



Using Copyright to Enforce Your Brand

*International Anti-Counterfeiting Coalition
Annual Conference 2023*

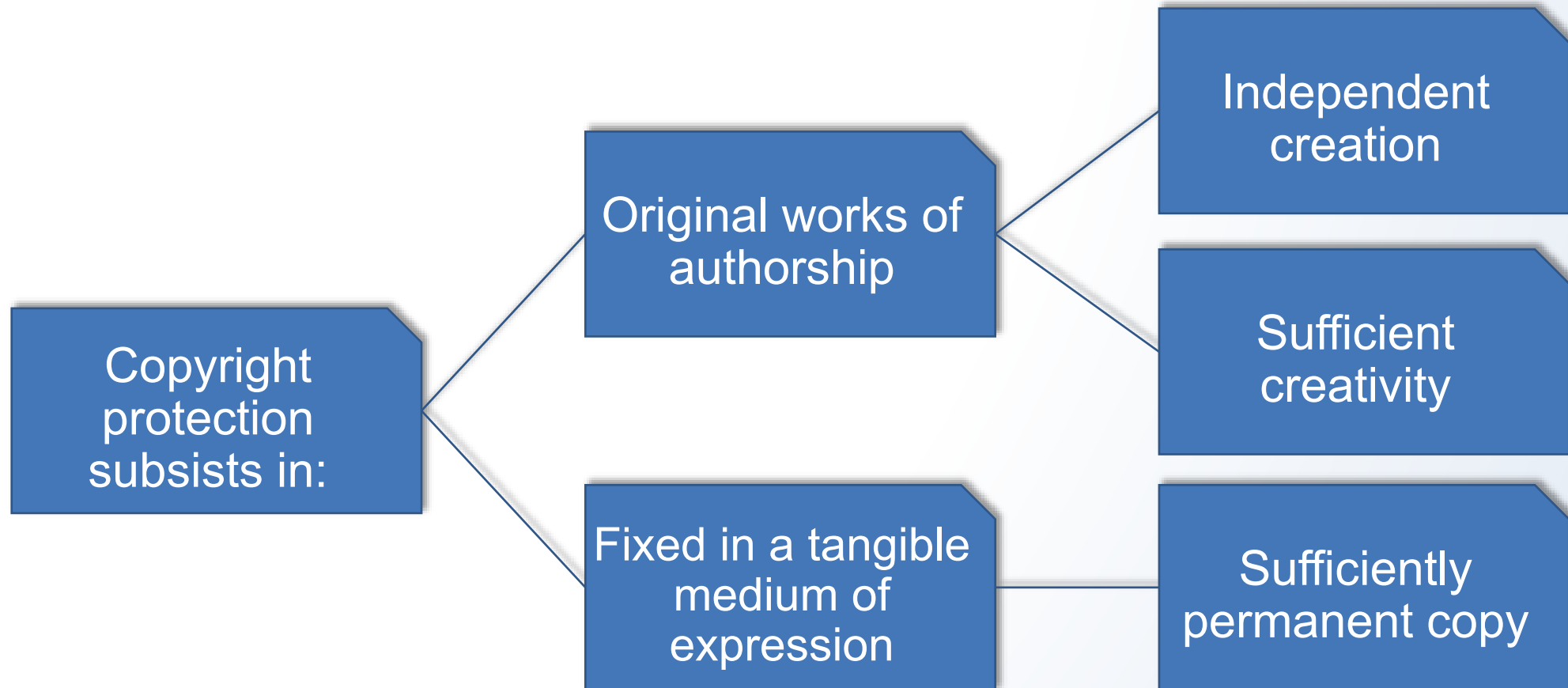
Jalyce E. Mangum

Attorney-Advisor

Office of the General Counsel

U.S. Copyright Office

jmang@copyright.gov





The following are examples of works not subject to copyright and applications for registration of such works cannot be entertained:

Words and short phrases such as names, titles, and slogans; **familiar symbols or designs**; mere variations of **typographic ornamentation, lettering or coloring**; mere listing of ingredients or contents

Ideas, plans, methods

Blank forms

Works consisting entirely of information that is **common property**

Typeface as typeface





Covered by Copyright

- Literary, musical, & dramatic works
- Pictorial, graphic, & sculptural works
- Pantomimes & choreographic works
- Motion pictures & other audiovisual works
- Sound recordings
- Architectural works

17 U.S.C. § 106(a)

NOT Covered by Copyright

- Works lacking originality
- Words & short phrases
- Coloring
- Spatial format & layout
- Familiar symbols & designs
- Common geometric shapes
- Ideas, plans, methods, & systems
- Blank forms
- Typefaces
- Useful articles

COMPARING COPYRIGHT & TRADEMARK



COPYRIGHT

Modicum of Creativity
(Source Identification Not Required)

No Protection for Single Words or Short Phrases

Protects Scandalous Material

Fonts, Typeface, Etc. Not Protected

Life Plus 70 years
95 years from publication or 120 years from creation if a work made for hire, anonymous, or pseudonymous work

