



Primer on US Intellectual Property Law for Nonprofit and Tax Exempt Organizations

COHEN & GRIGSBY, P.C.

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Scope of Presentation

- This is a high level overview mostly from the US perspective and NOT legal advice about specific situations or intellectual property protections under any legal system other than the United States.
- The information conveyed is of a general nature and is not intended to address the circumstances of any particular individual or entity. Legal analysis can be complex and often turns on small factual differences. No one should act upon such information without appropriate professional advice after a thorough examination of the particular facts involved.
- The opinions and views expressed in these materials are not necessarily those of the firm, nor do they necessarily represent firm policy, or recommended procedure at any given time.

Who do we serve?

- The Cohen & Grigsby Nonprofit and Tax-Exempt Organizations Group serves:
 - educational institutions,
 - research institutions,
 - healthcare organizations,
 - religious organizations,
 - trade associations,
 - community groups and social service agencies,
 - public broadcasting companies,
 - cultural and performing arts organizations, and
 - private and family foundations

What services do we provide?

- The Cohen & Grigsby Nonprofit and Tax-Exempt Organizations Group offers strategic consultation, legal services and governmental affairs
- Legal Services include:
 - Mergers and Affiliations
 - Joint Ventures
 - Shared Services
 - Human Resources
 - Intellectual Property
 - Financial Restructuring
 - Risk Management/Litigation
 - Contract Preparation and Review
 - Governance
 - Real Estate
 - Immigration
 - Benefits
 - Finance

What is Intellectual Property?

- Intellectual property is a general term for categories of rights in intangible creations of the mind
- There are four main types of IP:
 - Patents
 - Copyrights
 - Trademarks
 - Trade Secrets

Why Does IP Matter?

- All companies have intellectual property
 - Patents, copyrights, trademarks, trade secrets, and domain names
 - Contracts (*e.g.*, employment agreements, NDAs, license agreements)
- Intangible assets account for 80% of a company's value (Source: Forbes, Oct. 2014)
- Establishes protectable legal interests in the goods/services and the technology used to produce them
- Can be sold, licensed, or leveraged for profit
 - Royalty payments are an exception to UBIT
- Attracts investment or acquisition
- Provides a competitive edge by blocking competitors from market entry
- Builds brand awareness and loyalty among consumers

What does the IP Group do?

- Patent prosecution and strategic patent counseling
- Trademark selection, registration, and enforcement
- Copyright registration and protection
- Domain name registration and protection
- Protection of trade secrets and confidentiality
- Technology transactions and licensing
- Due diligence and risk assessments
- Clearance searches and opinions
- Litigation

Discussion Question

- What are the most common IP issues for nonprofit and tax exempt organizations?
- Ownership disputes of:
 - Trademarks
 - Copyrights
 - Domain names
 - Social media

Legal Battles Over Trademarks

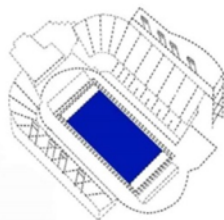
- Charity Brawl: Nonprofits Aren't So Generous When a Name's at Stake." *The Wall Street Journal* (Aug. 5, 2010):
 - “It is startling to us that Komen thinks they own pink,” says Mary Ann Tighe, who tangled with the breast-cancer charity over the color for her “Kites for a Cure” lung-cancer fund-raiser.
- Wounded Warrior Project v. Wounded Warriors Inc.
- Sunshine Kids Foundation (TX) v. Sunshine Kids Club of California

What is a Trademark?

