

SAEGIS is an entire suite of services provided by Thomson & Thomson that allows online worldwide trademark searching as well as searching of domain name registries and websites to locate common law uses of proposed marks

TRADEMARKCOM is an online search service offered by Micro Patent LLC, offering a variety of searchable databases, including federal marks, and common law uses of potentially conflicting marks

LEXIS and WESTLAW, the computer-assisted research system, offer access to vast trademark databases that may disclose potentially conflicting marks

Many law firms subscribe to one or more of these services so they can perform an initial screening search in-house

PTO Web Site : Perhaps the easiest and least expensive way to conduct a very preliminary search is to review the records of the PTO (<http://www.uspto.gov>) and its free public searching called **Trademark Electronic Search System (TESS)**

Step Two: The Comprehensive Search

A separate professional trademark search firm is existing for the companies when their need of searching the trademark. These companies review the records of the PTO (go through existing and pending application), review state trademark office records for state trademark registration, and they perform a "common law" search of various journals, directories, press releases, domain names and Internet references to locate unregistered names and marks.

These professional search firms can save considerable time and money and more importantly, provide a more thorough search than that which an individual can conduct on his or her own, they also check for identical and phonetically equivalent marks for similar goods and services and will also check for foreign equivalents.

They will charge for the searching of the marks The report is typically divided into three sections: results gained from reviewing PTO registrations and applications; results gained from reviewing state trademark records; and the common law results

TRADEMARK REGISTRATION PROCESSES

Preparing the application

Once a mark has been selected and evaluated for use and registrability, an application for federal registration of the /mark should be prepared and filed

- An application is provided by PTO
 - The name of the applicant
 - The citizenship of the applicant
 - The address of the applicant
 - The address of the applicant
 - An identification of the goods and or services offered under the mark
 - A drawing of the mark
 - A verification or declaration signed by the applicant or agent or attorney
- The application is based on actual use of the mark or the owner's intent to use the mark

- The process of moving an application through the PTO is called prosecution [(law) the institution and conduct of legal proceedings against a defendant for criminal behavior]
- The application must be in English
- Electronically filed application are provided by the PTO
- Self application is also be prepared as the letter size (namely 8 ½ inches by 11 inches) paper, typewriter, double-spaced, with margins of at least 1 ½ inches at the left and top of the pages
- The application should be written on only one side of the paper
- The filing and prosecution of trademark application are governed by the TMEP [Trademark Manual of Examination Procedure]
- The PTO introduced on electronic filing system in 1998
- The Trademark Electronic Application System [TEAS] Permits applicants to file numerous documents electronically
- PTO considers the electronically filed document after transmission

The applicant

The mark can be made only by the owner of the mark or, in the case of intent -to-use application, by a person who has a bonafide to use the mark in commerce

Application may be natural persons or business entities such as corporation, partnership, association, unions or other organization

Government entities such as nations, states municipalities and other governmental bodies

- The applicant name must be in correct legal form
- A mark should be identified in the application by the name set forth in its articles of incorporation

- Clients often make mistakes in their corporate names or in the punctuation
- The certificate of registration will issue in the name of the application as set forth in the application
- If the application is a person or business that conducts business under a fictitious [fake] business name, the application will be rejected
- The applicant is a partnership **For example:** “Balboa Gardens Partnership”, the application should be made by the partnership itself and the state in which the partnership was organized
- A trademark or service mark application is usually filed in the name of one party
- The PTO has been reluctant [unwilling] to accept application by joint applicants

- A joint venture or a partnership cannot be joint applicants

Identification of Goods or Services

The application must identify the goods and/or services offered or to be offered under the mark that is the subject of the application Careful consideration must be given to drafting this part of the application Goods and services are categorized by the PTO into forty-five separate classes, called

International Classes because many other nations use this same classification system established by WIPO Until 1973, the PTO used a different classification scheme, called the United States Classification Scheme Each class requires a filing fee of \$335

A detailed listing of the International Classes with numerous examples is found in Chapter 1400 of

TMEP, available on the PTO's web site If a mark is used for more than one class of goods or services, the applicant may either file a combined application, listing all of the goods and services Some attorneys prefer to file separate application believing that a defect in regard to one class of goods or services in a combined application will hold up registration for the mark in all class.

