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Office of General Counsel

Copyright and Trademark

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Four Types of Intellectual Property

- Patents (inventions, discoveries, plants)
- Trade Secrets (non-public formulas, processes, etc.)
- Copyrights (novels, paintings, photographs, movies, songs, presentations, etc.)
- Trademarks (distinct names, logos, symbols, non-functional packaging)



TRADEMARKS

Trademarks

- What is a trademark?
 - Any name, word, symbol or device
 - Indicates the source or origin of a good/service
 - And is capable of distinguishing those goods or services from those of other suppliers.
- Goals of Trademark law
 - Knowledge of source and quality of goods/services
 - Avoid consumer confusion.
- Trademark law is both state (Minn. Stat. 333.18) and federal (Lanham Act) law.

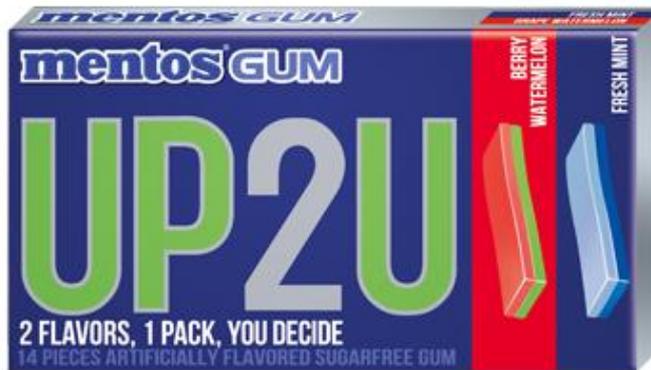
Trademark Registration

- Can register with the Minnesota Secretary of State and/or the US Patent and Trademark Office
- State Registration offers limited protection but is quick and inexpensive (\$50-\$70)
- Federal Registration offers more protection against infringement (and nationwide priority) but is time consuming and more expensive (\$275-\$425/class of good).

Requirements for Trademark Registration

- Mark must be unique
- Mark must already be in use in interstate commerce
- Must be distinctive (fanciful, arbitrary)
 - Not descriptive or geographic
- Or have acquired secondary meaning
- Can be a single letter, word, group of words, slogan, numbers, acronym, or drawing.
- Can also be a color, a sound, or the shape of a package.

Trademarks Are Specific to a Class of Goods or Services



*A unique partnership between M State and MSU Moorhead
that reduces tuition costs and supports degree completion.*

M | State

M MOORHEAD

Registering System Marks

- Decide what you want registered
 - Just the logo
 - Just the words
 - Words and logo together
 - All three?
 - Color or Black and White?
- Decide what classes of service
 - 041 Educational Services
 - 025 Clothing
 - Others
- Contact OGC with
 - Specimen of the mark on its own and samples in use
 - Date of first use
 - Contact name/address



Hennepin Technical College



DAKOTA COUNTY
TECHNICAL COLLEGE



“Ready or Not Math”