TRADEMARK

Fanciful, Arbitrary, Suggestive, or Descriptive with Secondary Meaning

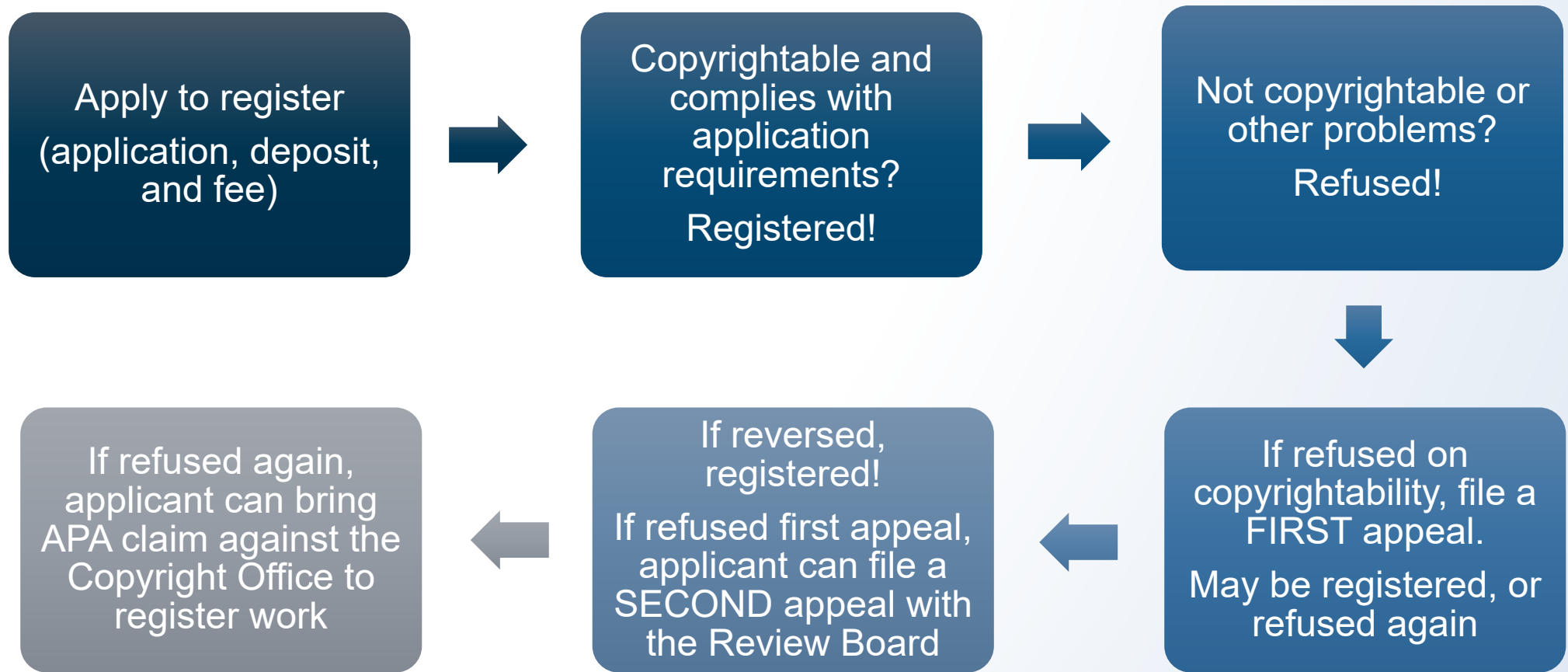
Single Words and Phrases Protected

No Scandalous Material

Fonts Can Serve Source Identification Purposes

Unlimited Term As Long As In Use

COPYRIGHT REGISTRATION PROCESS



1st Request for Reconsideration

\$350 per claim

Reasons/legal arguments supporting applicant's request for registration

Review by attorney in the Office of Registration Policy & Practice

2nd Request for Reconsideration

\$700 per claim

Must address earlier reasons for upholding the refusal to register

Review by 3-member Review Board (Register and GC (or their designees) and another Register designee)

Decision is by majority and is final agency action; can be challenged (for abuse of discretion) in federal court under Administrative Procedure Act

