

## COPYRIGHT REGISTRATION – A MUST HAVE FOR INFRINGEMENT LITIGATION

Presented by:

**Candace Lynn Bell**

*Member*

Eckert Seamans Cherin & Mellott, LLC  
The Carriage House  
91 Jewett Parkway  
Buffalo NY 14214

716.835.0240  
cbell@eckertseamans.com



**BUFFALO, NEW YORK**

The Carriage House  
91 Jewett Parkway  
Buffalo NY 14214

P: 716.835.0240

F: 215.851.8383

[cbell@eckertseamans.com](mailto:cbell@eckertseamans.com)

**WHITE PLAINS, NEW YORK**

10 Bank St.  
Suite 700  
White Plains, NY 10606

P: 914.286.6431

F: 914.949.5424

[cbell@eckertseamans.com](mailto:cbell@eckertseamans.com)

**PRACTICE AREAS:**

[Intellectual Property](#)

[Intellectual Property Litigation](#)

[International](#)

**STATE ADMISSIONS:**

New York

**COURT ADMISSIONS:**

U.S. District Court for the  
Northern District of New York

U.S. District Court for the  
Western District of New York

U.S. Court of International Trade

U.S. Court of Appeals for the  
Federal Circuit

U.S. Patent and Trademark Office

**EDUCATION:**

J.D., State University of New York  
at Buffalo Law School, 1990

B.A., Franklin & Marshall College,  
1987



## Candace Lynn Bell

### MEMBER

Candace Lynn Bell focuses her practice on intellectual property matters for United States-based companies and individuals as well as foreign-based individuals and companies doing business in the United States. She has more than 20 years of experience in working with clients to develop and manage trademark and domain name portfolios on a national and international basis, including developing brands, policing marks, and portfolio and registration management. She advises clients in a broad range of industries including software, insurance, entertainment, food service, bakeries, consulting, aviation, construction, precious metal refining, and retail. Candace also has an active trademark litigation practice representing clients in front of the Trademark Trial and Appeal Board of the United States Patent and Trademark Office and in federal courts.

She has served as lead counsel for her clients in jurisdictions around the globe directing local counsel in connection with trademark disputes. Based in Buffalo, New York, Candace has more than 25 years of experience counseling Canadian businesses expanding into the United States on intellectual property cross-border legal issues, including U.S. customs and corporation matters.

### REPRESENTATIVE MATTERS

- Represents a global performance consulting company as outside intellectual property counsel and manages the clients worldwide trademark portfolio and worldwide trademark litigation. By consolidating management of its worldwide portfolio and litigation with Candace and the Eckert Seamans IP team, the client is able to ensure its marks are protected worldwide in a uniform and cost-effective manner. Candace also manages the client's trademark litigation across the globe, using extensive foreign local counsel contacts, so the client itself has not had to find reliable foreign local counsel in various jurisdictions worldwide.
- *Kistner Concrete Products, Inc. v. Contech Arch Technologies, Inc.*, No. 92048733, TTAB (2011). Represented a concrete construction company in a cancellation proceeding against a trademark registration for a concrete arch shape. In a precedential decision, the Trademark Trial and Appeal Board cancelled the registration on the grounds the mark was functional and therefore not entitled to registration. Upon successful cancellation, the registrant could no longer pursue trademark infringement claims against a company using the concrete arch shape.

- *Avenza Systems Inc. v. Avencia Incorporated*, No. 92046736, TTAB (2009). Represented a geospatial software company in a combined cancellation and opposition proceeding against a trademark registration and a pending trademark application for geospatial software on the grounds of a likelihood of confusion with the client's already registered mark and trade name. The Trademark Trial and Appeal Board cancelled the registration on the grounds the mark of the subject registration was likely to cause confusion with the client's already registered mark. A second application for a nearly identical mark was successfully opposed on the same grounds.
- Represented several different online retailers and service providers in a number of domain name disputes regarding domain names that are likely to cause confusion with the clients' registered trademarks in disputes under the Uniform Domain Name Dispute Resolution Policy.

