Insights: Alerts

Key Takeaways: IP 101 for Non-IP Counsel

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Kilpatrick Townsend Partner **Allisen Pawlenty-Altman** and Associate **Kate Gaudry Ph.D.** recently participated in an interactive panel — "Technology and IP Forum: IP 101 for Non-IP Counsel" — presented by the National Capital Region Chapter of the Association of Corporate Counsel in Washington, D.C. The discussion, which also included panelists Tim Jezek from EchoStar and David Beck from Viavi Solutions, provided an overview of common IP issues arising from everyday business transactions, including what occurs when your company decides to acquire another company that owns patent, copyright or trademark rights to how to identify and protect patentable ideas, products or subject matter.

Patents

- Watch out for public disclosures which limit or prevent potential patent protection.
- Consider all types of patent protection (i.e. utility versus design, fast-track versus provisional slow-track).
- Evaluate scope, status and any challenges when considering potential licenses or acquisitions.

Trademarks

- Eliminating risky names early on can save money and avoid headaches down the road.
- In the US, parties develop trademark rights through use. Registration is helpful, and confers additional benefits like a legal presumption of the validity and ownership of the mark, but not required to claim trademark rights. Registration is not required to sue someone in court, as trademark plaintiffs can claim unregistered "common law" rights, though most trademark plaintiffs also assert federal trademark applications or registrations.

Copyright

- Copyright protection exists from the moment of creation. Registration is helpful, and confers additional benefits like a legal presumption of the validity and ownership of the copyright (if registration is made within five years of publication), but not required to claim copyright rights. Unlike with trademarks, however, you must register your copyright before you can sue someone in court.
- Always get an assignment if you are relying on a vendor or contractor to create copyright-protectable material.

Domains

- Avoid "squatters" by registering domain names before new product or business names are announced.
- Domain name ownership is NOT the same as trademark ownership. Don't rely solely on a domain name to establish trademark or brand rights.

Trade Secrets

- Trade secret rights last as long as they are protected.
- Make sure there are processes in place to keep trade secrets secret.

Overall

- Be sure that contracts are clear as to what IP is owned by the company.
- Define and distribute procedures identifying how each type of IP is protected.