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Key Trademark and Copyright Rules for Nonprofits to Follow – and Break!

July 17, 2014
Venable LLP
Washington, DC

Moderator:

Jeffrey S. Tenenbaum, Esq., Venable LLP

Panelists:

Andrew D. Price, Esq., Venable LLP

Justin E. Pierce, Esq., Venable LLP



Presentation





Key Trademark and Copyright Rules for Nonprofits to Follow – and Break!

Thursday, July 17, 2014, 12:30 p.m. – 2:00 p.m. ET
Venable LLP, Washington, DC

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September 16, 2014 – [What's Ahead for 2015: Preparing Your Nonprofit's Group Health Plan for the Employer Mandate](#)



Agenda

■ Trademarks: Follow and Break the “ACID” Test

- Brands need not always be used as adjectives and in a consistent manner
- Strong brands can be flexible, fluid, and “living”

■ Copyrights: Break Reliance on the “Automatic upon Creation” Rule

- Registered rights enhance your effectiveness in dealing with infringing content under copyright law and the DMCA
- Copyrights must be recorded in order for Customs to stop infringing imports



Trademarks: Follow and Break the “ACID” Test

Trademarks: The “ACID” Test

- The Test
 - Use trademarks as **Adjectives**
 - In a **Consistent** manner
 - With **Identification** re: whether mark is registered
 - And in a **Distinctive** or attention-grabbing manner



Trademarks: Is the “ACID” Test Outdated?

- Rules to Break
 - Use trademarks as **Adjectives**
 - In a **Consistent** manner
- Rules to Follow
 - Use trademarks with **Identification** re: whether mark is registered
 - And in a **Distinctive** or attention-grabbing manner
- Today
 - Strong brands can be flexible, fluid, and living



Trademarks: Is the First Part of the “ACID” Test Outdated?

- Old Rule
 - Use trademarks as **Adjectives**
- The Fear
 - Genericide
 - “photocopying” versus “Xeroxing”
 - Loss of rights
- The Times
 - Changing consumer sophistication and expectations
 - The mobile marketplace; short attention spans
 - Need to build brand interest and loyalty



Using Strong Brands as Nouns and Verbs

- New Rule
 - You may “verb up” strong brands or use them as nouns
- Examples
 - GOOGLE as a verb
 - Google PLAY: PLAY YOUR HEART OUT
 - Vanguard: Vanguarding

Start Vanguarding™ - Vanguard.com
 Ad www.vanguard.com/ ▼
 Vanguarding™ is being an owner as well as a client. Learn more.
 Vanguard has 823,897 followers on Google+
[Invest in a Mutual Fund](#) [Open an Account](#)
[Tools for Investing](#) [Fund Recommendation Tool](#)

- [ABC as adjective] WAY: LIVE [ABC as noun]



What Is a Strong Brand?



Using Strong Brands as Nouns and Verbs: Guidelines

- Make clear to consumers that the action suggested by **the verbed-up brand use cannot be accomplished without using the branded product or service.**
 - The verbed-up brand can be built into taglines, slogans, and/or logos that reinforce this point.
 - e.g., “Vanguarding can’t happen without Vanguard” and “play your heart out” can’t happen without “Google Play”



Using Strong Brands as Nouns and Verbs: Guidelines

- Create and publish **guidelines for “verbed-up” brand use** (and/or update trademark guidelines that reinforce this concept).
 - e.g., “Start Vanguarding” not “Get Vanguarded”



Using Strong Brands as Nouns and Verbs: Guidelines

- Register the verbed-up brand – or the tagline, slogan, or logo containing the verbed-up brand
 - The registry is king:

VANGUARDING

Word Mark	VANGUARDING
Goods and Services	IC 036, US 100 101 102, G & S: Financial brokerage services and financial informatio
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	77959213
Filing Date	March 15, 2010
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	June 29, 2010
Registration Number	3902041
Registration Date	January 4, 2011
Owner	(REGISTRANT) The Vanguard Group, Inc.

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Using Strong Brands as Nouns and Verbs: Guidelines

- Send **friendly letters** to publishers and media outlets that do not appear to appreciate the necessary connection between the brand and the verb in their references.



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Using Strong Brands as Nouns and Verbs: Guidelines

- Work with **dictionaries** to ensure that any verb listings are consistent with your new verbed-up brand policies.



Using Strong Brands as Nouns and Verbs: Guidelines

- Conduct regular **monitoring** of the public's use and view of the verbed-up brand – ultimately, it is the consuming public that determines, through its use, whether a verbed-up brand has lost distinctiveness through genericide.



Trademarks: Is the Second Part of the “ACID” Test Outdated?

- Old Rule
 - Use trademarks in a **Consistent** manner
- The Fear
 - No ability to “tack” use to current use
 - Loss of rights
- The Times
 - Changing consumer sophistication and expectations
 - The mobile marketplace; short attention spans
 - Need to build brand interest and loyalty



Using Strong Brands in a Fluid or “Living” Manner

- New Rule: You may use strong brands in a fluid or “living” manner
- Google “Doodles”: The Model



- Fluid trademarks
 - A misnomer?
 - Motion marks = marks with active movement
 - “Living” brands
 - They grow but essential character remains



Using Strong Brands in a Fluid or “Living” Manner

- Nonprofit tradition, culture, and policy
 - Does your nonprofit have members and/or chapters?
 - How do you currently control use of your brands by members and/or chapters?
 - Are they allowed to change the brands based on geographic region?
 - Are they allowed to change the brands seasonally?
 - Do they follow the “rules”?
 - What are you currently doing about brand control?
 - Is there a binding policy and do you enforce?
 - Would a flexible standard make your job easier?

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Using Strong Brands in a Fluid or “Living” Manner: Guidelines

- Make sure the subject design or stylization is **strong**, with substantial goodwill.

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Using Strong Brands in a Fluid or “Living” Manner: Guidelines

- Gauge how much to play with the design or stylization based on the **relative strength** of the mark.
 - Famous marks may be changed the most.



Using Strong Brands in a Fluid or “Living” Manner: Guidelines

- Change only the design or stylization, **not the corresponding word mark** (except when it comes to breaking the ACID test rule of using word marks as adjectives).



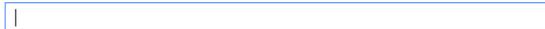
Using Strong Brands in a Fluid or “Living” Manner: Guidelines

- Make sure that the **essence of the logo is retained** (e.g., the stylization of the word mark GOOGLE is regularly discernible).



Using Strong Brands in a Fluid or “Living” Manner: Guidelines

- Continue regular trademark **use of the original** design or stylization.



Using Strong Brands in a Fluid or “Living” Manner: Guidelines

- Maintain trademark **registrations for the original** design or stylization and underlying word mark standing alone.
 - Again, the registry is king!



Using Strong Brands in a Fluid or “Living” Manner: Guidelines

- **Do not be a trademark bully** when others do parodies.
 - “Eat More Kale” lesson



Using Strong Brands in a Fluid or “Living” Manner: Guidelines

- Refer to fluid trademarks as “**living**” trademarks.
 - They are not really “fluid” / motion marks



Using Strong Brands in a Fluid or “Living” Manner: Guidelines

- Advocate for trademark offices to register living trademarks as such, and give them **special status**.
 - Argue for a new category for strong marks.
 - A logo should be able to change in more than a “material” way without loss of registration rights.
 - The underlying design or stylization should be entitled to broader protection, like the “surname” in a family of marks.
 - This is not a phantom mark situation, in which an applicant is really seeking to register multiple marks via one application.



Copyrights: Break Reliance on the “Automatic upon Creation” Rule

Copyrights: Reliance on the “Automatic upon Creation” Rule Outdated for Online Enforcement

- OLD: Copyright protection subsists from the time the work is created in fixed form. The copyright in the work of authorship immediately becomes the property of the author who created the work.
- NEW: While the old rule is still true, by taking the extra step to “register” your copyrights early, you can enhance your ability to deal with and stop unauthorized posting of your content online and in social media.



Registration of Copyrights Key for Online Enforcement

- The DMCA provides one of the most effective and cost-efficient ways to protect your copyright from infringement online and in social media.
- The DMCA sets forth how copyright owners may send a takedown notification letter to a website hosting infringing content.
- Upon receipt of a proper takedown notice, the website is on notice of the claim and must quickly take down the allegedly infringing material and send a notice to the user (or uploading entity) who uploaded the material.

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Registration of Copyrights Key for Online Enforcement

- Once notified, the user has the opportunity to respond and file a counter-notification letter claiming non-infringement, or do nothing (and the material will remain off the site).
- Upon receipt of a counter-notification letter, the website must inform the copyright owner.
 - If the copyright owner does nothing, the material may go back up on the site.
 - If (within 14 days) the copyright owner files suit against the alleged infringer, the website may not put the material back on the site while the litigation is pending.

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Registration of Copyrights Key for Online Enforcement

- The Copyright Act requires that before a party files a copyright infringement suit, a work must be registered with the Copyright Office.
- Courts are not in agreement on what is meant by “must be registered” in the statute. One school of thought is that a proper application must be on file with the Copyright Office before litigation, whereas the other school of thought believes one must have a final copyright registration.
- To further complicate matters, it can take anywhere from 2 to 7 months to get a registration.

