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IP Issues in Marketing and Advertising: Identifying and Perfecting IP Rights, Minimizing Risks, Avoiding Pitfalls

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IP Issues in Marketing and Advertising: Identifying and Perfecting IP Rights, Minimizing Risks, Avoiding Pitfalls

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Strafford Webinar

March 18, 2020

Copyright

What's copyright?

- Copyright is *original creative expression*, once fixed in tangible form
- Copyright doesn't protect ideas or facts
- You can't tell something is protected by copyright by looking at it
- Public domain has nothing to do with being “public”
 - Photos shared in social media and memes are protected by copyright too
- Fair use and parody unlikely to protect you
 - In advertising, fair use is unlikely to apply
 - Parody only applies to comment and criticism on the underlying work

Functional vs. Expression



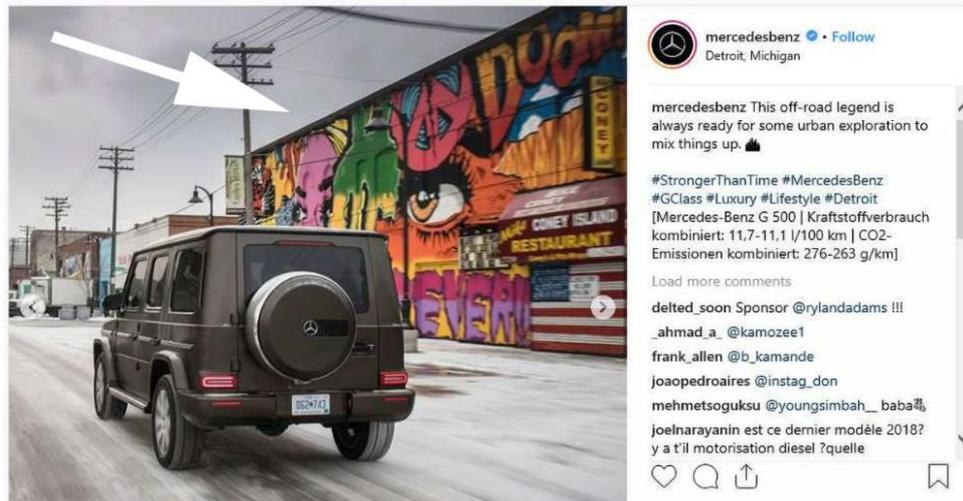
Idea vs. Expression

You can usually take ideas, just not the specific way they are expressed

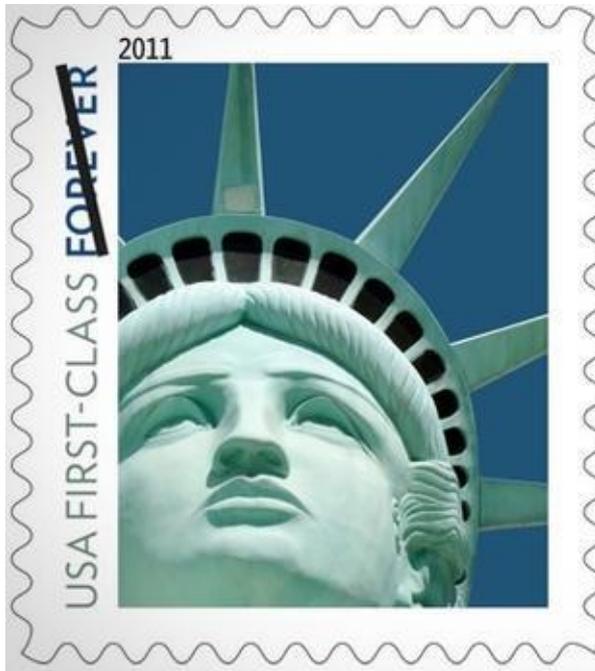


Copyright

- Mercedes is in a fight with street artists over the use of murals without their permission in social media
- Artists are alleging copyright infringement
- Does Mercedes have any good arguments here?



Are You Licensing the Right Thing?



Statue of Liberty Stamp
Mistake to Cost Postal
Service \$3.5 Million

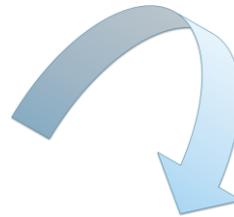
Using Photos without Permission

- Ariana Grande, Jessica Simpson, Khloe Kardashian and Gigi Hadid have all been sued by photographers for using photos on their social media channels without permission
- In a controversial ruling, a trial court found that news organizations that had embedded (**linked**) a photograph in social media postings were liable for infringement



Re-gramming?