<https://copyright.gov/rulings-filings/review-board/>

REVIEW BOARD CASES – REFUSAL AFFIRMED



FRIGIDAIRE



REVIEW BOARD CASES – REFUSAL REVERSED





SPEEDWAY
motors®

TEAM
SPEEDWAY
motors®



Advertisements
& Commercials

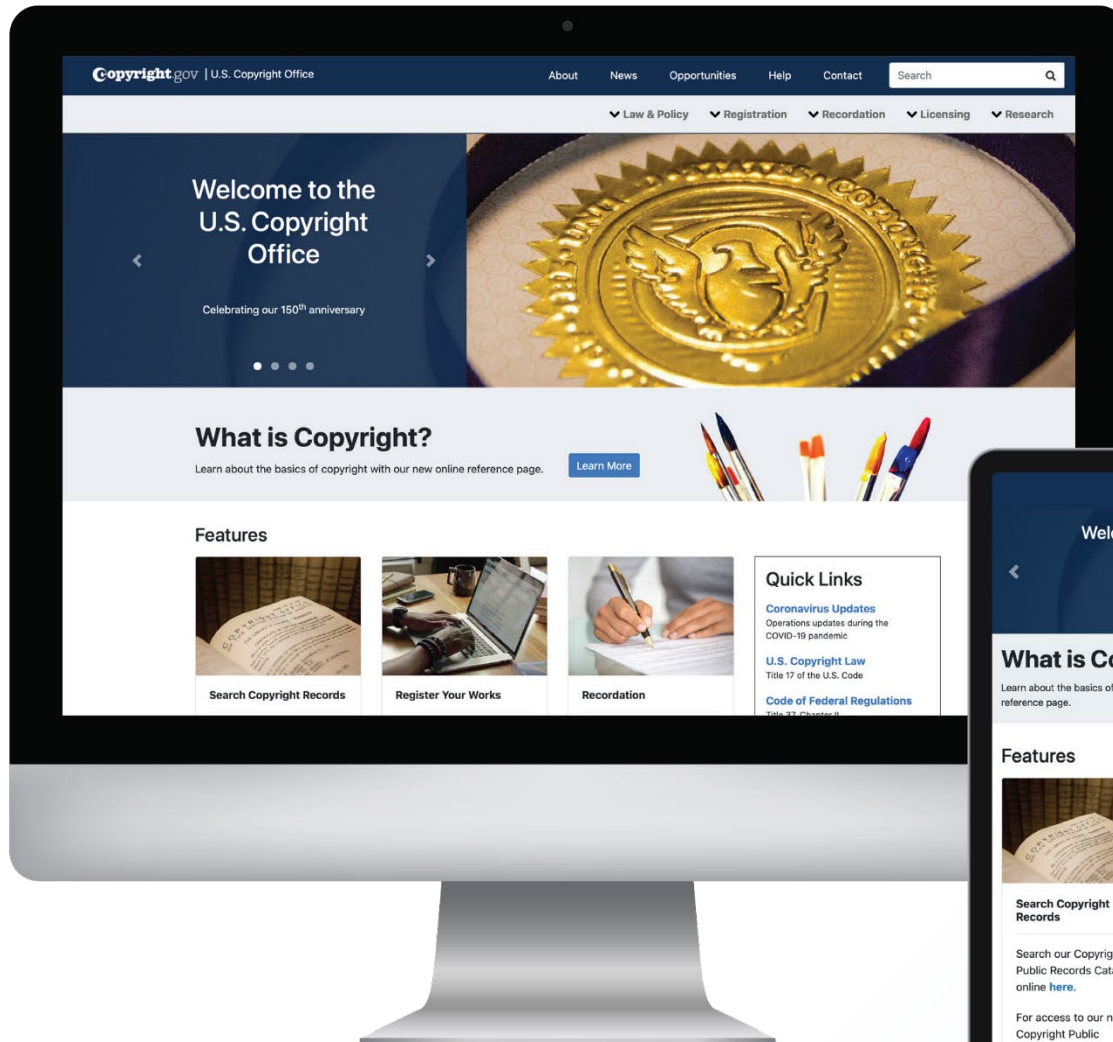
Promotional
Pamphlets &
Newsletters

Business
Manuals &
Training
Materials

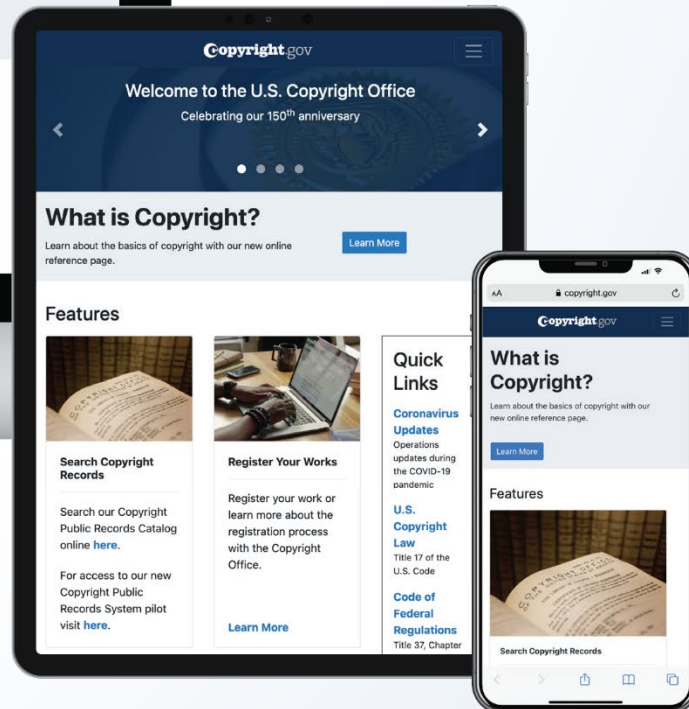
Presentations

Websites

Other Creative
Works!



Copyright.gov

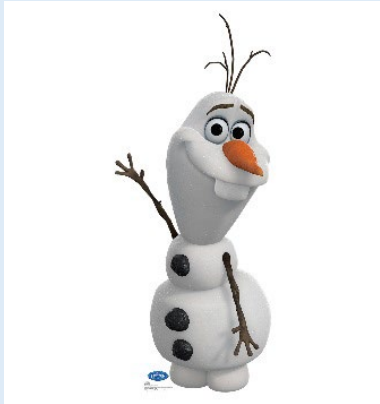


Obtaining Border Enforcement of Intellectual Property Rights & CBP's e-Recordation System



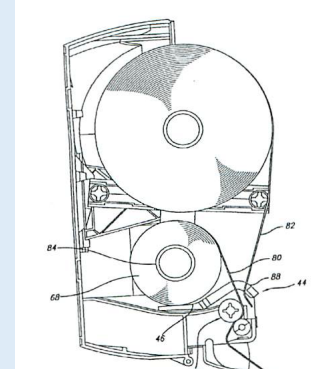
Which IP does CBP Enforce?

