar to that mark;
    - (II) in the case of a famous mark that is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of that mark; or
    - (III) is a trademark, word, or name protected by reason of section [706](#) of title [18](#) or section [220506](#) of title [36](#).



## Bad Faith Intent

- the registrant's trademark or other intellectual property rights in the domain name;
- whether the domain name contains the registrant's legal or common name;
- the registrant's prior use of the domain name in connection with the bona fide offering of goods or services;
- the registrant's bona fide noncommercial or fair use of the mark in a site accessible by the domain name;
- the registrant's intent to divert customers from the mark owner's online location that could harm the goodwill represented by the mark, for commercial gain or with the intent to tarnish or disparage the mark;
- the registrant's offer to transfer, sell, or otherwise assign the domain name to the mark owner or a third party for financial gain, without having used the mark in a legitimate site;
- the registrant's providing misleading false contact information when applying for registration of the domain name;
- the registrant's registration or acquisition of multiple domain names that are identical or confusingly similar to marks of others; and
- the extent to which the mark in the domain is distinctive or famous.<sup>1</sup>

## DMCA Safe Harbor

- 17 U.S.C. 512
  - OSP has reasonably implemented a repeat offender policy
  - OSP does not interfere with technical measures
  - (1) General requirements
    - (a) does not have actual knowledge that Work or activity is infringing;
    - (b) is not aware of circumstances from which infringing activity is apparent; or
    - (c) upon obtaining knowledge or awareness, OSP expeditiously removes Work
  - (2) Designate an Agent, including (Terms of Service)
    - (a) name, address, phone, email
    - (b) other info Register may deem appropriate

Questions?

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