

Nonprofit Organizations Committee Legal Quick Hit: Key Trademark and Copyright Rules for Nonprofits to Follow – and Break!

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3:00 p.m. ET

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Program Overview

- Trademarks: 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
 - Only registered rights effective under the DMCA in taking down infringing content.
 - Copyrights must be recorded in order for Customs to stop infringing imports.



Trademarks: Is the “ACID” Test Outdated?

- The Test
 - Adjectives
 - Consistent
 - Identification re: whether mark is registered
 - Distinctive or attention-grabbing manner
- The Fear
 - Genericide
 - Loss of rights
- The Times
 - Ever-shortening product lifecycles
 - The mobile marketplace; short attention spans



Using Strong Brands as Nouns and Verbs

- Examples
 - Google PLAY: PLAY YOUR HEART OUT
 - Vanguard: Vanguarding
 - Bing



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 “Google Play, play your heart out”)
- Create and publish verbed-up brand use guidelines (and/or update trademark guidelines) that reinforce this concept



Using Strong Brands as Nouns and Verbs: Guidelines

- 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



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
- 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



Using Strong Brands in a Fluid or “Living” Manner

- Google “Doodles”
 - Build brand interest and loyalty



- Fluid trademarks
 - A misnomer?
 - “Living” brands
- Nonprofit culture, tradition, and policy



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

- 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 (e.g., 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)



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

- Make sure that the essence of the logo is retained (e.g., 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



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

- Do not be a trademark bully when others do parodies
- Refer to fluid trademarks as living trademarks
- Advocate for trademark offices to register living trademarks as such, and give them special status



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, without registration you cannot enforce your rights online. Specifically, you cannot get ISPs and social media platforms to take down unauthorized content under the DMCA without having a “registered” copyright.



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 copyright owner with information regarding the seizure, including description of merchandise, quantity seized, country of origin, and name and address of the manufacturer and importer.



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