Trademark (ex officio)

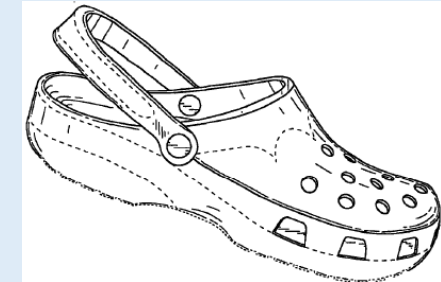


Copyright (ex officio)

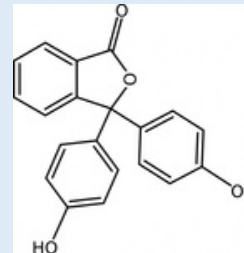
Utility Patent*



Design Patent*



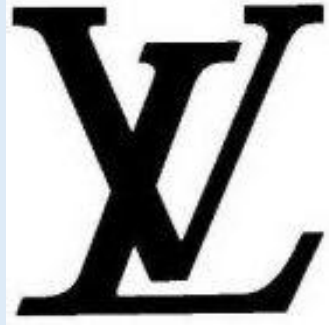
* ITC Exclusion Order Required



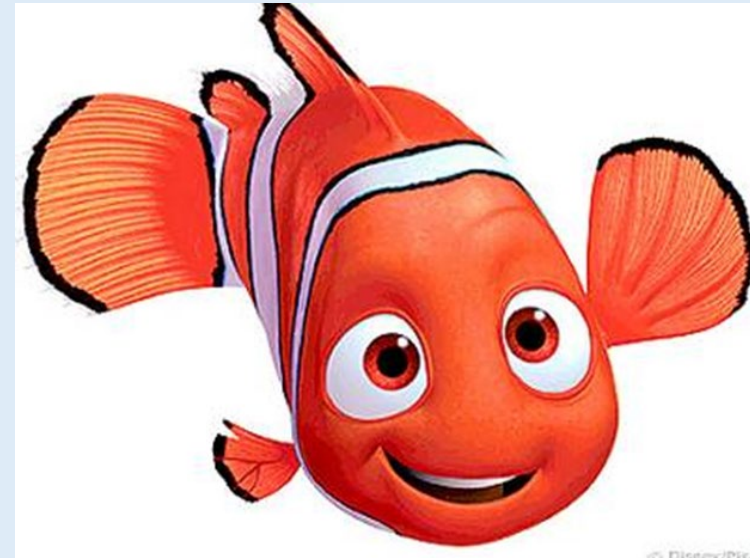
Trade Secret*

Main IP CBP Enforces

TRADEMARKS



COPYRIGHTS



IP Violations

- **Counterfeit** (19 U.S.C. § 1526(e))
 - Identical with or substantially indistinguishable from protected trademark
 - Spurious – applied without trademark owner’s permission
- **Confusingly Similar/Merely Infringing** (19 U.S.C. § 1595a(c)(2)(C))
 - Underlying violation of 15 U.S.C. § 1124
 - Copying or simulating mark that would likely cause the public to associate the suspect mark with a protected trademark
- **Piratical Copies** (19 U.S.C. § 1595a(c)(2)(C))
 - Underlying violation of 17 U.S.C. § 602
 - Substantially similar to protected copyright

DMCA Violation



- Definition of violation
 - According to the DMCA (17 U.S.C. § 1201(a)(2)), no person shall manufacture, import, offer to the public, provide, or otherwise traffic in any technology, product, service, device, component, or part thereof that —
 - (A) is primarily designed or produced for the purpose of circumventing a technological measure that effectively controls access to work protected under this title;
 - (B) has only limited commercially significant purpose or use other than to circumvent a technological measure that effectively controls access to a work protected under this title; or
 - (C) is marketed by that person or another acting in concert with that person with that person's knowledge for use in circumventing a technological measure that effectively controls access to a work protected under this title.
- Seizure authority
 - 19 U.S.C. § 1595a(c)(2)(G) incorporates the requirements of a DMCA device trafficking violation by reference to subsections (a)(2) and (b)(1) of 17 U.S.C. § 1201.
 - These are: (1) primarily designed or produced for the purpose of circumventing a technological measure that effectively protects a copyright; (2) only limited commercially significant purpose or use other than to circumvent; or (3) marketed with knowledge.
 - Although both subsections prohibit trafficking in a circumvention technology, the focus of subsection 1201(a)(2) is circumvention of technologies designed to prevent access to a work, and the focus of subsection 1201(b)(1) is circumvention of technologies designed to permit access to a work but prevent copying of the work or some other act that infringes a copyright.