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Registration of Copyrights Key for Online Enforcement

- Thus, if you do not already have a registration in place prior to filing a lawsuit in a DMCA enforcement scenario, you will not be able to adequately respond to a counter-notification letter within the 14 day window.
- This means you miss your chance to have the allegedly infringing material taken down while the litigation is pending, and if the copyright was not timely filed, you risk not being able to get attorneys' fees, statutory damages (up to \$150,000), or a quick injunction.

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Registration of Copyrights Key for Online Enforcement

RECOMMENDATION:

- Register your organization's copyrights prior to publication or public release.
- In today's digital world, any work released to the public can be easily copied and reproduced. It's best to file a copyright application before any infringement occurs.
- *An ounce of prevention is worth a pound of cure.* Consider the loss in value and potential litigation costs due to infringed copyrights vs. the US Copyright Office e-filing fee of \$35 per copyright.

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Benefits of Recording Copyrights with Customs

- Take the extra step to record your rights with Customs.
- When copyrights are recorded with Customs, they can monitor shipments and exclude, detain, and/or seize imported merchandise suspected to be counterfeit or infringing.
- Once goods are seized, Customs provides the copyright owner with information regarding the seizure – including description of merchandise, quantity seized, country of origin, and name and address of manufacturer and importer.

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Questions?

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To view recordings of Venable's nonprofit programs on our YouTube channel, see www.youtube.com/user/VenableNonprofits.

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Speaker Biographies





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AREAS OF PRACTICE

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 Wealth Planning
 Regulatory

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Nonprofit Organizations and Associations
 Credit Counseling and Debt Services
 Financial Services
 Consumer Financial Protection Bureau Task Force

GOVERNMENT EXPERIENCE

Legislative Assistant, United States House of Representatives

BAR ADMISSIONS

District of Columbia

Jeffrey Tenenbaum chairs Venable's Nonprofit Organizations Practice Group. He is one of the nation's leading nonprofit attorneys, and is an accomplished author, lecturer, and commentator on nonprofit legal matters. Based in the firm's Washington, DC office, Mr. Tenenbaum counsels his clients on the broad array of legal issues affecting charities, foundations, trade and professional associations, think tanks, advocacy groups, and other nonprofit organizations, and regularly represents clients before Congress, federal and state regulatory agencies, and in connection with governmental investigations, enforcement actions, litigation, and media relations. He also has served as an expert witness in several court cases on nonprofit legal issues.

Mr. Tenenbaum was the 2006 recipient of the American Bar Association's Outstanding Nonprofit Lawyer of the Year Award, and was an inaugural (2004) recipient of the *Washington Business Journal's* Top Washington Lawyers Award. He was one of only seven "Leading Lawyers" in the Not-for-Profit category in the prestigious 2012 *Legal 500* rankings, one of only eight in the 2013 rankings, and one of only nine in the 2014 rankings. Mr. Tenenbaum was recognized in 2013 as a Top Rated Lawyer in Tax Law by *The American Lawyer* and *Corporate Counsel*. He was the 2004 recipient of The Center for Association Leadership's Chairman's Award, and the 1997 recipient of the Greater Washington Society of Association Executives' Chairman's Award. Mr. Tenenbaum was listed in the 2012-14 editions of *The Best Lawyers in America* for Non-Profit/Charities Law, and was named as one of Washington, DC's "Legal Elite" in 2011 by *SmartCEO Magazine*. He was a 2008-09 Fellow of the Bar Association of the District of Columbia and is AV Peer-Review Rated by *Martindale-Hubbell*. Mr. Tenenbaum started his career in the nonprofit community by serving as Legal Section manager at the American Society of Association Executives, following several years working on Capitol Hill as a legislative assistant.

REPRESENTATIVE CLIENTS

AARP
 Air Conditioning Contractors of America
 Airlines for America
 American Academy of Physician Assistants
 American Alliance of Museums
 American Association for the Advancement of Science
 American Bar Association
 American Bureau of Shipping
 American Cancer Society
 American College of Radiology
 American Institute of Architects
 American Society for Microbiology
 American Society for Training and Development
 American Society of Anesthesiologists
 American Society of Association Executives

EDUCATION

J.D., Catholic University of America, Columbus School of Law, 1996

B.A., Political Science, University of Pennsylvania, 1990

MEMBERSHIPS

American Society of Association Executives

California Society of Association Executives

New York Society of Association Executives

America's Health Insurance Plans
Association for Healthcare Philanthropy
Association of Corporate Counsel
Association of Private Sector Colleges and Universities
Auto Care Association
Biotechnology Industry Organization
Brookings Institution
Carbon War Room
The College Board
CompTIA
Council on CyberSecurity
Council on Foundations
CropLife America
Cruise Lines International Association
Design-Build Institute of America
Ethics Resource Center
Foundation for the Malcolm Baldrige National Quality Award
Gerontological Society of America
Goodwill Industries International
Graduate Management Admission Council
Habitat for Humanity International
Homeownership Preservation Foundation
Human Rights Campaign
Independent Insurance Agents and Brokers of America
Institute of International Education
International Association of Fire Chiefs
International Sleep Products Association
Jazz at Lincoln Center
LeadingAge
Lincoln Center for the Performing Arts
Lions Club International
March of Dimes
ment'or BKB Foundation
Money Management International
National Association for the Education of Young Children
National Association of Chain Drug Stores
National Association of College and University Attorneys
National Association of Manufacturers
National Association of Music Merchants
National Athletic Trainers' Association
National Board of Medical Examiners
National Coalition for Cancer Survivorship
National Council of Architectural Registration Boards
National Defense Industrial Association
National Fallen Firefighters Foundation
National Fish and Wildlife Foundation
National Hot Rod Association
National Propane Gas Association
National Quality Forum
National Retail Federation
National Student Clearinghouse
The Nature Conservancy
NeighborWorks America
Peterson Institute for International Economics
Professional Liability Underwriting Society
Project Management Institute
Public Health Accreditation Board
Public Relations Society of America
Recording Industry Association of America
Telecommunications Industry Association
Trust for Architectural Easements
The Tyra Banks TZONE Foundation
U.S. Chamber of Commerce
United Nations High Commissioner for Refugees
Volunteers of America

HONORS

Recognized as "Leading Lawyer" in *Legal 500*, Not-For-Profit, 2012-14

Listed in *The Best Lawyers in America* for Non-Profit/Charities Law, Washington, DC (Woodward/White, Inc.), 2012-14

Selected for inclusion in *Washington DC Super Lawyers*, Nonprofit Organizations, 2014

Recognized as a Top Rated Lawyer in Taxation Law in *The American Lawyer* and *Corporate Counsel*, 2013

Washington DC's Legal Elite, *SmartCEO Magazine*, 2011

Fellow, Bar Association of the District of Columbia, 2008-09

Recipient, American Bar Association Outstanding Nonprofit Lawyer of the Year Award, 2006

Recipient, *Washington Business Journal* Top Washington Lawyers Award, 2004

Recipient, The Center for Association Leadership Chairman's Award, 2004

Recipient, Greater Washington Society of Association Executives Chairman's Award, 1997

Legal Section Manager / Government Affairs Issues Analyst, American Society of Association Executives, 1993-95

AV® Peer-Review Rated by *Martindale-Hubbell*

Listed in *Who's Who in American Law* and *Who's Who in America*, 2005-present editions

ACTIVITIES

Mr. Tenenbaum is an active participant in the nonprofit community who currently serves on the Editorial Advisory Board of the American Society of Association Executives' *Association Law & Policy* legal journal, the Advisory Panel of Wiley/Jossey-Bass' *Nonprofit Business Advisor* newsletter, and the ASAE Public Policy Committee. He previously served as Chairman of the *AL&P* Editorial Advisory Board and has served on the ASAE Legal Section Council, the ASAE Association Management Company Accreditation Commission, the GWSAE Foundation Board of Trustees, the GWSAE Government and Public Affairs Advisory Council, the Federal City Club Foundation Board of Directors, and the Editorial Advisory Board of Aspen's *Nonprofit Tax & Financial Strategies* newsletter.

PUBLICATIONS

Mr. Tenenbaum is the author of the book, *Association Tax Compliance Guide*, now in its second edition, published by the American Society of Association Executives. He also is a contributor to numerous ASAE books, including *Professional Practices in Association Management*, *Association Law Compendium*, *The Power of Partnership*, *Essentials of the Profession Learning System*, *Generating and Managing Nondues Revenue in Associations*, and several Information Background Kits. In addition, he is a contributor to *Exposed: A Legal Field Guide for Nonprofit Executives*, published by the Nonprofit Risk Management Center. Mr. Tenenbaum is a frequent author on nonprofit legal topics, having written or co-written more than 500 articles.

