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LEGALARTLINK

Intellectual Property Basics for Artists

Webinar 4 with Locust Projects' LegalARTLink Director Allyn Ginns Ayers

Tuesday, September 22 | 2PM ET

Via Zoom

EMPOWER YOUR CAREER.



ABOUT LEGALARTLINK

- Provides pro bono legal assistance and information to South Florida artists of all disciplines with the aim of empowering artists' careers.
- Locust Projects is currently waiving its membership requirement in order to assist artists through December 31, 2020.
- If you have a particular issue you are facing, please fill out the online form on the website or email:

legallink@locustprojects.org | [Click here for Artist Form](#)

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THE FINE PRINT

- The materials and information provided during this webinar are for informational purposes only. They are not intended to provide a legal opinion or constitute legal advice, which must be tailored to the facts of a particular situation.
- Due to regular changes in law and agency policy, the information provided during this webinar may not contain the most up-to-date legal or other information.
- Use of and access to this webinar does not create an attorney-client relationship between you and the provider. You should consult an attorney for legal advice relating to any particular issue or problem.

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WEBINAR PURPOSE

- This may be a good time for artists to consider their IP and develop a protection plan
- Webinar aims to:
 - Inform about different kinds of IP that may apply to your work
 - Provide information about how to take steps to secure protection

WHAT IS INTELLECTUAL PROPERTY?

- **WHAT IS PROPERTY?**
- **TYPES OF PROPERTY**
 - Real property (land, buildings, and other improvements)
 - Personal property (physical possessions)
 - Intellectual property (creations, inventions, information)

TYPES OF INTELLECTUAL PROPERTY

- **TRADE SECRETS:** information that confers a business advantage, when effort is made to keep the information secret
- **PATENTS:** new and nonobvious (1) nonfunctional designs and (2) useful inventions
- **TRADEMARKS:** words, symbols, and other perceivable features that identify the source of goods and services
- **COPYRIGHT:** original creative works once embodied in a perceivable form

TRADE SECRETS

- Variety of material that confers a business advantage, which cannot be discovered by legitimate means, and which is subject to reasonable efforts in order to keep it secret
- Examples:
 - Proprietary formulas and recipes (KFC or Coca Cola recipe)
 - Systems (search algorithm)
 - Aggregated information (client or vendor contact lists)
- Trade secrets do NOT include:
 - Publicly available information
 - Information capable of reverse engineering
 - Independent discovery of the same information
- Trade secrets are intended to protect fair trade interests

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TRADE SECRETS

- In order to qualify as a trade secret, there must be reasonable efforts to keep the information secret
- No bright line rule on what are reasonable measures
- Measures can include:
 - Confidentiality and nondisclosure agreements
 - Marking documents and information as confidential
 - Limiting access to information constituting a trade secret
 - Train employees who handle confidential information

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TRADE SECRETS

- **MISAPPROPRIATION:** improper use or disclosure of a trade secret
- **REMEDIES**
 - **Injunction:** Courts can order someone to stop using or prevent them from publishing trade secrets.
 - **Damages:** Courts can order wrongdoer to pay for economic harm or pay a royalty. If wrongdoer acted maliciously, court can order them to pay punitive damages.

TRADE SECRETS

- **TAKEAWAYS**

- Used for confidential information that gives you a competitive edge
- Do not have to register, but have to take steps to keep secret
- Confidentiality and non-disclosure agreements may not be sufficient but are important to establish reasonable secrecy measures

PATENTS

- Government-granted limited-term property interest for inventions
- Right to exclude others from making, using, offering for sale, selling, or importing the invention
- Limited monopoly to incentivize and reward innovation
- As of 2013, “first to file” system

PATENTS

- All patents must be 1) **new** and 2) **nonobvious**
- **NEW**
 - Cannot have been described in a printed publication, or in public use, on sale, or otherwise available to the public before the application is filed
 - Requires a public art search
- **NONOBVIOUS**
 - Even if not exactly shown in prior art, cannot patent an obvious adaptation or use of the preexisting invention

PATENTS

- **THREE TYPES OF PATENTS**

- **Design:** new, original ornamental design for an article of manufacture
- **Utility:** new and useful process, machine, article of manufacture, or composition of matter, or new and useful improvement
- **Plant:** distinct and new asexually reproducing variety of plant

PATENTS

- **DESIGN PATENTS**

- Protect the way a physical product looks: nonfunctional shape/configuration, surface ornamentation, or both
- 15 years from the date of the grant
- USPTO fees range from \$240 – 960 based on the size of the entity (does not include attorney fees)

PATENTS

- **UTILITY PATENTS**

- Protect the way an article works
- 20 years from date of filing
- USPTO fees range from \$350 – 1,420+ based on the size of the entity (does not include attorney fees)

PATENTS

- **APPLYING FOR PATENT PROTECTION**

- Patents are issued by the United States Patent and Trademark Office (USPTO)
- Process involves prior art search, preparing application documents and drawings
- Application is highly technical and using a patent agent (non-attorney certified to prosecute patent applications) or patent attorney is recommended, although not explicitly required
- Registered patents may use the ® mark; provisional patent applicants may use “Patent Pending”

