


IT'S A BIRD, IT'S A PLANE, IT'S IP?

February 24, 2022

A Boyle Fredrickson Production
with Special Guest Jascha Walter of
Northwestern Mutual



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Meet Your IP Counsel



Adam Brookman

Michael Griggs

Sarah Wong

Brad Meyer

Billie Jean Smith

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Meet Your Special Guest



Jascha Walter



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A TAMS-WITMARK TITLE

IT'S A BIRD... IT'S A PLANE... IT'S SUPERMAN®

Full-Length Musical, Comedy / 2f, 5m

Charles Strouse, Lee Adams, David Newman, Robert Benton

Music by Charles Strouse / Lyrics by Lee Adams / Book by David Newman and Robert Benton / (Based Upon the Comic Strip *SUPERMAN*) / Broadway Production Produced by Harold Prince in association with Ruth Mitchell / Directed for the Broadway Stage by Harold Prince

Up, up and away! Superman and his comic book cohorts fly into action... from Metropolis to your theatre!

Image: Joan Marcus

REQUEST LICENSE

GET THE SCRIPT

GET AN ESTIMATE

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There is no registration for “It’s a bird . . It’s a plane . . It’s Superman – despite the ®.
DC had a registration for a similar mark,
but it is no longer in force.

Word Mark	LOOK, UP IN THE SKY. IT'S A BIRD, IT'S A PLANE
Goods and Services	(CANCELLED) IC 035. US 101. G & S: ADVERTISING AND PROMOTIONAL SERVICES, NAMELY, CREATING ADVERTISING FOR OTHERS INCORPORATING COMIC STRIP MATERIALS. FIRST USE: 19880317. FIRST USE IN COMMERCE: 19880317
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	73722622
Filing Date	April 15, 1988
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	December 6, 1988
Registration Number	1527304
Registration Date	February 28, 1989
Owner	(REGISTRANT) DC COMICS INC. CORPORATION NEW YORK 666 FIFTH AVENUE NEW YORK NEW YORK 10103 (LAST LISTED OWNER) DC COMICS PARTNERSHIP ASSIGNEE OF NEW YORK 1325 AVENUE OF THE AMERICAS NEW YORK NEW YORK 10019
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	ELISE A. TENEN
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR).
Live/Dead Indicator	DEAD
Cancellation Date	October 3, 2009

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Trademarks for Unrelated Goods?



KEY TAKEAWAY: If a trademark is famous or well known, owners may want to expand their rights to other goods and services.

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These are Trademarks?!?



- RED SOLES for shoes (Christian Louboutin)
- ULTRA THIN for cheese (Sargento Foods)
- GOATS ON THE ROOF for restaurants (Al Johnson's Swedish Restaurant)
- SMELL of Play-Doh for modeling compounds (Hasbro)



Where to Look: Trademarks can be anywhere – under your feet, above your head, right in front of your nose.

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This is What a “Goats on the Roof” Trademark Registration Looks Like



Goods and Services
Mark Drawing Code

IC 042. US 100 101. G & S: restaurant services. FIRST USE: 19730601. FIRST USE IN COMMERCE: 19730601
(2) DESIGN ONLY

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Enough with the Trademarks!

- REALTOR
- PET DEPOT



The REALTOR® Logo



Commercial Logo



MLS Logo

- Multiple trademarks together - can you do that?
(Uh, no – not without permission)



- **KEY TAKEAWAY:** Do not automatically conclude “that cannot be a trademark.” It might be.

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Does it ever end?



- **KEY TAKEAWAY:** Brand elements such as letters, words, logos and designs on products may be protected.

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Name and Likeness & Copyrights

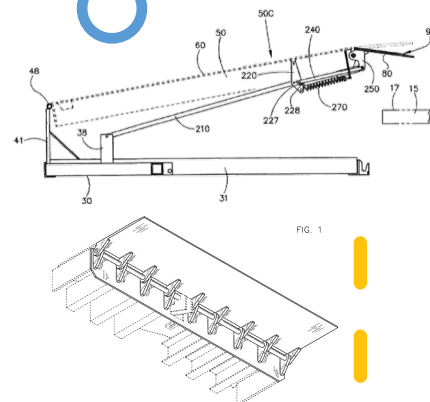


KEY TAKEAWAY: If you are depicting a person, whether living or dead, real or fictional, you may be encroaching on IP rights.

