



→ Edwin Komen

Of Counsel

2099 Pennsylvania Avenue, N.W.
Suite 100
Washington, DC 20006-6801

T: +1.202.747.1908

F: +1.202.747.3831

ekomen@sheppardmullin.com

Edwin Komen is of counsel in the Entertainment, Technology and Advertising and the Intellectual Property Practice Groups. He is based in the firm's Washington, D.C. office and shares time with the Century City and New York City offices.

Areas of Practice

Edwin's global practice includes all aspects of copyright, trademark and unfair competition law as well as personality rights under the laws of publicity, privacy and defamation with a particular emphasis on motion picture, media, advertising and technology companies—encompassing counseling and negotiations on both transactional and contested matters. He practices extensively before the U.S. Copyright Office and the U.S. Patent and Trademark Office.

Edwin maintains a full spectrum worldwide copyright and trademark practice with extensive background knowledge of the rules and regulations governing practice and procedure before the U.S. Copyright Office and the U.S. Patent and Trademark Office, including the Trademark Trial and Appeal Board.

Honors

Intellectual Property, *Legal 500*, 2015

Top Rated Lawyer, Martindale-Hubbell, 2012-2014

Experience

Edwin 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 U.S. and in other countries of the world. As such, Edwin is familiar with all aspects of the Copyright Act of 1976, its predecessor the Copyright Act of 1909 and all earlier U.S. Copyright Acts. He is also familiar with the Copyright Acts of foreign countries.

Edwin 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 (GATT), which includes the Trade Related Aspects of Intellectual Property Law (TRIPs). He has also reviewed the

various bilateral copyright relations between the U.S. 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, Edwin 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.

Edwin 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, and he often assists in preparing, prosecuting and securing copyright registrations.

Edwin 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, he makes 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, Edwin has represented his clients before the Trademark Trial and Appeal Board, the administrative tribunal within the USPTO which decides issues relating to trademark registrability.

Edwin also handles contested matters and often assists as co-counsel in complex intellectual property cases before the federal district and appellate courts, developing legal theories on copyright, trademark and related issues, preparing for oral argument and drafting briefs and other court papers. He 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.

Edwin is especially proud of his contribution to the panel of private attorneys that assisted the Register of Copyrights in preparing and reviewing the Compendium of Copyright Office Practices, III Edition that the Copyright Office released for comment on August 2014.

Edwin 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.

Articles

- Are Formats The Floor Mats Of Copyright?
Law360, 07.10.2012
- Limitations On Copyright Protection For Format Ideas In Reality Television Programming
2009 MEDIA LAW RESOURCE CENTER BULLETIN, Issue No. 4, at 97-121, 12.2009
- The Dirty Dozen - Part 2
Chain-of-title issues that may arise in the acquisition of rights for the production or development of a motion picture, video game or work dependent upon rights in copyright.
Daily Journal, 09.29.2009

- The Dirty Dozen - Part 1
Chain-of-title issues that may arise in the acquisition of rights for the production or development of a motion picture, video game or work dependent upon rights in copyright.
Daily Journal, 09.22.2009
- The Digital Countdown
Copyright World, 02.2009
- First in Line, Registration before Litigation
Copyright World Issue, 02.2008
- Beware the US Deposit Requirement
Copyright World, 09.2007
- Adding Onto eBay
With 4th Circuit decision, new uncertainty about injunctions extends to copyright cases.
04.23.2007
- The Top 10 Ways Copyright Law Can Ruin Your Transaction
02.28.2007
- Orphan Works - U.S. Developments
11.01.2006
- Into the Honey Trap?
08.31.2006

Edwin 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. He previously wrote the "U.S. Anti-Piracy" section of the *Fact Book* published by the American Film Marketing Association from the 1995 version through the 1997 revision. Edwin 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
- Co-author with M. Clanton, "Beware the US Deposit Requirement," *Copyright World*, September 2007
- Co-author with A.V. Lupo, E.H. Cohen and L. McLawhorn, "Copyright Infringement and the Internet," *IP Value*, 2004, published by Globe White Pate Ltd, London, UK, 2004
- "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 Suites?" *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 (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
- "United States of America: Anti-Piracy Measures" section, *AFMA Fact Book for the Americas*, 1997 Edition (author wrote and revised this section of the American Film Marketing Association Handbook on Business and Legal Practices for independent filmmakers in the U.S. since 1995)
- "GATT Changes in U.S. Copyright Law," *PTC Section News, Bar Association of D.C.*, Winter 1995

