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In 2003, Party Y uses “Pure Imagination” for graphic design services on publications in Texas and Oklahoma. Also uses TM in advertising on Internet in 2003. Who has the rights and where?

A) Probably Party X everywhere but in Texas and Oklahoma.
Getting TM Rights

• One gets a TM through use in commerce (like © in that no need to mark or register)
• Registration can make mark incontestable after five years
• To register, need to show proof of use in commerce (or intent to use); distinctiveness or secondary meaning
• Registration = Constructive nationwide use
Q) If I have an unregistered mark that I’m using to identify a product, how should I provide notice of my trademark rights?

A) SM
B) ®
C) TM
D) M
Q) Does Domino’s Pizza have to license it’s use of the Domino’s name from Domino’s sugar? (Sugar was first to use in commerce.) Why or why not?

A) Yes – both in food sector
B) Yes – exact same word
C) No – different fields
D) No – it’s fair use

Source: http://graphics.samsclub.com/images/products/0004920004754_LG.jpg

BY: miskan (flickr) http://creativecommons.org/licenses/by-nc/2.0/deed.en
TM Infringement Test

• Likelihood of Confusion
  – Strength of mark
  – Proximity of the goods
  – Similarity of the marks
  – Evidence of actual confusion
  – Similarity of marketing channels
  – Degree of caution from typical consumer
  – Defendant’s intent
Confusingly Similar?

Source: http://bp0.blogger.com/_ef_M4U2nwus/R_D5AnHQZII/AAAAAAAABMQ/ZdHEohRufRE/s1600-h/2verts.jpg
Q) Does the use of “Charbucks” as a blend of coffee infringe any TM rights of Starbucks? Why or why not?

A) Yes – confusingly similar
B) Yes - dilution
C) Both A & B
D) Neither
Dilution

• Only for “famous” marks
• Protects harm to your trademark, not necessarily competition
• Blurring or tarnishing
  • Not necessarily confusing
Q) Is the following use of the “Canon” TM an act of infringement and why or why not?

a) Yes – they are using the TM in commerce
b) Yes – you can’t tell who makes the toner
c) No – it’s a fair use
d) No – TM law doesn’t apply to replacement parts

Source: Undetermined
Brookfield Communications

- “stealth” use of trademarks
- Holding?
- Exit sign analogy – perfect?
Patent v. Copyright
<table>
<thead>
<tr>
<th>Copyright</th>
<th>Patent</th>
</tr>
</thead>
<tbody>
<tr>
<td>Protects expression not ideas</td>
<td>Protects ideas that have been reduced to practice</td>
</tr>
<tr>
<td>Life of author + 70 years</td>
<td>20 years from filing</td>
</tr>
<tr>
<td>Fair Use</td>
<td>No Fair Use</td>
</tr>
<tr>
<td></td>
<td>No Research Exemption</td>
</tr>
<tr>
<td>Works for hire</td>
<td>Employee inventor owns</td>
</tr>
<tr>
<td>Protects against copying</td>
<td>Innocent infringement not a defense</td>
</tr>
<tr>
<td>Protection is automatic (registration is relatively simple)</td>
<td>Extensive examination process before any rights granted</td>
</tr>
<tr>
<td>Originality (low bars)</td>
<td>Novelty and Nonobvious (high bars)</td>
</tr>
</tbody>
</table>
Software Considerations

• Copyright (automatic; covers the authorship in the source code) may be sufficient if:
  – Commercial life of software is less than time to get patent
  – Value is in the source code rather than in the method it performs
  – Method may not be patentable
  – Open source used

• Patentability standard for software patents is strict and uncertain (*Bilski* case pending)
  – Must be tied to a machine (possibly more than a general use computer) or result in a physical transformation