



# BRIEFS

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## COPYRIGHTING AND REGISTERING THE COPYRIGHT IN WEBSITES

Author: Mark D. Hansing

### Introduction

Websites can be the life-blood of some businesses. Substantial resources can be spent in-house or with outside developers. *How do you protect that investment?*

In some cases, novel functionality of a website can be patented. We first consider patents because they can protect an idea or function that is new and non-obvious, regardless of the particular text or graphics used on the particular website. Patents, however, are difficult to get and can be expensive. Trademarks can protect the words or logos that identify products or services associated with a website. But they don't protect its functionality or content. Copyrights are a good candidate because they at least protect content, and sometimes graphic features.

Copyrights have some quirky aspects. They protect against copying of content. They usually cannot protect the mere ideas or methods. But they can be an important tool to protect valuable work product on websites.

The law recognizes a copyright in your website the minute it is done. But in order to sue someone for infringement, you have to register with the U.S. Copyright Office. To entice you to register early, the law also gives several important benefits if you register right away (within three months of launching the site or at least before someone infringes). *First*, you get certain presumptions that you are the true copyright owner and the copyright is valid. *Second*, you don't have to prove the infringer has economically damaged you to get money from them; you can ask the Court to award anywhere between \$750 and \$30,000 with respect to each copied work (called "statutory damages"). If the copying was willful, this can be up to \$150,000. *Third*, if you prove infringement, in many cases the copier has to pay your attorneys' fees (this is rare in the U.S.A.). Each of these can make it much easier to enforce your rights.

Therefore, the advantages of registering are very meaningful for the relatively low cost. Copyright registration should be considered of any original expression and content, whether textual or graphical.

### Preliminaries

**Ownership.** Normally it is recommended that you own the copyrights in a website. If you create it, you own it. If you have full time employees create every bit of it, you own it. But if a non-full time employee or outside web site developer builds it (or part of it), you need to get a written agreement confirming all rights belong to you. With several surprisingly narrow exceptions, the default in copyright law is that the author (creator) of the work owns it, unless (a) he/she is your full time employee or (b) you get a written assignment. Critical: Get a written agreement with any outside web developer before the work starts.

**Administrator.** Make sure you (or a full time employee) is listed as administrator and contact for your web site domain name. This gives you better control of the website, its domain name and updates. Critical: Check to make sure the listed administrator for your website is the right person.

**Copyright Notice.** Some years ago, the law required you to have a copyright notice on any copyrighted work, or you might lose the copyright in it. No longer true, copyright notice is still normally recommended. It puts the public on notice of your claim of copyright. And it prevents a copier from pleading any monetary award should be reduced because they did not know it was copyrighted (the "innocent infringer" defense). Therefore, absent an overriding reason, place the copyright notice prominently throughout the website. The notice has three main components: copyright symbol (©), year the website was launched, and name of owner. Hypothetical examples are:

- © 2015 Jane A. Doe [for an individual]
- © 2015 Acme, Inc. [for a corporation]

### Steps to Register Copyright(s)

1. Get the preliminaries (above) done.
2. Gather needed information:
  - a. Full legal name of any authors (creators) of anything being claimed as copyright and a brief description of each person's contribution.
  - b. Full legal name of owner (if different than author(s)) and copies of any written assignments to owner, or confirmation of full time employment with owner.
  - c. Date (year/mo/day) the site was completed ("creation date").
  - d. Date (just the year) the site was launched ("publication date").
  - e. Does the site include work product or content from anyone else and, if so, specifically what and how you have rights to use it.
  - f. CD-ROM containing all the programming used to run the website.
  - g. PDF or paper copies (in color) of representative pages from the website that are generated by the programming (be sure and include at least those pages that you feel are most valuable or creative).
3. Decide on and prepare appropriate registration forms (preferred to be electronic but can be paper).
4. File with U.S. Copyright Office with appropriate fees (preferred on-line at [www.copyright.gov](http://www.copyright.gov), but sometimes can be paper).

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## Conclusion

A website is fundamentally text, graphical images, sometimes pictures, sometimes articles, databases, and arrangement of the foregoing. Like an illustrated book that includes text and drawings, copyrights can protect such content of websites.

A subtle aspect of copyrights is that they also can protect the computer programming that makes the website work and look the way it does; at least the specific way the programming is coded. A poem is a sequence of words the author arranges in a particular manner to convey an idea. Copyright is focused on protecting that “expression” of the author’s ideas as opposed to the general idea of the poem. Similarly, the software programmer

selects certain instructions, puts them in an order and sequence, and that expression of functionality can be protected. The computer code generates text and graphics on a website.

Therefore, it is important that the website owner get complete ownership copyright rights from anybody involve in programming or content (whether it be words or images). Moreover, for the relatively small cost, registration of that content as a copyright at least provides deterrence and leverage to those that would attempt to either wholesale copy or, in some cases, paraphrase or replicate substantially similar content.

Copyright registrations last around 100 years. But if there are more than minor changes made to the website, a new copyright likely exists, and it should be re-registered.