SPEAKING ENGAGEMENTS

Mr. Tenenbaum is a frequent lecturer on nonprofit legal topics, having delivered over 500 speaking presentations. He served on the faculty of the ASAE Virtual Law School, and is a regular commentator on nonprofit legal issues for *NBC News*, *The New York Times*, *The Wall Street Journal*, *The Washington Post*, *Los Angeles Times*, *The Washington Times*, *The Baltimore Sun*, *ESPN.com*, *Washington Business Journal*, *Legal Times*, *Association Trends*, *CEO Update*, *Forbes Magazine*, *The Chronicle of Philanthropy*, *The NonProfit Times* and other periodicals. He also has been interviewed on nonprofit legal topics on Fox 5 television's (Washington, DC) morning news program, Voice of America Business Radio, Nonprofit Spark Radio, and The Inner Loop Radio.



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AREAS OF PRACTICE

Trademarks and Brand Protection
 Intellectual Property
 Trademark Litigation
 Copyrights and Licensing
 Domain Names and Cyber Protection
 Advertising and Marketing
 Brand Protection

INDUSTRIES

Consumer Products and Services
 Nonprofit Organizations and Associations
 New Media, Media and Entertainment

BAR ADMISSIONS

District of Columbia
 Virginia, Associate Member
 (inactive)

EDUCATION

J.D., Southern Methodist University, 1996
 B.A., Vanderbilt University, 1991

Andrew Price has spent 16 years at Venable with one focus: he helps clients establish, protect and profit from their brands worldwide.

Ranked three years in a row as one of the elite trademark prosecution and strategy attorneys in Washington, DC, he is noted for a “fantastic global perspective,” “first-class knowledge of trademark law,” and “commercial acumen” (*WTR 1000*, 2012-2014; *Legal 500*, 2013-2014). He is “wholeheartedly recommended” for his “smart, dedicated and extremely creative approach. His ability to infuse life into even the driest legal issues is second to none” (*WTR 1000*, 2014).

Mr. Price was one of the earliest members of Venable's trademark practice, which has been ranked Tier 1 nationally and in Washington, DC (*U.S. News - Best Lawyers "Best Law Firms,"* 2011-2012). As a leading member of that group, he represents clients of all sizes, from startups and celebrities to nonprofits and multinational corporations – with a special emphasis on managing large portfolios of trademarks.

Mr. Price focuses his practice on brand strategy as well as searching, registering, licensing, and enforcing all types of trademarks worldwide (e.g., brand names, logos, slogans, trade dress such as product configuration, and non-traditional marks such as motion marks). His practice includes bringing and defending opposition and cancellation actions before the U.S. Trademark Trial and Appeal Board. He also works closely with the firm's Intellectual Property Litigation Group to bring and defend trademark-related lawsuits, including preliminary injunction motions, in the United States. Abroad Mr. Price oversees a personal network of top foreign lawyers in a full range of trademark work.

Dedicated to providing strategic counsel, client service, and value, he achieves “the perfect balance of being detail focused without losing sight of the big picture” (*WTR 1000*, 2013).

REPRESENTATIVE CLIENTS

Serves as chief U.S. and global trademark prosecution counsel to two leading smartphone providers, including Sony Mobile.

Serves as chief trademark counsel to a large number of clients in Venable's nationally recognized Nonprofit Organizations Practice Group.

Responsible for nearly 5,000 active trademark applications/registrations and oppositions/cancellations, including portfolios of the above clients plus the following, among others:

- a leading Hollywood production company;
- one of the world's largest investment companies;
- one of the world's top dance footwear and apparel companies; and
- one of the world's largest cloud hosting companies.

MEMBERSHIPS

International Trademark Association

Intellectual Property Owners Association

SIGNIFICANT MATTERS

Provided strategic counsel to a leading Hollywood production company on global brand protection, and became the company's chief global trademark counsel.

Represented Arianna Huffington in negotiating intellectual property aspects of the sale of *The Huffington Post* to AOL.

Created and managed the strategy to file 450 trademark applications worldwide for one of Interbrand's Best Global Brands 2012, and delivered the project under budget.

Registered the name of Apple's 2012 iPhone App of the Year based on acquired distinctiveness, after a personal meeting with the Examiner, months before the award.

Created a strategy that got a large mobile client's "crown jewel" trademark approved by the USPTO in 13 business days, after it lingered at another firm for 3-1/2 years with various objections.

Provided strategic counsel to a *Fortune 250* company on how to evolve its house brands, and filed a number of stealth applications in the process.

Helped Sony manage the intricacies of trademark law related to its acquisition of Ericsson's 50% interest in the Sony Ericsson joint venture.

Helped a joint venture of one of the world's top luxury automobile brands select house brands for a new "green" line of cars.

Won a seven-year battle to register a restaurant chain's main brand in the European Community.

Successfully defended a nonprofit against a party that claimed it jointly owned the client's name.

Successfully defended a large investment company in an opposition, with a counterattack that caused the competitor to withdraw and phase out its own slogan.

Worked with Venable's litigation team to defend and file preliminary injunction actions in U.S. District Court, resulting in favorable settlements.

Developed a global strategy that led to settlement after a party demanded our client not launch a critical product-line brand.

Managed the searching of over 500 trademarks for one client in one year.

Worked on high-dollar licensing transactions involving major TV show names.

Won an appeal for Sony Mobile to register a rare motion mark in the European Community, and obtained for the client one of the few U.S. registrations for a sound mark.

Stopped Asian and European counterfeiters of the world's top-selling dance sneaker.

Filed one of the first U.S.-based applications under the Madrid Protocol, and registered the well-known nonprofit brand MENSA worldwide through the system.

HONORS

Mr. Price was recognized in the *World Trademark Review 1000* in the category of Prosecution and Strategy in 2012, 2013 and 2014.

Mr. Price was recognized in *Legal 500* in the category of Trademarks: Non-Contentious in 2013 and 2014.

Mr. Price is a member of American Mensa, a client he helped represent for several years.

He was privileged to intern with the Public Defender Service for the District of Columbia, widely regarded as the premier public defender office in the country.

He was one of the first recipients of the Congressional Award, which is given in part for public service.

Mr. Price is also listed in *Who's Who in America 2012* (published Fall 2011).

ACTIVITIES

Mr. Price is a member of the International Trademark Association (INTA) and attends its annual meetings (named Best Dressed in Dallas by WTR for “full cowboy regalia”). He served on the Hiring Committee for Venable’s Washington, DC office for the last three years, and now serves on the firm’s Diversity Committee. With a colleague, he won the DC office’s Sir Francis Drake Bocce Tournament. In his spare time, he is a guitarist of 30 years, plotting his next performance at the office’s annual Halloween contest / talent show, which he has won as well.

RECENT PUBLICATIONS

- June/July 2014, Time to Break Some Trademark Rules in 2014, *World Trademark Review*
- May 14, 2013, As Nonprofits Expand Their Global Reach, a Special Focus on Tax, Trademarks and the Foreign Corrupt Practices Act
- March 12, 2013, Top Five International Trademark Pitfalls for Nonprofits
- December 13, 2012, Advertising News & Analysis – December 13, 2012, Advertising Alert
- December 11, 2012, Understanding New Restrictions on Advertising GI Bill Benefits
- August 2, 2012, The \$60 Million iPad Trademark Lesson Applies to All Brands, *All About Advertising Law, IP Buzz*
- June 13, 2012, Ten Best Practices for Protecting Your Nonprofit’s Intellectual Property
- May 21, 2012, The Trend In Top Brands – Use More Inventive Naming, *All About Advertising Law, IP Buzz, IP Frontline*

RECENT SPEAKING ENGAGEMENTS

- July 17, 2014, Key Trademark and Copyright Rules for Nonprofits to Follow – and Break!
- July 8, 2014, Legal Quick Hit: "Key Trademark and Copyright Rules for Nonprofits to Follow – and Break!" for the Association of Corporate Counsel's Nonprofit Organizations Committee
- May 14, 2013, As Nonprofits Expand Their Global Reach, a Special Focus on Tax, Trademarks and the Foreign Corrupt Practices Act
- March 12, 2013, Legal Quick Hit: "The Top Five International Trademark Pitfalls for Nonprofits" for the Association of Corporate Counsel's Nonprofit Organizations Committee



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 Privacy and Data Security
 Technology Transactions and
 Outsourcing
 Trademark Litigation
 Copyrights and Licensing
 Domain Names and Cyber
 Protection
 Patent Litigation

INDUSTRIES

Consumer Products and Services
 Emerging Companies: Venable
 Venture Services
 New Media, Media and
 Entertainment
 Pharmaceuticals
 Toys and Games
 Digital Media

Justin Pierce's practice covers a wide range of intellectual property matters, including patent litigation, trademarks and brand protection, anti-counterfeiting, copyrights, design rights, trade secrets, licensing, rights of publicity, domain name and social media disputes, and international government affairs work relating to intellectual property matters. Mr. Pierce also has significant experience in the application of intellectual property analytics and the development of intellectual property strategy.

Mr. Pierce has a unique combination of in-house and outside counsel experience in managing intellectual property assets and portfolios for large and small companies. As a patent litigator, Mr. Pierce has represented a number of clients in the consumer products, electronics, media, mobile device, pharmaceutical, software, and telecommunications fields. As a brand protection attorney, Mr. Pierce developed and implemented a global trademark and brand protection strategy for a major multinational manufacturer of mobile devices. As an IP transactions attorney, Mr. Pierce has extensive experience in licensing and leveraging IP assets in order to support the overall business goals of clients.

