Trademarks and Copyrights for Non-Profits

Rick McMurtry, Assistant General Counsel
Carly Regan, Corporate Legal Manager
Turner Broadcasting System, Inc.
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

<table>
<thead>
<tr>
<th>Word Marks</th>
<th>Non-Traditional Marks</th>
<th>Slogans</th>
</tr>
</thead>
<tbody>
<tr>
<td>CALVIN KLEIN</td>
<td></td>
<td>I’m lovin’ it.</td>
</tr>
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<table>
<thead>
<tr>
<th>Composite Marks</th>
<th>Logos, Design Marks or Stylized Marks</th>
</tr>
</thead>
<tbody>
<tr>
<td>STARBUCKS COFFEE</td>
<td>American Idol</td>
</tr>
<tr>
<td></td>
<td>Target</td>
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</table>
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](http://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

![World News](world-news.png) ![Coppertone](coppertone.png) ![Dove](dove.png) ![EXXON](exxon.png)

less distinctive | more distinctive
Brand Selection

- S&P and Commercial Impression Considerations
<table>
<thead>
<tr>
<th>Factors We Consider – Legal Analysis</th>
</tr>
</thead>
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<tr>
<td><strong>Infringement</strong></td>
</tr>
<tr>
<td>“Confusingly Similar” Mark in use</td>
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</tbody>
</table>

### Risk
- Injunction
- Damages
- Destroy Materials
- Rebrand Expense
- PR Nightmare

<table>
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<th>Registrability</th>
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<tr>
<td>“Confusingly Similar” Mark on register</td>
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<tr>
<td>Descriptive</td>
</tr>
<tr>
<td>Generic</td>
</tr>
</tbody>
</table>

### 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
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
- Trademark Rights
- 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 ™ 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