## A NEW KING OF PATENTS

Author: Kirk M. Hartung

Thomas Edison received 1084 patents over a 64 year period, from 1869-1933. Edison’s inventions spanned many industries, from the light bulb to motion pictures, power distribution, and communications. His aptitude for innovation earned him the title as the most prolific inventor in the history of the United States. Until recently...

On July 7, 2015, Lowell L. Wood, Jr. broke Edison’s record for issued patents, and now stands at well over 2000 patents in which he is named as an inventor. Like Edison, Wood’s inventions cover a variety of technologies, such as global warming geo-engineering, aerodynamics, auto anti-collision systems, virus preservation coolers, medical devices, gamma rays, microwave

ovens, spacecraft, consumer products, drug delivery systems, nuclear reactors, and even anti-concussion football helmets.

Wood was raised in southern California, started college at UCLA at the age of 16, received undergraduate degrees in chemistry and math, and then earned his PhD in astrophysics. He is best known for his role in the design, development and early-stage testing of space-based defenses against ballistic missile attack. Now at age 75, he works as an inventor at Intellectual Ventures, a technology research and patent firm located in Bellevue, Washington. He currently has over 3000 patent applications pending in the US Patent Office.

## PCT ROUNDTABLE

The Patent Cooperation Treaty (PCT) Roundtable is a prestigious, limited membership group of experienced international patent practitioners. The Roundtable came into effect in 1982 when use of PCT applications was just becoming a vital part of international patent application filing practice. The purpose of the PCT Roundtable was and is to initiate discussion between “front line” practitioners and users of the PCT and international authorities regarding the application processes and to identify issues with the practical usage of the PCT, as well as solutions to improve the worldwide “usability” of the whole PCT process. The authorities then take recommendations from practitioners and integrate them into their development of best practice processes. Other topics also discussed at the Roundtable meetings include upcoming changes, pilot programs and other topics of interest related to international patent filing. The Roundtable helps to keep an open dialogue between authorities who formulate the rules and processes and the practitioners who use these processes. Finally, a real added bonus is the chance to connect with other PCT users and develop relationships with other users who become invaluable resources in their own right.

Many well-known corporations have a presence at the PCT Roundtable, including but not limited to, 3M, Microsoft, Pfizer, and Ecolab. Intellectual Property firms are also represented, including Merchant Gould, Kenyon & Kenyon, and Venable, to name a few. A law firm or corporation may have no more than 2 representative members on the Roundtable at one time, and

membership is held at or around 50 so as to keep with the informal discussion “roundtable” format. Unfortunately with this limited membership, a wait list of potential members has formed and the wait to obtain membership can sometimes stretch to several years. When an opening becomes available, it is filled from the waiting list.

Our very own, Alice Pendergast, Foreign Specialist at MVS, was on the waiting list for many years and finally became a member of the PCT Roundtable about 8 years ago. Alice has been filing PCT applications for over 25 years. Although she has only been with MVS for about a year, she has excelled in knowledge and forward thinking regarding filing foreign applications. Alice also mentioned a real added bonus to attending the PCT Roundtable is the chance to connect up with other PCT users and to develop relationships with those other users who become invaluable resources in their own right. Alice came back from this year’s Roundtable meeting with materials regarding patent application filing trends from around the world and looks forward to applying this knowledge to enhance the International Group experiences at MVS. Alice hopes to have the pleasure of attending the PCT Roundtable as often as possible as it is such a great learning experience.

*Congratulations Alice!*



# WHEN THE CONSTITUTION CLASHES WITH TRADEMARK LAW

Author: Marcus Smetka

The U.S. Supreme Court recently granted the request for cert in *In re Tam* (more commonly referred to as the “Slants case”). The case seeks to determine whether or not a section of the 1946 Lanham Trademark Act which prohibits the registration of a trademark that “may disparage” persons is in conflict with the First Amendment. The decision in this case is likely to cause a widespread ripple effect that will impact pending decisions on a number of trademarks. One specific high profile trademark that is likely to be directly impacted by the decision in *In re Tam* is the Washington Redskins, of the National Football League, whose trademark registration was recently cancelled by the U.S. Patent and Trademark Office (USPTO) on the grounds that “Redskins” was disparaging.

The Lanham Act was enacted in 1946 by the U.S. government to create a national system for registering and protecting trademarks used in interstate commerce. Registration of a trademark provides significant legal rights and benefits to trademark owners, while also seeking to protect potential consumers from counterfeit goods. Federal registration of the trademark with the USPTO provides national rights for the mark, as opposed to common law marks which only provide rights to the owner of the mark in geographical areas where the mark is used. Under the Lanham Act, the USPTO must register source-identifying marks unless the mark falls into one of a number of categories. Presently, section 2(a) of the Lanham Act bars the registration of a mark that “consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute.”