Mr. Pierce has managed complex intellectual property licensing and litigation on an international scale in matters involving patents, trademarks, and copyrights. He has handled cases in various international proceedings, in U.S. federal courts, and before the U.S. International Trade Commission. In addition, he has structured and negotiated a number of intellectual property licenses for organizations seeking to leverage their intellectual property assets. While serving as in-house counsel and department head for a major multinational corporation, Mr. Pierce led a government relations initiative that enhanced company brand protection efforts in key markets around the world. Drawing upon his international experience, Mr. Pierce also provides counsel regarding cross-border trade, customs, and outreach to foreign governments on intellectual property matters.

Mr. Pierce has significant experience in advising entrepreneurs and start-ups—as well as senior management, marketing, engineering, and research and development teams of major corporations—on how to acquire, develop, and use intellectual property to achieve business objectives. Based on his in-house and management experience, Mr. Pierce has substantial knowledge of the business and strategy issues that challenge executives and their in-house legal teams. Mr. Pierce regularly speaks and writes on a number of intellectual property and brand protection issues.

Beyond his experience as an attorney, Mr. Pierce is an inventor or co-inventor on pending patents dealing with mobile applications, augmented and virtual reality, gaming, and anti-counterfeiting technology. Mr. Pierce is a graduate of the U.S. Military Academy at West Point. He served as an infantry officer in the U.S. Army, and attained the rank of Captain prior to attending the George Washington University Law School.

GOVERNMENT EXPERIENCE

Captain, United States Army

BAR ADMISSIONS

District of Columbia

COURT ADMISSIONS

U.S. District Court for the District of Columbia

U.S. District Court for the District of Delaware

U.S. District Court for the Northern District of West Virginia

U.S. Court of Federal Claims

EDUCATION

J.D., George Washington University Law School, 2000

B.S., United States Military Academy at West Point, 1992

MEMBERSHIPS

American Bar Association

American Intellectual Property Lawyers Association

International Trademark Association

SIGNIFICANT MATTERS

Managed a number of intellectual property litigation matters on behalf of a major multinational mobile device manufacturer, including management of §337 patent litigation in the U.S. International Trade Commission, and intellectual property litigation in various U.S. federal district courts.

Represented a major defense contractor and defended against an infringement action brought in the Court of Federal Claims involving a patent relating to the use of night-vision goggles in conjunction with full-color cockpit displays. *Honeywell Int'l Inc. v. U.S.*, 70 Fed. Cl. 424 (2006).

Represented a major pharmaceutical company and successfully established patent infringement by a generic drug company in a multi-month patent trial involving a multibillion-dollar anti-infective agent. 2004 WL 2973831 (N.D.W.Va.)

Represented a major wireless communications equipment provider and plaintiff in an infringement action concerning patents related to wireless technology under the IEEE 802.11 standard. *Agere Systems Guardian Corp. v. Proxim, Inc.* No. 01 339 RRM (D.Del.).

Represented a major wireless communications equipment provider and intervenor in an infringement action concerning wireless local area network technology. *In re Certain Wireless Local Area Network Cards, ITC Investigation No. 337-TA-455.*

Managed IP due diligence and review in a number of merger and acquisition transactions, including the provision of strategic advice concerning the scope and value of the target company IP, enforcement capability, infringement risks, and impact of ongoing IP litigation.

Represented a major international digital publishing company in a government affairs and advocacy matter regarding international copyright law issues.

Managed international intellectual property and brand protection-related advocacy and government relations on behalf of a major multinational corporation.

HONORS

Recognized in the *World Trademark Review 1000* for Prosecution and Strategy, 2013 and 2014

Recognized in *Legal 500*, Trademarks: Non-Contentious, 2013

RECENT PUBLICATIONS

- June/July 2014, Time to Break Some Trademark Rules in 2014, *World Trademark Review*
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- October 11, 2013, How Capitol Records v. Vimeo Shapes the Content Stream, *Law360*
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- August 22, 2013, Advertising News & Analysis - August 22, 2013, Advertising Alert
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- August 2, 2012, The \$60 Million iPad Trademark Lesson Applies to All Brands, *All About Advertising Law, IP Buzz*
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- 2012, United States chapter, "Anti-Counterfeiting 2012 – A Global Guide", *World Trademark Review*

RECENT SPEAKING ENGAGEMENTS

- July 17, 2014, Key Trademark and Copyright Rules for Nonprofits to Follow – and Break!
- July 8, 2014, Legal Quick Hit: "Key Trademark and Copyright Rules for Nonprofits to Follow – and Break!" for the Association of Corporate Counsel's Nonprofit Organizations Committee
- April 24, 2014, 2014 Brand IP Seminar Series, San Francisco
- February 27, 2014, 2014 Brand IP Seminar Series, New York
- February 18 - 20, 2014, Digital Entertainment World
- January 27 - 29, 2014, 12th Annual Anti-Counterfeiting & Brand Protection West Coast Summit
- December 9, 2013, "Making Sound Business Decisions: Considerations in Evaluating Whether to Litigate or Settle" at the Patent Infringement Litigation Summit
- October 1, 2013, Anti-Counterfeiting & Brand Protection East Coast Summit
- January 28 - 30, 2013, Anti-Counterfeiting & Brand Protection West Coast Summit

Additional Information



Time to break some trademark rules in 2014?

The increasing practice of brand owners ‘verbing up’ their own marks and in some cases deliberately disrupting their own logos demonstrates that strong brands can be flexible, fluid and living

Under the traditional rule of proper trademark use (also known as the ACID test), brands must be used:

- as adjectives;
- in a consistent manner;
- with an identification or symbol indicating whether the mark is registered; and
- in a distinctive or attention-grabbing manner.

While this standard works for many brands, the first two elements – using brands as adjectives only and in a consistent manner – are too restrictive when it comes to strong brands.

Beyond adjectives

Recent trademark usage trends suggest that there are ways that strong or well-known brands can use their marks as a noun or verb without substantial risk of genericide. A number of companies have used their key trademarks as verbs in advertising campaigns without suffering any apparent genericide damage – this is despite having publicly displayed policies on how to properly use and refer to their trademarks (ie, use as an adjective as opposed to verb/noun). For example, investment company Vanguard used the term ‘vanguarding’ to convey the long-term outlook of its investment products to investors; while Microsoft’s chief executive officer Steve Ballmer told the New York Times in 2009 that the Bing search engine brand had the potential to verb up and that he hoped people will ‘bing’ a new restaurant to find its address. Recently Google launched its advertising campaign “Play your heart out” to entice consumers to visit its PLAY store.

Traditionally, companies would not use or encourage use of their brand names as verbs, or as anything else beyond use as an adjective. Most feared that if a branded product or service became a verb, the brand would lose its distinctiveness and become a name for a generic category or function. A brand is lost to genericide when use of the term becomes so prevalent or generic that it is no longer associated with the brand-owning company.

History is replete with successful brands that were lost to genericide and are now viewed as generic terms for certain products: aspirin, escalator and zipper were all distinctive trademarks at one time. Companies even launched advertising campaigns to

encourage the public to use their trademarks properly. Consider the example of Xerox, which urged consumers to ‘photocopy’ instead of ‘xeroxing’ documents, in an attempt to ensure that the phrase ‘to xerox something’ did not become another way of saying ‘to photocopy something’.

If this happened, then the term Xerox would not be associated with the company’s distinctive brand of copiers, but instead with the function of photocopying. This was significant because genericide of the Xerox brand would have resulted in the loss of ability to distinguish its products or services from those of competitors.

Yet in stark contrast to these historical examples, the increase in competition in nearly every product category – along with greater consumer sophistication today – has reduced the risk posed by a brand name becoming a verb. Moreover, ever-shortening product lifecycles and the fleeting attention spans of most internet users mean that brands must focus on gaining a market share and voice in a short period of time.

As a practical matter in today’s market, when a brand becomes popular and its use widespread, there is low risk of genericide if the brand is verbed up. The public’s use of the Google brand is one of the best examples of this. People often say that they will ‘google’ something on the Internet to mean that they looked up some information online using the Google search engine, rather than just any search engine.

Given the pace of change evident in today’s internet-fuelled markets, there is clear business value associated with the verbed-up use of brands. To mitigate any risk of trademark genericide, we suggest that rights holders:

- make clear to consumers that the action suggested by the verbed-up brand use cannot be accomplished without using the branded product or service – the verbed-up brand can be built into taglines, slogans and/or logos that reinforce this point above (eg, “Vanguarding can’t happen without Vanguard” and “Google Play, play your heart out”);
- create and publish verbed-up brand use guidelines (and/or update trademark guidelines) that reinforce the first point above;
- register the verbed-up brand or the tagline, slogan or logo containing the verbed-up brand;
- send friendly letters to publishers and media outlets that do not appear to appreciate the necessary connection between the brand and the verb in their references;
- work with dictionaries to ensure that any verb listings are consistent with new verbed-up brand policies; and
- conduct regular monitoring of the public’s use and view of the verbed-up brand – ultimately, it is the consuming public that

Figure 1. Google Doodle examples



determines, through its use, whether a verbed-up brand has lost distinctiveness through genericide.