- Unlike on other social media platforms, there is limited “sharing” functionality of posted content on Instagram
- Sharing often occurs through screenshots, cropping, and “re-gramming”
- Be careful of copyright infringement and unauthorized workarounds



Practical Tips to Avoid Copyright Issues

- Don't copy someone else's work
 - You can generally copy the ideas, just not the particular creative expression
- Don't share the inspiration with the people who will be producing the work
 - Share genre and style, not specific choices
- Clear all third party material
 - Look carefully at what's in the background
 - Get proper licenses

Trademark

What's a trademark?

- Trademark is a name, tagline, logo, or other indication of source



Using Someone's Trademark



- Questions:
 - Is there a likelihood of confusion as to sponsorship, approval, endorsement?
 - Is there dilution (including tarnishment)?
 - Are you using the trademark for comparative advertising?
 - Are you using it to demonstrate compatibility?
 - Is your use not misleading or harmful?

In the news ... ® not ©



“The Cali-O Drive Thru”

The shoes pay homage to "this classic style and an essential part of the Cali lifestyle: its burger diners”

Frankfurt Kurnit Klein + Selz PC



Homage or *Infringement*?



No Sesame. All Street.

Homage or Infringement?

Hollywood REPORTER

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JUNE 29, 2015 8:00am PT by Eriq Gardner

 Lionsgate Sued for Snarling at "Nobody Puts Your Old 401(k) in the Corner" Advertisement



THR ESQ.
Power Lawyers 2015:
Hollywood's Top 100
Attorneys Revealed



Vestron Pictures/Courtesy Everett Collection

Lionsgate allegedly demanded a seven-figure license from TD Ameritrade for infringing a line from "Dirty

ADVERTISEMENT

"DAMN NEAR PERFECT"
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Nobody puts your old 401(k) in the corner.

Get step-by-step rollover assistance.

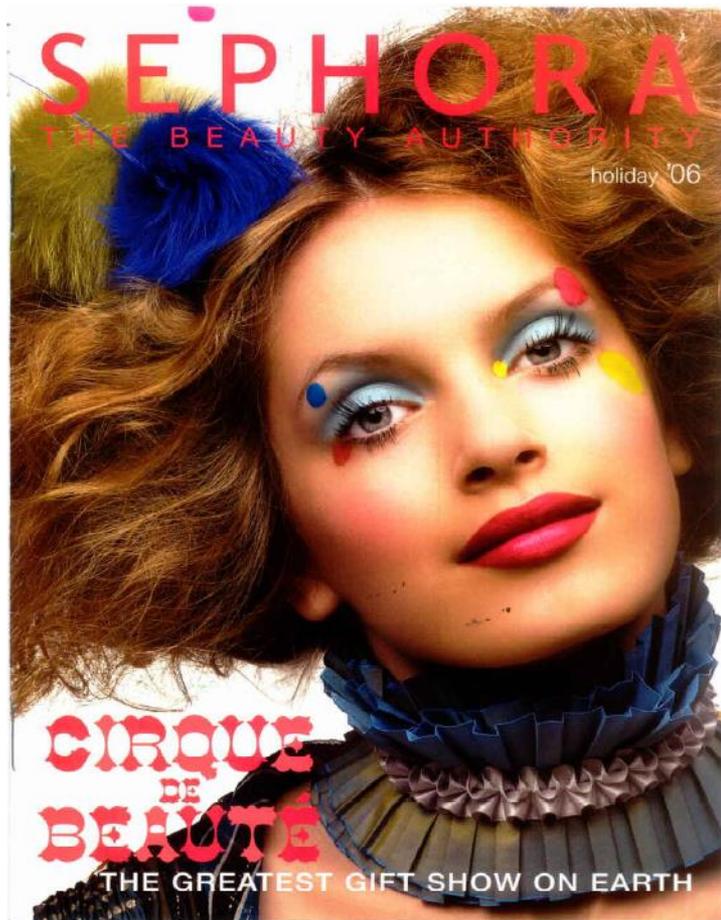
We know bringing your retirement assets together can be a hassle. It's why we have rollover consultants on hand to help you with the paperwork and assist in transitioning from your old provider. How easy is that?

Get up to \$600 when you roll over your old 401(k). Call TD Ameritrade at 800-213-4363 or go to tdameritrade.com/rollover for details.