- A trademark identifies and distinguishes the source or origin of goods and services
 - Names (e.g., CALVIN KLEIN[®] apparel and GEORGE FOREMAN[®] grills)
 - Brands (e.g., COKE[®] soft drinks and APPLE[®] computers)
 - Slogans (e.g., Wendy's slogan WHERE'S THE BEEF[®])
 - Sounds (e.g., NBC Universal Media's chimes)

Example of Design and Color Marks

United States of America
United States Patent and Trademark Office



Reg. No. 3,707,623 BOISE STATE UNIVERSITY (IDAHO STATE AGENCY)
Registered Nov. 10, 2009 BUSINESS BUILDING, ROOM 319
1910 UNIVERSITY DRIVE
BOISE, ID 83725

Int. Cl.: 41

**SERVICE MARK
PRINCIPAL REGISTER**

FOR: ENTERTAINMENT SERVICES, NAMELY, THE PRESENTATION OF INTERCOLLEGIATE SPORTING EVENTS AND SPORTS EXHIBITIONS RENDERED IN A STADIUM, AND THROUGH THE MEDIA OF RADIO AND TELEVISION BROADCASTS AND THE GLOBAL COMMUNICATIONS NETWORK, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 9-13-1986; IN COMMERCE 9-13-1986.

THE MARK CONSISTS OF THE COLOR BLUE USED ON THE ARTIFICIAL TURF IN THE STADIUM. THE MATTER SHOWN IN BROKEN LINES ON THE DRAWING SHOWS POSITIONING OF THE MARK AND IS NOT CLAIMED AS A FEATURE OF THE MARK.

THE COLOR(S) BLUE IS/ARE CLAIMED AS A FEATURE OF THE MARK.

SEC. 2(F).

SER. NO. 77-574,724, FILED 9-19-2008.

TERESA M. RUPP, EXAMINING ATTORNEY



David J. Kappas

Director of the United States Patent and Trademark Office

United States of America
United States Patent and Trademark Office

**susan g.
komen** 

Reg. No. 4,223,083
Registered Oct. 9, 2012
Int. Cl.: 36

THE SUSAN G. KOMEN BREAST CANCER FOUNDATION, INC. (TEXAS NON-PROFIT CORPORATION)
SUITE 250
5005 LBJ FREEWAY
DALLAS, TX 75244

SERVICE MARK

FOR: CHARITABLE FUNDRAISING SERVICES, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

PRINCIPAL REGISTER

FIRST USE 1-0-2012; IN COMMERCE 1-0-2012.

OWNER OF U.S. REG. NOS. 3,309,531, 3,424,712, AND OTHERS.

THE COLOR(S) BLACK, LIGHT PINK AND DARK PINK IS/ARE CLAIMED AS A FEATURE OF THE MARK.

THE NAME(S), PORTRAIT(S), AND/OR SIGNATURE(S) SHOWN IN THE MARK DOES NOT IDENTIFY A PARTICULAR LIVING INDIVIDUAL.

THE MARK CONSISTS OF THE NAME "SUSAN G. KOMEN" IN BLACK STYLIZED LETTERS WITH "SUSAN G." APPEARING ABOVE "KOMEN". TO THE RIGHT OF THE NAME IS A STYLIZED THREE-DIMENSIONAL REPRESENTATION OF A RIBBON WITH A DOT OVER THE TOP. THE OUTER PORTION OF THE RIBBON ON THE RIGHT HAND SIDE IS LIGHT PINK. THE INSIDE PORTION OF THE RIBBON ON THE LEFT HAND SIDE IS DARK PINK, AND THE DOT IS DARK PINK.

SN 85-408,200, FILED 8-26-2011.

JEFFERY COWARD, EXAMINING ATTORNEY



David J. Kappas

Director of the United States Patent and Trademark Office

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Trademark Classification System

- 45 different classes
 - Classes 1 to 34 are for goods
 - Classes 35 to 45 are for services
- The offerings of many nonprofits will fall within a service class:
 - Class 35: Association services; promotional services; business management services
 - Class 36: Charitable fundraising services
 - Class 41: Educational services; entertainment; sporting and cultural activities; providing information to others

Types of Trademark Protection

- Unregistered, common law rights
 - Based on actual use in commerce
 - TM; SM
- State Registration
 - Based on actual use in commerce
 - TM; SM
- Federal Registration with the USPTO
 - Based on actual use or intent to use in commerce
 - ®

