

TRADEMARKS, SERVICE MARKS and COPYRIGHTS

LEGAL PROTECTIONS AND USE AS ASSETS FOR CONSULTANTS AND EARLY
STAGE BUSINESS



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TRADEMARKS

Trademarks as Commercial Asset

- Business, Product or Service – Name, Logo, Slogan or Packaging
- Identify Source – Consumer Recognition; Coordinate “Message”
- Suggestive Marks – Marketing, Advertising, Promotion Savings
- Cost/ Benefit of Trademarks – Value of Business as whole

Offensive and Defensive Uses of Trademark

- Protection of Advertising Promotion Investment vs. Free Riders
- Good Will, Quality Reputation vs. Cheap Imitation, public confusion
- Suit for Infringement – Damages from deep pocket junior users
- Likelihood of Confusion – Dilution - Cyber squatting

TRADEMARKS (continued)

Benefits to Federal Trademark Registration

- Rights at Common Law; State Trademarks
- Federal Statutory Damages – Possible Attorney fees
- Federal Mark – in 50 States (Monopoly) – Priority over all future users whether or not sales made in other states

Adopting Mark for future Federal Registration

- Selection of mark – capable of registration
- Search prior registrations, other marks – Conflict with existing mark
- Plans for proper use of mark – Evidence “Use in commerce”
- Retention of specimens, records of use in commerce

TRADEMARKS (continued)

Filing Federal Trademark Registration

- Mark Types
 - ☐ Trademark
 - ☐ Service Mark
 - ☐ Certification
 - ☐ Collective
- Manner of Use or intended Use with Goods or Services

Hurdles to Federal Trademark Registration

- Distinctiveness Issue:
Suggestive Marks allowed
- No Likelihood of Confusion –
Issue of Priority and First Use

Trademark Prosecution Process

- Filing with PTO – PTO Office Action; Publication
- Registration, use, renewals proceedings

ITU Filings – Trademark “Reservations”

- Filing with PTO – Trademark Application for Registration Based on Bona Fide Intent to Use Mark
- Registration - Priority from original ITU Filing Date

COPYRIGHTS

What is a copyright?

- Copyright: Federal protection to authors of "original works"
- Arises automatically on creation – lasts author's life + 70 yrs
- Protection available to published and unpublished works.

Owner has exclusive rights to:

- Reproduce copies and prepare derivative works
- Distribute, sell, transfer, rent, leave or lend copies of work
- Perform a display of musical, dramatic and other art work

Owner is author, or employer who is treated as author

- Independent author can transfer copyright by "work for hire" agreement (also changes duration) or assignment of copyright

COPYRIGHTS (continued)

What works are protected?

Copyright protects "*original works of authorship*" that are fixed in a tangible form of expression

- Literary, musical, dramatic work
- Pictorial, graphic, and sculptural works
- Motion pictures, sound recordings
- Architectural works

What works are not protected by Copyright?

- Titles, names, short phrases, and slogans
- Mere listings of ingredients or contents with no original authorship
- Ideas, procedures, methods, concepts

COPYRIGHTS: Registration and Special Deposits

Advantages of Copyright Registration

- Establishes public record necessary for suit
- Evidences of validity & facts stated if filed within 5 yrs of publication
- Statutory damages and attorney's fees available if registration is made within 3 months after publication of the work
- Protection against the importation of infringing copies.

Various Forms /Special deposit requirements

- For online works: Form TX (text), VA (pictorial, graphics), PA (audio/visual)
- Trade secret protections for software: filing object code/blocked source code

Prosecution, Fair Use rights and Defenses to Copyright

- Need to show access to work and similarity to author's works
- Fair use views purpose, scope, effect, defense include inadvertance, laches

Thank You!

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