

Intellectual Property Law 101: Presentation Outline

Brian D. Wassom | October 2025

I. The Spectrum of IP Rights

- Trademark → Publicity → Copyright → Trade Secret - Patent
 - Overlapping protections possible
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II. Copyrights

- **Section 102, Copyright Act:**
"Copyright protection subsists in original works of authorship fixed in any tangible medium of expression..."
- **Original Works of Authorship:**
 - Literary works, music, drama, choreography, pictorial/graphic, motion pictures, sound recordings, architectural works
- **No Copyright Protection For:**
 - Useful articles (e.g., apparel, furniture, appliances)
 - Ideas, procedures, systems, methods of operation
- **Coverage:**
 - Copyrights cover an expression of ideas in tangible form, not the idea itself
- **Bundle of 5 Exclusive Rights:**
 - Reproduce
 - Prepare derivative works
 - Distribute copies
 - Perform publicly
 - Display publicly
- **Unlawful Use:**
 - Without authorization, it is unlawful to copy, distribute, prepare derivative works, perform, or display publicly
- **Term (if created after 1/1/78):**
 - Life of the author + 70 years
 - Works for hire: 95 years from publication or 120 years from creation, whichever expires first
- **Work Made for Hire:**
 - Created by an employee or specially ordered for use in a collective work, compilation, atlas, etc.
- **Incentives to Register:**
 - Infringement lawsuits require registration
 - Prerequisite for statutory damages and attorney's fees
- **Legal Test for Infringement:**
 - Work must be original, independently created, and minimally creative
 - Proof of copying + substantial similarity
- **Civil Exposure:**
 - Actual damages or statutory (\$750 to \$30,000; up to \$150,000 if willful)
- **Criminal Case:**
 - Willful infringement with retail value over \$1,000: fines up to \$250,000 and/or 5 years in prison
- **Fair Use:**
 - Four-factor test: nature of use, nature of work, amount used, market effect

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- o Case-by-case application
 - **Common Fallacies:**
 - o “There was no copyright notice.”
 - o “We bought this photo and used it before.”
 - o “It was in the public domain.”
 - **Client Counseling Opportunities:**
 - o Registration, ownership rights, licensing, clearance, enforcement
 - o Current issues: AI; photos on websites
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III. Trademarks

- **Definition:**
 - o Any word, name, symbol, or device used to identify and distinguish goods/services
- **Examples:**
 - o Word: McDONALD’S
 - o Stylized: Mtn Dew
 - o Symbol: Golden Arches, Nike Swoosh
- **Non-Traditional Marks:**
 - o Sound, color, fragrance, store layout
- **Unlawful Use:**
 - o Using a confusingly similar mark
 - o Likely to cause confusion or dilute a famous mark
- **Federal & State Statutes Provide:**
 - o Injunctive relief
 - o Damages (profits, actual damages)
 - o Destruction of infringing goods
 - o Attorney’s fees (exceptional cases)
- **Trademark Protection Process:**
 - o Brainstorming
 - o Preliminary search
 - o Comprehensive search
 - o Registration
- **Distinctiveness Spectrum:**
 - o Generic → Descriptive → Suggestive → Arbitrary → Fanciful
- **Trademark Searches:**
 - o Preliminary (knockout)
 - o Comprehensive (databases, web, domain names, business names)
- **Proposed Mark Not Available If:**
 - o Conflicts with existing mark or pending application
 - o Likely to confuse with similar marks
- **Trademark Registrations:**
 - o “First to file” vs. “first to use” countries
 - o U.S. is “first to use”
- **Common Mistakes:**
 - o Not searching before adopting
 - o Choosing descriptive marks

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- **Common Law Rights:**
 - Arise by use in a geographic area
 - Can be lost by delay or non-use
 - **U.S. Trademark Registrations:**
 - Enhance common law rights
 - Provide nationwide protection
 - Allow “intent to use” applications
 - **Trademark Application Requirements:**
 - Mark
 - Owner info
 - Description and specimen
 - Basis (use or intent to use)
 - **Application Prosecution at USPTO:**
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IV. Trade Dress