State Registration

- In PA, register with the Bureau of Corporations & Charitable Organizations
- The filing fee is \$50
- 5 year term

Federal Registration

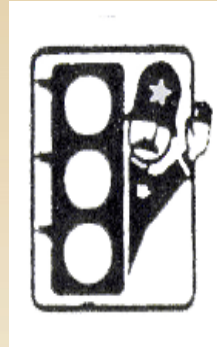
- Register with the USPTO
- The filing fee is \$275-325 per class
- 10 year term (5 year affidavit of use)
- Federal trademark registration with the USPTO provides certain benefits, including:
 - The exclusive right to use the mark nationwide in connection with the goods or services covered by the registration
 - The right to use the registered trademark symbol ® to discourage infringement

How does a trademark search help you?

- Determine whether a particular trademark is available for use and/or registration
- Discloses prior conflicting registrations, pending applications or common law uses
- Identify and assess potential risks and obstacles in adopting and using a new trademark
- Avoid unnecessary costs associated with a failed trademark application, defending an unnecessary lawsuit, or rebranding a product or service

Judging Confusion

- Sight



- Sound
 - CYGON v. PHYGON for insecticides
- Connotation (i.e., meaning)
 - PLEDGE v. PROMISE for furniture cleaner

What is a Copyright?

- Copyright protects original works of authorship that are fixed in any tangible form or medium of expression
 - Independently created by the author (or authors)
 - At least minimally creative

Works Protected by Copyright

- Literary works (e.g., books, periodicals, manuscripts, film, tapes, and computer programs)
- Musical works, including accompanying words
- Dramatic works, including accompanying music (e.g., scripts and screenplays)
- Sound recordings
- Architectural works
- Pictorial, graphic, and sculptural works (e.g., fine, graphic, and applied art and art reproductions, photographs, prints, maps, models, and technical drawings)
- Motion pictures, video games, and other audiovisual works
- Pantomimes and choreographic works

Example of Copyrightable Subject Matter

- Literary and pictorial works: webpage

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KEYWORD

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We're more than a law firm.

For today's evolving global marketplace, our law firm forms meaningful relationships that deliver powerful results. We make it our priority to get to know our clients.

We work as skilled legal advisors and trusted business counselors so you can forge new opportunities, protect what you have worked for and reach your full potential.

PROFESSIONAL SPOTLIGHT

MICHAEL E. SILVERMAN
DIRECTOR

Mike is a business attorney and the Chair of Cohen & Grigsby's Tax Group. He advises clients in negotiating and structuring mergers, acquisitions and divestitures, and with respect to tax planning, transition and exit planning, captive insurance companies and estate planning matters.

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NEWS & VIEWS EVENTS

Cohen & Grigsby Appoints New Associate in Business Transaction Services Group

Cohen & Grigsby Attorneys Named 2019 "Lawyers of the Year" by Best Lawyers®

Best Lawyers in America® Recognizes Six Cohen & Grigsby Attorneys in Naples

Best Lawyers in America® Recognizes 31 Cohen & Grigsby Attorneys in Pittsburgh

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C&G Gallery
Now showing: C&G Gallery presents "Abandoned Pittsburgh," photography by Chuck Beard.

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Copyright Registration

- Registration is not required to establish federal copyright ownership
- Filing for registration in the US Copyright Office provides certain benefits, including:
 - Registration costs \$35-55
 - The ability to bring an action for copyright infringement
 - Recovery of attorneys' fees and special categories of damages not otherwise available in an infringement action

Who is the “Author” of a Copyrighted Work?

- The “author” may be one person, or two or more persons (in which case the work is jointly owned by its authors)
- For a “work made for hire”, the employer is the initial owner of the copyright in that work, unless agreed differently in a signed writing
- An independent contractor must sign a **copyright assignment agreement** to transfer ownership to the party that commissions the work
 - e.g., photographers, graphic designers, web editors

“We Found It Online, So We Can Use It, Right?”



