



WESTCHESTER COUNTY BAR ASSOCIATION NEWSLETTER

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June 2011

President's Message

BY CAROL L. VAN SCOYOC, ESQ.



LAW DAY 2011: A TIME TO REFLECT AND CELEBRATE OUR LEGAL SYSTEM

I had the distinct honor and privilege for the first event of my term as president of the Westchester County Bar Association to participate in the Naturalization Hearing and Law Day Ceremony 2011 held on May 4th in the Central Jury Room of the Richard J. Daronco Westchester County Courthouse. The Hon. William J. Giacomo, Westchester County Supreme Court Judge, presided over the proceedings. It was truly an inspiration to see the beaming faces of the new citizens upon being administered the oath of allegiance by the Hon. Timothy C. Idoni, Westchester County Clerk, and welcomed by the Hon. William J. Giacomo. Deputy County Executive Kevin J. Plunkett presented the County's Law Day proclamation and read it into the Court record. John Marwell, Esq., Vice President of the New York State Bar Association, Ninth Judicial District, and Past President of the WCBA, and Dolores Scott Braithwaite, Esq., Commissioner of the Westchester County Human Rights Commission, both eloquently addressed the new citizens on their role as Americans and then the County Clerk presented each of the 120 new citizens a certificate of naturalization.

Law Day is a time for all of us not only to reflect upon the significance of the rule of law, and the role that it assumes in the fundamentals of our nation, but also to appreciate and celebrate its contributions to the freedoms Americans enjoy and at times, take for granted.

(continued on page 2)

The Importance of Having an Intellectual Property Strategy



BY YUVAL H. MARCUS, ESQ.

Increasingly, a company's most valuable assets are the brands, ideas and innovations that give it a competitive advantage. These intangible assets, which are known as intellectual property ("IP"), often account for more than 70% of a company's value. By utilizing certain legal tools, such as filing applications for trademarks, patents or copyrights, a company can both increase the likelihood that it will be able to stop a competitor from diverting business, and simultaneously increase company value. Many companies, however, do not have a plan in place to make sure that their IP assets are being adequately protected and utilized.

Indeed, some companies do not even know which IP protections they have in place. Without an IP strategy, a company is vulnerable to severe adverse consequences such as significant lost sales, a decrease in company value and the inability to stop copycats from infringing its IP rights. It is extremely important, therefore, that every company develop and implement an IP strategy.

As a first step in developing an IP strategy, an IP audit should be conducted. The IP auditor, usually an IP attorney, should review the company's short and long term business goals and survey the existing IP assets of the company. Taking both offensive and defensive considerations into account, an evaluation should be made as to whether the current IP protections in place are adequate or if modifications need to be made.

(continued on page 11)

INSIDE...

Exiting in Style	4	Members on the Move	12
Sections & Committees	6	Annual Banquet	14
High School Mock Trial	7	Staff Profile	16
SMJ & Accounting Proceedings	8	From the Back Bench	20
CLE Center	10	Classifieds	22

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IP Strategy

(continued from page 1)

The following are some of the most basic questions that should be addressed as part of a company's IP strategy:

DOES THE COMPANY HAVE THE RIGHT TO USE ITS COMPANY NAME OR DOMAIN NAME?

Many companies mistakenly assume that just because a corporate name or domain name is available for purchase, the company can use that name. This is not necessarily the case and very often companies do not find out about potential problems until they achieve significant success or expand into new markets and only then receive a demand letter.

DOES THE COMPANY HAVE THE RIGHT TO USE ITS BRAND NAMES FOR ITS PRODUCTS AND/OR SERVICES?

Any company that launches a new product or service without first conducting a trademark clearance search for the brand name risks the embarrassment and expense of having to change its brand name in the event that a third party has superior rights.

WHICH BRAND NAMES ARE OWNED BY THE COMPANY AND WHERE DOES THE COMPANY HAVE RIGHTS?

