

# Expert Tips and Avoiding Rookie Mistakes When It Comes To Owning Your Creative Content

Business owners have many types of creative content:

- Written content on their website, blogs, social media, newsletters and promotional materials
- Photos and videos
- Graphic images (especially logos)
- Brand assets (especially slogans, taglines and distinctive product packaging designs)
- Educational or seminar content and handouts, client hand-outs used in your work
- Policies and procedures, template documents created for use in your work

The laws regarding ownership of creative content generally provide that the creator (author/artist) is the owner of rights in the work product unless there is a written agreement transferring ownership rights to a third party. There is an exception for works made by direct employees paid to create content within their scope of employment. However, despite the work for hire doctrine, it can sometimes be unclear if it applies to certain employees or work product. To avoid any gaps in protection, it is best that these obligations be set forth in employee policies or standard employee agreements signed by new hires. Language assigning intellectual property rights to the employer is often combined with confidentiality and non-compete agreements for new hires. Where feasible, it is ideal to obtain a written assignment for each piece of work created that is a significant proprietary business asset

For work commissioned from non-employee contractors, a written agreement known as a work for hire agreement is required for the business owner to own the work product. However, not all work product<sup>1</sup> will fit within the work for hire doctrine, so it is important that business owners who hire contractors to create content for them have a written agreement securing ownership over the work product whether it meets the definition of a work for hire or not by including a clause such as “if the work product is not deemed a work for hire, then the author/artist expressly and irrevocably assigns all copyright to [the hiring party].” These can be stand-alone agreements or clauses contained within other contracts defining the working relationship and scope of work. The agreements regarding transfer of ownership of intangible rights for copyrights and trademarks differ from boilerplate assignments used in other areas of the law and must contain certain language to be enforceable. Some states may require notarization, even if the federal rules

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<sup>1</sup> “Works Made for Hire” are works specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas if the parties expressly agree in a signed written agreement that the work shall be considered a Work Made for Hire.

do not require it. Engaging an experienced attorney can be especially advantageous to ensure clear and enforceable ownership of the business' rights in the work product.

This is especially important when the work being commissioned is part of a trademark asset such as a logo design or slogan/tagline. The business can only register the work as a trademark asset if it owns (or has an exclusive license to) the work product.

One additional issue for business owners that sometimes poses a barrier to registration of trademarks occurs when a graphic artist uses fonts or images from a software program rather than original created designs. Some programs have a license agreement that prohibits use of the font or graphic in any registered trademark. The business owner will want to do its due diligence to ensure that any work product brand assets are not using images and fonts that cannot be incorporated into registered trademarks.

### **Representations and Warranties from Creators and Professional Clearance Searches on Work Product**

With so much available content online, some content creators “grab” something they found online and modify it to customize and adapt it. However, this can create a potential exposure to the business if there are allegations of infringement from the owner of the underlying content that was modified. Business owners should minimize risk exposure by requiring employees, contractors and other content generators to affirm that they independently created the work as an original work and did not copy it from another source. These can be included in the engagement agreement for the work to be created along with an indemnification for the business owner if it incurs costs because of third-party infringement claims.

For trademarks (such as logos, trade names and slogan/taglines), a professional clearance search may be a good investment to ensure that there is no potential infringement of third-party rights. Comprehensive clearance searches should include a review of federal, state and pertinent international trademark registries, state business and DBA registers, domain name registers, social media sites and other places where brand names may be used (product catalogs, online business directories, national or industry specific online retail sites, industry related review/rating sites) and a general internet search using major browsers like Google, Chrome, Bing and Internet Explorer.

### **Proper use and placement of copyright and trademark notices**

While not legally required to enforce your rights, providing public notice of your claim to copyright or trademark has benefits in terms of enforcement options and damages that may be collected. It is a best practice to use proper notices, but also important that business owners avoid improper use as well. The business owner can be held responsible for the business' materials and website, even if he or she hired someone else to create them for the business. The laws governing

use of notice symbols (or "marking") and the consequences for improper use vary by jurisdiction and can include claims of false advertising, fines and criminal penalties.

The placement of a copyright notice should be visually perceptible. It should be easily seen and read and contain 4 elements in this order:

- © Symbol or the word "Copyright" (or the abbreviation "Copr.")
- Year of Publication: If the work has been made public (known as "published"), the year of publication (you may include a range of years if your content is regularly updated)
- Copyright Owner's name (this can be an individual, multiple people, a business or other organization). It can be a recognizable abbreviation or a DBA
- A statement of any reserved rights (if any). If there are none, then this can be omitted.
  - All rights reserved (You own and retain all rights to your work)
  - Some rights reserved (You allow the use of your materials under certain circumstances, which you should specify in an intellectual property rights clause somewhere on your website or service contracts (in your terms and conditions))
  - No rights reserved (You release your work into the public domain)

The placement of a trademark notice should be on or immediately adjacent to the claimed mark itself. The "TM" (Trademark Symbol used in relation to goods) and "SM" (Service Mark Symbol used in relation to services) notice symbols may be used with a mark at any time an owner has commenced use of the mark in commerce (begins offering products or services to the public under that brand). Once a United States federal registration issues (not a state registration), the ® notice symbol may be used with the mark when appearing in connection with the goods and/or services covered by the registration. The ® notice symbol may not be used (but TM may be used) while the application is pending, only after a federal registration number is issued for the mark.

Use of the ® with an unregistered mark or for unregistered goods and/or services can give rise to a claim of false advertising. An alleged infringer can raise the misuse of the symbol as a basis for an equitable defense in response to an infringement claim and the mark owner could lose its rights to the mark. If a United States registration is granted, then the product packaging may legally display the ® mark for the distribution only in the United States. If the product is sold in a foreign jurisdiction, the brand owner must conform to the marking and symbol requirements of local foreign trademark law where the product or service is being sold.

The federal law requires the ® symbol or notice statement to be "with the mark," (meaning in close proximity to it) but does not specify any other requirements on the marking's location. When it comes to multiple mentions of a trademark – registered or unregistered – it is not required that the symbol be used every time the mark is used on a website page, brochure, packaging, display, or other material, but it should minimally be used with the first and most prominent use of the mark (for example, the first use in a website page header).