

I. Copyright

A. General.

1. What is it?

- Protection for the expression of ideas. Ideas are not protectable, but the way you express them is.
- Clients often come to me and say I have this idea can I protect it? The answer is no, not until you fix it in some way.
- Once a work is fixed, it is protected by federal Copyright.
- No common law or state protection – federal only.
- **Work must be fixed in a tangible medium.**
- **Must be original** – low level of scrutiny – new to the author, not the world.
- **Must be an expression.** Others can use the same ideas, but express them differently – idea of superhero story not protectable, but the way of telling the story, plot lines, characters, etc. are.
- If you create something, put a copyright notice on it.
- Still need to get a federal registration to have the ability to enforce your copyright against others. Can only sue in federal court. Entitles you to:
 - Rebuttable presumption of validity;
 - statutory damages (\$750 - \$30,000; increases to \$150,000 if willful) and only if infringement occurs before registration.
 - attorneys' fees for the prevailing party at court's discretion.
- Duration of protection
 - General rule - individual author – life + 70
 - joint works – life of last surviving author + 70
 - Work Made for Hire, anonymous, pseudonymous – 120 from creation, or 95 from 1st publication – whichever shorter.

B. What is protected?

1. Literary works
2. Musical works – musical compositions; what you see on paper, written melody, lyrics, etc.
3. Dramatic works – plays, screen plays, etc.
4. Pantomimes and choreographic works – routines.
5. Pictorial, graphic and sculptural works – maps, sculptures.
6. Motion pictures and audio visual works.
7. Sound recordings - what you hear
8. Architectural works – buildings and architectural plans/drawings.
9. Derivative works – works based on 1 or more preexisting works that are recast, transformed, or adapted.
10. Compilations

C. What do you get as the copyright owner – bundle of 6 rights:

1. Public performance
2. Public display
3. Reproduction
4. Adaptation

5. Public distribution
6. Digital transformation

D. How do you get a federal registration?

1. Apply online - \$65 for single work.
2. Enter author(s), type of work, claimant/owner;
3. Submit a copy as a deposit
4. 6-8 month turnaround.
 - Can be expedited with special handling for certain circumstances:
 - Pending or prospective litigation
 - Customs matters
 - Contract or publishing deadlines
 - \$800 additional fee per application.
 - Usually complete within 1 week.
5. No real substantive review as Copyright Office allows the litigants to determine validity if a dispute arises. The registration is presumed to be valid, but you can overcome the presumption by showing various things:
 - Fraudulent registration
 - Not really the owner – multiple owners
 - Not original

E. Why do you want protection? Exclusivity and money. New revenue streams – Licenses, YouTube, etc.

1. Opportunity to license use of the work to third parties.
2. Client that has copyright protection in videos she puts on YouTube; contract with Sony for right to use clip in a new movie.
3. Online Distribution Agreement with Production and Placement company that will either place existing YouTube content on different channels or produce new content for placement with client.
 - What rights are involved? Name and likeness, copyrights in works;
 - Who owns the rights to the works being distributed;
 - What is the revenue split for the different distribution outlets;
 - merchandise and ancillary revenue; what are splits?

F. Issues We See Locally.

1. Ownership questions and disputes.
 - Ownership of the material object does not always convey ownership of the copyright.
 - The copyright in a work is owned by the author. The author is the party who creates the work, i.e., translates the idea into a fixed, tangible expression entitled to copyright protection.

- AI issue – current position is that the work must be created by a human. Therefore, the works created by AI are not protectible, even if they are created from original and creative prompts from humans. Must distinguish the elements created by AI from those created by a human if both had input on a work.
 - Works Made For Hire – under certain conditions the creator is not the legal author
 - The employer is the owner if the creator is an employee acting within the scope of their employment
 - Multi-factor analysis re whether creator was an employee or an independent contractor
 - If work created by an independent contractor, then they are presumed to be the author. Presumption can be overcome if:
 - A signed writing confirming the work made for hire agreement
 - Work falls into 9 categories:
 - contribution to collective work
 - part of a motion picture or other a/v work
 - translation
 - compilation
 - instructional text
 - test
 - answer material for a test
 - atlas
 - supplementary work
 - If not a work made for hire, then an assignment is needed to transfer ownership.
 - We see this where an artist is hired to create some marketing materials for a business or an event. If there is not an agreement specifying the ownership and transfer of the copyrights, then the artist legally retains ownership and the business may only have an implied license to use the materials (but not any ownership).
 - Joint ownership – Need to determine which author owns what elements of the work, i.e., illustrator and writer.
 - Can get murky when you have a person being interviewed on camera for a documentary and have to account for the contributions of the subject being interviewed, the interviewer, the cameraman, the editor, etc.
2. Duration of Protection. Not hard to determine for works created on or after 1/1/78 under current Copyright Act. It gets trickier when dealing with older works protected before 1/1/78 under the 1909 Copyright Act as this had different requirements for registration, copyright notices and renewals. If they weren't followed, then the work entered the Public Domain.