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PATENTS

- **PATENT INFRINGEMENT:** making, using, offering for sale, selling, or importing a patented invention without permission
- **Remedies:**
 - **Injunction** – Court can order the infringer to stop infringing the patent
 - **Monetary damages** – lost profits, established royalties, or reasonable royalties (if willful infringement, treble damages)
 - **Attorneys' fees** – pay for the patent owner's legal fees in bringing the case
 - **Seizure, destruction, and impoundment of the infringing goods**

PATENTS

- **TAKEAWAYS**

- Use for new useful inventions or nonfunctional designs to prevent others from marketing the same items for a limited amount of time
- Only have protection if filed
- Can be very expensive to obtain and probably need a specialized attorney

TRADEMARKS

- **WHAT IS A TRADEMARK?**

- Word, symbol, or other perceivable feature that identifies the source of goods or services – think brand names or logos
- Trademark = goods; service mark = services
- Mark must be used to designate source, not as ornamentation or decoration
- Trademarks are intended to protect consumers
- Common law, state, and federal registration

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TRADEMARKS

- **STRENGTH OF MARK**

- Fanciful/arbitrary
- Suggestive
- Descriptive
- Generic

TRADEMARKS

- **COMMON LAW RIGHTS**

- Rights obtained by use within a geographic area – registration not required
- Can be superior to registration, but limited to areas where mark was actually used
- Can use the TM symbol to assert trademark
- Use of name as business name does not necessarily create trademark rights – must use the mark to designate the source of goods or services

- **STATE LAW RIGHTS**

- States provide registration that gives rights within the state
- In Florida, fee is \$87.50 per class

TRADEMARKS

- **FEDERAL REGISTRATION BENEFITS**

- Presumption of ownership and exclusive right to use the mark nationwide
- Public notice of ownership of mark
- Listing in USPTO database
- Can record mark with US Customs and Border Protection to prevent importation of infringing goods
- Use of federal registration symbol: ®
- Bring infringement action in federal court
- US registration as basis to obtain foreign registration

TRADEMARKS

- FEDERAL REGISTRATION

- Register online via [Trademark Electronic Application System](#)
- Register per “class” of goods (e.g., clothing, toys and sporting goods, and entertainment services)
- Filing fee of \$225-275 per class depending on type of application
- Must file maintenance documents affirming continuous use and pay fees

TRADEMARKS

- **TRADEMARK INFRINGEMENT:** use of a valid mark, or a similar mark, which would be likely to cause consumer confusion about the source of a good or service
- **REMEDIES:**
 - Injunction
 - Money Damages
 - Attorneys' fees in exceptional cases

TRADEMARKS

- **TAKEAWAYS**

- Useful when you have a specific name or logo used to identify goods or services that you market
- Can prevent others from using same or similar mark in a confusing manner
- Obtain rights through use, but registration may confer benefits

COPYRIGHT

- IP granted to creators of **works of authorship**:
 - Visual Art
 - Literary Works
 - Sound Recordings
 - Audiovisual Works
 - Dramatic Works
 - Choreographic Works
 - Architectural Works
- Intended to incentivize creative expression

COPYRIGHT

- **EXCLUSIVE RIGHTS**

- Copy the work
- Distribute the work through sales
- Perform and display the work publicly
- Make derivative works (adaptations) based on the work

- Copyright ownership exists once the work is created in a tangible means of expression

- Copyright protection lasts for the life of the author plus 70 years

COPYRIGHT

- **AUTHORSHIP**

- Copyright ownership vests initially with the “author” or creator of the work
- Works Made for Hire
- Joint Authorship

COPYRIGHT

- **REGISTRATION BENEFITS**

- Necessary to file a copyright infringement lawsuit
- Evidence of validity of copyright
- Eligible for statutory damages, attorneys' fees, and costs
- Register with US Customs and Border Patrol to prevent importation of infringing copies

COPYRIGHT

- **HOW TO REGISTER**

- Register online using [Copyright Office Electronic Registration System](#)
- Fees of \$45-65 per work
- Relatively easy to do on own, but consultation with attorney is still recommended

COPYRIGHT

- **COPYRIGHT INFRINGEMENT:** exercise of one of the exclusive rights of copyright ownership without permission of the copyright owner
- **Remedies:**
 - Injunction
 - Impounding and destruction of infringing items
 - Damages
 - Actual damages and infringer profits; or
 - Statutory damages (\$750-30,000 or up to \$150,000 for willful infringement)
 - Attorneys' fees and costs (if timely registered)

COPYRIGHT

- **FAIR USE:** a defense to copyright infringement meant to balance First Amendment expression with copyright protection; generally applicable to commentary, criticism, parody, news reporting, research, and scholarship
- **Four Factor Test:**
 - Purpose and character of the use
 - Nature of the copyrighted work
 - Amount and substantiality of the portion used in relation to the copyrighted work as a whole
 - Effect of the use on the potential market for or value of the copyrighted work

COPYRIGHT

- **TAKEAWAYS**

- If you are making creative works, you are definitely a copyright owner
- Check your contracts for clauses relating to ownership
- While you don't need to register your works to own copyright, it can provide a lot of protection in the event of infringement and is relatively inexpensive

Q&A

**Please ask questions in the chat
or email them to legallink@locustprojects.org**