IP Violation Samples

Counterfeit



Identical/Substantially
Indistinguishable

Confusingly Similar

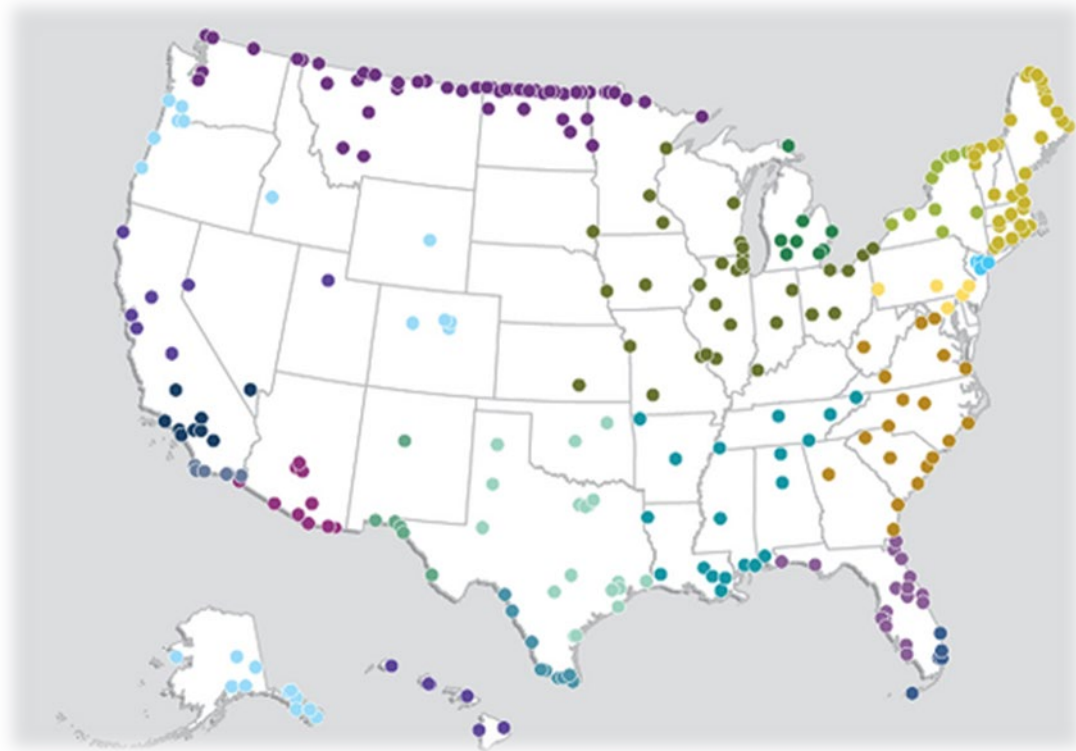


Copying/Simulating

Piratical Copy



Substantially Similar



U.S. Customs & Border Protection e-Recordation Program

Registration v. Recordation

Registration relates to the official act of filing (1) a trademark with the U.S. Patent & Trademark Office, or (2) a **copyright** with the U.S. Copyright Office for a federal registration.



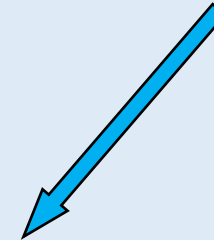
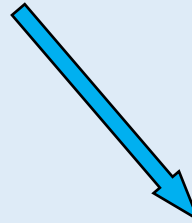
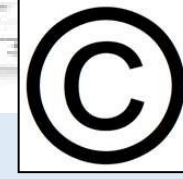
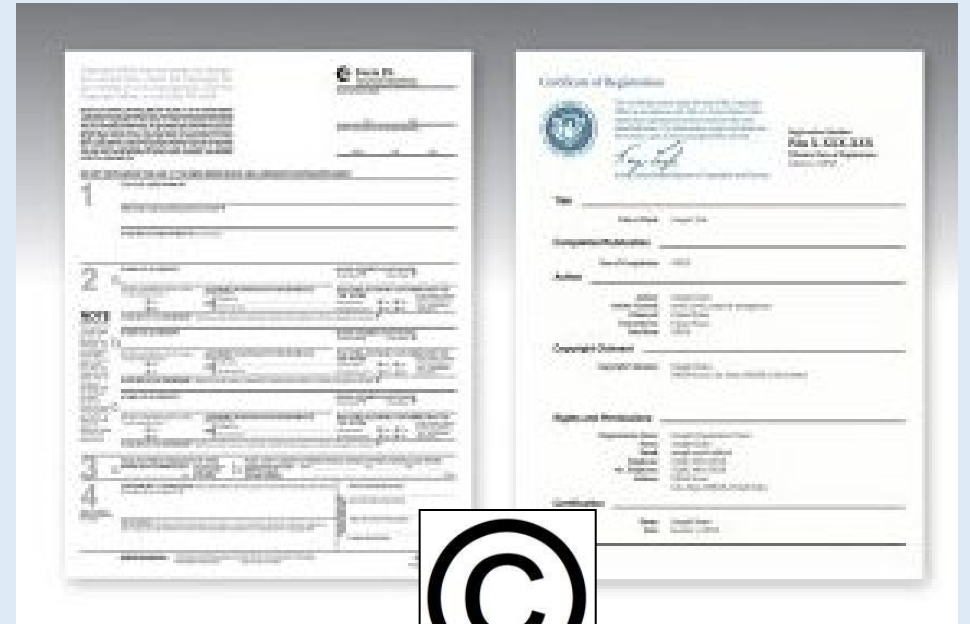
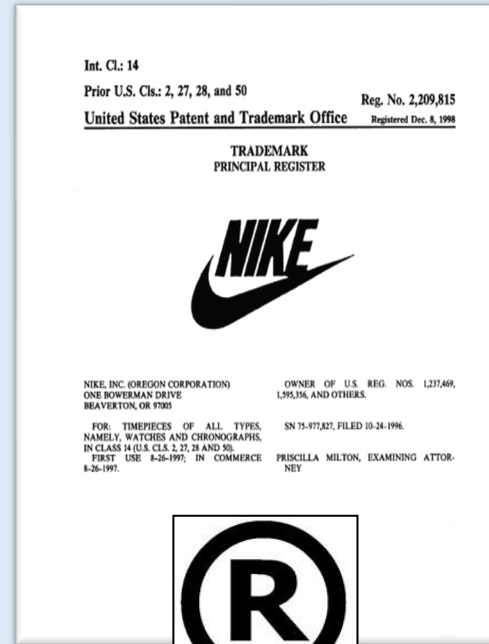
Recordation refers to bringing a valid, federally registered right (trademark or copyright) to CBP (IPE Branch, R&R) in order to protect against the importation of infringing goods. 19 CFR § 133.1, *et seq.*



Distinction: Seizure is not always possible of goods that violate unrecorded rights.