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Trademark - dilution



“Ambush marketing”

- Associating yourself with an event for which you’re not an official sponsor is often called “ambush marketing”
- Avoid creating confusion about whether you are an official sponsor
 - Don’t use the sponsor’s trademarks
 - Avoid other things that may suggest an association (colors, uniforms, etc.)



Using a Competitor's Trademarks in Your Hashtags?

- Social media ads for Strauss' MagicSleeve referred to its competitor's product, Invisalign, by using the hashtag "#invisalign" in posts.
- Align, maker of Invisalign, sued for trademark infringement, arguing that the use of its trademarks in Strauss' hashtags was likely to cause consumer confusion. Strauss argued that the use was permissible because it was nominative fair use.
- Court found no nominative fair use because Strauss did not use the hashtags to identify Align's products, but instead used them to refer to its own product, and Strauss used more of Align's trademarks than was reasonably necessary to identify Align's product. Court further found that none of the hashtags were "reasonably necessary" to identify Strauss's product.

“Clearing” a Hashtag

- When using a trademark-like hashtag, make sure the same type of trademark search is conducted.
- Risk of using a hashtag that is already in use – not just a trademark risk, but a practical issue as well.



Practical Tips to Avoiding Trademark Issues

- Consider potential trademark issues when developing campaigns
 - Did you do a *trademark search*?
- Use caution when using others' trademarks
 - Is your use likely to *cause confusion*?
 - Is your use likely to harm a famous trademark?
 - Is the TM owner litigious?
 - Do other special rules apply?
- Understand what your MSA requires parties to do

The Right of Publicity

What are publicity rights?

- Protects name, picture, likeness, voice, and identity from **commercial** use without permission
 - Can be living or dead
 - Celebrities, politicians, and regular people
 - Doesn't matter whether it's true
 - Doesn't matter whether there's no false endorsement
 - No exception for incidental use



What is permission?

- Written permission
- Potentially a clear invitation to engage with the brand on social media
- What's not permission?
 - Posted signs
 - Attending an event
 - Mentioning a brand in social media

How far can you go?

- Kayla Kraft submits photo through “Natty Rewards” promotion
- Rules give license to A-B and include standard promises of non-infringement
- She sues anyway
- Who owns the photo? (Hint: Kayla is in the photograph and this is not a selfie.)
- Sought unspecified monetary damages, as well as injunctive relief that would ban the defendants’ continued use of her photograph.



Worth Millions?



Instagram



Duane Reade
@DuaneReade

Follow

Love a quick #DuaneReade run? Even @KatieHeigl can't resist shopping #NYC's favorite drugstore bit.ly/1gLHctl pic.twitter.com/uGTc3k1Mii

Reply Retweet Favorite More



RETWEETS
74

FAVORITES
181



Lookalikes

- Ariana Grande sues Forever 21 over use of lookalikes
- The company had approached her and she said she wasn't interested in participating in the campaign
- Right of publicity protects name, picture, likeness, voice, and even identity



Voice

- Not just actual voice
- Watch out for sound-alikes
- Are you re-recording a famous song?