## PROFESSIONAL AFFILIATIONS

- Erie County Bar Association, Intellectual Property, Computer and Entertainment Law Committee
- New York State Bar Association, Intellectual Property Law Section
- American Bar Association, Intellectual Property Section

## COMMUNITY INVOLVEMENT

- Parkside Community Association, a nonprofit group working on behalf of Parkside, a National Register of Historic Places neighborhood, Immediate Past President
- Darwin D. Martin House Complex Restoration Corporation, Member of the Near Neighbors Committee
- Temple Beth Zion, Member of the Annual Fund Campaign Committee

## AWARDS AND RECOGNITION

- *Business First* and *Buffalo Law Journal* "Who's Who in Law"

## NEWS AND INSIGHTS

### PUBLICATIONS

- ["Four Steps to Take Today to Protect Your Copyrights."](#) co-authored, *PhotoPXL*, July 2019.
- ["'What do you mean I can't name my artisanal gin after my dog?' It's not that simple: Do's and don'ts for trademarking your craft beer, spirit, or wine."](#) *Artisan Spirit Magazine*, March 2019.
- ["What's in a name? Trademark considerations when using your name as your brand."](#) *Eckert Seamans' Construction Law Update*, Spring 2019.

- [“A Primer on Trademarks for the Construction Industry.”](#) Breaking Ground Magazine, January/February 2019.
- [“A primer on trademarks for the construction industry.”](#) *Eckert Seamans’ Construction Law Update*, Fall 2018.
- “Considerations When Taking an Appeal from the United States Patent and Trademark Office Trademark Trial and Appeal Board,” *Eckert Seamans’ Legal Update*, March 2014.
- [“Protecting Your Valuable Brand: The Importance of Trademarks.”](#) Internet Marketing Association Newsletter, February 2013.
- “Functionality as a bar to registration – Recent cases before the United States Patent and Trademark Office Trademark Trial and Appeal Board,” *Eckert Seamans’ Legal Update*, Fall 2012.

#### SPEAKING ENGAGEMENTS

- “Google AdWords Update: What You Need to Know,” moderator, Internet Marketing Association IMPACT 2013 conference, September 2013.

2019 Update: LEGAL PRIMER

# Copyright Registration A Must Have for Infringement Litigation

Presented by:  
Candace Lynn Bell, Esq.

**ECKERT  
SEAMANS**  
ATTORNEYS AT LAW



August 8, 2019

## Overview



- What Is a Copyright and Why Should Businesses Care ?
- The Need for a Certificate of Registration for Copyright Infringement Litigation
- Obtaining the Certificate of Registration and Statute of Limitation Issues
- Pro-Active Steps for Copyright Portfolio Management



2019 Update: LEGAL PRIMER

**ECKERT  
SEAMANS**  
ATTORNEYS AT LAW

## Copyrights – What Are They?



- What is a Copyright?
  - It is a bundle of exclusive protections and rights for the author of an “original work of authorship” that is “fixed” in a tangible form of expression. 17 U.S.C. §§102 - 106
- What Types of Work May Be Protected by Copyright?
  - Literary works
  - Pictorial, graphic and three dimensional works
  - Audiovisual works
  - Sound recordings
  - Other Works

[www.copyright.gov/circs/circ01.pdf](http://www.copyright.gov/circs/circ01.pdf)



2019 Update: LEGAL PRIMER

**ECKERT  
SEAMANS**  
ATTORNEYS AT LAW

## Copyrights – Important Dates



- When Does a Copyright Come into Being?
  - Generally, under the Copyright Act of 1976, for works created after January 1, 1978, in the United States, protection exists from the moment the work is fixed. 17 U.S.C. §§ 302
- However, the ability to initiate civil litigation to enforce a copyright does not arise until the copyright is registered.  
17 U.S.C. § 411 and §501



2019 Update: LEGAL PRIMER

**ECKERT  
SEAMANS**  
ATTORNEYS AT LAW

## Copyrights – Why Should Businesses Care ?



- Nearly all businesses and organizations have copyrightable materials
  - Examples include:
    - Websites, including any photographs, demonstration videos, brochures, white papers, technical drawings and specification sheets
    - Product packaging, including graphic designs, artwork, product photographs
- Copyright owners have the ability to protect against unauthorized reproduction, copying, distribution and display of their works



