

---

**Copyrights and Trademarks:**  
**What Every SHPE Leader Needs to Know**

2019 SHPE National Institute for Leadership Advancement  
Phoenix, AZ  
August 2, 2019

Jeffrey S. Tenenbaum, Esq.  
Chair of the Nonprofit Organizations Practice  
Lewis Baach Kaufmann Middlemiss PLLC  
Washington, DC



# Overview of Copyright and Trademark Law

- ✓ IP is some of your nonprofit's most valuable property – copyrights, trademarks, patents, and trade secrets
- ✓ “Trademarks” include trademarks, service marks, certification marks, and collective membership marks
- ✓ Two key areas of focus: protecting your own IP and avoiding infringing others' IP rights
- ✓ Similarities and differences between copyrights and trademarks, and the overlap between them (e.g., logos can be subject to both copyright and trademark protection)
- ✓ Federal s. state v. common law rights
- ✓ There are many easy, simple steps that will go a long way in this area, but front-line staff need to be educated on these issues (e.g., staff training sessions)
- ✓ Role of IP registrations and notices
- ✓ Role of volunteers – the copyright rules for employees are completely different than for volunteers and contractors
- ✓ Rights of privacy and publicity – as distinguished from copyright rights
- ✓ There are other ways to protect your content besides copyright and trademark law (such as contractually)



# 1. Use Copyright and Trademark Notices

- Use copyright notices (e.g., © 2019 ABC Association. All rights reserved.) on and in connection with all creative works published by your nonprofit and trademark notices on all trademarks and service marks (and certification marks, if any) owned and used by your nonprofit.
- Use TM for non-federally registered marks and ® for federally registered marks.
  - While copyright and trademark notices are not required, their effective use can significantly enhance your intellectual property rights, including eliminating an "innocent infringement" defense.
- Be sure to use them prominently, consistently, and in all media.

## 2. Register Your Trademarks and Domain Names

- ✓ Register them both domestically (federal or state) and internationally (often country by country).
- ✓ Register your nonprofit's name and important logos, slogans, certification marks, and other trademarks and service marks with the U.S. Patent and Trademark Office.
  - While federal registration of your marks is not required to obtain and maintain trademark rights in the United States (common law rights are enforceable in the U.S.), it can be extremely helpful in enhancing and enforcing them nationwide.
  - It also can be required for certain remedies or enforcement.
    - » In particular, registration is a necessary component in the domain name dispute process.

## 2. Register Your Trademarks and Domain Names

(continued)

- ✓ It is also important to remember the national scope of trademark rights and to seek protection in foreign countries (the international trademark Madrid Protocol has numerous limitations).
  - In most foreign countries, trademark rights are based on a first-to-file system; therefore, foreign trademark registration—as early as possible—is essential.
- ✓ Also, be sure to immediately obtain domain-name registrations for all current and prospective (important or material) trademarks.
  - In summary, while the federal and foreign trademark registration processes are not simple and generally do require the use of legal counsel, they are well worth the effort and cost for enhanced rights and protection.

### 3. Register Your Copyrights



- ✓ Register your nonprofit's website, publications, and all other important, original, creative works (that are fixed in any print, electronic, audio-visual, or other tangible medium) with the U.S. Copyright Office.
  - While such registration is not required to obtain and maintain a copyright in a work, it is a prerequisite to filing suit to enforce your rights and confers other important, valuable benefits.
  - If your works are registered either within the first three months of initial publication or before infringement of the works occurs, your organization will be able to pursue statutory damages and attorneys' fees, as opposed to just actual damages.
    - » This is a major difference, especially in a nonprofit setting, and provides your organization with significant leverage in the event of a copyright infringement dispute.

### 3. Register Your Copyrights (continued)

- Copyright registration is a very simple and inexpensive process, and does not require the use of legal counsel (see [www.copyright.gov/registration](http://www.copyright.gov/registration)).
- It also can be very helpful for protecting and enforcing your copyright rights overseas, and for getting prompt, responsive action by Internet service providers, social media operators, and others where you are seeking for content to be taken down because it infringes your own copyright rights.





# 4. Police Use of Your Intellectual Property



- ✓ Monitor and police the use of your copyrights and trademarks by others and enforce your rights where necessary.
  - Use periodic web searches and outside monitoring services, among other means, to identify potential infringement of your copyrights and trademarks.
  - Don't hesitate to send cease-and-desist letters where warranted, but understand that enforcement can involve different types of dispute resolution processes.
  - Enforcement does not necessarily involve the filing of a lawsuit, and does not even always require the use of legal counsel.
  - Mediation, arbitration, and simple settlement are good alternatives as well, especially where enforcement costs are a concern.

## 5. Codify All Licenses from Your Nonprofit to Others in Writing

- ✓ Whenever your nonprofit lets others—such as volunteers, members, chapters, affiliates, sponsors, certificants, accreditants, endorsed vendors, or others—use your nonprofit's name, logos, copyrighted works, and other intellectual property, put the terms and conditions of the license in writing and get the other party to agree to its terms.
- ✓ Be sure to put strict limits on how the intellectual property can and cannot be used, and what happens if those rules are violated.
  - Typically, other important legal provisions will be included as well (e.g., use limitations, no defamatory comments, no endorsement by nonprofit).
  - Need affirmative consent if want to be able to enforce – click-and-accept is OK.

## 5. Codify All Licenses from Your Nonprofit to Others in Writing (continued)

- ✓ The license does not have to be a signed paper document; online click-and-accept licenses are equally enforceable, as U.S. law recognizes electronic contracts and signatures.
- ✓ While oral or implied non-exclusive licenses can exist, they can be difficult to interpret, difficult to enforce, limiting in nature, and otherwise problematic for your nonprofit.
  - In short, do not rely on such oral and implied agreements when a written agreement will better evidence contractual rights.

