

Key Trademark and Copyright Issues Every Print or Digital Media Publishing Company Should Know: In Practical Terms

By [Linda J. Zirkelbach](#)

Whether your company publishes media in traditional print form, or creates content, licenses rights, and offers content digitally, it is essentially functioning as a publishing company. The references in this article to “publications” typically refer to either digital or print media. Trademarks and copyrights are key assets of a publishing or media company. However, the rules of the road are often misunderstood or overlooked. A good understanding of the law in both areas can result in tremendous value for your company and the avoidance of costly disputes that could cost it not only significant legal fees (yours and you could also be ordered to pay the fees of the adverse party) and money damages, but also disruption to your business, if you need to pull certain digital content or reprint your print publications. If you use the terms “trademark” and “copyright” interchangeably, you are not alone. Read on for some useful tips.

Put simply, trademarks are your “brand,” and copyrights are your “content.” Trademarks are most often words or symbols (or a combination of both) that are prominently used on one’s goods or services. A copyright protects the *original expression of the idea*, whereas a patent can protect the idea itself. Because only a minimum level of creativity is required for something to be copyrightable, many things are capable of being copyrightable “works.” Examples include written works, websites, marketing materials, music, photos, videos, software programs, artwork, and even logos in some instances. Your company likely owns many more copyrights than you may think about

on a daily basis.

Below is a practical guide to some key trademark and copyright issues and pitfalls your publishing company should understand:

1. **Search, Clear, and Register Your Trademarks/ Brands in All Markets in Which you Do Business or Plan to Do Business**

Simply deciding upon and using a trademark, without certain legal offense and defense, is risky. First, it is advisable to have trademark counsel search and clear your desired trademark before you begin using it, to make sure there are no prior users of your desired trademark, or of one confusingly similar, in your market, who could sue you for trademark infringement or pose a bar to your efforts to register your trademark. Second, registering your trademark federally has very significant benefits. Third, in many foreign countries, the first party to file an application to register any given trademark can obtain superior rights to the mark. This could mean that, if another party filed to register your trademark in a foreign country before your company did, you may not be able to use your trademark/brand in that particular country. This is particularly true in the digital environment where companies abroad may see your trademark and decide they would like to file to register it in their country. Trademark registration is relatively inexpensive and usually much more desirable than having to completely change your brand, or engage in a costly dispute or negotiation, in order to enter a foreign market.

2. Be Sure That Your Current Insurance Policies Cover IP Claims

Typically, general commercial liability insurance policies do not cover IP infringement claims, although you may have other coverage in place that provides for some IP infringement coverage. This can be an unpleasant surprise if you learn, after you receive an infringement claim, that no insurance coverage is available to your company. Check with your insurance broker or agent, and your legal counsel, to determine whether and the extent to which your policies cover the likely types of IP claims that could be asserted against your company and make the necessary changes while you still can.

3. Have Your New Digital or Print Publications Reviewed and Cleared by Qualified Counsel

You likely worked with numerous third parties to create your print publications or other digital content, or included material in your publications from other sources. In many cases, without the proper agreements, you may not have the necessary rights to include certain content and are exposing your company to liability for a copyright infringement lawsuit or a claim that you violated a third party's publicity or privacy right. Damages in these cases, particularly in copyright infringement cases, can be extremely high. For this reason, it is advisable to have qualified counsel review your new publications before they are released to ensure that your company does have the necessary rights. We regularly identify issues while it is still early enough to fix them by obtaining the proper agreement prior to releasing the publication or swapping out one piece of content for another for which the company does have rights, or can easily obtain the necessary rights. If you have an insurance policy that covers IP claims, your insurance carrier may expect that your company conducts a proper legal review of your publications prior to publishing them. Check on this point. Below are some useful tips on how best to document your rights in order to reduce the time spent on legal review and avoid a scramble to obtain the necessary rights on the eve of your publication date.

4. Fully Understand The Terms of Your Licenses, Publishing Agreements, or Other IP Rights-Related Agreements

We see many companies using a template licensing or publishing agreement from a form book. It is important to have solid licensing and publishing agreements, tailored to your particular content distribution needs and business model. It is also very important that your company and those directly involved in the execution of the agreement understand its terms and any changes negotiated with the other party to the agreement, so that your company complies with your obligations. An investment at the outset can save significant time and expense if it avoids a costly and distracting dispute with the author or licensor in which you risk paying legal fees (yours and potentially those of the other party in many copyright cases) and money damages and possibly having to pull your publication or remove certain content from your digital publications. Today, everyone is repurposing content. Where your company can get into trouble is if the party that created the content gave you a narrow license to use its material in only a specific, limited way and your company unwittingly exceeds the scope of that license when reusing the material beyond the original scope granted. Fully understand the terms of the licenses you have and try and obtain broad rights upfront. Such rights can be incredibly valuable to your company later if you are able to broadly repurpose the content you already previously used.

