Intellectual Property Law

Author(s): Michael R. Patrick

Source: *GPSolo*, MARCH/APRIL 2013, Vol. 30, No. 2, NICHE PRACTICES (MARCH/APRIL 2013), pp. 16-19

Published by: American Bar Association

Stable URL: https://www.jstor.org/stable/23630797

JSTOR is a not-for-profit service that helps scholars, researchers, and students discover, use, and build upon a wide range of content in a trusted digital archive. We use information technology and tools to increase productivity and facilitate new forms of scholarship. For more information about JSTOR, please contact support@jstor.org.

Your use of the JSTOR archive indicates your acceptance of the Terms & Conditions of Use, available at https://about.jstor.org/terms

American Bar Association is collaborating with JSTOR to digitize, preserve and extend access to *GPSolo*

JSTOR

This content downloaded from
149.10.125.20 on Sat, 05 Feb 2022 15:47:52 UTC
All use subject to https://about.jstor.org/terms

Masterfile

This content downloaded from
149.10.125.20 on Sat, 05 Feb 2022 15:47:52 UTC
All use subject to https://about.jstor.org/terms

Intellectual Property Law

By Michael R. Patrick

Intellectual property has traditionally been considered a niche or boutique practice area, but intellectual property has undergone so much growth in scope and complexity over the past several decades that the terms "niche" and "boutique" seem inappropriately limiting. In the day-to-day practice, lawyers in this field may prosecute several trademark applications, file an action seeking a preliminary injunction, join forces with law enforcement to crack down on counterfeit merchandise and prosecute counterfeiters, or interact with clients and other counsel to negotiate any number of agreements and transactions. The breadth of the practice often feels more "general" than "niche." Nevertheless, it is an invigorating practice area that permits an attorney not only to obtain expertise in a multifaceted area of the law, but also to interact with a broad set of areas and challenges that are more often associated with general practice.

DEVELOPING, MAINTAINING, AND PROTECTING INTELLECTUAL PROPERTY RIGHTS

One of the most stimulating aspects of an intellectual property practice is the opportunity to interact with a broad array of clients who are seeking to breathe life into a new concept or product, take their concept or product from initial stages of research and development to full-scale production and distribution, or protect their concept or product from infringing competitors or nefarious counterfeiters. Just as clients come in all different shapes, sizes, and budgets, they also come at vastly different stages of conceptualization, development, production, and commercialization. Some clients come with little more than a wish and a dream or the bare bones of a product or concept written on paper (I have seen napkins, too), while others come with developed prototypes and comprehensive marketing plans, and they may already be well into various stages of financing and capitalization. Regardless of where on the spectrum our clients stand, our role is to understand their goals and objectives and advise them on appropriate, cost-effective approaches tailored to fit their specific situation.

We recommend that a client retain an intellectual property attorney at the earliest possible stage. Unfortunately, a number of clients wait, not realizing that their actions—or inaction—can forever affect the validity or even the value of intellectual property rights they are able to obtain. Hiring an intellectual property attorney at the earliest possible stage helps ensure that all possible intellectual property rights associated with a product or concept are protected and appropriate decisions are made that will not adversely affect these rights.

In initial meetings with a client concerning a particular product or concept, it is crucial to understand not only the concept or product but also the client's objectives, goals, finances, and resources. The overall strategy depends on understanding the interplay of these elements. For example, we must determine the necessity and feasibility of securing intellectual property protection domestically, internationally, or both. The question of whether to obtain protection in particular countries, not just the United States, involves a variety of factors, including where the product is manufactured or service provided, where it will be distributed and sold or the service rendered, and whether it will be available in bricks-and-mortar retailers or online. All these factors must be considered in line with the client's budget for intellectual property acquisition and subsequent maintenance and protection.