1

**REGISTER with
USPTO or
U.S. Copyright
Office**



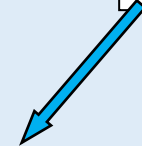
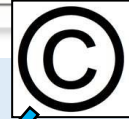
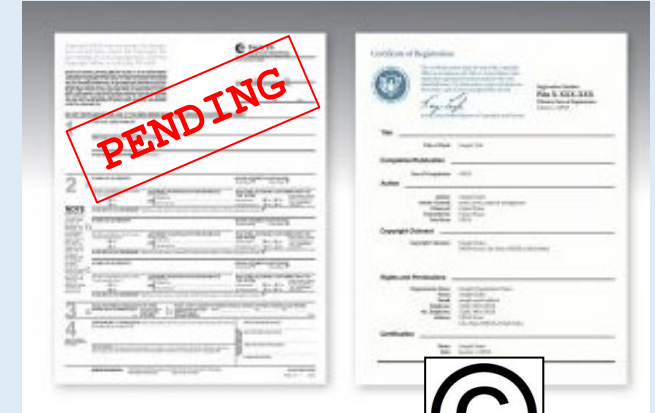
IPRR INTELLECTUAL PROPERTY
RIGHTS e-RECORDATION

2

**RECORD
with CBP**

Temporary Copyright Recordation

- We allow **temporary recordation** for **pending copyright registrations** with the USCO
- Provides the applicant protection while waiting for USCO approval
- Term of protection is only for 6 months or until the registration is granted
- Once the copyright is granted applicant must apply anew and pay the \$190 fee



CBP's *ex officio* copyright enforcement authorities

- Detention of suspected piratical items and DMCA prohibited devices for further evaluation
- Seizure of confirmed pirated copies
- Forfeiture and Destruction



Benefits of Recording COPs with CBP

No International Classes (IC) associated with copyrights, unlike trademarks



Benefits of Recording COPs with CBP

CBP Rec. No. COP 18-00199,
USCO Reg. No. VA2-104-216
“RICK AND MORTY STYLE GUIDE (2016)”



Rick and Morty Tutti
Frutti Star Bites 300mg
Cannabis Infused
Gummy Edibles

Recording with CBP



1

**Submit Application
Through IPRR**



2

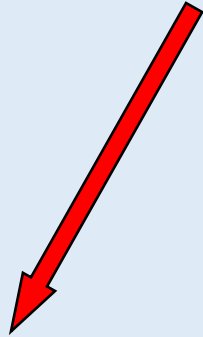
**IPE Branch
Review**



3

**Once Approved,
Recordation Appears
on IPRS/IPRiS**

IPRR INTELLECTUAL PROPERTY
RIGHTS e-RECORDATION



IPRS INTELLECTUAL PROPERTY
RIGHTS SEARCH



IPRiS INTELLECTUAL PROPERTY
RIGHTS *internal* SEARCH

IPRiS INTELLECTUAL PROPERTY RIGHTS *internal* SEARCH



What Information Does CBP Ask For?

- Image of Registration Certificate
- Accurate image(s) of protected copyright as used in commerce, in ".jpg," ".gif" or ".pdf " format
- Names of licensees or parties authorized to reproduce the copyright
- Country of Manufacture
- Point of Contact: name, address, telephone and email address
- "Additional Information"
- Product Authentication Manual or Authentication Guide

Recordation Fees

New Recordations:

- Trademark: \$190 per class of goods, per trademark
- Copyright: \$190 per copyright

Renewal:

- Trademark: \$80 per previously recorded class of goods, per trademark
- Copyright: \$80 per copyright

Recordation Term:

- Trademark: The recordation will remain in force concurrently with the underlying trademark registration, if renewed with CBP every 10 years
- Copyright: The recordation will remain in force concurrently with the underlying copyright registration, if renewed with CBP every 20 years

Report *Importations* of Counterfeit or Piratical
Merchandise to CBP



<https://eallegations.cbp.gov/>

Report *Online Sales* to Immigration and Customs
Enforcement



<https://www.iprcenter.gov/contact-us>



Recordation Holder Training Opportunities

- CBP offers recordation holders the opportunity to provide enforcement-oriented training to CBP Officers in the field
- Training may be conducted virtually or in-person at the Ports of Entry
- To request a training opportunity, please email tradeseminars@cbp.dhs.gov

Resources

Best Practices for working with CBP: [Best Practices in Working with U.S. Customs and Border Protection to Help Enforce Your Intellectual Property Rights at the Border | U.S. Customs and Border Protection \(cbp.gov\)](https://www.cbp.gov/trade/priority-issues/ipr/bestpracticesov)

CBP Recordation application: <https://iprr.cbp.gov/>

IPR Search: <https://iprs.cbp.gov/#/>

Informed Compliance Publication, *CBP Enforcement of IPR*
https://www.cbp.gov/sites/default/files/assets/documents/2017-Feb/enforce_ipr_3_0.pdf

Intellectual Property Enforcement Branch

Regulations & Rulings Directorate

Office of Trade, Washington, DC

- Presenter: Morgan McPherson Morgan.N.McPherson@cbp.dhs.gov
- Branch Chief: Alaina.vanHorn@cbp.dhs.gov
- Recordation Questions: IPRRQUESTIONS@cbp.dhs.gov
- IP Enforcement Matters: HQIPRBRANCH@cbp.dhs.gov



QUESTIONS?