5. Make Certain That You Have Appropriate Written Agreements in Place That Cover Ownership or Use of Copyrights with Non-Employees Who Create Content for Your Company

A very common misconception of companies is that if the company paid for an outside contractor to create the copyrighted material, then the company owns the copyright to that material. This is not necessarily the case. The only way that a company owns the copyright in a work created by an individual is if (a) the individual is/was an employee of the company who created the work within and during the scope of his or her employment by the company, (b) the work created quali-

fies as a “work made for hire” under the fairly narrow definition within the copyright statute and you have an agreement signed by the person who created the work stating that it is a work made for hire, or (c) you have a written agreement signed by the person who created the work stating that he/she has assigned (transferred ownership of) the copyright to your company. If your company does not satisfy at least one of the above three criteria, it does not own the copyright.

However, you may still have a license to use the copyright. And, in some cases, that may be all that your company needs. But because the scope of the license can vary greatly, it is important that you obtain a solid license in writing with the necessary scope included. On one end of the spectrum, as to scope, is a nonexclusive license just to reproduce or distribute the material for one particular purpose, such as a one-time use. On the other end of the spectrum is an exclusive license that is perpetual, royalty-free, worldwide, irrevocable, and for any use whatsoever, including print and digital rights. It is important that you have clear documentation of the scope of any license, otherwise you could find that you are uncertain whether you can use the material, or worse, that you are involved in a copyright dispute. Copyright law requires exclusive licenses to be in writing. While nonexclusive licenses are permitted to be oral and even implied, without something in writing, you would be relying on memory and potentially later disputing what was previously agreed, with no documentation to support your understanding.

6. Have Agreements Covering Both Copyrights and Rights to Use the Individual’s Likeness

Do not forget that in order to use a person’s likeness (e.g., a photo or video clip), your company must also have a likeness release from the individual in addition to a license from the photographer or videographer (or ownership, if applicable). It is a very common mistake to obtain rights from only one of the two parties. You may also be able to obtain all the rights you need from the licensors of stock photos, depending on the situation.

7. Ensure That Your Company Obtains Permissions or Other Licenses to Use Pre-Existing Content from Third Parties

If your company desires to include pre-existing third-party content (i.e., copyrighted material from other sources that already existed) in your publications, it is important to obtain written permission from the third party for the permitted use. As a general matter, absent a fair use exception (which typically is very limited in applicability to commercial publishers), this must be properly licensed or your company may be liable for copyright (and/or trademark) infringement. And try to obtain a broad, written scope of use in the first place if at all possible (and it usually is very possible). Also, make sure to keep good and clear records of your licenses; one day you will need to find that license.

8. Keep Good Records of Your Registrations, Publications Dates, and Licenses Granted and Received

Although your company’s time and resources may be limited, it is important that you have a good recordkeeping system. You may need to rely upon it one day. So many companies have difficulty locating their important documents when they need them, including agreements that they own certain content they had paid for years before, when they attempt to use the content again in another publication or in another manner. First, put your Certificates of Copyright Registration in a safe place. In the event of a dispute, you may need an original to provide to a court. If you have misplaced yours, you will have to order new ones, which takes time and money. Second, keep records of when you first “published” your work (which is often when it hit the market, was first distributed, or was first posted on the Internet), because that information may be critical when it comes to establishing that an infringer had “access” to your content in order to prove liability, or to prove that you are entitled to seek statutory damages and attorney’s fees based on the timeline of publication of your work, your application to register it, and the infringement. Third, keep records of the permissions or licenses your com-

pany grants to third parties. You may see your content elsewhere and need to ascertain whether you granted the party in question permission to do this. A party also may contact you and ask for an “exclusive license” for some particular content; you will need to make sure that you have not already granted another party a license, or, if you have, you will have to determine the term of the license or how you might terminate it. Fourth, your company should keep records of the licenses and other copyrights that third parties grant to your company. You will likely need to determine at another point what rights you have if you want to continue using something you once licensed, or use it in another way. Of course, it also is critical evidence that you did not infringe in the event the other party alleges that you are infringing because he/she had no record of granting your company a license.