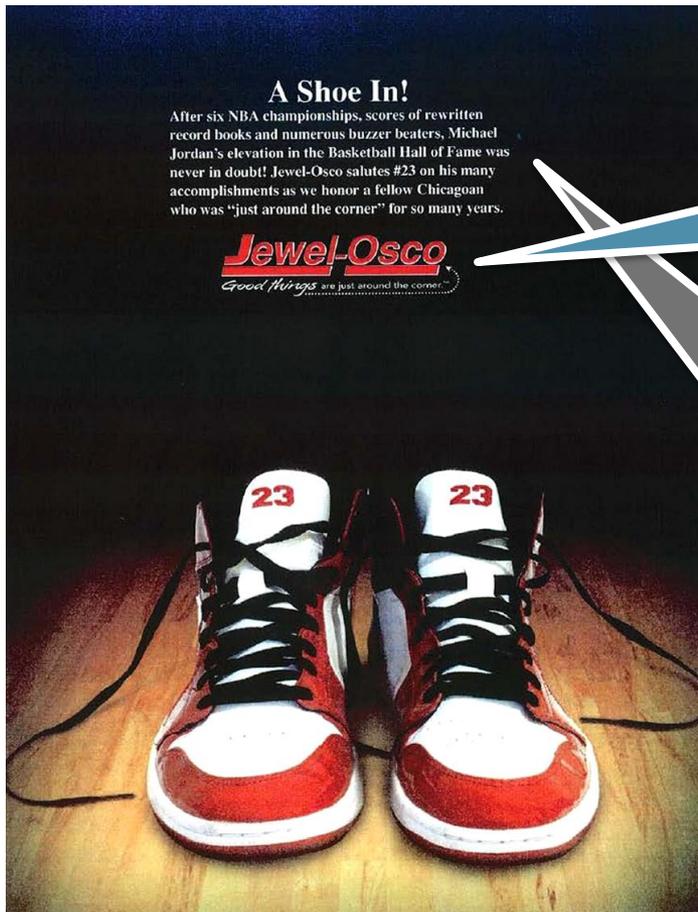


What is a “Likeness”?

“10 Hours of Walking in NYC as a Woman”



But I don't even mention a product!



A Shoe In!

After six NBA championships, scores of rewritten record books and numerous buzzer beaters, Michael Jordan's elevation in the Basketball Hall of Fame was never in doubt! Jewel-Osco salutes #23 on his many accomplishments as we honor a fellow Chicagoan who was "just around the corner" for so many years.

Jewel-Osco
Good things are just around the corner.

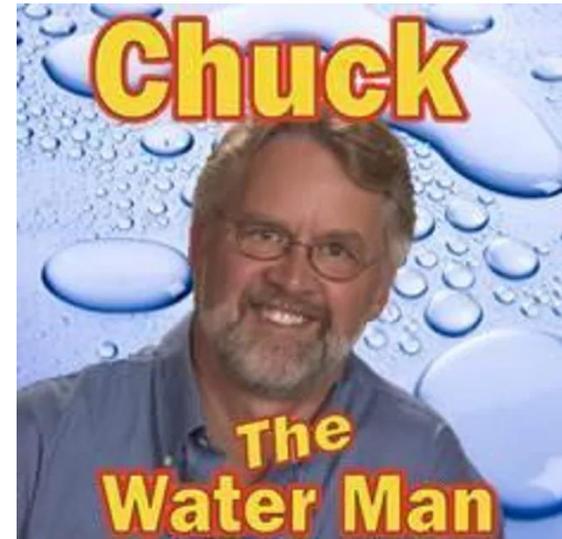
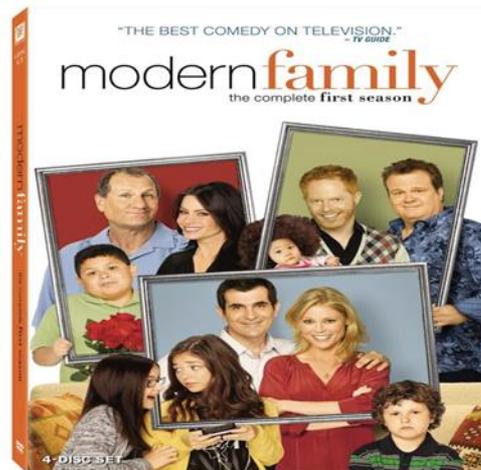
“Good things are *just around the corner*”

“Jewel-Osco salutes #23 on his many accomplishments as we honor a fellow Chicagoan who was ‘*just around the corner*’ for so many years.”

When Multiple Rights are Implicated

Don't Forget to Clear It All!

- There can be multiple rights in an asset
- Don't forget that you need permission for all



A Brief Note on Damages

What Can Happen?

- Copyright:
 - Statutory damages are available where work registered within three months of publication or before the work is infringed.
 - \$750-\$30,000 per copyrighted work; \$150,000 for willful infringement
 - Attorneys' fees are available to prevailing defendant or prevailing plaintiff with timely registration
- Trademark:
 - Statutory damages are not available.
 - Actual damages available in the form of plaintiff's lost sales and/or harm to brand, defendant's profits, or reasonable royalty
 - Amount of actual damages may be difficult to prove
 - Disgorgement of defendant's profits requires showing of willful infringement in some cases
 - Attorneys' fees available in exceptional cases

What Can Happen?

- Right of Publicity:
 - Various theories of damages designed to address harm to the commercial value of one's identity.
 - fair market value of the aspects of one's identity that have been misappropriated
 - loss to one's future earnings potential or value to them of future publicity opportunities
 - defendant's profits from using the misappropriated identity.

THANK YOU!

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This outline presents issues in summary form and is not comprehensive. It may not be applicable in all situations. It is not intended to be legal advice.