



Intellectual Property

By Brian Wassom, Honigman Miller Schwartz and Cohn LLP

Intellectual property, or “IP,” is often the most valuable thing a client owns. But many attorneys could not explain to their clients the difference between a copyright and a trademark, let alone how to protect them or avoid infringing the IP of others. The following primer offers a few basics that all practitioners should keep in mind.

Copyright

Copyrights protect creative expression—books, movies, photographs, paintings, architectural designs, sculptures, music, even choreography. It does not protect ideas—only particular expressions of ideas. To merit copyright protection, the “work” in question must be “fixed in a tangible medium”—e.g., paper, canvas, or a computer file—and contain the author’s own original expression. Elements of the work that are not original or creative (such as the physical objects depicted in a photograph, or generic components in a blueprint or lyric) are “fil-

tered out” of the copyright. Authors automatically own the copyright to their works when they are created. In order to enforce that right, however, it must be registered with the U.S. Copyright Office (copyright.gov). The form is simple and costs only \$40. It is best to register within 3 months of publication, to maximize the chance of recovering attorneys’ fees and statutory damages in an infringement suit. Your clients have virtually no reason not to register their websites, publications, and other expressive materials. They should also check periodically to see if others are copying their works.

Copyrights generally last for the author’s life plus 70 years. They give their owners 5 basic rights—to control the reproduction, display, performance, distribution, and adaptation of their works. Each can be separately licensed. But this cuts both ways; be sure that the works your clients use are licensed. For example, several local restaurants have been sued for perform-

ing copyrighted music without a license, including one near the county courthouse.

Trademark

Trademarks are indicators of source. They tell consumers who is providing a certain product or service. Logos, trade names, slogans, and packaging are all common examples. When someone sees the Golden Arches, for example, they know they’ll get a Big Mac instead of a Whopper.

Clients develop rights in a trademark by using it in commerce. The first to use it in a particular market has priority. Federal registration (which can be done electronically at uspto.gov) isn’t strictly necessary, but offers several advantages, such as presumptive nationwide rights and more options for recovering damages.

The boundaries of trademark rights are somewhat fuzzy. Your client infringes another’s mark if its mark is “likely to cause confusion in the marketplace” with the other mark.

That is a fact-specific question that depends on how similar the marks appear, and several factors concerning how they are used.

Disputes are often resolved through “mutual co-existence agreements,” in which the parties take measures to prevent customer confusion.

Owners of “strong” marks can sue for dilution of their mark, in addition to infringement. But one who is lax in enforcing their rights can be at risk of abandoning them.

Therefore, famous marks are often aggressively enforced—as a Mt. Clemens shop using a green-and-white circular logo found out when Starbucks’ attorneys came knocking.

Protecting the goodwill of your client’s mark, and avoiding infringement of others’ marks, requires careful market research and informed counsel.

Patent

This is what most attorneys mean when they say “IP,” but it’s really just one piece of the patchwork.

Patents give inventors of useful devices or methods the exclusive right to control their inventions. The rights last for 20 years from the filing date of the application. Unlike with other IP rights, federal registration is vital to protecting a patent. Inventors generally have one year from the date that they first publicly reveal their invention to apply for a patent.

Macomb County is home to scores of manufacturers and inventors who need informed patent advice. You'll need someone who's admitted to the Patent Bar to prosecute a patent application.

Right of Publicity

This is an individual's right to control the use of their own likeness in commercial advertising. It grew out of the common law of privacy, so it is governed by the states rather than federal law. Some states have statutes on point; in Michigan, it is still a common law right. In fact, most of Michigan's law on this topic has been "predicted" by federal courts. As such, the right's boundaries are unclear. Using a photo of a celebrity on a product probably infringes the celebrity's publicity right—and photograph cases are usually where the right

is asserted. Be sure your clients obtain both the copyright and publicity rights when buying or licensing photos.

But a local federal judge held last year that Activision did not violate The Romantics' rights by allegedly mimicking their "sound" in the game Guitar Hero, because (among many other things) Michigan's right of publicity doesn't cover voices. Our local federal appellate court has also ruled that average Joes do not have a right of publicity—only celebrities whose likenesses have monetary value. And both it and the Activision court expressed serious concern that taking this right too far intrudes into the First Amendment's protection of free speech and commentary on public issues.

There is, of course, much more to say about these and related IP fields. But these basic principles should help you spot issues and help your clients protect their valuable IP assets. ■

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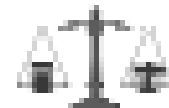
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