

## INFRINGEMENT OF THE IP RIGHTS OF OTHERS – TRAPS FOR THE UNWARY

Presented by:

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**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

**EDUCATION:**

J.D., State University of New York  
at Buffalo Law School, 1991

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

- "[Rise in Trademark Pendency Causes New Challenges for Practitioners](#)," Bloomberg Law, February 2023.
- "[Tips to Leverage and Protect Trademarks in Challenging Times](#)," Artisan Spirit, Summer 2020, (see pages 74 & 75).
- "[Supreme Court's Opinion in Booking.com Case Suggests Trademark Registration May be Available for Certain Generic.com Marks](#)," Eckert Seamans' Intellectual Property Alert July 15, 2020.

- [“Protecting Creative Works After \*Fourth Estate v. Wall-Street.com\*,”](#) co-authored, IP Watchdog.com, January 2020.
- [“Your Label, Your Bottle, Your Story, Your Copyright: How copyrights can protect your craft alcohol’s unique vibe,”](#) Artisan Spirit Magazine, Winter 2020.
- [“INSIGHT: Tips for Protecting Creative Works Following SCOTUS Copyright Ruling,”](#) co-author, Bloomberg Law, August 2019.
- [“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.
- [“IP Update: New Guidance – File Copyright Applications Routinely for Important Works,”](#) Eckert Seamans’ Intellectual Property Update, 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.

## MEDIA COVERAGE

- [“Can a Wine Ever Really be ‘Clean’?”](#) Wine Enthusiast Magazine, August 2020.

## SPEAKING ENGAGEMENTS

- [“Copyright Registration – A Must Have for Infringement Litigation,”](#) presenter, Eckert Seamans’ Continuing Legal Education Seminar, August 2019.
- “Google AdWords Update: What You Need to Know,” moderator, Internet Marketing Association IMPACT 2013 conference, September 2013.

# Infringing the IP Rights of Others Traps for the Unwary

Candace Lynn Bell, Esq. | Eckert Seamans CLE  
Legal Primer

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## Digital Media and the E-Business

- Unprecedented access to copyright protected materials
  - Multiple sources
  - Multiple devices
- Ease of copying in a digital media environment
  - Cut and Paste
  - Copy and Paste
  - Drag and Drop
- Multiple contributors to a Company's e-presence
  - Web designer/web developer
  - Employees
  - Third parties

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## Innocent Actions or Hidden Traps or Both?

- Posting a photo on the Company's LinkedIn Page
- Posting a photo on the Company's social media account(s)
- Posting a photo on the Company's website
- Posting text from another company's website
- Posting another company's trademark(s)
- Posting a photo of a competitor's product bearing the competitor's trademark
- Playing music or a video on the Company's website
- Broadcasting music or video content in the Company's waiting areas or show rooms

## To Post or Not to Post . . . . .

- What has not changed?
- What has changed?
  - The rise of companies whose business, in whole or in part, is to search for copyright protected materials posted on social media and websites without license or authorization
    - How: Software advances for locating use
    - Why: Copyright Liability - strict liability  
Monetary Damages

## What Happens When Unauthorized Use is Found?

- Cease and Desist Letters
  - Take Down Demands
  - Information Requests – connection to monetary demands
  - Response Deadlines
- Monetary Demands
  - Back License Payments
  - Damages
    - Statutory Provisions

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## Posting Photos or Copied Text on Social Media or Websites – Part One

- Key Questions to Ask:
  - Where did the photo or text come from?
  - Did you create it?
  - Did you get permission to use it?
  - Did you purchase a license?
  - What are the terms of the license?

## Posting Photos or Copied Text on Social Media or Websites – Part Two

- Key Questions to Ask:
  - Are there rights of privacy issues?
  - Are there right of publicity issues?
  - Are there any trademark rights?
  - Is there a comparative advertising issue?



## Playing Music or Videos and Broadcasting Music or Videos – Part Three

- Additional Key Questions:
  - Who created each element?
    - Music
    - Lyrics
  - Did you get permission to use it and broadcast it?
  - Did you purchase a license?
    - BMI
    - ASCAP
    - SESAC
  - What are the terms of the license?
    - Sites and numbers of viewers

## Just because it's on the internet . . . Just because it's on a social media site . . .

- Does Not Mean it is in the Public Domain
- Does Not Mean it is Free
- Creative Commons Generic License
  - <https://creativecommons.org/>
  - Different types
    - Attribution
    - Non-commercial

## Just because it's on the internet . . . Just because it's on a social media site . . .

- Does Not Mean There is a “Fair Use” Defense
- “Fair Use” – 4 Factors
  - the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
  - The nature of the copyrighted work;
  - The amount and substantiality of the portion used in relation to the copyright work as whole; and
  - The effect of the use upon the potential market for or value of the copyright work.

(17 U.S.C §107)

## Considerations for Avoiding The “Hidden” Traps – Part One

- Create Company Policies on Posting
  - Coordinate with HR
- Educate all employees on the issues
  - On-going Training
  - Coordinate with HR
- Designate specific employees who can update and post to the Company's digital environment
  - Coordinate with IT and Marketing
- Policing of Company's e-presence
  - Coordinate with IT and Marketing

## Considerations for Avoiding The “Hidden” Traps – Part Two

- Contract provisions with third parties, including web designer/developer
  - Representations of right to use content
  - Indemnification of Company by Third Party content provider
  - Assignment of copyright to the Company, if any created
  - All “Work Made for Hire” arrangements memorialized in a written agreement
  - Coordinate with Legal
- Obtain licenses, if needed
  - BMI, ASCAP and SESAC
  - Getty Images
  - Track specific terms, such as attribution and license fees
  - Comply with license terms
  - Coordinate with Legal

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# QUESTIONS