3. Public Domain Day – January 1 of every year. The date when certain works enter the public domain after their copyright protection expires. On January 1, 2025, copyrighted works from 1929 entered the public domain.
 - <https://web.law.duke.edu/cspd/publicdomainday/2025/>
 - <https://publicdomainreview.org/blog/2025/01/public-domain-day-2025/>
 - Works entering on 1/1/25 include:
 - The Sound and the Fury by William Faulkner
 - A Farewell to Arms by Ernest Hemingway
 - A Room of One's Own by Virginia Woolf
 - Musical composition for 'Singin' in the Rain', lyrics by Arthur Freed, music by Nacio Herb Brown
 - Sound recording for Rhapsody in Blue, recorded by George Gershwin
4. Infringement letters from photographers claiming an image was used without authorization. Some are more legitimate than others (i.e., from Getty images) and others are for copyright trolls.
5. ASCAP / BMI letters re public performance licenses for venues and commercial establishments.
6. DMCA Takedown Notices. Authorized under the Digital Millennium Copyright Act. A means of removing copyrighted content from a website following a request by the copyright owner. Website hosts and web service providers are quick to comply because this allows them to avoid liability for infringement.
 - McDonald's Ice Cream machines. Up until late 2024, the DMCA prevented anyone other than the manufacturer of the machines from fixing them. This is because the DMCA protects the code embedded in the ice cream machines and made it illegal for third parties, like McDonald's employees and franchisee owners, to break the digital locks installed by manufacturers. The new rule allows outside vendors to fix "retail-level commercial food preparation equipment."
7. Infringement – not frequent in our area because most works are not registered prior to infringement.

G. Top Cases from 2024.

II. Trademark.

A. General

1. What is it?

- An indicator as to the source of a particular good/service;
- Integral to any brand; building reputation and goodwill;
- Trademark vs. service mark
- Can be a word, design or combination;
- Can also be a smell (play doh sent owned by Hasbro, Inc.), color, sound (NBC chime, ESPN Sports Center theme; MGM roaring lion), package design and product shape (coke bottle)
- Strong (arbitrary and fanciful) vs. weak (descriptive) marks
- Different than a trade name;

B. How do you protect a trademark.

1. Determine applicable goods/services
2. Common Law
3. State
4. Federal – Lanham Act

C. Process

1. First perform search;
2. State application
3. Federal application
 - Draft – id goods/services, owner, use basis, etc.
 - File
 - Initial review
 - Office Actions
 - Publication
 - Opposition
 - Notice of Allowance
 - Statement of Use
 - Registration
 - Cancellation
 - Maintenance – Declaration of Continued Use; Renewal
 - Foreign Protection

D. Prosecution and Litigation Issues and Practical Applications –

1. Prince example – Warner Bros. initially owned the PRINCE trademark for use in connection with musical records and performances. When they couldn't agree to contract terms, he had to use his Love symbol and be the artist formerly known as Prince until his contract with Warner was done.
2. Priority – first to file or first to use
3. Clearance Issues
4. Craft beer and cocktail industry

5. Cannabis

- The PTO is currently refusing to register marks for use on cannabis and any other goods and services that violate the Controlled Substances Act (CSA). Under the CSA, it is unlawful to sell, offer for sale, or use any facility of interstate commerce to transport drug paraphernalia, i.e., “any equipment, product, or material of any kind which is primarily intended or designed for use in manufacturing, compounding, converting, concealing, producing, processing, preparing, injecting, ingesting, inhaling, or otherwise introducing into the human body a controlled substance, possession of which is unlawful under the CSA.” References to cannabis are acceptable though; in fact, there are currently at least hundreds of live, registered marks used in connection with goods/services relating to cannabis.
- State filing in a state that has legalized it. Must be in use to file.
- Fed filing for related goods/services;

6. Trademark bullying;

7. Disparaging marks - Washington Redskins;

E. Issues We See Locally.

1. Assignments, or lack of assignments, during asset sales.
2. Trademark filing solicitation scams.
3. Amazon Brand Registry enforcement and takedown notices.
4. Very descriptive marks that are difficult to protect.

F. Top cases from 2024

G. Most valuable brands.

1. Apple - \$482B
2. Microsoft - \$278B
3. Amazon - \$275B
4. Google - \$252B
5. Walmart - \$112B