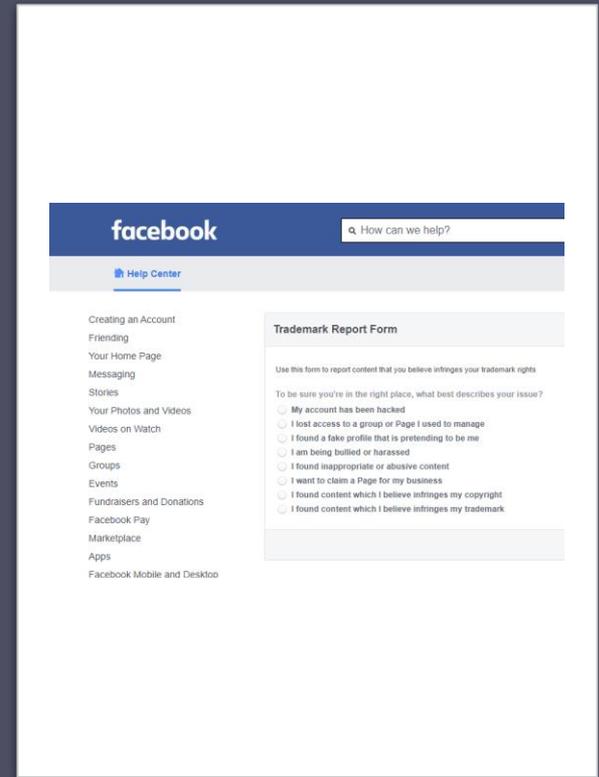
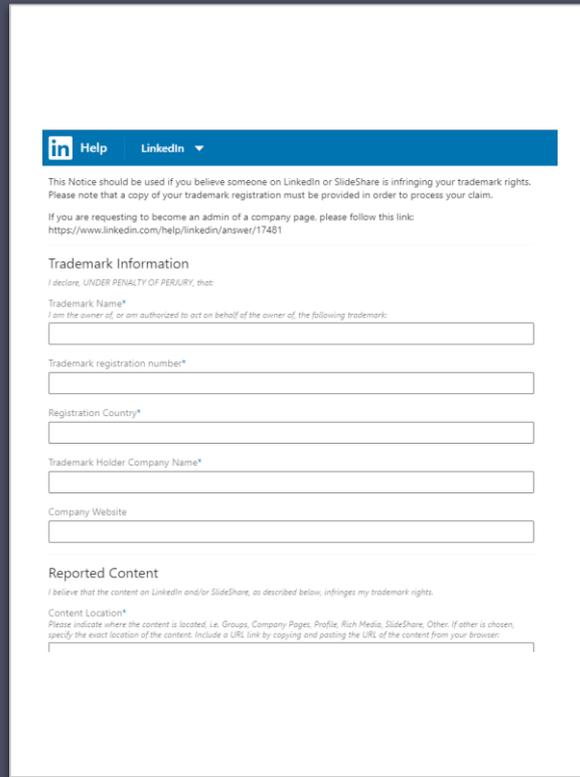
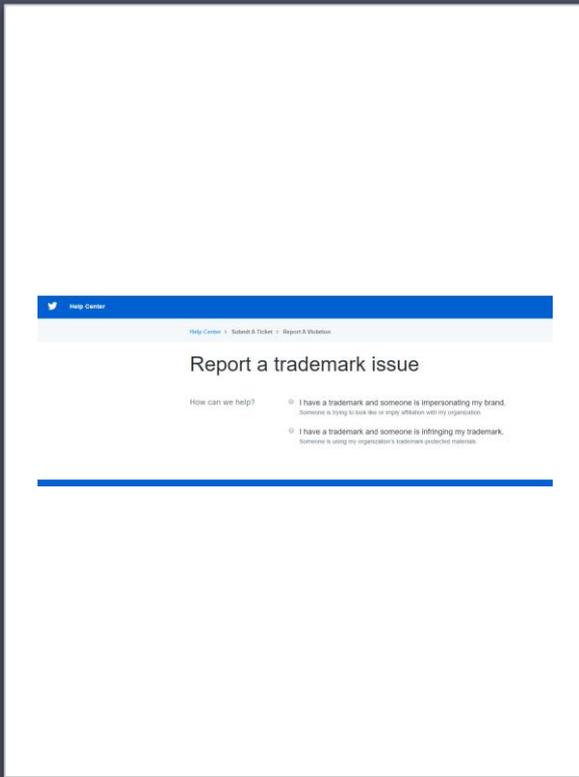
Registering System Marks

- What you register has to be in use
 - Or you can file an “intent to use” application but it nearly doubles your cost
- And remain in use when you renew in 5 years
 - Must file affidavits of use every 5 years and pay renewal fees
- Small changes require registration of a new mark



Why Register?

- Priority for a mark is determined by date of first use, but only in your geographic area
- Federal registration gives you constructive nationwide priority
 - Would prevent another “Century College” from using the mark in California
- Allows additional damages and attorneys fees if you prevail in an infringement action
- Given priority in domain name disputes before ICANN