Fluid and living brands

Traditional thinking says that a mark should be represented in a consistent manner (ie, the same way each time). Brand owners fear the loss of rights that can occur when they cannot tack rights from an updated version of a mark onto rights from the original mark. Tacking requires that two marks make the same continuing commercial impression, which can prove a high bar. However, can a rights holder act strategically to get the best of both worlds: a mark that is protected, yet flexible?

Google did something disruptive and innovative when it started morphing its GOOGLE logo on a regular basis. The so-called 'Doodles' are, as the search giant notes, "fun, surprising, and sometimes spontaneous" (see examples above). Initially, the Doodles startled consumers. Now demand is so great that Google has a team of dedicated illustrators and has created over 1,000 variations of its brand. The innovation worked: the Doodles have helped Google to attract consumers, keep them interested and build brand loyalty.

Some call brands such as this fluid trademarks. However, this may be a misnomer. It might be more accurate to call these brands living trademarks. Like a time-lapse video of a person ageing, these brands transform in appearance over time, but retain their essence; but unlike such a video, these marks are not really fluid – the word calls to mind motion marks, which have a stream of movement that is missing here.

Why do living trademarks work for Google? The brand is strong enough to avoid getting lost in the Doodles. The underlying famous brand, in effect, shines through. Over time, the Doodles have arguably enhanced goodwill in the Google brand by making it come to life in the eyes of consumers. And Google has conditioned consumers – for the benefit of all brand owners – to believe that strong brands can change, yet remain consistent source indicators.

Google notably continues to use its classic GOOGLE logo (see below) and maintains registrations for both that logo and the word GOOGLE in standard characters. Moreover, Google has played it safe on the PR side by not attacking Doodle parodies and becoming a trademark bully.

Tinkering with a major brand was once unthinkable. Google's experiment has changed consumer expectations of what it means for a strong brand to be consistent. It should therefore change how

brand owners, their counsel and trademark offices view strong brands: they have the ability to morph and at the same time to build goodwill. In the non-profit context, the concept of a living trademark provides a particularly intriguing option. Non-profits with strong brands could – if their culture, tradition and polict allow – be more forgiving when it comes to allowing chapters, for example, to make changes to the licensed brand to attract attention and build brand loyalty with their local audience.

Trademark offices should find a way to register living trademarks and give them special status. Offices could require brand owners to submit evidence of a mark's strength and examples of the mark in varied form. In exchange, registrations could provide rights in the part of the mark that is consistent and confer two special legal presumptions. First, the logo may change in more than a material way without loss of rights in the underlying design or stylisation. Second, the underlying design or stylisation is entitled to broader protection than a typical design or stylisation, in the same way that the root word of a family of marks is entitled to broader protection by virtue of the family. (Trademark offices could note that this does not mean the mark is a phantom mark, such as LIVING XXXX FLAVOURS, where XXXX is a variable signalling that the applicant seeks to register multiple marks through one application.)

So, when breaking the traditional (ACID test) rule of using marks in a consistent manner, rights holders and counsel should:

- make sure the subject design or stylisation is strong, with substantial goodwill;
- gauge how much to play with the design or stylisation based on the relative strength of the mark (eg, famous marks can be changed the most);
- change only the design or stylisation, not the corresponding word mark (except when it comes to breaking the ACID test rule of using word marks as adjectives, above);
- make sure that the essence of the logo is retained (eg, the stylisation of the word mark GOOGLE is regularly discernible);
- continue regular trademark use of the original design or stylisation;
- maintain trademark registrations for the original design or stylisation and underlying word mark standing alone;
- not be a trademark bully when others do parodies;
- refer to fluid trademarks as living trademarks; and
- advocate for trademark offices to register living trademarks as such, and give them special status.

Trademark law and practice must evolve to keep pace with changing consumer sophistication and expectations. As it does, do not be afraid to break the old rule of proper trademark use when it comes to strong brands, especially famous ones. [WTR](#)

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Figure 2. The classic Google logo



ARTICLES

April 23, 2014

CONSIDERATIONS FOR NONPROFITS WHEN USING GETTY'S NEW "FREE" IMAGES

This article was also published in the May/June 2014 edition of Signature magazine and in a National Association of Home Builders e-newsletter on May 2, 2014.

AUTHORS

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Getty Images, one of the largest online U.S. stock photo image companies, recently made over 35 million photo images from its inventory available for free online use by any interested person. Getty had previously charged for the use of all of its images. Given the ease with which a digital image can be copied, however, frequent use of Getty's images online caused the images to turn up in search engine results that led to rampant re-use and sharing by additional persons without an appropriate legal license from Getty. This shift in Getty's policy offers a new approach to prior and often unsuccessful attempts by Getty to control the systemic infringement of its images online. Getty's new policy provides a select group of images for free via a new embedding feature that provides attribution and a link back to Getty Images' website. Beginning March 6, 2014, a nonprofit entity will be able to visit Getty Images' library of content, select an image, and copy an HTML-embedded code to use the image on its own website.

Nonprofits often make frequent use of Getty images on their respective websites. This policy shift offers an intriguing option for nonprofits to exploit a Getty image at no cost. Although nonprofit organizations can use these photos for free, it remains critical to understand the limits of Getty's new policy.

The new Getty policy does not permit all types of use. Specifically, Getty Images' Terms of Service states that the images cannot be used: "...for any commercial purpose (for example, in advertising, promotions or merchandising) or to suggest endorsement or sponsorship." The line between what kind of use constitutes commercial use as opposed to non-commercial use on the Internet is murky at best. Consequently, understanding the limits of Getty's free usage option may prove difficult to navigate. Getty has yet to offer a comprehensive interpretation of its Terms of Service for this new image policy.

Some pieces of insight from Getty on its interpretation of what constitutes "commercial purposes" have begun to emerge. In a recent statement emailed to the online publication GeekWire, a Getty spokesperson said the following:

"Embedded Getty Images content may be used only for editorial, non-commercial purposes (meaning relating to events that are newsworthy or of public interest). If the use promotes a company, product, or service, the users will need to purchase a license. If not, they can use the embedded content so long as they are happy to use it in the embed frame and functionality. The presence of ads on a site doesn't automatically make use of an embedded image on that site a commercial use. Think about sites like CNN.com or any online newspapers or magazines which support editorial content with site ads. The key attribute in classifying use as commercial is whether the image is used to promote a business, goods or services, or to advertise something. If not, it is a non-commercial use. Likewise, corporate blogs would be treated as editorial/non-commercial unless the image is directly being used to sell or promote their products or services."

This recent statement helps to clarify Getty's own interpretation. First, it is now clear that nonprofit entities likely cannot use the images to market their own products or services. Further, it is likewise clear that use in connection with editorial or news-based activities looks acceptable. But, use generally on a website, in connection with programs or events, or where other third-party advertising is a part of the use remains less clear. In other words, grey areas remain.

Nonprofit entities should keep another issue in mind when determining whether to use the free images.

According to Getty's Terms of Service, Getty gives to itself some additional rights in connection with providing the photos at no cost, namely, "Getty Images (or third parties acting on its behalf) may collect data related to use of the Embedded Viewer and embedded Getty Images Content, and reserves the right to place advertisements in the Embedded Viewer or otherwise monetize its use without any compensation to you." The data collection may relate to benign purposes. However, the opportunity exists for targeted advertising over which a nonprofit may not be in a position to exert much control. Accordingly, use of a free image may require allowance for uncontrolled third-party images and advertisements.

Overall, while the release of these photos by Getty is certainly a great opportunity for the enhancement of web content for nonprofits with limited budgets, it is important to use the images with caution. Nonprofit entities should keep in mind the restrictions on use as well as the possibility of the placement of future ads when determining how and where to use the new free images.

ARTICLES

March 10, 2011

NONPROFITS: DON'T GET CAUGHT NAKED (LICENSING)

Association Trends (and elsewhere in various forms)

This article also appeared in the Annual Legal Review section of the March 17, 2011 issue of Association TRENDS. To read the entire section, visit the [Association TRENDS website](#).

Additionally, this article was published in the American Association of Medical Society Executives (AAMSE)'s Hotline on March 4, 2011; Final Proof, an e-newsletter by Association Media & Publishing, on March 15, 2011; the Summer 2011 issue of Chamber Executive; the July 21, 2011 edition of ASAE's Dollars & Cents; and the July/August 2011 issue of Taxation of Exempts.

Nonprofit organizations often allow others to use their trademarks – such as their logos – without much control. This was not a major problem years ago when nonprofits were less aggressive in disputing trademarks and had charitable missions that made courts more tolerant. Today's nonprofits are different.

The Wall Street Journal noted the rise in trademark battles among nonprofit organizations in a page-one story on August 5, 2010. As I told *The Journal*, "The days are probably over when nonprofits just said, 'We'll just get along with anybody who's a nonprofit because we're all trying to do good here.'"