Using Copyright to Enforce Your Brand

Dr. Virginia Cervieri

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MONSUAREZ



1

Copyright Law No.9.739

2

Intellectual Property Protection
Law No. 17.616

3

Berne Convention for the Protection
of Literary and Artistic Works (DL
No. 14.910).

RELEVANT LEGISLATION

CASE STUDY 1:

Seizure of infringing personal care products

- During the COVID-19 pandemic, Customs officials inspected a container proceeding from China, whose consignee was a Uruguayan company, located in Rivera (border city with Brazil).

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Inspection



CASE STUDY 1:

Seizure of infringing personal care products

- Merchandise: toothbrushes identified with the brand name "SMELL FRESH DUAL ACTION" that imitate the COLGATE-PALMOLIVE copyrights,

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Infringing products




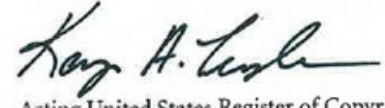
CASE STUDY 1:

Seizure of infringing personal care products

- Infringement: Unlawful reproduction imitating the original design of the "Double Action Toothbrush Pack", on which COLGATE-PALMOLIVE COMPANY holds the universal copyright (Art. 44 of Law No. 9.739).
- Registration number VA 2-102-566 - US Copyright Office .

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 This Certificate issued under the seal of the Copyright Office in accordance with title 17, *United States Code*, attests that registration has been made for the work identified below. The information on this certificate has been made a part of the Copyright Office records.


Acting United States Register of Copyrights and Director

Registration Number
VA 2-102-566
Effective Date of Registration:
May 15, 2018

Title _____

Title of Work: Double Action Toothbrush Pack

Completion/Publication _____

Year of Completion: 2006
Date of 1st Publication: January 01, 2007
Nation of 1st Publication: United States

Author _____

• Author: Colgate-Palmolive Company
Author Created: 2-D artwork
Work made for hire: Yes
Domiciled in: United States

Copyright Claimant _____

Copyright Claimant: Colgate-Palmolive Company
300 Park Avenue, New York, NY, 10022, United States

Certification _____

Name: James D. Weinberger
Date: May 15, 2018
Applicant's Tracking Number: CPC 0611111



CASE STUDY 1:

Seizure of infringing personal care products

- Actions: criminal complaint for infringement of COLGATE-PALMOLIVE COMPANY's copyrights in order to seize the merchandise and obtain the destruction .

Comparative

Original
Product



Counterfeit
Product



CASE STUDY 1:

Seizure of infringing personal care products

- Destruction: Following COLGATE's expert opinion, the Judge considered that the infringement was proven and ordered the destruction (February 2021).

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CASE STUDY 1: Seizure of infringing personal care products

- Sustainable destruction techniques were applied, which allowed the recycling of most of the waste .

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CASE STUDY 2:

Seizure of infringing video game consoles

- Customs officials at Carrasco Airport stopped suspicious merchandise from China .

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CASE STUDY 2:

Seizure of infringing video game consoles

- Merchandise: video game consoles "SUP GAME BOX" containing an ordered list of more than 400 video games (among them : MARIO BROS, PIKACHU, etc .)



Original product



Infringing product

CASE STUDY 2:

Seizure of infringing video game consoles

Infringements:

- Trademark: adulteration of the registered trademark "GAME BOY" owned by NINTENDO OF AMERICA INC, and unauthorized use of "SUPREME" trademark owned by CHAPTER 4 CORP.DBA SUPREME (Art. 81 of the Trademark Law).

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GAME BOY

Word Mark: " " " "

Holder: NINTENDO OF AMERICA INC.

Registration No: 515.038

Classes: 9 y 28

SUPREME

Supreme

Word and device: " " " "

Holder: CHAPTER 4 CORP.DBA
SUPREME.

Registration No.: 499.869

Classes: 9, 28 y 35

CASE STUDY 2:

Seizure of infringing video game consoles

Infringements:

- Copyright: unlawful reproduction of the logo "SUPREME BOX LOGO" registered by CHAPTER 4 CORP.DBA SUPREME and video games of NINTENDO OF AMERICA INC protected by copyright (Art. 44 of the Copyright Law).

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CERTIFICADO

Registro Público del Derecho de Autor

Para los efectos de los artículos 162 y demás relativos de la Ley Federal del Derecho de Autor, y del artículo 67 de su Reglamento, se hace constar que la **ANOTACIÓN MARGINAL** cuyas especificaciones aparecen a continuación, ha quedado asentada en el Registro Público del Derecho de Autor, con los siguientes datos:

Solicitada por: JEBBIA JAMES
Consistente en: SEÑALAR AL TITULAR DE LOS DERECHOS PATRIMONIALES DE LA OBRA, EN VIRTUD DEL RECONOCIMIENTO DE COLABORACION REMUNERADA DE FECHA ONCE DE MARZO DEL AÑO DOS MIL VEINTE, SIGNADA POR JAMES JEBBIA, PARA QUEDAR COMO SE INDICA A CONTINUACION LA INSCRIPCION:

TITULAR: CHAPTER 4 CORP. DOING BUSSINES AS SUPREME (CON FUNDAMENTO EN EL ARTICULO 83 DE LA L.F.D.A.)