To determine if a mark is disparaging under section 2(a) of the Lanham Act, the examining attorney considers:

1. What is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; and
2. If that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

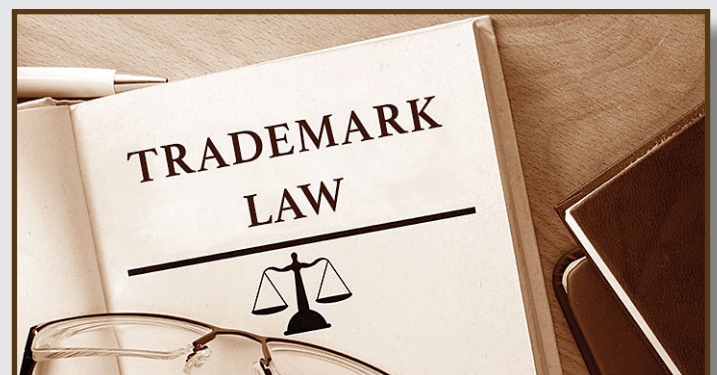
Trademark Manual of Exam. Proc. §1203.03(b)(i) (Jan. 2015 ed.) (citing *Geller*, 751 F.3d at 1358).

In *In re Tam*, Mr. Tam is the “front man” for the Asian-American band “The Slants”. In November 2011, Mr. Tam filed an application with the USPTO seeking to register the mark THE SLANTS based on prior use of the mark by the band dating back to 2006. The examining attorney refused to register the mark, citing that the mark is likely to disparage “persons of Asian descent” under section 2(a). Mr. Tam appealed the examining attorney’s refusal to register the mark to the Trademark Trial

and Appeal Board (TTAB), arguing that his band was seeking to own the stereotype and re-appropriate the disparaging term. However, the TTAB affirmed the examiner’s refusal to register the mark. Mr. Tam then appealed that the TTAB erred in finding the mark disparaging and that section 2(a) of the Lanham Act is unconstitutional. On appeal, the Court affirmed the TTAB’s determination.

Mr. Tam then appealed to the U.S. Court of Appeals to the Federal Circuit, challenging the constitutionality of section 2(a) of the Lanham Act. The Federal Circuit first looked to determine a level of scrutiny. The Federal Circuit held that because the section 2(a) of the Lanham Act discriminates on the basis of content of the message conveyed, 2(a) is presumptively invalid, and must satisfy strict scrutiny. The Federal Circuit also rejected the idea that the government is free to restrict constitutional rights within the confines of its trademark registration program. Lastly, the Federal Circuit held that the government had not provided a substantial government interest justifying the section 2(a) bar on disparaging marks, ultimately ruling that the disparagement provision of section 2(a) is unconstitutional.

Next up, the U.S. Supreme Court will have the opportunity to weigh-in on the constitutionality of the Lanham Act. The Washington Redskins will be one of many awaiting the eventual outcome. In my opinion, the decision at the Supreme Court will ultimately be decided by whether the Supreme Court agrees with the Federal Circuits application of strict scrutiny in this matter. If the Supreme Court applies strict scrutiny, the Federal Circuit decision is likely to be affirmed. However, if the Supreme Court determines that a reduced level of scrutiny should be applied, then this increases the odds that the Federal Circuit decision is overturned. Should the disparagement provision be upheld as unconstitutional, the expectation would be that the Lanham Act will require revision, and Mr. Tam and the Washington Redskins trademarks should proceed to registration with the USPTO. While Mr. Tam and the Redskins presently have common law rights in the use of the mark, as discussed above, registration of the mark with the USPTO provides them with additional legal rights as the trademark owner. These legal rights both help in enforcement and defending use of the mark in commerce.



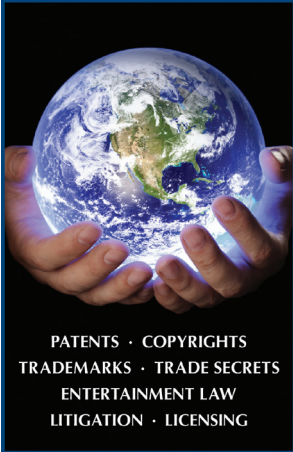


MCKEE, VOORHEES & SEASE, PLC

801 GRAND AVE SUITE 3200  
DES MOINES, IOWA 50309-2721

WWW.IPMVS.COM  
515-288-3667

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### WE'RE THERE

#### **September 6 - 8, 2016**

Caitlin M. Andersen attended the American Agricultural Law Association Annual Symposium in Oklahoma City.

#### **September 28 - 29, 2016**

Heidi S. Nebel and Jill N. Link attended the AUTM Partnering Forum for Agriculture in Saskatchewan, Canada.

#### **October 11, 2016**

Jonathan L. Kennedy attended the South Dakota Innovation Expo in Rapid City, SD.

#### **November 10, 2016**

Jonathan L. Kennedy and Caitlin M. Andersen presented at the Iowa Biotech Legal Symposium in Des Moines, Iowa.

#### **November 10 - 12, 2016**

Kirk M. Hartung and Marcus A. Smetka attended the fall LEGUS meeting in Hoboken, NJ.

#### **November 17, 2016**

Jonathan L. Kennedy and Caitlin M. Andersen presented at Iowa Biotech Legal Symposium in Iowa City, Iowa.

*If you're interested to learn about what our MVS attorneys attend and learn, please contact them through [www.ipmvs.com](http://www.ipmvs.com) or by calling 515-288-3667.*

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