Entertainment Law Blog Posts

- "Trademark Modernization Act Strengthens Rights of Brand Owners," February 22, 2021

Intellectual Property Law Blog Posts

- "Protecting Semiconductor Chip Design under the Semiconductor Chip Protection Act of 1984 (SCPA) – Part II (Infringement and Defense)," January 11, 2023
- "Protecting Semiconductor Chip Design under the Semiconductor Chip Protection Act of 1984 (SCPA) – Part I (Registration and Inspection)," January 11, 2023
- "Trademark Modernization Act Strengthens Rights of Trademark Owners," February 2, 2021
- "Italian Film Composer "Scores" for Authors," August 29, 2019
- "Supreme Court Holds that a Copyright Claimant May Commence an Infringement Suit Only After the Copyright Office Registers the Copyright," March 7, 2019
- "Florida Now Follows New York to Find No Common Law Public Performance Right For Pre-1972 Sound Recordings," October 27, 2017
- "The Southern District of New York Finds "Work Made For Hire" Under Italian Copyright Law," October 23, 2017

- "Eleventh Circuit Joins Split Court Decisions on Registration Precondition for Copyright Suits," June 5, 2017
- "New York Court of Appeals Says No Common Law Public Performance Right For Pre-1972 Sound Recordings," January 3, 2017
- "First Amendment SLAPPs Publicity Right Plaintiff in "Hurt Locker" Case," February 23, 2016
- "Laches, Statutes of Limitations and Raging Bull: The Supreme Court Re-Emphasizes The Pitfalls Of Delay In Copyright Cases," July 7, 2014
- "Intent To Use – It's Not The Thought That Counts," April 10, 2014
- "DOMA goes down - Copyright goes up - U.S. v. Windsor, Supreme Court, No. 12-307, decided June 26, 2013," June 26, 2013
- "BONDing WITH NPE's - The requirement for security for costs or expenses under Section 1030 of the California Code of Civil Procedure," March 29, 2013
- "Thin Copyrights - Protected But Not Infringed," January 24, 2013
- "FCC's New Closed Captioning Rules Kick Into Gear," September 12, 2012
- "A Copyright Office Double-Header," June 27, 2012
- "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'FI: There Goes the Termination Right," September 21, 2006

FCC Law Blog Posts

- "The DMCA: Seeking Safe Harbor in a Sea of Troubles," March 31, 2014

Video Game Law Blog Posts

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

Books

International Comparative Legal Guide to: Copyright 2017: Chapter 1
10.2016

The International Comparative Legal Guide to: Copyright 2016 (2nd ed.): Chapter 30- U.S.A.
12.2015

Media Mentions

Law360's 2018 Media & Entertainment Editorial Advisory Board
Law360, 03.23.2018

Attys React To High Court's Copyright Attys' Fees Ruling
Law360, 06.17.2016

Speaking Engagements

Edwin 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.

Edwin spoke on a Fashion Week law panel during a symposium sponsored by The George Washington University Law School in Washington, D.C. on February 12, 2013. In addition, he spoke at the Mid-South Intellectual Property Institute Conference on Termination Rights Under Sections 203, 304(c) and 204(d) of the Copyright Act at the University of Mississippi in Oxford, Mississippi, on February 22, 2013. During New York Fashion Week in September 2011, he spoke on the Fashion Design bill currently pending before Congress. Edwin also presented at the March 2012 New York Fashion Week.

Edwin has also made presentations to a variety of bar and professional associations, including the American Bar Association, the Canadian Literary and Artistic Association, the U.S. 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.

Memberships

Member, American Bar Association

Member, Bar Association of the District of Columbia

Member, Copyright Office Affairs Committee 303, American Bar Association

Former Chair, Copyright Office Affairs Committee 303, American Bar Association

Member, *Law360* Editorial Advisory Board

Former Chair, Treasurer, Secretary, Council Member, Copyright Committee of the Patent, Trademark and Copyright Section, Bar Association of the District of Columbia

Former Chair, Young Lawyers Section, Publications Committee, Bar Association of D.C.

Member, Copyright Society of the USA

Previous Trustee, Copyright Society of the USA

Member, Board of Editors, *Journal of the Copyright Society*

Practices

Entertainment, Technology and Advertising

Intellectual Property

Copyrights

False Advertising, Lanham Act and Unfair Competition

IP Licensing, Technology and Commercial Transactions

Trade Secrets

Trademark Applications and Prosecution

Trademarks and Trade Dress

Industries

Entertainment, Technology and Advertising

Esports & Games

Food and Beverage

Music

Nonprofit

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

California