In these initial phases, we examine all facets of potentially available intellectual property

This content downloaded from 149.10.125.20 on Sat, 05 Feb 2022 15:47:52 UTC
All use subject to https://about.jstor.org/terms

protection for the particular concept or product. This generally includes:

1. Identifying and clearing proposed trademarks and filing applications to register them before the U.S. Patent and Trademark Office (USPTO);
2. Identifying patentable elements and filing an application to obtain a patent before the USPTO;
3. Identifying elements potentially subject to copyright protection and filing applications for registration with the U.S. Copyright Office; and

A substantial portion of our day-to-day practice is devoted to combating infringers.

4. Identifying and taking steps to preserve and protect "trade secrets" and other confidential or proprietary information.

In addition, during the initial phases and as the concept or product moves forward, we help the client to identify potential revenue streams. One of the most crucial areas that an intellectual property owner should explore is licensing. Licensing is when the intellectual property owner grants another party the right to use the intellectual property in exchange for a fee (also known as a royalty). Without a license, the other party would be an infringer. The particular form of licensing employed will hinge on the property involved (e.g., software licensing or technology licensing or character licensing or sports licensing). Where the license involves a high-profile brand of characters, it is referred to as "merchandising," which includes licensing in the context of celebrities, entertainment, music, and sports. In the past several decades, the licensing industry has grown considerably. Part and parcel of our day-to-day practice is advising licensors and licensees on all aspects of the licensing relationship.

Once the property has been identified, we assist the client in beginning to develop and implement recommended strategies to protect and preserve the validity and value of the client's intellectual property rights. These strategies take many forms, but often include, at a minimum, vigilant monitoring of unauthorized uses of the client's intellectual property, enforcement actions such as litigation, and, in some cases, working with law enforcement to file criminal charges against counterfeiters.

INTELLECTUAL PROPERTY ENFORCEMENT AND LITIGATION

Intellectual property litigation generally involves the infringement of trademark, copyright, patent, or trade secrets rights, or the threat of infringement of these rights. Awareness of actual infringement or of the threat of infringement can occur in a remarkable number of different ways. For example, customers may notify a manufacturer of an infringing product, a company executive may see counterfeit products sold on street corners while strolling through a city, or an Internet search might reveal unauthorized uses of a trademark or the sale of counterfeit goods. A substantial portion of our day-to-day practice is devoted to developing and implementing strategies to effectively monitor, discover, and prosecute—either civilly or criminally—potential infringers.

When infringement or the threat of infringement is discovered, we develop a strategy to address the issue on a cost-efficient but effective basis. Part of the process is completion of an analysis of whether the infringement occurs internationally or in the United States. If internationally, the analysis includes consideration of the mechanisms that are available to redress the infringement or threat of infringement in the foreign country. Although certain circumstances sometimes warrant the immediate filing of an action in court, once potential infringers are identified, the next step is to put them on notice. This is traditionally accomplished through a "cease and desist" letter. "Cease and desist" letters, while still widely used as a means to initially contact a potential infringer, can be problematic because a potential infringer may choose to file a preemptive declaratory judgment action instead of responding to the letter. This can result in a substantial disadvantage to intellectual property owners if they either did not want to take the matter to litigation or if the potential infringer files the action in a forum that is not desirable to the property owner (e.g., a property owner in New York sends a cease and desist letter to a potential infringer in California, and the potential infringer files a declaratory judgment action in California).

With the proliferation of the Internet and global e-commerce, it has become increasingly difficult to positively identify infringers and counterfeiters and to take effective enforcement actions against them. The Internet makes it possible for counterfeiters and infringers to easily conceal their identities and evade detection and prosecution. This poses a substantial problem to intellectual property owners and attorneys. We have to spend a significant amount of time and devote considerable resources to investigate and identify online counterfeiters and infringers. However, even while investigating an objectionable situation and identifying the responsible party, it is possible to mitigate some of the attendant damages. For example, if the infringement involves copyright-protected material on the Internet, the Digital Millennium Copyright Act (DMCA), 17 U.S.C. § 512 sets forth a specific procedure to put Internet service providers on notice of the infringement and to require them to remove the material. With respect to domain names, the Uniform Dispute Resolution Policy

This content downloaded from 149.10.125.20 on Sat, 05 Feb 2022 15:47:52 UTC
All use subject to https://about.jstor.org/terms

(UDRP) allows domain name disputes to be arbitrated through an approved dispute resolution service provider at substantially less cost than a federal court action. Both alternatives are generally substantially less expensive than litigation and available even where the precise identity of the counterfeiter or infringer is not known or is concealed.