“Everytime the lawyers tell their old jokes they end up arguing over copyright infringement.”

All rights to the image(s) are owned by Cartoon Stock or the originator of the image and are protected by United Kingdom or appropriate local copyright laws, international treaty provisions and other applicable laws. Reprinted under a Limited License from Cartoon Stock.

- Do you have permission to use the work?
- Statutory damages
 - Statutory damages of \$750 to \$30,000 exist (up to \$150,000 if willful)
- Non-profit status alone will not excuse infringement

What is a Domain Name?

- A domain name is an electronic address
- Domain names can be acquired from the Internet Corporation for Assigned Names and Numbers (ICANN)-designated registrars
- ICANN mandates the Uniform Domain Name Dispute Resolution Policy (UDRP) for settling disputes, e.g., cybersquatting

What is a Domain Name? (cont.)

- Domain name availability should inform your trademark strategy
 - Don't overlook the new extensions!
 - e.g., .NGO, .foundation, .giving, .community, etc.
- For the same price of a UDRP action (\$5,000), you can purchase dozens of domain names across extensions
- Domain names can be registered as a trademark (with or without the *.com* or other suffix) under certain circumstances

Don't Ignore Social Media

- Ownership of a trademark to the corresponding handle may be just as important as owning the domain name
- Twitter, Instagram, Facebook, Pinterest, etc.
- Think of these as part of your IP portfolio
- Treat access/login credentials as you would other valuable IP – these are valuable!

What is a Trade Secret?

- A trade secret is:
 - Business, financial, and technical information
 - Kept confidential by its owner through reasonable efforts
 - Economically valuable because the information is not generally known
- For example, Coca-Cola's soda formula, KFC's fried chicken recipe, and the source code of Adobe's PHOTOSHOP[®] software are trade secrets

Trade Secret Protection

- Trade secrets are not registered like patents, trademarks, and copyrights
- Protect trade secrets by making reasonable efforts to keep this information confidential, for example, by:
 - Never giving confidential information to customers or other individuals outside of the company unless:
 - Authorized by management
 - The recipient has signed a written Non-Disclosure Agreement

What is a Patent?

- A patent is a right granted by the US government to an inventor for a limited time to exclude others from:
 - Making, using, offering for sale, or selling the invention in the US
 - Importing the invention into the US
- Utility patents (including business method patents) are the most common types of patents
- Design patents are also available

Examples of Utility and Design Patents

United States Patent [19]

Kretschman et al.

[11] Patent Number: 6,004,596

[45] Date of Patent: Dec. 21, 1999

[54] SEALED CRUSTLESS SANDWICH 5,853,778 12/1998 Mayfield 426/89

[75] Inventors: Len C. Kretschman, Fergus Falls, Minn.; David Gaske, Fargo, N. Dak.

[73] Assignee: Menusaver, Inc., Orrville, Ohio

[21] Appl. No.: 08/986,581

[22] Filed: Dec. 8, 1997

[51] Int. Cl.⁶ A21D 23/00

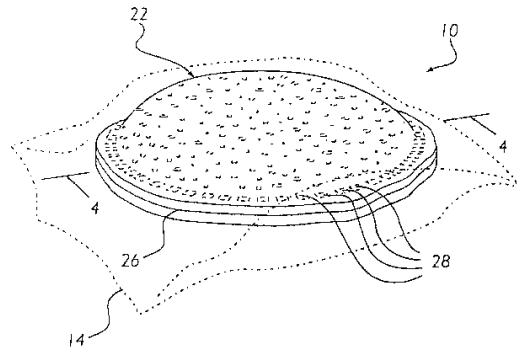
[52] U.S. Cl. 426/94; 426/274; 426/275; 426/297

[58] Field of Search 426/94, 274, 275, 426/297, 138

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4,382,768	5/1983 Lifshitz et al. 426/275

10 Claims, 4 Drawing Sheets



US0006004596A



US00D593087S

(12) United States Design Patent

Andre et al.