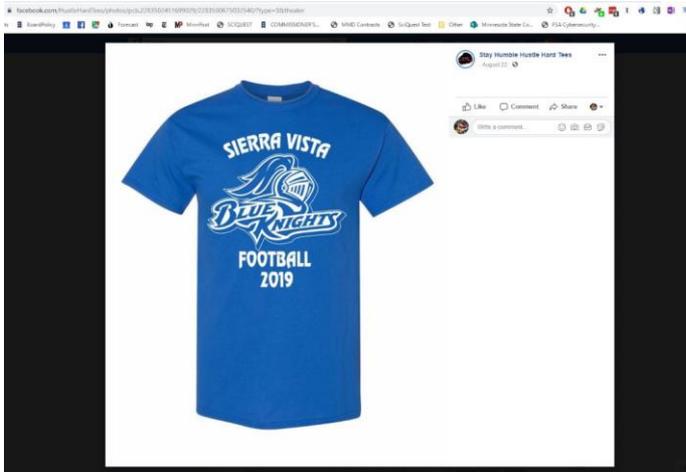


Why Register?

Easiest way to get infringing social media pages removed.

Protecting Your Marks

- You may use TM or SM for unregistered marks
- Once federally registered: use [®]
- OGC can send cease-and-desist and walk you through take-down procedures.



Re: Cease and Desist | Blue Knights

o McGee, Sarah A
:c Hegman, Liz

Ms McGee,

First let me say I apologize and will remove everything ASAP. I had no idea that design belonged to anyone. A customer came to me with it and I did not research where it came from. I was just happy to get the business from a local youth football league and did it. Lesson learned on part. Thanks for not taking legal action and giving me a chance. May I asked how you found it on my little facebook page though. Just curious. Thanks

On Fri, Sep 6, 2019 at 1:18 PM McGee, Sarah A <Sarah.McGee@minnstate.edu> wrote:

Please see the attached correspondence regarding the Blue Knights trademark. Thank you.

Prevention: Choose Unique Marks!

- Important for tag lines, program names, or other prominent uses
- Search Google and the USPTO website (TESS)
- Make sure Trademark clearance is included in third party design contracts
- Do not limit your search to identical marks but anything that could cause “confusion”
- Even if not sued for infringement, changes can be costly





COPYRIGHTS

Copyright

- **What is a copyright?**
 - The exclusive legal right to publish, print, perform, sing, record, literary, artistic, or musical material
 - Includes the right to authorize others to do the same
- **Protects only the fixed expression of original ideas**
 - “Captured in a sufficiently permanent medium such that the work can be perceived, reproduced, or communicated for more than a short time.”
- **Goals of Copyright Law**
 - Balance the interests of creators with that of the public
 - Encourages the sharing and access of work by creating limited exclusive rights
- **Federal Copyright Act**
 - Copyright automatically exists upon creation of work, but registration provides additional benefits

What Type of Works Are Eligible?

- Literary works (words, numbers, or other symbols regardless of the media, includes computer programs)
- Musical works (and accompanying lyrics)
- Dramatic works (and accompanying music)
- Choreographic works
- Pictorial, graphic and sculptural works (includes maps)
- Audiovisual works (motion pictures and television)
- Sound recordings (whether musical, spoken or other sounds)
- Architectural works
- Compilations (assembling select preexisting materials in a way that the resulting work as a whole is an original work of authorship)

What Type of Works Are Not Eligible?

- Ideas, procedures, methods, systems, processes, principles or discoveries
- Titles, personal or business names, short phrases, slogans, domain names
- Mere listing of ingredients or contents or simple set of directions
Works not fixed in a tangible form (improvisation or other live events not recorded)
- Typeface, fonts, layout or design
- Blank forms (scorecards, graph paper, diaries, calendars, rulers)
- Familiar symbols (punctuation, common patterns, peace sign and gender signs, hazard symbols, religious symbols)
- Duplications of public domain works
- Federal government works

Who Owns The Copyright?

- The author who created the work.
- Two authors are joint owners with an indivisible interest in the whole if they:
 - Created a single work with the intent to merge their contributions into inseparable or interdependent parts of a unitary whole (versus a collective work, where each author's contribution is separate and distinct from the ownership in the collective work as a whole)
- The employer or contractor if the work is a “work made for hire.”
 - Made as part of employee's regular duties or
 - If contractor, entered into an express, written agreement to consider the work as a “work made for hire” and it is an eligible work (collective work, audiovisual work, a compilation, instructional text, etc.)
- A third party upon assignment.
 - If using a contractor and the work will not fall into one of the enumerated categories eligible for “work for hire”, must get an assignment (e.g., website design, photography, custom software) to ensure ownership.

