

Practices & Industries

Trademark, Copyright & Advertising

Overview

The Day Pitney Trademark, Copyright and Advertising group recognizes that legal rights are only valuable if they are matched to a client's business objectives. Our attorneys work collaboratively with each of our clients to learn the client's business goals and to develop an appropriate legal strategy based on those goals.

The group represents clients of all sizes, including some of the world's most highly respected and successful brand owners. Through it all, we never lose sight of what's important: to add value to each client's business and to provide clients with tangible benefits from their intellectual property.

Trademarks and Brand Management

The global electronic business economy mandates a strategic approach to trademark selection, clearance, adoption and protection. In today's rapidly changing business environment, brand owners must consider more than simply owning registrations in particular jurisdictions. Developing and implementing internal, local and global trademark strategies is essential. Our group has a wealth of experience in, and a proven track record of, guiding and advising our clients in their U.S. and global branding initiatives.

We work closely with our clients to understand their business and to assist with identifying assets that are worth protecting and those that are not. By working collaboratively and strategically with our clients, we can streamline the brand development and protection process, so that each client's branding initiatives are both effective and cost-efficient.

Trademark Clearance, Prosecution and Maintenance

We assist clients with the selection and clearance of new trademarks as well as the prosecution of trademark applications in the United States and elsewhere. While there are many "mechanical" aspects of trademark prosecution and clearance practice, an overall strategy must direct this work.

The rising cost of obtaining and maintaining global protection requires tough decisions about the scope of protection for a particular brand. Our ability to assist clients in readjusting their portfolios to reflect alignment with their business objectives has resulted in significant reductions in legal expenses for trademark clearance, prosecution and maintenance work.

Trademark Watching and Policing

Trademark-savvy companies recognize that maintaining a trademark's strength requires affirmative action to prevent third-party use of the same or similar marks. The cost of litigation, however, makes court action against every infringer impracticable. Thus, trademark owners face a dilemma: Failure to police a mark can weaken it substantially, but instituting a federal action against every third-party user is not economically feasible. An effective trademark policing program is one that allows a company to understand the scope of protection afforded a particular mark, and to maintain those rights while avoiding the need for litigation.

A key aspect of the program is early detection, before the infringer has invested significant sums in the infringing mark. For this reason, we offer a variety of watching solutions, including, for example, watching newly filed and recently published applications and common law and business name usage. In addition, we work with clients to develop an overall strategy

before sending a cease and desist letter, so that the client is prepared to deal with any eventuality (including third parties who refuse to cease their infringing activities or who otherwise claim a right to continue to use their mark).

Trademark Licensing

We are involved in all aspects of a global trademark licensing practice, including negotiating and drafting marketing and distribution agreements, licensing agreements, and franchise agreements. We often assist clients in developing model licensing provisions that are included in all purchase orders, leases or similar documents. Such services enable our clients to capitalize on the goodwill of their trademarks, and to realize value where they otherwise may have thought none existed.

Due Diligence in Mergers and Acquisitions

We work closely with our firm's corporate lawyers in connection with mergers and acquisitions. Our experienced team members are able to quickly spot trademark and copyright issues in a target acquisition. We collaborate with the corporate deal team, as well as the client, to assess the risk associated with acquiring certain assets. We conduct targeted due diligence to ensure that our clients acquire intellectual property assets free of encumbrances or other surprises, and draft appropriate representation and warranty provisions of purchase agreements.

Copyrights

Our group provides general copyright counseling as well as litigation and licensing services to clients of varying size and industry sectors. Our clients range from large corporations to independent authors, artists and designers, all of whom rely on, or need clearance to use, valuable copyrighted works. In addition, our clients depend on our experience in corporate transactions, including mergers, acquisitions and divestitures, involving the transfer and ownership of copyrighted works.

We have extensive experience in negotiating and drafting joint development and other agreements involving software, computer-related works, literary works, published works, industrial designs, media and musical works. Our team of experienced intellectual property litigators has a long history of success in enforcing and defending copyright claims.

Internet and E-Commerce

As the Internet continues to evolve, so too do the legal and business challenges of doing business online. Our attorneys were among the first to write and speak on Internet issues and continue to do so. The proliferation of e-communications and e-commerce continues to generate new risks and legal needs for our clients. We have met those needs in a variety of ways. For example, we work both with our clients and attorneys from related practice groups to develop internal processes to protect intellectual property rights; we draft industry-specific and client-specific privacy policies, website terms of use, and nondisclosure and confidentiality agreements; and we assist with the development of personnel policies and protective measures in connection with the use and monitoring of electronic mail, voicemail and the Internet. Conducting of business via the Internet and in conjunction collecting visitors' private information increases the exposure of corporations to claims of fraud and identity theft. We regularly help our clients comply with the Gramm-Leach-Bliley Act and Federal Trade Commission regulations for data collection and encryption.

Advertising

With any advertising initiative, our key goals are to preserve the essence of the creative message, assist our clients in meeting legal and regulatory compliance obligations, and grow the value of the client's brand through the strategic use of relevant intellectual property law. Our group's attorneys have experience not only with the substantive areas of advertising and promotion law, but also with related legal areas that affect a company's advertising and promotions efforts (including trademark, copyright, antitrust, unfair competition, privacy and data security, licensing, product disparagement, regulatory defense, consumer protection and the First Amendment). We assist our clients in a broad range of areas, including the following:

- Clearing and pre-publication review of advertising, marketing and promotion materials
- Structuring and drafting rules for sweepstakes, skill contests, promotional games, and sales and employee incentive programs
- Litigating and defending false advertising, infringement, trade dress, consumer fraud, defamation and product disparagement claims

- Advising on and prosecuting/defending right of privacy and right of publicity claims
- Privacy and data security, including e-mail marketing
- Internet marketing
- Telemarketing and direct marketing