More recently, in November 2010, a federal appeals court, in a case called *Freecycle*¹, found that a nonprofit abandoned its trademarks because it engaged in what is called "naked licensing." Simply said, naked licensing is when a trademark owner allows another party to use its trademarks without sufficient control. All trademark rights are lost when abandonment occurs.

The amount of control required to avoid naked licensing depends on the circumstances, though *Freecycle* provides some guidance. The big-picture mistakes of the trademark owner in *Freecycle* would apply to most trademark owners. In *Freecycle*, the court found the owner failed to have an overall system of control. Specifically, the owner (1) failed to retain express contractual control over use of the marks by its members, (2) failed to exercise actual control over use of the marks by its members, and (3) was unreasonable in relying on the quality control measures of its members. Thus any trademark owner should establish control in writing, exercise actual control, and not rely on members to control themselves, as discussed further below.

To determine what type of control is needed within this system, it is useful to understand the type of mark being challenged in *Freecycle*. In *Freecycle*, the marks (e.g., FREECYCLE) appeared to be traditional trademarks (*i.e.*, marks that identify the source of goods/services); the owner sought to register its logo as such. The marks did not appear to be certification marks (*i.e.*, marks that certify the quality of goods/services) or collective membership marks (*i.e.*, marks that just signify membership in an organization).

Arguably collective membership marks require less – or at least a different type of – quality control compared to traditional trademarks and certification marks. This is because collective membership marks just signify membership in an organization. These marks do not signify that goods/services come from a particular source (like the traditional trademark THE NATURE CONSERVANCY on a magazine) or that a product is of a certain quality (like the certification mark UL on an electronics device, which shows approval by the nonprofit Underwriters Laboratories). This distinction is important in considering how to treat marks used by the members and chapters of nonprofits. It may help to treat such marks as collective membership marks to avoid naked licensing.

AUTHORS

Andrew D. Price

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Often a nonprofit wishes to allow members and chapters to use the nonprofit's primary logo as a sign of membership, though the nonprofit does not wish to manage a certification program like UL or a traditional trademark license (e.g., as used in merchandising). In that case, the nonprofit should take three steps.

First, the nonprofit should ensure the mark does not make the impression of a certification mark or traditional trademark, but instead makes the impression of a membership mark. An effective way to convey this to the world is to add the word "MEMBER" (for members) or "CHAPTER" (for chapters) to the mark and apply to register the mark as a collective membership mark with the U.S. Patent and Trademark Office (USPTO).

Second, the nonprofit should change its bylaws and/or policy manual in such a way that will license the mark to members and chapters, and automatically bind them to specific controls for use of the mark. The specific controls would include a requirement not to use the mark other than as a sign of membership (except that chapters could provide limited services the nonprofit expects from a chapter). The controls would also require members/chapters not to change the mark, and to stop using the mark when member/chapter status is lost.

Third, the nonprofit should actively enforce the trademark terms of the bylaws and/or policy manual. (Note that, barring an instance of a nonprofit's members agreeing to be bound by the terms of a policy manual as a condition of membership, only a nonprofit's bylaws are contractually binding on members of the nonprofit – if the organization has *bona fide* members – so that if the provisions are included in a policy manual, you will want to cross-reference that fact in the bylaws. For non-membership nonprofits, there will need to be some affirmative agreement to the terms and conditions, such as an online click-and-accept feature.)

As a final point, it is important to note that the trademark owner in *Freecycle* alleged that a 1993 case called *Birthright*² stood for the principle that loosely organized nonprofits, which share "the common goals of a public service organization," should be subject to less stringent quality control requirements. The court in *Freecycle* said that even if it were to apply a less stringent standard, the trademark owner in *Freecycle* would not meet the lower standard (and that even a lower standard would still require some monitoring and control, consistent with *Birthright*). The court did not take the chance to say whether the "less stringent" requirements should still apply to nonprofits in today's world, though the court seemed skeptical.

We would expect a modern court that takes a position on the *Birthright* issue will say the "less stringent" requirements for quality control do not apply to nonprofits in today's world – especially nonprofits without charitable missions. The party in *Birthright* provided charitable, emergency services for women with crisis pregnancies. Many nonprofits today are not focused on charity but are more like businesses. Many nonprofits today have the size, professional staff, and resources to manage their trademarks like any for-profit company. Thus, nonprofits today should be prepared to be viewed like for-profit companies for trademark law purposes.

Even if nonprofits happen to be subject to "less stringent" requirements, they should be prepared to face aggressive adversaries in trademark disputes. Thus nonprofits should rise to meet basic quality control requirements by establishing control in writing, exercising actual control, and not relying on members to control themselves. In any case, it may help nonprofits to treat certain marks as collective membership marks and take appropriate steps to ensure the marks are treated that way by consumers, the USPTO, and courts – or risk getting caught engaged in naked licensing.

* * * * *

Andrew D. Price is a partner at Venable LLP in the Trademarks, Copyrights and Domain Names practice group who works frequently with the firm's nonprofit organizations practice. For more information, please contact him at adprice@Venable.com or 202.344.8156.

This article is not intended to provide legal advice or opinion and should not be relied on as such. Legal advice can only be provided in response to a specific fact situation.

¹ *FreecycleSunnyvale v. Freecycle Network*, 626 F.3d 509 (9th Cir. 2010).

² *Birthright v. Birthright Inc.*, 827 F.Supp. 1114 (D.N.J. 1993).

ARTICLES

June 2004

ASSOCIATION TRADEMARK BASICS

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Association names and acronyms may be trademarks protected under federal law or at common law. But what happens when your association's name or acronym is used by another association? Can you prevent the other association from using your mark or will your association have to give up its mark after all the time and money expended on building recognition in the mark? The answer is: it depends.

It is important for every association to understand the basics of trademark law in order to secure its trademark rights, to recognize infringement of its marks, and to avoid possible infringement of someone else's trademark.

A trademark is any word, phrase, symbol, or design (or combination thereof) used by a company, individual, or association to identify the source of a product. A service mark is the same as a trademark except that it identifies the source of a service. A certification mark is a mark used by an authorized third party to indicate that their products or services meet the standards set by the owner of the mark.

Choose your mark carefully, because not all trademarks are entitled to protection under either common law or federal law. Generic marks (those that are the common name of the product or services offered, for example, CARS for cars), or descriptive marks (those describing a feature, function, quality, characteristic, use or user of the product or service offered, for example, USED CAR DEALER for a magazine in the field of automobiles), marks that are primarily surnames, geographically descriptive marks, national symbols or scandalous marks are generally not protected. However, descriptive marks and surname marks can acquire trademark significance through extensive use of the mark over time. It may also be possible to get around these problems by combining a generic, descriptive or surname mark with a distinctive logo design; the words together with the design may be protected.

Ideally before a trademark is chosen, the mark should be "searched" and cleared for availability. Searching can answer two questions: will the use or registration of the mark infringe someone else's mark, and will you be able to stop or prevent someone else from using the same or a similar mark to identify the source of the same or similar products or services? It is worth noting that infringement of a trademark does not have to be intentional; innocent infringement still forms the basis for a cause of action against the later user. Therefore, searching and clearing trademarks can be a critical part of managing and protecting your association's intellectual property.

Trademark rights are established either by use of the mark in commerce, or by federal registration with the U.S. Patent and Trademark Office ("USPTO"). For state or local associations, state registration also is available. Generally, the first party to use the mark in commerce or the first to file an application for registration has the right to use or register the mark. For example, if the Association for Bicycle Safety filed a trademark application for the mark ABS with the USPTO on March 12, 2003 covering association services, namely, promoting bicycle safety, and the American Bicycle Society begins using ABS on June 12, 2003 in connection with association services, namely, promoting the interests of bicyclers, the safety group would have superior rights (once the application matures to a registration) and could prevent the latter group from using the ABS mark.

Trademark rights extend to the same or similar marks when used to identify the same or related products or services. There may be a likelihood of confusion between two parties' use of the same or similar mark on the same or similar products or services in the same industries, such as in the ABS example above. On the other hand, two different users of the same mark may be able to coexist if the marks are used on different products or services in different industries. For example, the Association for Bicycle Safety and the American Baker Society could both use the mark ABS.

One exception to this rule is if one of the marks is a "famous" mark. The owner of a famous mark may be able to prevent others from using the same mark on *any* product or service if such use causes

dilution of the distinctive quality of the mark. However, a recent Supreme Court ruling has made proving dilution of famous marks much more difficult, especially when the marks are not identical.

Understanding the basics of trademark law will help strengthen the value of your association's trademarks as well as prevent your association from infringing the trademark rights of others, with the sometimes devastating consequences that can follow.

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ARTICLES

June 2004

ASSOCIATIONS AND COPYRIGHT: PRACTICAL TIPS FOR SUCCESS

AUTHORS

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Despite great potential to use intellectual property to raise non-dues revenues and better serve members, many association leaders fear that the “hassles” or “mistakes” surrounding copyright issues in the past preclude new knowledge-based product development. One lawyer’s response? Do something about it.

