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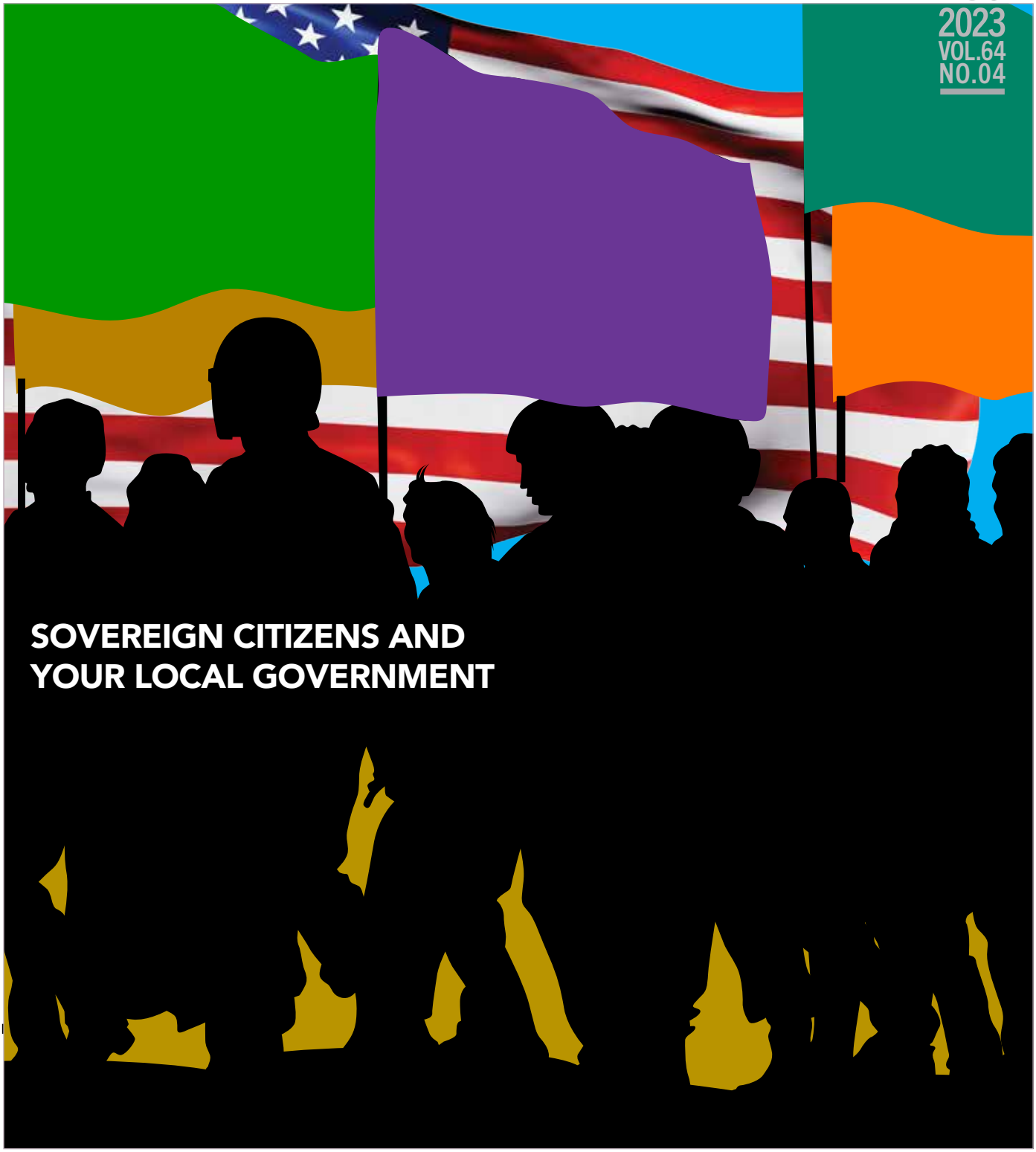

SOVEREIGN CITIZENS AND YOUR LOCAL GOVERNMENT

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SOVEREIGN CITIZENS AND YOUR LOCAL GOVERNMENT

By: Judith El Masri, Executive Vice President, The Randle Law Office, Houston, Texas

As Americans debate the merits of liberal or conservative policies, the proper functioning of legislative, executive, and judicial branches, and the appropriate balancing of state versus federal authority, another faction disavows the very legitimacy of any government. Ignoring authority and challenging laws at every turn, the sovereign citizen presents unique challenges for local government attorneys.

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PRACTICE TIPS

By: CYRIL VIDERGAR,
Assistant City Attorney,
City of Fort Collins, Colorado

Local Government Branding: Protecting Your Municipality's Goodwill

Creating a unique brand for a municipality involves investment. This is as true for original scholarly works produced by employees on the job as it is for creative logos and marks which a city may design in-house or derive by hiring an artist. These original works of art and identity can have value far beyond community pride. They are not merely part of the public domain and represent intellectual property a municipality can choose to federally register and protect, even if state laws do not extend a similar protectable property interest for public entities.

Two forms of federally recognized intellectual property rights automatically attach to these original works: copyright and trademark (or "service mark" in most municipal contexts). Each applies to a different subject matter and offers a different scope of protection.