- **Definition:**
 - Overall style/look of product or packaging
 - **Requirements:**
 - Must be non-functional, distinctive, source-identifying
 - **Examples:**
 - Coca-Cola bottle, paint can design
 - **Key Cases:**
 - Coach v. AnnTaylor, LeSportsac v. Kmart, The Keebler Co. v. Rovira
 - **Samara Bros. Case:**
 - Supreme Court: must prove “secondary meaning”
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V. Domain Names

- **ACPA – 17 USC 1125(d):**
 - Protects against bad-faith registration of confusingly similar domains
 - **UDRP:**
 - Faster/cheaper resolution than litigation
 - Transfers domain ownership
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VI. Patent Law

- **Purpose:**
 - To encourage innovation by granting inventors exclusive rights to their inventions for a limited time in exchange for public disclosure.
- **Types of Patents:**
 - **Utility patents** – for new and useful processes, machines, articles of manufacture, or compositions of matter, or any new and useful improvement thereof. These are the most common type of patent and cover how an invention works or is used. Common examples include mechanical devices, chemical compounds, electronics, and software-based inventions (if they meet subject matter eligibility). Utility patents require a full written description and at least one claim defining the scope of the invention.

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- o **Design patents** – for new, original, and ornamental designs for an article of manufacture. These protect only the appearance of the object, not its function. Design patents are often used for consumer products, packaging, and user interface icons. To qualify, the design must be novel, non-obvious, and not purely functional. Infringement is assessed based on whether an ordinary observer would consider the accused design substantially similar to the patented one.
 - o **Plant patents** – for new and distinct plant varieties that are asexually reproduced (i.e., through methods other than seeds, such as cuttings or grafting). These patents are relatively rare and typically used in agricultural or horticultural contexts. The plant must be novel, non-obvious, and clearly distinguishable from known varieties.
- **Patent Eligibility:**
 - o Must be **novel, non-obvious**, and **useful**.
 - o Not patentable: abstract ideas, laws of nature, natural phenomena.
- **Application Process:**
 - o File with the U.S. Patent and Trademark Office (USPTO).
 - o Includes a detailed description, claims, drawings (if applicable), and oath/declaration.
 - o May file a **provisional** application to secure a filing date (expires after 1 year).
- **Patent Term:**
 - o Utility: 20 years from filing date (subject to maintenance fees).
 - o Design: 15 years from issuance (no maintenance fees).
- **Patent Prosecution:**
 - o Examination process where USPTO reviews application for compliance and patentability.
 - o Applicant may amend claims and argue against rejections.
- **Enforcement:**
 - o Patents give the right to exclude others from making, using, selling, or importing the invention.
 - o Patent owner must initiate enforcement; no automatic policing by the government.
- **Infringement Remedies:**
 - o Injunctions, damages (reasonable royalties or lost profits), and potentially treble damages for willful infringement.
- **Practice Tips for Non-Patent Attorneys:**
 - o Watch for public disclosures before filing – can jeopardize rights.
 - o Encourage early consultation with a patent attorney.
 - o Understand the difference between owning a product and owning patent rights to it.

VII. Right of Publicity

- **Overview:**
 - o ~25 states recognize this right
 - o Protection for name, likeness, voice, signature, persona
- **Restatement (Third) of Unfair Competition:**
 - o Use of identity for commercial advantage = liability
- **Identity Must Have Commercial Value:**

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- o Adds value to goods/services
 - o “Man on the street” not protected
- **It Could Happen To You:**
 - o Examples of unauthorized use in advertising
- **Use in Trade:**
 - o Must be in commercial transactions
 - o First Amendment may apply
- **Privileged Uses:**
 - o News reporting, parodies, biographies, entertainment, incidental advertising
- **Remedies:**
 - o May include injunctions, damages, fees
 - o May survive death