9. Apply to Register Your Copyrights within the 90-Day Window

It is a best practice to have an internal system to ensure that you apply to register your company’s copyrights with the U.S. Copyright Office within 90 days of the publication of your “work.” Your “works” include not only print publications, but websites or software programs, etc. It can be important to register later versions or updates, such as of your websites or software programs. In contrast to federal trademark registration, copyright registration is a much simpler, inexpensive process, typically without any back-and-forth with the Copyright Office. Here is why copyright registration—and when you do it—is so important:

If you (1) applied to register your work before the infringement occurred, or (2) the infringement occurred before you applied to register your work, but you still filed your application within the first 90 days after the publication of your work (which generally means when it hit the market, went live, or was first distributed), you are permitted to seek *both* statutory damages *and* attorney’s fees in litigation. As background, a copyright owner who proves liability can elect either (a) actual damages or (b) statutory damages from an infringer. Actual damages (e.g., what the infringement really cost you in dollars) can be extremely hard to prove. Even if you can prove actual dam-

ages, they can sometimes be very low and/or very expensive to prove in litigation. In contrast, the copyright statute sets forth the minimum and maximum statutory damages that a court can award per work infringed. Except for very unusual circumstances, by statute, a court must award from a minimum of \$750 to a maximum of \$30,000 per work infringed if the infringement was “non-willful.” Where a court finds that an infringement was “willful,” which is often the case, the court can award up to \$150,000 per work infringed. These are powerful numbers.

Provided that either (1) or (2) above applies, you are also permitted to seek your attorney’s fees in court. Attorney’s fees can be significant, and an alleged infringer may be on the hook to pay both your legal fees and the infringer’s own legal fees. A cease-and-desist letter pointing out the possibility of having to pay both (a) sizeable statutory damages and (b) the copyright owner’s attorney’s fees often will stop an infringer in his tracks. A large potential court award also can encourage a quick and efficient settlement and/or put your company in a strong position in the event of litigation.

If you did *not* (1) apply to register your work before the infringement occurred or (2) file your application to register your work within 90 days from publication of your work (even if the infringement occurred in that 90-day period), then you can only seek actual damages, which are very difficult, and expensive, to prove, and you cannot seek attorney’s fees. If you do not timely apply to register your works and find yourself in a dispute, a seasoned copyright lawyer will be well aware of the significant limitations of any claim you might threaten to file—and assume that you may not follow through with any litigation.

10. Place Appropriate Copyright Notices on Your Works

Under current law, a copyright owner is not required to place a copyright notice on his/her copyrighted work. However, it is highly advisable that your company place an adequate notice on your works for several reasons. First, as a general rule, if an alleged infringer had access to your copyrighted work, and this work had an

adequate copyright notice, the infringer will not be found to be an “innocent” infringer, which can otherwise mitigate actual or statutory damages. Second, you make it clear to the average person that your company claims a copyright in the particular content and put them on notice that they should not copy the material without your permission. Third, having a copyright notice tells others whom to contact should they wish to seek a license or permission to use your copyrighted work (often for a fee).

The copyright statute requires that a proper notice must include

- a) The symbol ©, or the word “Copyright” or abbreviation “Copr.”
- b) The year of first publication of the work.
- c) The name of the copyright owner, or an abbreviation by which the name can be recognized, or a generally known alternative designation of the copyright owner.

11. If You Operate a Website, or Other On-Line Forum or Network, That Permits Third Parties to Post Content on Your Website, Forum, or Network, (1) Prominently List Your Digital Millennium Copyright Act (DMCA) Agent, (2) Designate Your DMCA Agent at the Copyright Office, and (3) Implement an Internal Protocol so That You May Quickly and Fully Comply with the Copyright Statute if You Receive a DMCA Notice

As a general rule, if there is infringing content in your materials, whether print or online, your company could be held strictly liable even if a third party uploaded the infringing content to your website. However, section 512 of the Copy-

right Act has a very specific and formulaic procedure that can potentially mitigate your liability by providing a “safe harbor” from otherwise strict liability, provided that you carefully adhere to it. Put simply, section 512 of the Copyright Act sets forth a mechanism by which your company can designate a DMCA Agent to receive what people typically refer to as a “DMCA Notice,” and you must follow the procedure carefully. Not only must you designate a DMCA Agent on your website (and other electronic systems or networks controlled by your company), and provide all of the information required by the Copyright Act; you also must file a Notice of Interim Designated Agent at the Copyright Office. In the event you receive a valid DMCA Notice, you must respond expeditiously and follow the requirements set forth by section 512 of the Act. An added benefit to the potential “safe harbor” from liability is that complainants have a straightforward, and very commonly used, method to contact your company in the event they find content they believe to be infringing on your site, rather than go straight to a traditional dispute. If you receive a notice styled as a “DMCA Notice” or “512 Notice,” or anything similar, do not ignore it.

* * * * *

In sum, trademarks and copyrights are the backbone of any publishing or media company. If trademarks and copyrights are properly understood at all levels of your company, your company can leverage your assets, can run more efficiently and effectively, and avoid potential liability to third parties. It is critical to your business that your company understands the rules of the road and has internal systems in place to properly address the issues discussed above.



[Linda J. Zirkelbach](#)
ljzirkelbach@Venable.com
202.344.4410

[Click here for more information on Venable’s Publishing and Digital Media Practice.](#)