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Is it patented? Is it protected trade dress?

- Utility and/or design protection
 - Dock leveler
 - Initially filed as utility application
 - Design application subsequently filed
 - Product configuration trade dress based on acquired distinctiveness can last forever
 - BUT . . . Engage in “look for” advertising to develop rights.



- **KEY TAKEAWAY:** Think outside the box! In addition to seeking utility protection for a design, consider also filing a design patent application for products having a distinct appearance. Try to develop trade dress rights and by doing “look for” advertising.

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Is it a trade secret?

- Trade secrets can include any confidential business information which provides an enterprise with a competitive edge and is unknown to others.
- **Where to look:** They are everywhere. Just ask your employees what they would not want your competitors to know.
- **KEY TAKEAWAY:** Unless identified, they can literally walk out the door as a company found out with a grad student intern. Do a trade secret audit, identify trade secrets, and provide sufficient protocols to protect them.



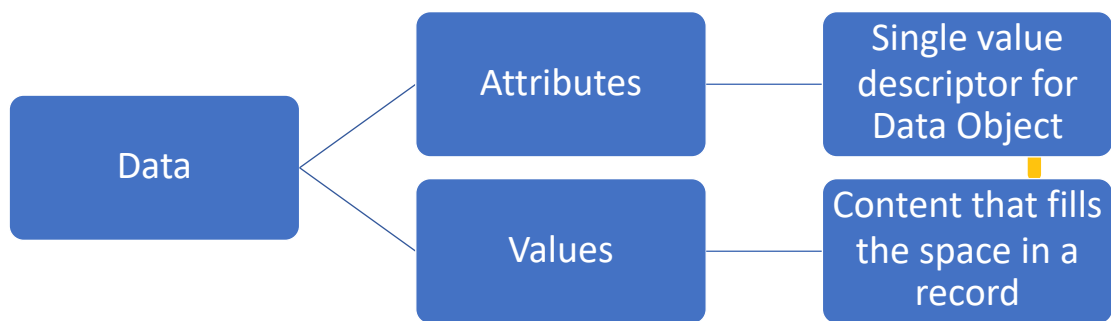
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When you hear the word “Data”
where does your mind go?
Straight to IP? Be Honest!



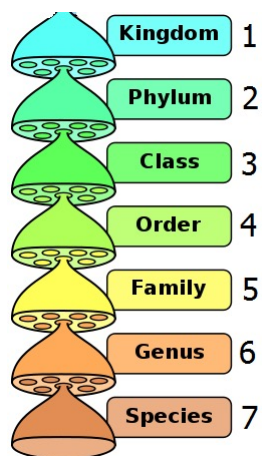
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The most basic elements of Data



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Taxonomies



Collection Taxonomy

Display Taxonomy

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Application to things as basic as these:



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Final Takeaways: Part I

- Do not automatically conclude “that cannot be a trademark.” It might be. Does some characteristic of your goods/services differentiate you from competitors?
- Do not automatically conclude that a trademark used with other goods/services will not be an issue. Is the mark well known or famous?
- Commonly known descriptive words and logos may be protected.
- Are you depicting a person or using a person's image? Living or dead? Real or fictional? Are you using a photograph of them?

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Final Takeaways: Part II

- Unless identified and protected, trade secrets can literally walk out the door. Do a trade secret audit, identify trade secrets, and provide sufficient protocols to protect them.
- In addition to seeking utility protection for a design, consider also filing a design patent application for products having a distinct appearance. While design patent protection is in place, begin to accrue trademark rights and evidence that the design is used as a source identifier
- Don't forget that data can also be IP. So make sure to limit its disclosure.

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Thank You!

BOYLE
FREDRICKSON
INTELLECTUAL PROPERTY LAW

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