

Monday, February 8, 2010

Equine Law Update: Protecting Intellectual Property in the Equine World

By Susan Stone Rosenfield

Overview

Intellectual property is most simply defined as property that one cannot build a physical fence around. This type of property is often defined as a product of the mind which has commercial or other value. Examples of this type of property include literary or artistic works such as books, songs and software, as well as names, brands, symbols, trademarks and inventions.

Trade Names, Trademarks and Logos

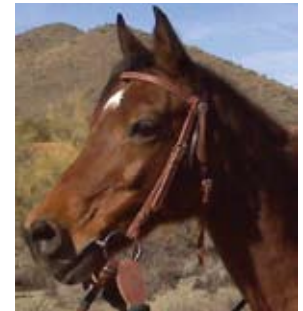
One can easily appreciate the value in a good name. Without a doubt, a person, company or facility's name is connected with the underlying reputation of that person, company or facility. For example, a name or trademark that is associated with high quality horses and breeding, training, farms and ranches, equine products or other equine-related services is a valuable asset that should be protected in order to maintain and grow that value. Similarly, logos (which may be used with or without a name), are also symbols of the quality of horses, training, breeding, farms and ranches, equine products, and other services offered.

With proper steps, one can both enhance the value of one's names and logos, and also provide protection against harm resulting in confusion and/or weakening caused by other parties using the same or similar names or logos. Such steps may include obtaining state and/or federal registrations for one's names and logos, and using proper notification to the public, including to your competitors, of your rights in such names and logos. In addition, prior to choosing a new name or logo, it is advisable to conduct research to make certain that such name or logo will not conflict with the rights of others.

Promotional and Website Considerations

All promotional materials, including websites, brochures, business cards, letterhead, advertisements in periodicals, banners and other signage at events should reflect your name, and wherever possible, should contain appropriate notices of ownership of trademark and copyright. Further steps to protect your name and trademark rights include taking action as soon as possible when you become aware of another person or facility using the same or confusingly similar name or logo. However, prior to communicating with another party that you believe it infringing your rights, it is highly advisable to consult an attorney knowledgeable in this area to avoid adverse consequences.

Hiring others to assist you with in marketing projects such as designing and/or operating your website and in designing and preparing other marketing material, as well as with facility designs, needs to be done in such a way as to maintain your rights. For example, a mistake commonly made when engaging another party to



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produce logos, websites, architectural plans for stables and other structures is failing to have a written agreement that provides which party actually owns what is being produced. It is not correct to assume that because you paid for it, you own it. Therefore, it is highly advisable that you enter into a contract with any third party you engage to provide services that might include intellectual property. That contract should contain appropriate terms so that any intellectual property created as a result of the services will be assigned to and owned by you.

You should take care in displaying materials on your website such as photos, drawings and articles that you have not completely originally created or for which you have not obtained express written permission to use in the way you are using it. For example, a photo that appears in a magazine is typically subject to copyright ownership rights by the photographer and/or the publisher of the magazine, which would preclude you from posting it on your website or reproducing it or using it in any other way. If you display a photo of another's product and there is a trademark on that product, you could potentially be held liable for trademark infringement. Links on your websites to other websites can also subject you to liability, in some cases, due to the appearance of a false association between the owners of the two websites.

Another consideration with respect to websites is to be certain that you have an adequate "terms of use" policy to which the user of the website must agree. Particularly with respect to interactive websites, it is critical to require users to review and then click on a button to confirm that the user agrees to the terms of use. Failure to require this could subject the website owner to liability to the user or to third parties. In addition, collecting information provided by users of the website, including, but not limited to, credit card information, requires that you obtain, store and use this information in accordance with applicable law.

Livestock Branding

Many horse owners choose to brand their horses and cattle as a clear means to identify the livestock should they be lost or stolen. Most states have specific laws regarding the choice and registration of brands. For example, the state of Arizona requires that your brand be registered, and once registered the brand must be re-registered every five years. A new brand must meet certain requirements, including that it not be similar to another brand in use in Mexico or in any of the states bordering Arizona (California, Nevada, New Mexico, Utah). When selling a brand, it is important that your sale agreement convey the registration, the physical branding devices, and all other rights in the brand. In Arizona and in many other states, once the brand is transferred, the transfer must be filed with the appropriate state agency. Because the transfer does not extend the expiration period, you must keep track of this and renew at the appropriate time. You should be familiar with and follow your state's applicable law.

Patents

Yet another form of intellectual property that may arise in the equine industry involves inventions, which may be protectable by patent, if the invention is novel (new) and unobvious. For example, devices such as muck rakes, feeding bin holders, tractor accessories, dietary supplements, bits, saddle pads, chemical compositions for repelling flies, a new way of attaching a lead line to a halter, grooming tools, etc. may be patentable if they meet certain criteria. Patents provide a legal means to exclude others from making, using or selling the invention claimed in a patent. However, owning a patent does not necessarily give the owner the right to make use or sell what has been invented, because there may be other patents that would be infringed by practicing your invention. A further consideration with respect to patent protection is that in the U.S., in order to obtain patent protection, an application for patent must be filed no later than one year after the invention is publicly used or displayed, sold, offered for sale or described in a written publication. Most foreign countries, however, do not provide this one year grace period; therefore if patent protection outside of the U.S. is desired, it is important to file a patent application as soon as possible after the invention is conceived.

Summary

The above information is just a thumbnail sketch of the intellectual property issues that might affect anyone in the equine industry or any horse owner. This Article is not intended to provide or replace legal advice. If Fennemore Craig can be of assistance in this area, please contact Susan Rosenfield at srosenfield@fclaw.com; or go to our firm website at www.fclaw.com/equine-law.

Susan Stone Rosenfield is a registered patent attorney and is of counsel with Fennemore Craig. Her practice focuses on all aspects of intellectual property, including the adoption, defense, and enforcement of copyright, patent, trademark and trade secret rights. Her practice involves the management of intellectual property portfolios, due diligence investigations and intellectual property audits. Her experience in patent preparation and prosecution of both U.S. and international patent applications is the foundation for counseling clients on patent acquisition, licensing, due diligence review, infringement and validity analysis and litigation. She earned her B.S., Biology (1988) from Virginia Polytechnic Institute and State University and her J.D. (1992) from George Mason University.

Sharon J. Oscar is the firm's Equine Law Practice Group Chair. She handles a variety of equine-related contracts, including training and management contracts, releases and indemnities, horse show-related contracts and consultation, the sale and leasing of horses, breeding agreements, litigation support, and the sale, acquisition and leasing of horse properties. She manages the Practice Group, assisting the clients in determining which Fennemore Craig attorneys can best represent the clients' interests, whether in entity formation, immigration, litigation, syndications, tax counseling, employment, or creditors rights and bankruptcy, among other areas. Sharon is also a State Bar of Arizona Certified Real Estate Specialist. Sharon earned her B.A. (1972) from The University of Arizona and her J.D. (1975) from Ohio Northern University College of Law.



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