The PTO requires that the identification of goods or services be as clear, accurate and concise as possible Once the application filed, no other item can be added in the process of registration, a separate application should be applied

REGISTRATION

A registration will issue about twelve weeks after publication in the official gazette

If no notice of opposition is filed to the application

For an ITU [Intent-to-Use] application registration will occur after publication in the official Gazette

The PTO will issue a certificate of registration for the mark

The term of the registration is presently ten years from the date the mark is registered [for registration issued before November 16, 1989, the term is twenty years]"TM" for Trademark & SM for service mark

UNIT-3

COPYRIGHTS

Introduction

Every year millions of Americans create original works like books, music, research and other forms of creative expression All these creation are Intellectual Property and all of them are protected by copyright

Writers, editors and publishers, understanding copyrights issues are essential Especially now that the production of counterfeit [imitating] and pirated goods, including written works, has become so prevalent

In 2005 more than \$600 billion in pirated and counterfeited goods were recognized by WCO [World Customs Organization] Now-a-days the internet has made copying and distributing protected material easier than ever before for avoiding copying the material So, in order to protect yourself from IP theft, it's important to know the basics about rights

Definition

“The legal protection given to published works forbidding anyone but the author from publishing or selling them An author can transfer the copyright to another person or corporation, such as a publishing company”

What is a Copyright?

Copyright is a form of protection provided by US Law to the authors of **“Original Works of Authorship”** fixed in any tangible medium of expression

- ❖ The manner and medium of fixation are virtually unlimited

- ❖ Creative expression may be captured in words, number, notes, sounds, pictures or any other graphic or symbolic media
- ❖ The subject matter of copyright is extremely broad, including literary, dramatic, musical, artistic, audiovisual and architectural works
- ❖ Copyright protection is available for both published and unpublished works

History

- ❖ In England prompted the first insistence upon protection for publication of books
- ❖ Bookbinders and printers demanded protection from copying of books
- ❖ Authors also began to demand protection from unauthorized copying and demanded to share in the financial rewards
- ❖ Finally, in 1710, parliament enacted the first copyright statute [Act/law], the Statute of Anne [Named after Anne, Queen of Great Britain, the Statute become the foundation for British and American Copyright Law]
- ❖ The first copyright law is enacted under the new US Constitution, Protecting books maps and charts for 14 years with privilege of renewal for another 14 years
- ❖ Copy right registration is made in the US district court where the author or proprietor resides
- ❖ The first copyright entry, “The Philadelphia Spelling Book” by John Barry, is registered in
- ❖ US District court of Pennsylvania Protection is for 14 years with a renewal period of author 14 years

Common Law Right

- The enacted the first copyright act in 1790 and the first federal copyright registration were issued
- Until January 1, 1978 [the effective date of the 1976 copyright Act] the US had a dual system of copyright protection
- Until 1978, an author has a perpetual common law right to their unpublished works
- Once the work was published, however, the common law perpetual copyright was extinguished and protection was afforded by virtue [quality] of the 1909 act, provide protection up to fifty-six years
- Publication is the distribution of copies of a work to the public for sale or other transfer of ownership, by rental lease, or lending
- The dual nature of copyright protection was complex, often led to controversy
- The 1976 act eliminated the distinction between unpublished and published works

For Example: Ernest Hemingway's *A Farewell to Arms* [Published in 1929], are governed by the act in existence on the date of their publication. Hemingway's book would thus be governed by the 1909 act

Just as trademark rights arise from use and not from registration with PTO

- A copyright registration from the copyright office provides certain advantages to author's of work, including the following

- Registration establishes a public record of the copyright claim
- Before an infringement suit may be filed in court, registration is necessary for works of
 - US origin
- If made before or within five years of publication, registration will establish Prima facie evidence in court of the validity of the copyright and of the facts stated in the certificate and
- If registration is made within three months after publication of the work or prior to an infringement of the work, statutory damages and attorney's fee will be available to the copyright owner in court action

Copyright protection generally lasts until seventy years from the death of the author

The 1976 copyright act is found at 17 USC §§101-1101 and it was amended for several times

In 1980, specific protection was afforded to computer programs as works entitled to copyright protection

Copyright Act © represents Another 1998 amendment to copyright law is the Digital Millennium Copyright act

The United States Copyright Office:

The copyright office is not permitted to give legal advice and will not offer guidance on matter such as disputes, suits against possible infringers or other matters related to copyright

Among the more useful publications and materials are the following:

- Forms for copyright registration
- Circular 1, “Copyright Basics”,
- Circular 2, “Publication on copyrights”,
- Circular 3, “Copyright Notice”,
- Circular 4, “Copyright Fees”
- Circular 15, “Renewal of Copyright”
- Circular 15a, “Duration of Copyright”; and
- Circular 38a, “International copyright Relations of the United States”; and
- Circular 61, “Copyright Registration for computer Programs”