Your association wants to launch a new online educational service. The association’s staff develops a wonderful, innovative proposal. The service would hinge on taking years’ worth of association-“published” materials on every aspect of your industry and reformulating it into a user-friendly, searchable database.

Or perhaps the idea is to take past articles on select topics from your magazines or newsletters, or past speaker handouts from your conferences, and repackage them into a new, more-accessible online service for members. Or maybe the concept is to create a “best practices” online library, culling sources from your association’s publications, meetings, and other resources. These potential revenue-raisers might even involve another industry association.

In all of these instances, your association’s ability to engage in the exciting new venture hinges on its ownership – or at least right to use – the intellectual property (i.e., copyrights) in the relevant materials. If association employees created all of the materials, the copyright issues would be simple and likely non-existent. Unfortunately, in the world of association management – where staff has no choice but to rely on the invaluable input of and content from volunteers and outside contractors – the legal analysis is far from simple.

In fact, due to a basic, straightforward, yet very misunderstood concept of our copyright law – that the paid or unpaid creator of the work is the owner of the copyright in that work (except for an employee acting within the scope of his or her employment and certain other very limited circumstances) – the realities of this law can throw a big monkey wrench into your association’s well-conceived plans. Some associations are so fearful of copyright law and its implications that they shy away from even attempting what could be highly successful ventures.

All of this is terribly unfortunate – and very unnecessary. Once understood, this simple tenet of copyright law can be quickly used to the association’s advantage. For instance, by obtaining brief, one-paragraph copyright “assignments” (transfers of ownership) or “licenses” (permission to use, which can be drafted broadly and perpetually) from volunteer authors, speakers, and committee members, as well as from all paid contractors and consultants, the association can ensure that it has the rights to do with “its” publications whatever it chooses, without restriction, without fear of reprisal from copyright holders, and without having to pay royalties to hundreds of “joint authors.” And even if your association may not have been as proactive as it should have been over the years – you would be shocked at how many have not – all is not lost. These problems are solvable – easier at the outset than later on, to be sure – but solvable nonetheless.

In short, an even rudimentary understanding of the basics of copyright and trademark law can go a long way toward giving your association the flexibility it needs and wants to engage in the activities it desires, to launch the new ventures it conceives of, and to otherwise act in the best interests of the association rather than let intellectual property laws be the tail that wags the dog.

Below are 11 tips that will, if followed, go a long way toward protecting and maximizing your association’s intellectual property and avoiding the infringement of others’. The following guidelines should provide the framework for effective association policies and practices in the copyright and trademark area:

1. Use copyright and trademark notices. Use copyright notices (e.g., © 2004 The Center for

Association Leadership. All rights reserved.) on and in connection with all creative works published by your association and trademark notices on all trademarks, service marks, and certification marks owned and used by your association (e.g., TM for non-registered marks and ® for registered marks). While copyright and trademark notices are not required, their effective use can significantly enhance your intellectual property rights, including eliminating an “innocent infringement” defense.

2. Register your trademarks. Register your association’s name, logos, slogans, certification marks, and all other important marks with the U.S. Patent & Trademark Office. While federal registration of your marks is not required to obtain and maintain trademark rights, it can be extremely helpful in enhancing and enforcing them. In addition, obtain domain name registrations for all available names you plan to use in the future, and try to obtain registrations from others if your association has superior rights to the domain name.

3. Register your copyrights. Register your association’s Web site, publications, and all other important, original, creative works that are fixed in any print, electronic, audio-visual, or other tangible medium with the U.S. Copyright Office. Again, although such registration is not required to obtain and maintain a copyright in a work, it is a prerequisite to filing suit to enforce your rights, and it confers other valuable benefits. Copyright registration is a very simple, inexpensive process that can be done without the assistance of legal counsel.

4. Police use of your intellectual property. Police the use of your copyrights and trademarks by others and enforce your rights where necessary. Use periodic Web searches, among other means, to do so. Enforcement does not necessarily involve the filing of a lawsuit.

5. Codify all licenses in writing. Whenever your association lets others – such as members, chapters, affiliated entities, or endorsed vendors – use your name, logos, copyrighted works, and other intellectual property, put the terms and conditions of the license in writing. Note that an assignment (transfer of ownership) must be in writing to be valid, as must an exclusive license (permission to use). While oral or implied non-exclusive licenses can exist, they can be difficult to interpret, difficult to enforce, limiting in nature, and otherwise problematic for your association. If a copyright owner will not assign a copyright to your association, simply obtain a broad, permanent license instead. A perpetual, irrevocable, worldwide, restriction-free, royalty-free license to use a copyright holder’s work in any medium – whether exclusive or non-exclusive – can be virtually as good as ownership and typically much easier to obtain.

6. Make sure you own or have permission to use all intellectual property. Ensure that your association owns or has appropriate permission to use all intellectual property (e.g., text, graphics, photos, video) that appears in its publications, on its Web site, and in all other media. More copyright problems arise in this area than any other. You may have conceived the idea, supervised the work’s creation, and paid for it, but that does not mean you own the work. You may have only a limited license for a specific use. When you wish to use the work on another project or in another medium, you may learn that a separate fee and permission is required.

7. Maintain agreements with contractors. Maintain written contracts with all contractors to your association, such as software developers, lobbyists, and other outside consultants and contractors, to ensure that your association is assigned the ownership rights (or at least sufficient, irrevocable license rights) to all intellectual property created by the contractor under the agreement. Without something in writing, the basic rule in copyright law is that the person who creates the work is the one who owns it, regardless of who paid for the work to be created. This rule does not apply to employees, ownership of whose work (that is within the scope of their employment) automatically vests in the employer. If your association is a joint author with another party (e.g., association employees working side-by-side with technology consultants to write software for your association), seek to obtain an assignment from the co-author(s) to your association.

8. Negotiate agreements with authors and speakers. For the same reason stated previously, obtain a written and sufficiently broad license or assignment from all non-employed writers and speakers for your association, including members. Be sure that, for licenses, the permission is irrevocable, worldwide in scope, royalty-free (if applicable), exclusive (if applicable), covers all possible uses of the work in all media, contains a release to use the author or speaker’s name and photograph, and contains appropriate representations and warranties.

9. Don’t forget to collect agreements with board and committee members. Again, for the same reason, obtain a written assignment from every member of your board of directors and committees that assigns ownership of all intellectual property they create (within the scope of their service to the association) to the association. Such a form also can be used to impose confidentiality

obligations on members, to require conflict-of-interest disclosure, and to impose noncompetition restrictions.

10. Protect your membership database. Since names, addresses, and other contact information contained in your membership directory, mailing labels, and membership list are generally not protected by copyright because they usually don't possess the minimum level of originality required, it is imperative for your association to use a "shrinkwrap" license, click-and-accept feature, or other form of contractual commitment to place explicit, binding limits and conditions on the use of your membership list by members, vendors, and others. Failure to do so may leave your association with little or no recourse to prevent unrestricted use of this most-valuable information by those who obtain a copy of it.

11. Rules for interactive online services. As part of your association's chat rooms, bulletin boards, e-mail exchanges, and other member-interactive online services, regularly distribute rules that prohibit the posting of any copyright-infringing materials (along with other rules). In addition, be sure to immediately remove infringing material if it comes to your association's attention.

The bottom line is that a fear of copyright infringement should not prevent association leaders from seriously considering new knowledge products as a way to better serve members, develop non-dues revenues, and forward the organization's mission. However, they should expect to devote significant time and effort to both clearing up any copyright confusion, securing all necessary copyright rights, and ensuring that intellectual property processes and policies are in place and followed.

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Trademark Clearance and Protection

ANSWERS TO THE QUESTIONS BUSINESSES KEEP ASKING



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In the practice of trademark law, there are certain questions that business executives and corporate counsel continually ask. The theme is often whether they can avoid the need for a trademark attorney. Here are answers to some of the most common questions about clearing and protecting trademarks in the United States:

(1) What is the worst thing that can happen if we commit trademark infringement and how likely is this to occur? The real owner could haul you into federal court and obtain an injunction to immediately stop you from using the mark. If they own a federal trademark registration and can show you acted in bad faith (e.g., you intentionally tried to confuse consumers), they could obtain treble damages (e.g., three times your profits). They could also obtain attorney's fees plus a permanent injunction that would forever enjoin you from using the mark. And you would face the cost required to re-brand your goods or services. In practice, most trademark disputes settle before a lawsuit is filed. The owner typically sends the infringer a cease-and-desist letter. If the infringer agrees to stop (either immediately or during a short phase-out period), the owner may release the infringing party and hold it harmless. Still, one can

never predict how aggressive an owner might be in the case of infringement.