## 6. Make Sure You Own or Have Permission to Use All Intellectual Property

- ✓ Ensure that your nonprofit owns or has appropriate permission to use all intellectual property (e.g., text, graphics, photos, video, trademarks, etc.) included in its publications, on its website or social media, etc.
  - Certain sites offer free photos and graphics (e.g., pexels.com and unsplash.com for photos and canva.com for graphics).
- ✓ Most common copyright problems arise from the issue of sufficient rights or permission.
  - For example, you may have conceived the idea, supervised the work's creation, and paid for it, but that does not mean you own the work.
  - You may have only a limited license for a specific, narrow use.
- When you wish to use the work on another project or in another medium, you may learn that a separate fee and permission are required—or that such other use is even prohibited.

## 6. Make Sure You Own or Have Permission to Use All Intellectual Property (continued)

- ✓ As such, for copyrights, obtain either an assignment or work-made-for-hire (transfer of ownership; assignments must be in writing to be valid) or a license (permission to use; exclusive licenses must be in writing to be valid, but it is strongly advisable to put non-exclusive licenses in writing).
- ✓ For written copyright or trademark licenses, be sure that they:
  - are irrevocable, perpetual, worldwide, and royalty free (if applicable);
  - specify whether exclusive or non-exclusive (or perhaps exclusive for a certain period of time);
  - cover all possible current and future uses of the work in all media;
  - contain a release to use the author, speaker, or owner's name, photograph, biographical information, etc. (if applicable);
  - contain appropriate representations and warranties (and, in limited cases, indemnification); and
  - Are signed or otherwise agreed to by the other party.

## 7. Agreements with Independent Contractors

- ✓ Maintain written contracts for development or creation with all independent contractors to your nonprofit—such as software developers, consultants, photographers, lobbyists, and all other contractors—to ensure that your nonprofit is assigned the ownership rights (or at least sufficiently broad license rights) to all intellectual property developed or created by the contractor under the agreement.
  - Without such a writing, the basic rule in copyright law is that the person who creates the work is the one who owns it, regardless of who paid for the work to be created.

# 7. Agreements with Independent Contractors

(continued)

- This rule does not apply to employees, ownership of whose work (that is within the scope of their employment) automatically vests in the employer (as part of the work-made-for-hire doctrine).
  - As such, if the contractor is not self-employed, the assignment should come from someone authorized to bind the employer.
- If your nonprofit is a joint author of a copyrightable work with another party (e.g., nonprofit employees working side-by-side with an outside technology consultant to develop new software for your nonprofit), be sure to seek to obtain a copyright assignment (or at least a sufficiently broad license) from the co-author(s) if you wish to use the joint property in a manner that differs from the standard rights available to joint authors/owners (e.g., for enforcement, exploitation, or profit-sharing).
  - Joint authors / joint works – each joint author has right to use the work without the other(s)' consent but all profits from such use have to be shared proportionately with all joint authors based on their respective contributions/ownership

## 8. Agreements with Authors and Speakers

- ✓ For the same reason as in the previous slide, obtain a written and sufficiently broad license or assignment from all (non-employed) writers and speakers for your nonprofit, including members and other volunteers.
- ✓ Be sure that, for licenses, the permission is sufficiently broad—as outlined in Tip #6—and most certainly that it permits you to use both written material (such as articles and PowerPoint presentations) and audio or visual recordings of their presentations in any manner your nonprofit may choose in the future.



## 9. Agreements with Officers, Directors, Committee Members, and (Sometimes) Other Volunteers

- ✓ For the same reason as in the previous slide, obtain a written statement from all nonprofit officers, directors, and committee members (and any other volunteers helping to create copyrightable content) assigning ownership of all intellectual property that they create (within the scope of their service to the nonprofit) to your organization.
- ✓ Incidentally, such a form also can be, and often is, used to impose confidentiality obligations on these individuals, to require conflict of interest disclosure, and to impose any other desired restrictions or guidelines on their service or conduct.

# 10. Protect Your Membership Database

- ✓ With regard to membership associations, because the name, addresses and other contact information contained in your membership directory/list are generally not protected by copyright law—as they usually do not possess the minimum level of originality required—if your organization publishes the directory or permits others to use the list, it is imperative to use a "shrink wrap" license, click-and-accept feature, or other form of contractual commitment to place explicit, binding limits and conditions on the use of that information by members, vendors, chapters, affiliates, and others.
  - Failure to do so may leave your nonprofit with little or no recourse to prevent unrestricted use of this most valuable information by those who obtain a copy of it.

# 11. Rules for Interactive Online Services

- ✓ Many nonprofits operate listservs, chat rooms, and other interactive online services utilized by their members, supporters, or others (who are not employees of your nonprofit).
  - This may be done directly through their website, using outside service providers, or through a social media platform.
    - If so, it is important to regularly distribute rules that prohibit the posting of any copyright- and trademark-infringing information or marks (along with other rules, such as prohibiting negative comments about individuals and companies, discussions about prices or fees, encouraging participants not to do business with others, and the advertising or marketing of products or services).
- ✓ In addition, be sure to maintain a compliant "take-down" policy and to immediately remove (or have removed) any material that violates these rules if it comes to your nonprofit's attention.
  - Federal Digital Millennium Copyright Act

## QUESTIONS

**Jeffrey S. Tenenbaum, Esq.**  
**Chair of the Nonprofit Organizations Practice**

**Lewis Baach Kaufmann Middlemiss PLLC**  
**1101 New York Avenue, NW, Suite 1000**  
**Washington, DC 20005**

[Jeff.Tenenbaum@lbkmlaw.com](mailto:Jeff.Tenenbaum@lbkmlaw.com)

**Telephone: 202-659-6749**