To order copyright publications, write to:

Circulars and announcements are available via facsimile

If you do not know the document number of the items you want, you may request that a menu be faxed to you

All the data pertaining to copyrights are available in Internet

The copyright office provides a free electronic mailing list, “NewsNet”, that issues periodic e-mail messages on copyright issues

Copyright office process the application via electronically

Originality of Material:

Introduction

The limits of copyrightability are dictated [command] by federal statute

According to 17 USC § 102, copyright protection exists in original works [tangible medium]

Thus, there are three basic requirements for copyrightability:

1. A work must be original
2. A work must be fixed in a tangible form of expression; and
3. A work must be a work of authorship

Originality of Material

To be eligible for copyright protection

Material must be original

Meaning

Independently created

Posses a modicum of creativity

It should not confused with novelty, worthiness or aesthetic [dealing with beauty] appeal

“Originality” thus does not mean “first”, it merely means “independently created”,

A slight amount of “creative spark”

Fixation of Material :(17USC § 101

The copyright act protects works of authorship that are “fixed in any tangible medium of expression”

A work is “fixed”:

When it is embodied [existing in broad form]

Phonorecord and is sufficiently permanent

Stable to permit it to be perceived, reproduced or communicated for a period of more than transitory [temporary] duration

Thus there are two tangible categories

Copies: A copy is a material object from which a work can be perceived, reproduced or communicated, either directly by human perception or with the help of a machine

Phonorecord: A Phonorecord is a material object in which sounds are fixed and from which the sounds can be perceived, reproduced or communicated either directly by human perception or with the help of a machine

Works of Authorship: (17 USC § 102)

The copyright act provides that copyright protection subsists [support oneself] in original works of authorship fixed in any tangible medium of expression, now known or hereafter developed, from which they can be perceived, reproduced or otherwise communicated

The list is preceded by the phrase that works of authorship “include” those categories, demonstrating that the listed categories are not only types of works that can be protected, but are illustrate only

- Literary works
- Musical works
- Dramatic works
- Pantomimes and choreographic works
- Pictorial, graphic and sculptural works
- Motion pictures and other audiovisual works
- Sound recording and
- Architectural works

Exclusions from copyright protection:

- Ideas, Methods, or System
- Blank forms, Titles, short phrases and common property
- Public domain works
- Facts
- Computing and measuring devices

The Rights afforded by copyright law: Introduction

The copyright act provides that, subject to certain exceptions, the owner of a copyrights has the exclusive rights to do and to authorize any of the following:

- i. To reproduce the copyrighted work in copies or phonorecords
- ii. To prepare derivative works based on the copyrighted work
- iii. To distribute copies or phonorecords of the copyrighted work to the public
- iv. To perform the copyrighted work publicly
- v. To display the copyrighted work publicly
- vi. To perform the copyrighted work publicly by means of a digital audio transmission
- vii. Unless exemption exists, unauthorized exercise of any of these rights by another is an infringement

These exclusive rights, usually referred to as a “bundle”

Rights of Reproduction:

- The most fundamental of the rights granted to copyright owners is the right to reproduce the work
- A violation of the copyright act occurs whether or not the violator profits by the reproduction
- Only the owner has the right to reproduce the work
- Secretly taping a concert, taking pictures at a performance, or recording all violate the owner’s right to reproduce
- The suggestion of congress, in 1978 a group of authors, publishers and users established a not-for-profit entity called Copyright Clearance Center [CCC]

- CCC grants licenses to academic, government and corporate users to copy and distribute the works
- It collects royalty fees, which are distributed to the authors
- Companies that photocopy articles from journals and magazines often enter into licensing arrangements with the CCC so they can make copies

Rights to prepare Derivative works:

Section 106 of the copyright Act provides that the owner of a copyright has the exclusive right to prepare derivative works based upon the copyrighted work

This right is often referred to as the right to adapt the original work

Definition:

“A derivative work is broadly defined as a work based upon one or more preexisting works, such as a translation, dramatization, fictionalized motion pictures version, abridgment condensation or any other form in which a work may be recast, transformed, or adapted

a work consisting of editorial revisions, annotations, elaborations, or other modifications is also a derivative work

New material represents original work of authorship

Rights of distribution and the first sale doctrine:

Section 106 (3) of the copyright act provides that the owner of a copyright has the exclusive right to distribute copies or phonorecords of the work to the public by sale or other transfer of ownership A violation of the distribution right can arise solely from the act of distribution itself

