



## Edwin Komen

Partner

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### PRACTICE AREAS

- Entertainment, Media and Technology
- Intellectual Property

### INDUSTRIES

- Entertainment, Media and Technology
- Fashion, Apparel and Beauty
- Food and Beverage
- Video Game

### OVERVIEW

Mr. Komen is a partner in the Entertainment, Media & Communications and Intellectual Property Practice Groups in the firm's Washington, D.C. office splitting his time in the Century City office. His global practice includes all aspects of copyright, trademark and unfair competition law, with a particular emphasis on motion picture, media, advertising and technology companies. He practices extensively before the United States Patent and Trademark Office and the United States Copyright Office.

### Areas of Practice

Mr. Komen maintains a full spectrum copyright and trademark practice with extensive background knowledge of the rules and regulations governing practice and procedure before the the United States Copyright Office and United States Patent and Trademark Office including the Trademark Trial and Appeal Board.

### EDUCATION

- J.D., George Washington Law School, 1976
- B.A., Cinema, University of Southern California, 1971, *cum laude*, *Phi Beta Kappa*

### ADMISSIONS

- District of Columbia Bar
- California

### EXPERIENCE

Mr. Komen deals with transactional, contested and rights clearance issues on behalf of motion picture companies and other entertainment and media clients. Producers of motion pictures and television programs need to secure rights in underlying properties requiring a search of the registration and recorded document records at the Copyright Office, a review of production file documents and an analysis in light of copyright law both in the United States and in other countries of the world. As such, Mr. Komen is familiar with all aspects of the Copyright Act of 1976, its predecessor the Copyright Act of 1909 and all earlier United States Copyright Acts. Mr. Komen is also generally familiar with the Copyright Acts of many major foreign countries as they affect rights clearance issues.

Mr. Komen has also studied and written numerous opinion letters on the various international copyright treaties and how they interact with the various domestic copyright laws. These treaties include, among others, the Berne Convention of 1886 (and its various revisions including the Paris Act of 1971), the Universal Copyright Convention of 1952 (and

as revised at Paris in 1971) and the General Agreement on Tariffs and Trade (the "GATT") which includes the Trade Related Aspects of Intellectual Property Law (the "TRIPs"). Mr. Komen has also reviewed the various bilateral copyright relations between the United States and many other foreign countries especially as they may supplement, expand on or otherwise modify the obligations of the various countries under the multilateral copyright treaties.

In addition to work with motion picture and television producers, Mr. Komen represents clients from all fields of the intellectual property industry such as advertising, interactive software, online services, live theatrical productions, music publishing, record labels, architecture, photography, sculptural works, toys, apparel, textiles, carpets, industrial tools and products, automotive products, and virtually any other product or service whose value substantially depends on copyright or trademark protection.

Mr. Komen advises principally on transactional issues surrounding copyrights, trademarks and related matters encompassing the right of publicity, right of privacy, defamation and domain name registration. He also negotiates and drafts agreements on behalf of media and entertainment clients. Mr. Komen often assists in preparing, prosecuting and securing copyright registrations.

Mr. Komen represents and assists companies and individuals in securing, perfecting and marketing their copyright, trademarks and service marks both domestically and worldwide for use in all media and on all goods and services -- beginning with a clearance search for availability of a trademark through issuance of a registration certificate. By working with a skilled staff of paralegals and associates, Mr. Komen maintains reasonable rates by making certain that trademark applications are properly researched, prepared and filed so that prosecution will flow as seamlessly and as efficiently as possible through the administrative process of review and approval before the USPTO. Where the Trademark Examiner declines to register or the application is opposed by someone with a contrary interest, Mr. Komen has represented his clients before the Trademark Trial and Appeal Board, the administrative tribunal within the USPTO which decides issues relating to trademark registrability.

Mr. Komen often assists as co-counsel in complex intellectual property cases before the federal district and appellate courts. He is both an advisor and active participant -- developing legal theories on copyright, trademark and related issues, preparing for oral argument and drafting briefs and other court papers. Mr. Komen has also appeared as an expert witness on both copyright matters and technical film issues based on his experience as both a legal and film professional.

Mr. Komen studied film at USC and subsequently served as a Peace Corps volunteer on the island of Yap, Micronesia and was a professional film editor.

He currently sits on the Advisory Counsel for the Film School at Montana State University in Bozeman.

**HONORS**

- Young Lawyer of the Year, 1982

**MEMBERSHIPS**

- Member, American Bar Association
- Member, Bar Association of the District of Columbia

- Member, Previous Chair, Copyright Office Affairs Committee 303 of the ABA
- Previous Chair, Treasurer, Secretary, Council Member, Copyright Committee of the Patent, Trademark and Copyright Section, Bar Association of the District of Columbia
- Previous Chair, Young Lawyers Section, Publications Committee, Bar Association of D.C.
- Member, Previous Trustee, Copyright Society of the USA
- Member of Board of Editors for the Journal of the Copyright Society.