Copyright protects the unique expression of an artist and controls how the work is reproduced, i.e. the right to "copy" it (this right also extends to performance of musical and theatrical works); Trade and service marks instead are consumer focused, providing assurance to a purchaser that a product bearing a mark is as anticipated in quality and from a certain source, i.e. what a mark represents.

Under federal law, copyright attaches as soon as a work is created, provided it is original and "fixed in a tangible medium of expression, " e.g., physical items like sheet music, paintings, and written words, or intangible items like software machine code. Basic federal rights do not require registration with the U.S. Copyright Office. So long as you use the copyright notice (© and the year of publication and owner's name), the work is "protected" under the Copyright Act of 1976 (U.S. Code Title 17) and only the copyright owner may authorize reproduction or performance.

Federal registration nevertheless makes it easier for a municipality to prove ownership, as well as providing the "teeth" to enforce ownership rights, including the right to file an infringement case in federal court, and claim damages and attorney's fees in a lawsuit.

If a city retains an outside artist or contractor, e.g., marketing firm, to create a logo, design a website, or create another work, the contractor owns the copyright, unless the service contract indicates the art was a "work for hire" or the contractor agrees in writing to transfer the copyright. If a city does not hold these copyrights, it needs the third party's permission to change the creation, including getting permission and/or paying royalties to use art on updated brochures, posters, and new merchandise.

Trademarks and service marks also confer immediate intellectual property rights as soon as a city begins using them to indicate the source of products or services. Trademarks never exist on their own, however; they are always tied to specific goods or services. Initial use nevertheless starts building the market or "trade" recognition needed to eventually achieve federal trademark protection.

Using the "TM" or "SM" symbol with products or services, respectively, lets citizens and other communities know your city is claiming a mark to identify its civic brand and activities. The "registered" symbol ® however, can only be used after federal registration.

• Goods are products you sell or

transport across state lines and bear your mark.
- Services are activities you provide for others, using your mark in advertising or carrying out those activities.

Like basic copyright protection, even though federal registration is not required to use a trademark, it provides key benefits, including the following:

- Legal presumption of ownership;
- Right to stop others from using it; and
- Right to sue in federal court to protect it.

Registering a mark requires a detailed application, evidence of use or intent to use in commerce, and thorough examination of the application by a U.S. Patent and Trademark Office (USPTO) examining attorney. The USPTO may refuse registration if a proposed mark is merely descriptive or confusingly like a previously applied-for or registered mark.

When a mark only describes goods or services, it is not identifying the source or brand of the item; it is merely describing something about the item, e.g., a quality, characteristic or main ingredient. Similarly, the USPTO will refuse to register a mark that is the generic name for the goods or services. This often occurs with municipal marks that consist mainly of the city's name, which is considered merely a "geographic descriptor."

As such, under The Trademark Act (Lanham Act, 15 U.S.C. § 1125, adopted in 1946) not all elements of a mark – whether graphical or word form – can be protected individually. While this may lessen what is referred to as "the bundle of sticks" or property interests a city may exercise, it also prevents a mark owner from prohibiting anyone's use of the city's name or a common term of language, which would inhibit communication.

To increase the likelihood the USPTO will accept a city's mark for registration, it needs to avoid confusing similarity in appearance, sound, or meaning to other marks. Marks can be confusingly similar without being identical, e.g., if visually similar or have a similar meaning, e.g., translations of foreign words. Confusingly similar marks don't necessarily need to be used with identical goods or services; the goods or services just have to be related. Fortunately, there are "use classes" for government services (035, 041, and 045) that make it easier to properly distinguish and categorize a municipality's marks for federal registration.

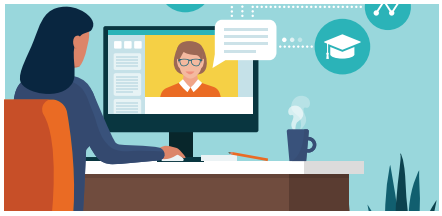
Choosing a mark that uniquely and with fanciful terms or graphics points to your city as the source of your goods and services, distinguishing them from neighboring community's goods or services, will increase the likelihood your city's mark will be eligible for registration and federal protection either as art or a "composite" of art and words.

All that said, municipal copyrights and trademarks can be federally registered and are worth protecting. Many municipalities even hold multiple registered works and marks. The principal purpose and value of these registrations is to control the commercial use and apparent "source" of information and materials bearing the city's name or logo. Residents and consumers are then assured that materials or vehicles bearing the city's logo are "official" and represent the quality and integrity for which the city stands.

- More information about the copyright registration process with the U.S Copyright Office can be found at: https://www.copyright.gov/
- More information about trade and service mark eligibility and registration can be found at: https://www.uspto.gov/trademarks/ **ML**



Cyril Vidergar is an Assistant City Attorney for Fort Collins, Colorado. He primarily focuses on regulatory and transactional work with the city's broadband and electric utilities, technology and capital project procurement, telecommunication right of way permitting, and utility customer billing and data privacy issues. Prior to joining the city, he practiced as a private attorney in Longmont, Colorado, representing statutory towns in land use, utility, and oil/gas regulations, and litigation and appeals, as well as counseling private clients in intellectual property, regulatory compliance, technology transfer, and start-up funding transactions.



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