Inscripción Modificada:
Trámite: REGISTRO DE OBRA
Título: SUPREME BOX LOGO
Número de Registro: 03-2020-031812403000-01
Fecha de Registro: 24 de marzo de 2020

Con fundamento en los artículos 2, 206, 209 fracción III y 211 de la Ley Federal del Derecho de Autor; artículos 64, 103 fracción IV y 104 del Reglamento de la Ley Federal del Derecho de Autor; artículos 1, 3 fracción I, 4, 8 fracción I y 9 del Reglamento Interior del Instituto Nacional del Derecho de Autor, se expide el presente certificado.

Número de Anotación Marginal: 03-2021-111713570100-05

El presente certificado forma parte del registro 03-2020-031812403000-01.
Lo anterior para los efectos legales a que haya lugar.

Ciudad de México, a 15 de diciembre de 2021
EL DIRECTOR DEL REGISTRO PÚBLICO DEL DERECHO DE AUTOR

JESUS PARETS GOMEZ
SECRETARIA DE CULTURA
INSTITUTO NACIONAL DEL DERECHO DE AUTOR
DIRECCIÓN DE REGISTRO PÚBLICO DEL DERECHO DE AUTOR

CULTURA | INDAUTOR



Copyright registered in

CERTIFICATE OF REGISTRATION
FORM PA
UNITED STATES COPYRIGHT OFFICE
REGISTRATION NUMBER
PA 178-079
EFFECTIVE DATE OF REGISTRATION
7 19 83
YEAR MONTH DAY

DO NOT WRITE ABOVE THIS LINE. IF YOU NEED MORE SPACE, USE A SEPARATE CONTINUATION SHEET.

1
TITLE OF THIS WORK
MARIO BROS.
PREVIOUS OR ALTERNATIVE TITLES
None
NATURE OF THIS WORK
Coin-operated video game including audio-visual display fixed in semiconductor circuitry

2
a
NAME OF AUTHOR
Nintendo Co., Ltd.
DATES OF BIRTH AND DEATH
Year Born Year Died
Was this contribution to the work a "work made for hire"?
Yes No
AUTHOR'S NATIONALITY OR DOMICILE
Name or Country
Citizen of Japan
Disincorporated in Japan
WAS THIS AUTHOR'S CONTRIBUTION TO THE WORK
Anonymous? Yes No
Pseudonymous? Yes No
If the answer to either of these questions is "Yes," see detailed instructions.

NOTE
NATURE OF AUTHORSHIP
audio-visual work
Briefly describe nature of the material created by this author in which copyright is claimed.

b
NAME OF AUTHOR
DATES OF BIRTH AND DEATH
Year Born Year Died
Was this contribution to the work a "work made for hire"?
Yes No
AUTHOR'S NATIONALITY OR DOMICILE
Name or Country
Citizen of Japan
Disincorporated in Japan
WAS THIS AUTHOR'S CONTRIBUTION TO THE WORK
Anonymous? Yes No
Pseudonymous? Yes No
If the answer to either of these questions is "Yes," see detailed instructions.

c
NAME OF AUTHOR
DATES OF BIRTH AND DEATH
Year Born Year Died
Was this contribution to the work a "work made for hire"?
Yes No
AUTHOR'S NATIONALITY OR DOMICILE
Name or Country
Citizen of Japan
Disincorporated in Japan
WAS THIS AUTHOR'S CONTRIBUTION TO THE WORK
Anonymous? Yes No
Pseudonymous? Yes No
If the answer to either of these questions is "Yes," see detailed instructions.

3
YEAR IN WHICH CREATION OF THIS WORK WAS COMPLETED
1983
DATE AND NATION OF FIRST PUBLICATION OF THIS PARTICULAR WORK
Only if the work has been published. N/A U.S.A.
1983
COPYRIGHT CLAIMANT(S)
Name and address must be given even if the claimant is the same as the author given in space 2.
Nintendo of America Inc.
4820 150th Avenue NE
Redmond, WA 98052
TRANSFER
If the claimant(s) named here in space 4 are different from the author(s) named in space 2, give a brief statement of how the claimant(s) obtained ownership of the copyright.
By assignment
REMITTANCE NUMBER AND DATE
70851
U.B. SPECIAL
DO NOT WRITE HERE

Copyright registered in

CASE STUDY 2:

Seizure of infringing video game consoles

- Actions: criminal complaint for infringement of intellectual and industrial property rights of NINTENDO OF AMERICA INC and CHAPTER 4 CORP.DBA SUPREME in order to seize the merchandise and obtain the destruction thereof .
- Destruction : pending .

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SUSTAINABLE DESTRUCTION

- Destruction of products in infingement following technical expertise .
- SCORE GREEN project : creation of basketball backboards using as raw material the waste generated from the destruction of counterfeit plastic products .

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Here is the link to play the video: <https://www.youtube.com/watch?v=jofG8zYhWmg>

FIRST DONATION



SECOND DONATION



THIRD DONATION



SUPPORT:

BVLGARI



COLGATE-PALMOLIVE COMPANY

CHANEL

crocs™

EPSON®
EXCEED YOUR VISION

HORUS


LACOSTE



TAGHeuer



COLABORATE:

**El Rey
del En
treteni
miento**

SPALDING



Thank you!



Dr. Virginia Cervieri
vcervieri@cm lawyers.com .uy