## ARTICLES

- "Limitations On Copyright Protection For Format Ideas In Reality Television Programming", 2009 *MEDIA LAW RESOURCE CENTER BULLETIN*, Issue No. 4, at 97-121, December 2009
- The Dirty Dozen - Part 2, *Daily Journal*, September 29, 2009
- The Dirty Dozen - Part 1, *Daily Journal*, September 22, 2009
- The Digital Countdown, *Copyright World*, February 2009
- First in Line, Registration before Litigation, *Copyright World Issue*, February 2008
- Beware the US Deposit Requirement, *Copyright World*, September 2007
- Adding Onto eBay, April 23, 2007
- The Top 10 Ways Copyright Law Can Ruin Your Transaction, February 28, 2007
- Orphan Works - U.S. Developments, November 1, 2006
- Into the Honey Trap?, August 31, 2006

Mr. Komen has written on a variety of copyright and related topics including copyright concepts for the general practitioner, copyright legislation, colorization and the U.S. adherence to the Berne Convention. Mr. Komen is a frequent contributor to, and on the Editorial Board of, the periodical *Copyright World*. He has written the U.S. Anti-Piracy section of the *Fact Book* published by the American Film Marketing Association, a trade association representing independent film producers beginning with the 1995 edition and continuing through the most recent 1997 revision. Additionally, he currently sits on the Editorial Board of the *Journal of the Copyright Society of the U.S.A.*

- "In copyright cases, too much splitting can lead to no standing," *The National Law Journal*, August 15, 2011
- "Beware the US Deposit Requirement," *Copyright World*, September 2007 (co-authored with M. Clanton)
- "Copyright Infringement and the Internet," *IP Value*, 2004, published by Globe White Pate Ltd, London, UK, 2004 (co-authored with Anthony V. Lupo, Elizabeth H. Cohen and Latresa McLawhorn)
- "No More "CARPIng" at the Copyright Office," *Patent, Trademark and Copyright Law Section, Bar Association of the District of Columbia Newsletter*, Spring 2004.
- "Leftovers from the Holidays" (examines how 2002 copyright issues will continue to affect IP issues in 2003), *Copyright World*, March 2003.
- "Caveat Plaintiff: Risks of Reconstructing Copyright Deposits" - case note on Coles v. Wonders, 62 USPQ 2d 1217 (9th Cir. 2002), *Copyright World*, May 2002.
- "The Copyright is in the Mail" - A special report on the Copyright Office's mail delivery problems, *Copyright World*, March 2002.
- "Statutory Damages: Are They Still Available?," *Copyright World*, March 2002.
- "U.S. Formalities Still Raise Problems," *Copyright World*, June/July 2000.

- "Are States Immune from Copyright Suits? The Story Continues...", *Copyright World*, May 1999.
- "A Constitutional Riddle: Are States Immune from Copyright Suits?," *Copyright World*, September 1998.
- "Supreme Court Immunizes States from Patent and Copyright Actions," *PTC Section News*, Spring/Summer 1996.
- "GATT Restoration: 30-Day Defense," *Copyright World*, June/July 1995.
- "U.S. Copyright Restoration Under GATT: The Return of the Vampire Copyrights," *Copyright World*, February 1995.
- "The Kiss of Death ...Or Life: A Detailed Look at the Ways in Which GATT Changes Copyright," *Small Press: The Magazine of Independent Publishing*, Summer 1995.
- *Texas Lawyer*, May 15, 1995 (author interviewed for general article on GATT).
- *Copyrights 1996*: Report on what to look for in copyrights in the coming year, PTC Section Newsletter, Bar Association D.C., Fall 1995.
- "NAFTA'S Copyright Magic Show: Retroactive Protection for Film Does A Disappearing Act," *Copyright World*, February 1994.
- "Blue Ribbon Panel Issues Report on Copyright Registration Incentives," *Copyright World*, November 1993. This article generally reported on the Library of Congress' working group known as the ACCORD which was assigned the task of reviewing and commenting on proposed legislative reform of the Copyright Office and on copyright registration incentives.)
- "Copyright Renewals in the United States: Putting a New Face on Old Formalities," *Copyright World*, February 1993.
- "AFMA Fact Book for the Americas: United States of America: Anti-Piracy Measures," 1997 Edition. (The author wrote and revised this section of the American Film Marketing Association Handbook on Business and Legal Practices for independent filmmakers in the United States since 1995.)
- "GATT Changes in U.S. Copyright Law," *PTC Section News, Bar Association of D.C.*, Winter 1995.

### Intellectual Property Law Blog Articles

- "Sublicenses By Exclusive Licensees Of Copyrights - Copyright "Clarification" May Change The Law," August 16, 2010
- "Copyrights: First Amendment Trumps Copyright Restoration", April 16, 2009
- "Hot News Meets DMCA", March 6, 2009
- "Open Source Licensing Finds Protection Before The CAFC", November 14, 2008
- "First Sale Doctrine Not Applicable To Foreign Imports Manufactured And First Sold Abroad", November 14, 2008
- "The National Geographic Gets The Picture", August 11, 2008
- "Meshworks, Inc. V. Toyota Motor Sales U.S.A.: Good News and Bad News for Creators of New Media Works", July 7, 2008
- "The Copyright Office Makes An Improvement For The Worse", April 17, 2008
- "First In Line: Registration before Litigation", March 12, 2008
- "Adding Onto eBay", May 23, 2007
- "Orphan Works - U.S. Developments", November 30, 2006
- "POOH'F!: There Goes the Termination Right", September 21, 2006

**Law of the Level Blog Articles**

- "Branded: Product Placement and Video Games", June 19, 2009
- "The Digital Countdown", May 25, 2009

**SPEECHES**

- Mr. Komen has spoken on a variety of copyright and related topics including copyright concepts for the general practitioner, copyright legislation, colorization and the U.S. adherence to the Berne Convention. Mr. Komen recently spoke during Fashion Week, September 2011, in New York, on the Fashion Design bill currently pending before Congress.
- He has also made presentations to a variety of Bar and professional associations, including the American Bar Association, the Canadian Literary and Artistic Association, the United States Trademark Association (now the International Trademark Association), the Virginia Bar, the Canadian Bar Association, the American Film Marketing Association, the American Intellectual Property Law Association and the Cannes Film Festival as well as lectured on film law at Montana State University's Department of Media and Theatre Arts where he sits on the Department's Advisory Council. One of the most recent speaking engagements included an update on copyright law, that Mr. Komen presented at the IPO 2006 Annual Meeting.