What's Included in a Copyright?

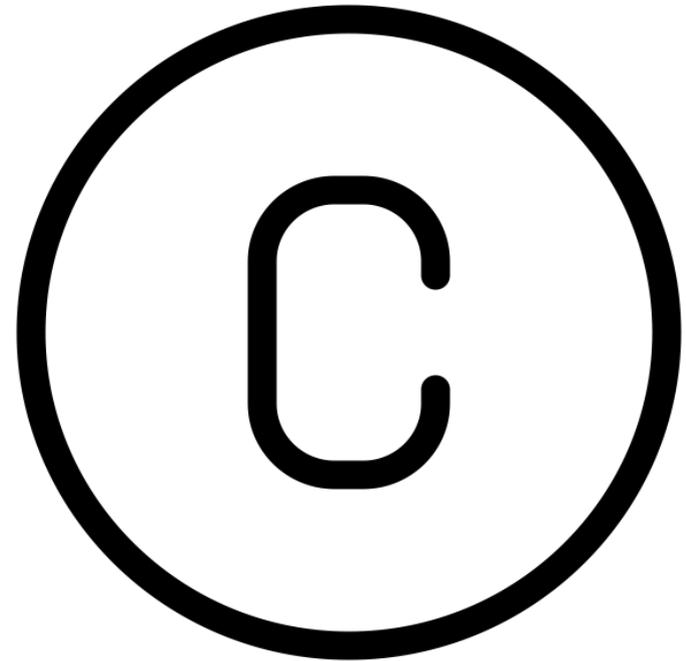
- A bundle of rights:
 - Reproduction
 - Derivative works
 - First distribution by sale or other transfer
 - Public performance
 - Public display
 - Action for infringement

Copyright Registration

- A copyright exists as soon as a creative work is fixed in a tangible medium, but registration provides additional advantages
 - Ability to file a lawsuit for infringement
 - Eligibility for statutory damages
- <https://www.copyright.gov/registration/>
- Length of term? It depends
 - No renewal required
 - Life of author + 70 years
 - May be different for older or anonymous works
 - <http://copyright.cornell.edu/resources/docs/copyright2014.pdf>
- Anything before 1924 is public domain (1925 in 2020)

Copyright Notice

- Use © notice even if not registered
- A copyright notice is a statement placed on copies of a work to inform the public the owner is claiming ownership.
 - The © symbol, the word Copyright, or the abbreviation “Copr.”
 - The year of first publication of the work
 - The name of the copyright owner (or an abbreviation or other generally known alternative designation)
- Optional after March 1, 1989
 - But prevents “innocent infringer” defense
 - Allows others to seek permission from the owner



Created by icon 54
from Noun Project

- Copyright by icon 54 from the Noun Project

Minnesota State IP Policies

- Policy 3.26 – Intellectual Property
 - Describes the ownership of institutional works, scholarly works, personal works and student works, and how the ownership can be modified by agreement
- Policy 3.27 – Copyrights
 - Must Register Prior to Commercialization
 - “A copyright notice shall be placed on college, university, and system owned materials that will be made available to the public. The date in the notice shall be the year in which the materials are first published.”
- Procedure 3.27.1 Copyright Clearance.
 - **Employees and students are responsible for clearing copyright of materials before use.**

