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Campus Conversations: Legal Matters

**Hot Topics in US Intellectual Property Law for
Institutions of Higher Education**

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Copyright Law Update

Fourth Estate Public Benefit Corp. v. Wall-Street.com:

Case pending before the US Supreme Court regarding whether a copyright registration must be granted (or refused) before a copyright owner can sue for infringement.

Copyright Law Update

Copyright basics:

- Copyright law protects works of authorship including books, manuals, brochures, art, music, software, etc.
- Copyright arises automatically when the work is fixed in a tangible medium (digital, written, recorded, etc.)
- Copyright protects the artistic expression, not ideas.

Copyright Law Update

Registration is not required, but in the U.S. offers important benefits:

- **Registration (or refusal) is a prerequisite to suing for infringement.**
- **If registration occurs before infringement or within 3 months after “publication,” eligible for statutory damages, attorney’s fees and costs.**
- **Record rights with U.S. Customs and Border Protection to block infringing imports.**
- **Prima facie evidence of validity if registered within 5 years of “publication.”**

Copyright Law Update

Issue before the Supreme Court

- Is a pending copyright application enough, or does plaintiff need an actual copyright registration, when suing for infringement?
- Circuit Courts of Appeal are split: Fifth and Ninth Circuits say an application is enough; Tenth and Eleventh Circuits say No. Others undecided.
- Oral argument January 8, 2019.

Copyright Law Update

Takeaway lessons:

- Review what valuable works of authorship may warrant the cost/hassle of registration.
- Try to register not later than 3 months after first “publication.”
- If bringing an infringement lawsuit, consider paying \$800 extra to fast-track the registration.
- Many copyright infringement battles are now resolved by takedown notices, which don’t require a copyright registration.

Copyright Law Update

Digital Millennium Copyright Act:

Liability safe harbor for online service providers who may otherwise be liable for infringing materials posted by users.

17 U.S.C. 512(c)

Copyright Law Update

DMCA safe harbor from copyright infringement liability for online service provider if it:

- **Designates an agent to receive notifications of claimed copyright infringement**
- **Makes the agent contact information available on its website**
- **Register the agent with the Copyright Office**
- **Promptly act on takedown notices**
- **Take appropriate action against repeat infringers**

Copyright Law Update

DMCA takeaway lessons:

- Register a DMCA agent at Copyright.gov
- Check registration to make sure up-to-date
- Calendar the renewal
- Make sure takedown notices are handled correctly

Many colleges and universities have registered a DMCA agent, including Harvard, Yale, Buffalo State, and Niagara County Community College.

Trademark Law Update

Domain name pirates are registering *.com* domain names as soon as a trademark application is filed with the US Patent & Trademark Office.

Trademark Law Update

- **Trademark law protects brand names (college name, marketing slogan, team name) and logo designs.**
- **In most countries, registration is critical.**
- **In the US, registration with the US Patent & Trademark Office is not mandatory but provides important benefits.**

Trademark Law Update

- Domain name registration through a company like GoDaddy.com is typically fast and cheap. Fighting a domain name pirate is expensive and takes time.
- Pirates watch the new trademark filings (e.g. Podunk University Rocks) and immediately file .com domain name (PodunkUniversityRocks.com)
- **Takeaway lesson:** consider .com domain registration before filing trademark application

Trademark Law Update

- Canadian trademark amendments effective June 17, 2019
- Major changes in application and renewal processes
- **Takeaway lesson:** If you offer goods/services in Canada, consider filing a broad trademark application before June.

Trademark Law Update

Trademark piracy in China continues to be a headache for many US trademark owners. Takeaway lessons:

- **Search and register brands in China if you have a campus/office there or have goods manufactured, exported, or sold in China.**
- **Register before trade show or initial meetings. Early registration is critical.**

Trade Secrets Law Update

Defend Trade Secrets Act:

In order to obtain maximum damages in suing an “employee” for misappropriation of trade secrets, an organization needs to include the DTSA boilerplate clause in employee and independent contractor agreements. 18 U.S.C. 1833.

Takeaway lesson: Use DTSA boilerplate clause in employment agreements, employee handbooks, etc.

Trade Secrets Law Update

DTSA Boilerplate: “An individual shall not be held criminally or civilly liable under any Federal or State trade secret law for the disclosure of a trade secret that (A) is made (i) in confidence to a Federal, State, or local government official, either directly or indirectly, or to an attorney; and (ii) solely for the purpose of reporting or investigating a suspected violation of law; or (B) is made in a complaint or other document filed in a lawsuit or other proceeding, if such filing is made under seal.

An individual who files a lawsuit for retaliation by an employer for reporting a suspected violation of law may disclose the employer's trade secret to the attorney of the individual and use the trade secret information in the court proceeding if the individual (A) files any document containing the trade secret under seal; and (B) does not disclose the trade secret, except pursuant to court order.”

Patent Law Update

Inventorship issues: Suggestions on how to work with private companies and be a more attractive business partner.

- **Sidestepping inventorship issues - deciding ownership of IP early.**
- **Accolade vs. legal right.**

Patent Law Update

Streamlining the patent process:

- **Company growth vs. monetizing university IP.**
- **Can you do both?**

Patent Law Update

3D printing:

- **What makes something patentable?**
- **Copyright issues with 3D print files.**

Patent Law Update

Recent patent trends:

- **On-Sale Bar – better to just file first**
- **Public disclosure - publication vs. patent filings?**
- **Patent assignment musts – “will and hereby do”**
- **Software patents – they are still alive and well!**
- **Blockchain – the new 3D printing**
- **Artificial Intelligence – the new new 3D printing**

E-sports IP issues

Explosion of e-sports activities in higher ed. E-sports majors, clubs, teams, and arenas.

The number of post-secondary institutions offering esports scholarships has grown almost five times in the past year.

The business and legal issues are still evolving.

E-sports IP issues

Some colleges and universities are filing e-sports trademark applications. Examples:

- **University of Akron has filed applications for the AKRON ESPORTS Logo for clothing and e-sports events.**
- **Harrisburg University has filed an application for STORM for its e-sports events and an application for HUE FESTIVAL for its e-sports festival.**

E-sports IP issues

- **Player typically needs a license from the game publisher to play the game.**
- **Tournament host may need to enter into a tournament license/contract or comply with tournament rules and guidelines (e.g. Rocket League guidelines).**



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