- (2) We just searched the free trademark database on the Trademark Office website; our proposed trademark looks available, so can we start using it? The answer is no. A basic search using the Trademark Electronic Search System (TESS)—the database the Trademark Office provides for public searching—does not provide the tailored results you need to make this decision. You can study how to perform an advanced or Boolean search on TESS. For the results to be complete and meaningful, however, the searcher must have experience creating trademark search logic and applying the multi-factor test for trademark infringement: that is, whether there is a likelihood of confusion as to the source of goods or services connected with two marks. Moreover, trademark attorneys often use proprietary databases for serious trademark searching, since those databases tend to be cleansed to remove errors and enhanced to add useful history. Even this level of searching is preliminary, though. A full search is often needed to take a closer look at federal applications/registrations. It also adds coverage for state trademark applications/registrations, common-law marks (i.e., marks that are not the subject of an application/registration, but can still be protected based on actual use), and domain name registrations (which can reveal additional common-law marks).
- (3) We just searched the GoogleSM search engine and it looks like there are no common-law uses of our proposed trademark; can we rely on this as our common-law search? The answer is no. The Google "Advanced Search" is a good place to start, especially if you perform an exact-phrase search. Whether this is reliable, though, still depends on the search logic employed and the ability of the searcher to analyze the results. And remember that search engines are limited to searching only the Internet. A full common law search, by contrast, looks at hundreds

of newspapers, magazines, telephone directories and other resources that may not be available online. Remember that U.S. law provides that common-law trademarks—that is, marks that are used in commerce but not the subject of applications or registrations—can be protected in their geographic areas of use and sometimes beyond.

- (4) We just searched for the domain name we wanted and found it available, so we registered it; are we now safe to use it as a trademark? The answer is no. If you want to register ANVIL.COM as a domain name and others just own ANVILLE.COM and ANVIL.ORG, you can obtain the registration you want. Still, there could be another party who already owns a federal trademark application/registration for ANVIL, or common-law rights in the mark, for identical goods or services. That party might send you a cease-and-desist letter alleging trademark infringement. It might also claim that it is entitled to own the domain name registration. You will not have to surrender the domain name registration unless you obtained it in bad faith (e.g., you knew about their trademark rights and sought to confuse consumers). As a practical matter, however, the domain name will be of limited value if you cannot use the trademark that corresponds with it.
- (5) The secretary of state where our corporation is located just granted us our trade name; are we now safe to use it as a trademark? The answer is no. Secretaries of state do not evaluate trade names using the same test or information applied to trademarks. Instead, they generally consider only whether there is another identical trade name or "D.B.A." (i.e., doing-business-as designation) already registered in that state. If not, they will grant your trade name; for example, they may allow "Anvil Corp." and "Anville Ltd." to coexist. Secretaries of state will not look at the goods or services connected with your name/mark. And they will not look at state or federal trademark applications/registrations, or common-law trademarks.
- (6) We discovered that another party owns the trademark we want for the same goods or services; can we make some small change to our mark to avoid problems? The answer is probably not. The

similarity of two marks is a key factor in the test for trademark infringement. Similarity depends on whether two marks are too close in appearance, sound, connotation, and commercial impression. The following changes are generally insufficient: making the mark plural (e.g., ANVIL to ANVILS); changing spelling but not phonetics (e.g., from ANVIL to ANVILLE); conjoining two words (e.g., from ANN VILLE to ANNVILLE); adding stylization; or adding a slogan or design element. Since parties pick trademarks because they like the appearance, sound, connotation, and impression, they are generally unwilling to alter these features in a material way.

- (7) We discovered that another party already owns the trademark we want; can we call them and get their permission to use it? The answer is yes, but it rarely works and you must be willing to live by their decision. Most trademark owners view their rights broadly, especially owners represented by trademark counsel. Since a trademark is not presumed abandoned until the owner fails to use it for three years, they will generally resist stating in writing that it has abandoned a mark. Moreover, since the strength of a mark is much determined by how many similar marks are registered or being used, owners are generally reluctant to allow others to coexist. Unless you have some leverage (e.g., prior rights in a geographic area of interest), owners are unlikely to accede. If they do not accede, you must pick

another mark; otherwise, they could point to your communications as evidence that you acted in bad faith.

- (8) What are the major advantages of a federal trademark registration? They are a presumption that you are the exclusive owner of a mark and the ability to use the registration symbol (“®”). An important part of this presumption is that it extends nationwide from the filing date of your application. The filing date could be years earlier than the date on which you first use the mark. And the nationwide scope could be much broader than your initial geographic use of the mark. When third parties perform trademark searches and see that you own a registration or application—or observe you using the registration symbol—it should deter them from trademark infringement. If a party commits infringement, the registration allows you to send a persuasive cease-and-desist letter. This gives you the best chance to resolve the dispute favorably without the need for costly litigation.
- (9) Should we simply file the trademark application ourselves? The answer is probably not. There are great advantages to having an attorney file the application. First, the attorney will craft an identification of goods or services that is sufficiently broad to be valuable—it cannot be broadened after the application is filed. Second, if the mark is weak, the attorney will avoid an identification that reinforces that weakness—it is difficult to rehabilitate a

mark whose weakness has already been acknowledged. Third, the attorney will help you present the mark in the way that provides the broadest protection—you cannot alter a mark in a material way after an application is filed. Fourth, the attorney will guide you regarding possible conflicting marks and help tailor your application and use of the mark to minimize the chance of conflict. Fifth, the attorney can help you minimize initial government fees. Sixth, the attorney will enter the application and any resulting registration in an electronic docketing system—this helps avoid abandonment due to a missed deadline. Finally, the attorney will help you understand (and give you the best chance at overcoming) any substantive or procedural issues raised by the Examining Attorney at the U.S. Patent and Trademark Office.

In sum, the most commonly asked trademark questions tend to be variations on a theme, namely, “Can we go it alone?” The answer is maybe; but consider this question: Can you really afford a misstep regarding the name that consumers will equate with your company—and the assets and goodwill that trademark could represent? If not, a trademark attorney can help. **IPT**

ARTICLES

March 1, 2002

DOES YOUR ASSOCIATION OWN THE WORK PRODUCT OF YOUR CONTRACTORS, AUTHORS, SPEAKERS, OFFICERS, DIRECTORS, AND COMMITTEE MEMBERS?

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Jeffrey S. Tenenbaum

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Except for employees acting within the scope of their employment and certain other limited cases, the basic rule under U.S. copyright law is that the creator of an original work is the owner of the copyright in that work (regardless of who paid for the work to be created), barring a written assignment of the copyright to another party. This widely misunderstood rule applies with equal force in the association community, and it applies not only to outside contractors such as consultants and lobbyists, but also to your association's volunteer or paid authors, speakers, officers, directors, and committee members. Failure to understand this rule can have devastating consequences for your association.

It is critical for your association to ensure that it owns, or at least has appropriate permission to use, all intellectual property (*e.g.*, text, graphics, photos, video) that it uses in its publications, on its Web site, and in all other media. Your association's staff may have conceived the idea and supervised the work's creation – with your association paying for it – but that does not mean your association owns the work. You may have only a limited license for a specific use. When you wish to use the work on another project or in another medium, you may find the work's creator demanding a separate fee or other consideration – or you may be precluded from using it at all.

Contractors. Maintain written contracts with all contractors to your association – such as software developers, lobbyists and all other outside consultants and contractors – to ensure that your association is assigned the ownership rights (or at least sufficient, irrevocable license rights) to all intellectual property created by the contractor under the agreement. If your association is a *joint* author with another party (*e.g.*, association employees working side-by-side with technology consultants to write software for your association), seek to obtain an assignment from the co-author(s) to your association.

Authors and Speakers. Obtain a written and sufficiently broad license or assignment from all (non-employed) writers and speakers for your association, including members. Be sure that, for licenses, the permission is irrevocable, worldwide in scope, royalty-free (if applicable), exclusive (if applicable), covers all possible uses of the work in all media, contains a release to use the author or speaker's name, photograph, and biographical information, and contains appropriate representations and warranties.

Officers, Directors and Committee Members. Obtain a written assignment from all association officers, directors and committee members assigning ownership of all intellectual property that they create (within the scope of their service to the association) to the association. Note that when a work has numerous creators (such as a set of standards or a report produced by a committee, perhaps in conjunction with association staff), each of the individual contributors (including the association) may be a joint owner of that work, each with the right to use the work and each with a proportional right to share in all proceeds from the work. Below is an abbreviated version of a sample assignment form for use with association committee members (more comprehensive versions of such forms are sometimes used):

Copyright Assignment Form for the ABC _____ Committee

As a member of the _____ Committee (the "Committee") of the ABC Association ("ABC") that assists ABC staff members and others in the development, modification and refinement of _____ and related material for its _____ (collectively, the "Intellectual Property"), I, _____, hereby completely, exclusively and irrevocably assign and agree to assign to ABC in perpetuity ownership of all of the copyrights (and all rights subsumed thereunder) in and to all of my contributions to the Intellectual Property (the "Contributions"), both those Contributions that have been made in the past and those that will be made in the future. I hereby grant, convey, assign, and set over unto ABC, its successors and assigns, on an exclusive basis, all of my right, title and interest in and to the copyrights in the Contributions, including, without

limitation, copyrights and renewals and/or extensions thereof, for all territories of the world in perpetuity. Good and valuable consideration has been provided to me for the assignment of these rights. In addition, I hereby waive any and all rights of attribution and integrity with respect to ABC's use of the Contributions.

Signature _____

Date _____