Copyright Clearance

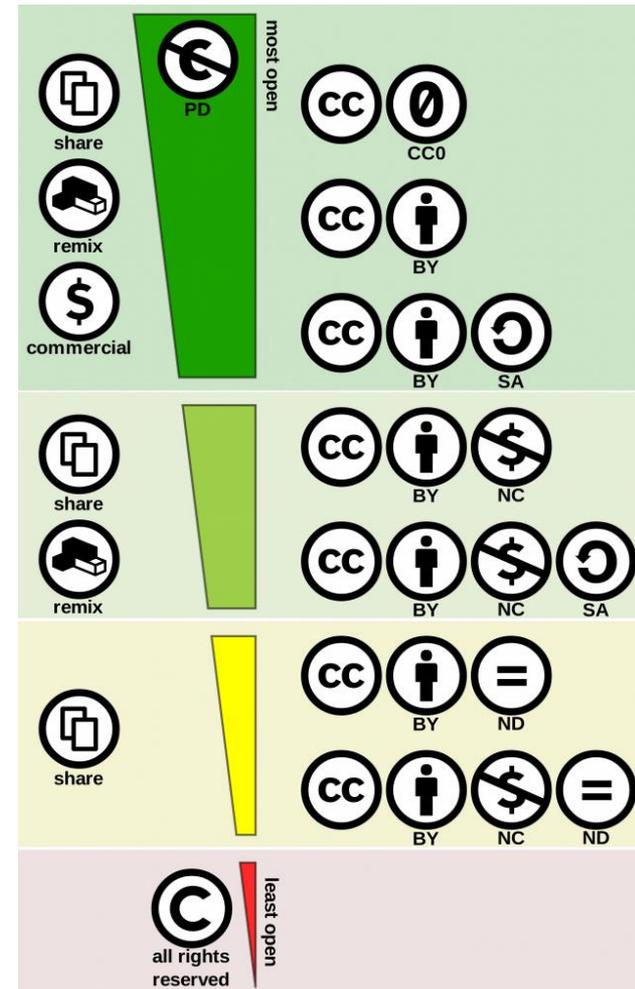
- The act or process by which a person ensures a proposed use of materials is in compliance with copyright law. The act or process involves **obtaining permission** from the copyright owner, **conducting a fair use** analysis, and/or **determining** that the materials are in the **public domain** or are not eligible for protection under copyright laws.

Obtain Permission

- To use copyrighted materials of others you must have permission.
- Formal permission is called a “license,” which is a type of legal agreement.
- You generally need to contact the publisher of the work
 - ASCAP, BMI or SESAC for music
 - Penguin Random House
- Or find a “stock” photo/video/music company that sells works with a license included
 - E.g., Marmoset music, Getty images, iStockphoto
- **Attribution is not a substitute for permission**

Creative Commons is a Type of Permission

- Creative Commons is a type of license that the creator has applied to the work in advance.
- Many platforms allow you to search for creative-commons licensed materials (Flickr, YouTube)
- Types of Licenses
 - CC: Creative Commons
 - CC0: Public Domain
 - BY: Attribution Required
 - NC: Non-Commercial
 - SA: Share Alike
 - ND: No Derivatives



Creative Commons License Spectrum" by [Shaddim](#) (CC BY)

Or Determine Fair Use

- Certain limited use of copyrighted materials for teaching, criticism, commentary, reporting, scholarship, and research is considered a "fair use" and does not constitute an infringement of copyright. The law sets forth the following four factors to be used in determining whether a particular use is a fair use:
 - The purpose and character of the use, including whether such use is of a commercial nature;
 - The nature of the copyrighted work;
 - The amount and substantiality of the portion used in relation to the copyrighted work as a whole;
 - The effect of the use upon the potential market for, or value of, the copyrighted work.
- What constitutes fair use is never a bright line
- Checklist here:
https://www.minnstate.edu/system/asa/academicaffairs/policy/copyright/docs/Fair_Use_Checklist1.pdf

Other Fair Use Exemptions

- Classroom Use Exemption
 - Allows multiple copies for in person classroom use if it meets a test for brevity/spontaneity, the cumulative effect test, and includes a © Notice
- TEACH Act
 - Allows some transmission of film, vide, non-dramatic works in online classroom setting.

Or Determine Material is Not Eligible for a Copyright

- Published before this date in 1924
- Published by the Federal Government or any Federal agency
- Books published between 1924 and Jan 1, 1964 that did not renew their copyright
- Copyright disclaimed
 - e.g., Wikimedia commons, CC0
- Certain works not protected
 - Short phrases (most titles!), facts, theories, recipes, lists, names, blank forms, familiar symbols,

Be Careful What You Post

- If you have not cleared a copyright, the owner may find the material and bring a lawsuit for infringement (or demand a large settlement in lieu of the suit).
- This applies to all media everywhere.
 - Photos on a website
 - Photos embedded in a conference talk in a PDF on the conference host's website
 - On Twitter (as tweets or retweets) or any other Social Media
 - Songs in Videos uploaded to YouTube