(10) Patent No.: US D593,087 S

(45) Date of Patent: ** May 26, 2009

(54) ELECTRONIC DEVICE

(56) References Cited

(75) Inventors: Bartley K. Andre, Menlo Park, CA (US); Daniel J. Coster, San Francisco, CA (US); Daniele De Iulio, San Francisco, CA (US); Richard P. Howarth, San Francisco, CA (US); Jonathan P. Iye, San Francisco, CA (US); Steve Jobs, Palo Alto, CA (US); Duncan Robert Kerr, San Francisco, CA (US); Shin Nishihori, San Francisco, CA (US); Matthew Dean Rohrbach, San Francisco, CA (US); Douglas B. Strager, Menlo Park, CA (US); Calvin O. Soid, Palo Alto, CA (US); Christopher J. Stringer, Portola Valley, CA (US); Eugene Antony Whang, San Francisco, CA (US); Rico Zorkendorfer, San Francisco, CA (US)

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(73) Assignee: Apple Inc., Cupertino, CA (US)

(**) Term: 14 Years

(21) Appl. No.: 29/282,833

(22) Filed: Jul. 30, 2007

Related U.S. Application Data

(63) Continuation of application No. 29/270,880, filed on Jan. 5, 2007, now Pat. No. Des. 558,756.

(51) LOC (9) CL 14-03

(52) U.S. Cl. D14/341; D14/203.7; D14/138 G

(58) Field of Classification Search D14/137;

D14/138, 147, 191, 218, 247, 248, 341, 347;

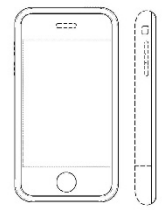
D14/496, 138 R, 138 AA, 138 AB, 138 AC,

D14/138 A1, 138 C, 138 G, D10/65, 78,

D10/104, D13/168, D18/7, 455-556, 1,

455-566, 575 L, 575 S, 345/169

See application file for complete search history.



Patent Registration

- Companies protect their inventions by filing an application for patent protection in the US Patent and Trademark Office (USPTO)
- Utility patents protect new, non-obvious, and useful processes, machines, manufactured goods, chemical, biological, and other compositions of matter, and improvements thereof
- Design patents protect new, original, and ornamental designs of manufactured articles

IP Licensing

- The mechanics for licensing IP rights depend on the type of IP being licensed
 - Patent, know-how, trademark and copyright licenses
- The terms of an IP license are governed by the commercial intentions of the parties
 - Subject to the general law and antitrust issues

How Do Companies Protect IP?

- Registering its copyrights and trademarks
- Applying for patents on inventions
- Keeping its trade secrets confidential and limiting their disclosure, including information concerning any invention or discovery for which it may decide to seek a patent
 - Obtaining signed NDAs
 - Engaging watch notice services to monitor new IP application filings by other companies

How Do Companies Protect IP? (cont'd)

- Marking packaging, advertising, marketing materials, and websites with appropriate IP notices
 - © 2016 Cohen & Grigsby, P.C.
 - **CULTURE OF PERFORMANCE**[®] is a registered trademark of Cohen & Grigsby, P.C.
 - **C&g**[™] is a trademark of Cohen & Grigsby, P.C.

How Do Companies Protect IP? (cont'd)

- Monitoring the market and its competitors' activities
- Reviewing industry-specific trade papers, magazines, and websites
- Developing best practices for IP protection and training employees on the subject
- Enforcing its rights against infringers by sending cease and desist letters, and when appropriate, commencing litigation

How Do Companies Avoid Infringement?

- Conducting a thorough investigation to obtain legal clearance of all IP prior to use
- Implementing policies and guidelines to reduce infringement risk
- Educating employees about company policies and guidelines
- Training employees about the types of IP that are most relevant to their jobs and industry

Conclusion

- Never assume that what you see in the marketplace, in the media, or on the internet is in the public domain and free to copy, download, or use
- If you are unsure whether something contains the protected IP of another party, always check with the IP Group before downloading or using it

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