- The distributor did not make an unlawful copy or the copy being distributed was unauthorized
- Thus, blockbuster video store can be liable for violating an owner's right to distribute
- Once the author has parted with ownership of copyrighted material, the new owner of a lawfully made copy can treat the object as his or her own
- The new owner the right to lend the book or movie to a friend, resell the work at a garage sale, or even destroy it
- The first sale doctrine does not apply to or limit the author's exclusive rights to prepare derivative works or rights of public performance and
- Without permission of authorship the goods are not permitted to imported into the US

Rights to perform the work publicly

Section 106 [5] of the Copyright Act provided that

- a. in the case of all copyrighted works other than sound recording & works of architecture, the copyright owner has the exclusive right to display the work publicly
- b. A display is "public" under the same circumstances in which a performance is "public"
- c. Namely if it occurs at a place open to the public (or) at a place where a substantial number of persons outside of the normal circle of a family

Copyright Ownership Issues [17 USC § 201(a)]:

Copyright in a work protected under the copyright act vests [provide with power and authority] in the author or authors of the work

Issues about ownership arise when more than one person creates a work

Ownership of a physical object is separate and distinct from ownership of the copyright embodied in the material object

Unless copyright has been explicitly conveyed with those physical articles, the original authors generally retain all other rights associated with the works

Joint Works [intent to create a unitary whole]

A joint work is a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole

One copyright exists in the created works

Joint authors are those who “mastermind” or “super mind” the creative effort

Ownership Rights in Joint Works

If individual are authors of a joint work, each owns an equal undivided interest in the copyright as a tenant in common, [each has the right to use the work, prepare derivative works, display it without seeking the other coauthor’s permission]

If profits arise out of such use, an accounting must be made so, that each author shares in the benefits or proceeds

The death of a coauthor, his or her rights pass to heirs who then own the rights in common with the other coauthor

Ownership in Derivative or Collective Works

- The author of the original book has rights only to his or her work and cannot reproduce or perform the derivative work without permission
- If a work such as a book is created by one person who intends it to be complete at the time and illustrations are later added to it by another, the work cannot be a joint work
- because there was no intention of the parties to create a unitary whole at the time of their creation
- The author of the derivative work cannot create further works based on the original book without permission and cannot reproduce the original work without permission
- Multiple ownership rights may also arise if separately copyrightable works are compiled into a collection

For Example: If essays written by Jerry Seinfeld, Ellen DeGeneres, and Paul Reiser are collected into a humor anthology by Bill Jones (with permission of the original authors), the original authors retain their exclusive rights (such as rights to reproduce, distribute, and perform) in their respective essays

No joint work is created because there was no intent at the time the separate essays were created to merge them into a unitary whole. No derivative work is created because the original works have not been transformed in any way and nothing new has been added to them. The anthology by the compiler, Bill Jones, is a collective work and pursuant to section 201(c) of the act, Jones acquires only the right to reproduce and distribute the contributions as part of the particular collective work or any revision of the collective work.

Works Made for Hire

The general rule is that the person who creates a work is the author of that work and the owner of the copyright therein, there is an exception to that principle: the copyright law defines a category of works called **works made for hire**

If a work is “made for hire”, the author is considered to be the employer or commissioning party and not the employee or the actual person who created the work

The employer or commissioning party may be a company or an individual

There are two types of works that are classified as works made for hire; works prepared by an employer within the scope of employment and certain categories of specially ordered or commissioned works

Copyright Registration

A work is “created” when it is fixed in a copy or phonorecord for the first time

Although not required to provide copyright protection for a work, registration of copyright with the Copyright Office is expensive, easy and provides several advantages, chiefly, that registration is a condition precedent for bringing an infringement suit for works of US origin

To register a work, the applicant must send the following three elements to the Copyright Office: a properly completed application form, a filing fee, and a deposit of the work being registered

Registration may be made at any time within the life of the copyright

THE APPLICATION FOR COPYRIGHT REGISTRATION

The following persons are entitled to submit an application for registration of copyright:

- the author (either the person who actually created the work or, if the work is one made for hire, the employer or commissioning party)
- the copyright claimant (either the author or a person or organization that has obtained ownership of all of the rights under the copyright originally belonging to the author, such as a transferee)
- the owner of exclusive right, such as the transferee of any of the exclusive rights of copyright ownership (for example, one who prepares a movie based on an earlier book may file an application for the newly created derivative work, the movie); and
- the duly authorized agent of the author, claimant, or owner of exclusive rights (such as an attorney, trustee, or anyone authorized to act on behalf of such parties)

Application Forms

The Copyright Office provides forms for application for copyright registration