Be Careful What You Post

- Cease-and-Desist Letters and \$\$\$ Demands Received for:
 - Stock photos posted in a carousel on study abroad website
 - Students who posted a stock photo in a story broadcast on student TV station
 - Students created an e-commerce website to sell swimsuits for a class project and used stock photo images
 - Faculty included a photo from Google images in a presentation given at multiple conferences and uploaded to many sites across the web
 - Program hosted on campus radio station had unlicensed stock photo on website

Don't Feed the Trolls

- A copyright troll is a party (person or company) that enforces copyrights it owns for purposes of making money through litigation, in a manner considered unduly aggressive or opportunistic, generally without producing or licensing the works it owns for paid distribution.
- Critics object to the activity because they believe it does not encourage the production of creative works, but instead makes money through the inequities and unintended consequences of high statutory damages provisions in copyright laws intended to encourage creation of such works.

Your Tweet Could Cost You

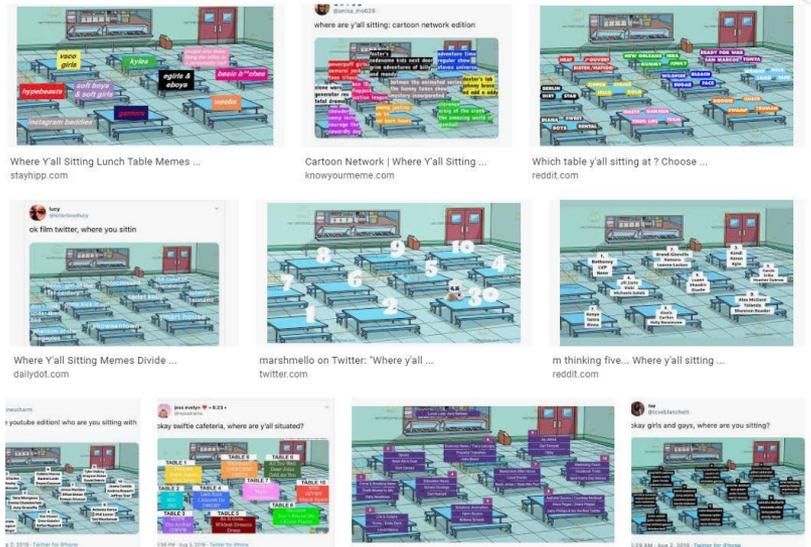
- Coaches and sports teams' twitter accounts posted a passage from a sports psychology book without permission or attribution.
- They also re-tweeted other tweets with the same passage embedded.
- The author sued a local school district for copyright infringement and they paid

The screenshot shows a news article from the Pioneer Press website. The article title is "Rosemount school district to pay author \$40,000 for unauthorized sports tweets". The author is Josh Verges. The article text states that three tweets and a retweet cost the Rosemount-Eagan-Apple Valley school district \$40,000. It also mentions that the district agreed to pay Texas sports psychologist and author Keith Bell last month to resolve a copyright infringement lawsuit in U.S. District Court in Minnesota. A "MOST POPULAR" sidebar on the right lists "1. Man charged with stabbing of whose body".

<https://www.twincities.com/2018/10/03/rosemount-school-district-to-pay-author-40000-for-unauthorized-sports-tweets/>

That Meme Could Cost You

- Summer of 2019 “Where Y’all Sittin” Meme went viral
- Underlying image was from a stock cartoon site with watermarks
- One of our athletic teams tweeted out a version of this meme
- The cartoon company’s lawyer demanded \$8,000 for a retroactive license



The CASE Act

- Copyright Alternative in Small-Claims Enforcement Act of 2019
- Establishes a voluntary out-of-court tribunal under the Copyright Office to handle “small claims,” with no attorney required.
- The tribunal, made up of experienced copyright lawyers, can award damages of up to \$15,000 for misuse of one copyrighted work and \$30,000 for misuse of two or more works
- Passed the House overwhelmingly (October 2019); awaiting a vote in the Senate
- Because it is voluntary and does not have fee-shifting of FCA lawsuit, copyright “trolls” will continue to exist

CONTACT US FOR HELP!

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