In circumstances where litigation is warranted, actions for counterfeiting and infringement are brought in federal court. In certain instances, proceedings can be brought before the USPTO's Trademark Trial and Appeal Board (TTAB), for example in the form of either an opposition proceeding (opposing the registration of a trademark) or a cancellation proceeding (seeking cancellation of an existing trademark registration). Intellectual property cases tend to be highly involved and present complex factual issues and legal scenarios. For example, in the context of cases involving trademark infringement, the case often hinges on a battle of experts and consumer surveys. The parties each submit competing expert testimony and consumer surveys conducted to measure the existence of (or lack of) likely confusion in the marketplace or public recognition of the trademark at issue. The experts and the quality of the surveys are significant—a poor survey is often the death knell for a case.

The discovery phase in intellectual property disputes, just as in other complex commercial litigations, is often extensive and protracted. Although it is true that cases will frequently settle during the discovery phase, settlement usually does not occur until after the parties have exchanged thousands of documents and conducted a number of depositions—in short, until each side has "sized up" the strength and/or weakness of the other's case.

Given the costs associated with civil litigation, we often explore other methods to resolve intellectual property disputes. Alternative dispute resolution (ADR) has become an increasingly popular method to resolve disputes. The general theory is that ADR can reduce the costs associated with an intellectual property dispute, particularly in the area of discovery. In our experience, ADR can be effective under certain circumstances—although it is not always less costly than litigation.

Coordinating criminal and civil actions has proven remarkably effective in our practice.

In some cases, prior to filing a civil action in court, particularly with respect to counterfeit goods, we work with law enforcement authorities and prosecutors to coordinate an investigation and criminal prosecution of individuals or entities engaged in the illegal conduct. We do this because relying on civil litigation alone is often not an effective strategy. Counterfeiters are likely "fly-by-night" operators that are ready to pick up their illegal operations and move on when you begin to close in on them. Additionally, they often are able to conceal the fruits of their illegal activities, making it difficult to enforce judgments against them. In our practice, the coordination of criminal and civil actions has been remarkably effective in reducing the impact and extent of counterfeit activities.

BREAKING INTO INTELLECTUAL PROPERTY

In view of the wide range of issues and areas addressed by an intellectual property attorney on any given day, it is imperative for attorneys seeking to enter the practice of intellectual property law to understand that establishing an understanding of the core principals and foundations of intellectual property law is important. The following is a list of topics, ideas, and resources to help you get started:

- Attend CLE courses and seminars on intellectual property law. There are a wide variety available.
- Explore the USPTO website (www.uspto.gov). The website contains a wealth of information and resources.
- Develop a relationship with intellectual property owners and understand their goals, objectives, and industries.
- Stay up-to-date with intellectual property laws and issues. My law firm maintains a blog at www.gandb.com/blog that features developments, tips, and pointers.
- Explore trade associations and other organizations related to intellectual property commercialization, protection, and enforcement. Some notable organizations are: Licensing Industry Merchandisers' Association, International Trademark Association, and American Intellectual Property Law Association.
- Cultivate a passion to help clients protect, develop, and preserve their intellectual property rights.

Intellectual property law is a rapidly changing practice area that is affected by laws and regulations promulgated by agencies in myriad jurisdictions around the world. If you want to practice in this field, it is immensely important to continually strive to keep pace with changes in the relevant rules, regulations, and laws. ■

Michael R. Patrick (patrick@gandb.com) is a partner with Grimes & Battersby, LLC (www.gandb.com), in Norwalk, Connecticut. His practice focuses primarily on intellectual property, entertainment, and litigation.

This content downloaded from 149.10.125.20 on Sat, 05 Feb 2022 15:47:52 UTC
All use subject to https://about.jstor.org/terms