2019 Update: LEGAL PRIMER

**ECKERT  
SEAMANS**  
ATTORNEYS AT LAW

## Copyright Civil Infringement Litigation before *Fourth Estate*



- The Copyright Act provides:
  - . . . . no civil action for infringement of the copyright in any United States work shall be instituted until pre-registration or registration of the copyright claim has been made in accordance with this title. . . . 17 U.S.C. § 411(a)
- What does “registration” mean . . . .
- U.S. Courts of Appeals (Circuit Courts) and even different U.S. District Courts within the same Circuit analyzed the the issue of “when” registration occurs differently
  - The Application Approach – filing an application to register a copyright with the Copyright Office meets the requirement.
  - The Registration Approach – having a Certificate of Registration in hand meets the requirement.



2019 Update: LEGAL PRIMER

**ECKERT  
SEAMANS**  
ATTORNEYS AT LAW

## Copyright Civil Infringement Litigation after *Fourth Estate*



- The U.S. Supreme Court granted *certiorari* in the *Fourth Estate Public Benefit Corp. v. Wall-Street.com LLC* case “to resolve a division among the U.S. Courts of Appeals on when registration occurs in accordance with 411 (a)” 2019 WL 1005829 Paragraph 4.
- Court held for the Registration Approach
- *Fourth Estate Public Benefit Corp. v. Wall-Street.com LLC*  
2019 WL 1005829 (U.S. Mar. 4, 2019)



2019 Update: LEGAL PRIMER

**ECKERT  
SEAMANS**  
ATTORNEYS AT LAW

## Copyright Civil Infringement Litigation Claim Accrual



- The Copyright Act provides:  
. . . . No civil action shall be maintained under the provisions of this title unless it is commenced within three years after the claim accrued . . . 17 U.S.C. § 507
- What does “claim accrued” mean . . . .
- There is a split among the U.S. Circuit Courts on when a “claim accrues”
  - The Discovery Rule – the claim accrues when the owner of the copyright knows or has reason to know of the act which is the basis for the claim. *(Cites omitted)*
  - The Injury Rule – the claim accrues when act which is the basis for the claim OCCURS *(Cites omitted)*



2019 Update: LEGAL PRIMER

**ECKERT  
SEAMANS**  
ATTORNEYS AT LAW



## Regular Registration Processing Times at the Copyright Office



- Registration Processing Times:
  - No follow up with claimant required
    - Web Claims – 1-7 months, average 4 months
    - Mail Claims - 1-18 months, average 7 months
  - Follow up with claimant required
    - Web Claims – 1-15 months, average 7 months
    - Mail Claims - 1-28 months, average 14 months

[www.copyright.gov/registration/docs/processing-times-faqs.pdf](http://www.copyright.gov/registration/docs/processing-times-faqs.pdf)

Latest Posted Copyright Office Update as of March 31, 2019



2019 Update: LEGAL PRIMER

**ECKERT  
SEAMANS**  
ATTORNEYS AT LAW

## Pro-active Steps for Copyright Owners



- File Pre-Emptively
  - Consider what types of works should have an application filed after creation
  - Added benefit of statutory damages
- Be Prepared to Act Quickly
  - Have in hand the information to complete an application
  - Expedited Processing – estimated turn around time
    - Higher Filing Fees



2019 Update: LEGAL PRIMER

**ECKERT  
SEAMANS**  
ATTORNEYS AT LAW

## Pro-active Steps for Copyright Owners



- Maintain Copyright Portfolio Documentation
  - Tracking of all aspects of the works
    - Contracts – employee agreements, independent contractor agreements
    - License agreements
    - Copies of the work
    - Docketing for tracking progress of applications
- Consider Increasing the Budget for Copyright Filings



2019 Update: LEGAL PRIMER

**ECKERT  
SEAMANS**  
ATTORNEYS AT LAW

## Questions?



Candace Lynn Bell, Esq.  
cbell@eckertseamans.com  
(716) 835.0240



2019 Update: LEGAL PRIMER

**ECKERT  
SEAMANS**  
ATTORNEYS AT LAW