Trademark rights in the United States are created

through use of the brand name for a product or service in a particular geographic area. If a company obtains a trademark registration from the United States Patent and Trademark Office, its trademark rights extend throughout the United States even if the company is only using its brand(s) in New York State. Trademark rights in foreign countries must be established on a country by country basis.

DOES THE COMPANY OWN ITS LOGO(S) AND/OR ITS WEBSITE DESIGN?

Absent a written agreement confirming ownership by the company, the graphic artist the company retained or the website developer it engaged may own this valuable property.

DOES THE COMPANY HAVE THE RIGHT TO USE THE PHOTOGRAPHS, WRITTEN MATERIALS AND/OR MUSIC ON ITS WEBSITE OR IN ITS PROMOTIONAL MATERIALS?

If the content was not created by a company employee acting within the scope of his or her employment, licenses may be required to use this content.

DOES THE COMPANY HAVE WRITTEN POLICIES AND AGREEMENTS TO PRESERVE ITS CONFIDENTIAL INFORMATION?

Internal, non-public information such as customer lists, pricing information, manufacturing processes

(continued on page 17)

IP Strategy

(continued from page 11)

and marketing strategies can be protected as trade secrets provided that a company takes adequate steps to preserve the confidentiality of this information. Companies should have written policies to prevent the disclosure of confidential information, and have employees and independent contractors sign confidentiality agreements.

DOES THE COMPANY HAVE PROCEDURES IN PLACE TO IDENTIFY AND PROTECT ITS INVENTIONS?

The ability to use the patent laws to protect inventions and designs is lost in certain countries when an invention is disclosed or used publicly. In the United States, a patent application must be filed within one year of such public use or disclosure. Procedures should be implemented to identify those inventions that may be protected by patents and to ensure that patent applications are filed on a timely basis.

DOES THE COMPANY HAVE THE RIGHT TO MAKE, USE, SELL, OFFER TO SELL OR IMPORT ITS PRODUCTS?

Just because a product is available for purchase abroad, such as in China, does not necessarily mean that a company is free to import and sell that product in the United States. Many companies learn the hard way that it is important to obtain a *Freedom to Operate* opinion from patent counsel prior to launching new products to reduce the risk of being sued for patent

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infringement. This is particularly the case when introducing a product that competes with an existing product in the marketplace.

DOES THE COMPANY HAVE A PROCEDURE IN PLACE TO MAKE SURE THAT ITS PRODUCTS ARE PROPERLY MARKED WITH PATENT NUMBERS?


A patent owner that properly marks its products with issued patent numbers is eligible to recover monetary damages for infringing products sold prior to giving the infringer actual notice of the infringement. Conversely, a company that sells products that are marked with the patent numbers of expired or unrelated patents is subject to potential liability for “false marking.” Thus, it is extremely important to implement a company policy for patent marking.

These are just a few of the questions that should be asked when creating a company’s IP strategy.

Failure to address these items will often come to light when it is too late to correct, such as when dis-

(continued on page 19)

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IP Strategy

(continued from page 17)

covered in due diligence as part of an acquisition. As a result, the company may have to accept a lower valuation. Similarly, often the lack of a coherent IP strategy will force the company to make unwanted concessions in litigation. An experienced IP attorney can conduct an IP audit and help design and implement an appropriate IP strategy by identifying what can and should be protected and then utilizing the appropriate legal tools to protect these valuable IP assets.

Yuval H. Marcus (marcus@leasonellis.com) is a Partner at Leason Ellis, and specializes in litigating trademark, copyright and patent disputes. He is Co-Chair of the Intellectual Property, Computer and Telecommunications Law Committee of the Westchester County Bar Association.

Thank you to Robert Burstein (bobby.burstein@gmail.com) for his contributions to editing all the articles in this Newsletter. Robert graduated from Pace Law School in May 2011. He is the WCBA's intern.



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