

BRIEFS

CHIPS and Science Act of 2022 is Now Law... Now What?



Heidi S. Nebel

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The CHIPS and Science Act, recently signed by President Biden, is poised to revolutionize the technology transfer industry.

The Act includes a provision of \$3.1 Billion to support technology transfer and represents the first ever federal funding support for the commercialization of government supported research. Not since the Bayh Dole Act of 1980 has there been such groundbreaking legislation in the field of commercialization of science-driven innovation.

The Bayh Dole Act enables universities and non-profit research institutions to own, patent and commercialize inventions that are developed with federally funded research (which amounts

to around \$140 Billion a year). The passage of this bill gave birth to the technology transfer industry.

With vastly limited resources, universities have managed to be incredibly successful in transferring federally funded research into commercial products. The economic development from technology transfer boosts our economy, cures and provides new treatments for diseases, and allows us to compete with countries like China on a global scale.

In a joint report published earlier this year by BIO and AUTM, (Economic Contributions of University/ Nonprofit Inventions in the United States: 1996–2020), the impact of technology transfer on our economy was reported to be up to \$1.9 Trillion, including the creation of 6.4 million jobs. University based technology transfer resulted in the COVID vaccine, and has produced another 153 FDA approved vaccines. University based research has also given us CRISPR gene editing technology, healthier food products, as well as software and electronic engineering inventions that enable smart phones, computers, and space travel. All of this BEFORE the influx of \$3.1 Billion.

The CHIPS and Science Act will be administered by the NSF, and, if fully appropriated, allows any university or research institution to apply for, and receive, up to 1 million dollars a year in support for technology transfer for each of 3 years.

What does this mean?

More inventions developed, more patent applications filed, more commercial products created and brought to market, more jobs, more start-ups, more economic development, and more opportunity for us all.

Take for example, my home state of Iowa. According to the 2020 report from the Board of Regents, Iowa universities received over \$1.2 Billion in research investment in 2020. Of that, \$628 Million was from federal funding. Commercialization efforts of this research resulted in over 4500 jobs and \$4.63 Million in revenue for the state. What if each of the three universities had another million dollars to put towards these commercialization efforts in any given year?

That said, we would be wise to begin a plan for this economic boon. There will be a massive need for more technology transfer professionals, intellectual property professionals, researchers and STEM individuals in general. Those who plan now will be able to reap maximum benefit of this exciting new era for our country.

Copyright Law Tips for In-House Counsel



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Copyright law can be complex. Issues are usually fact specific, require significant interpretation and a case-by-case analysis. The answer to most copyright law related questions is some iteration of “it depends” but some simple education is often the best tool to avoiding issues and combatting copyright myths and misinformation.

1. Copyright Law Does Not Protect Ideas

Copyright law does not protect ideas, facts, concepts, systems, or methods of doing something. Copyright law protects original works of authorship fixed in a tangible medium of expression. Further, copyright law protects the specific expression of an idea.

For example, a copyright is not going to protect the general story idea or general plot of a book, marketing materials, or other work, rather, it protects the specific expression (plot, character traits, names, etc.) of the ideas expressed in those works.

PRACTICAL TIP: You are generally allowed to use or summarize ideas, articles, or topics without reproducing the original(s).

2. Do Not Assume Images or Other Works Posted Online are Free to Use

Assume that all images and creative works found through online searches are protected by copyright unless/until you can determine that is not the case. Copyright clearance can be time consuming and frustrating, however, even if you are unable to locate the owner of a copyrighted work, without receiving a license and/or written permission from the copyright owner, you run the risk of copyright infringement issues in the future.

PRACTICAL TIP: Only use a work (image, video, audio file) found through an online search once you've done your copyright research and determined it is not protected by copyright. You must receive permission to use a copyright-protected work, even if the owner is unlocatable or won't respond to your permission requests. Alternatively, there are plenty of companies online that provide low royalty or royalty free works for use.

3. Copyright Protection is Automatic

As mentioned previously, copyright protects original works of authorship, *fixed* in a tangible medium of expression. Thus, copyright protection attaches to a Work, the minute it is save, or *fixed* in a tangible form (e.g. written on paper, saved to a memory card or hard drive). Additionally, while the © symbol and other formalities were required in previous versions of copyright law, that is no longer the case. The Copyright Act of 1976 removed all formality requirements to copyright protection. While it is no longer required, including a copyright notice or copyright symbol on your documents/works serves as a valuable educational tool to prevent intentional, and unintentional, copying.

PRACTICAL TIP: Just because you do not see a © symbol does not mean a work is not protected by copyright.

4. Registration with the Copyright Office is not Mandatory

Registration with the Copyright Office is not mandatory but can provide certain benefits. Namely, registration provides a presumption of copyright validity and certain benefits when enforcing your copyright rights.

PRACTICAL TIP: Even if the work is not registered with the U.S. Copyright Office, unless it is original to you or your organization, you should generally still assume it is protected by copyright.

5. Licenses Expire

Most licenses have a defined Term and expire after a set amount time or other benchmark identified in the license agreement.

PRACTICAL TIP: Keep a database of all signed licenses and highlight important provisions including Term, royalties, and any relevant benchmarks.

6. Copyrights Can only be Transferred via a Signed Writing

Copyrights can be assigned or transferred at any time, however, for a copyright assignment to be valid it must be done via a signed writing. There are many copyright assignment templates and documents available online, which may be acceptable depending on your specific question. If you are not sure, it is a good idea to contact an attorney with expertise in copyright related transfers.

PRACTICAL TIP: Ensure all copyrights are documented via contract or other written agreement.

7. Works Made for Hire

One copyright myth we run into regularly is the assumption that if you or your organization hire a third party create a Work, you automatically own the copyright in that Work. If the author of the Work is an employee of your organization, and the work is created within the normal scope of that employee's job description, that assumption is likely accurate. However, if you engage a third party to develop artwork, a website, or any other creative work, unless that work falls within nine enumerated categories (which are much narrower than most people realize), copyright rights originally vest in the author of a work. Thus, in order for you or your organization to own those copyright rights, they must be transferred via a signed writing.



PRACTICAL TIP: Ensure that all service agreements and any agreements with third parties have works made for hire and copyright assignment language included in them.

8. Not All Copyrights are Equal

Copyright protects original works of authorship fixed in a tangible medium of expression. Thus, originality is a requirement for copyright protection. While the originality requirement is not a high bar, it does have two distinct parts that must be met: 1) the work must have “at least a modicum” of creativity, and 2) it must be the independent creation of its author. However, simply meeting this standard does not always provide the greatest protection under copyright law. Courts have developed the concepts of “thin” and “thick” copyright protection. Thin protection extends to works that involve minimal creativity, or are based on other works and public domain information, while thick protection extends to wholly original or highly creative works.

PRACTICAL TIP: Just meeting the bare minimum of originality does very little for your business, both from a copyright perspective and from a marketability standpoint. Ensure your organization is making efforts to make the work original and creative.

9. Fair Use is Considered on a Case-by-Case Analysis

Any unauthorized use of a work is considered copyright infringement. However, for a variety of reasons, some uses are considered a “fair use” under the Fair Use Doctrine. Fair use is an affirmative defense to copyright infringement and all fair use analysis’ use four fair use factors to make a judgement call.

The four fair use factors are:

- 1) The purpose and character of the use, including whether such use is of commercial nature or is for nonprofit educational purposes,
- 2) The nature of the copyrighted work,
- 3) The amount and substantiality of the portion used in relation to the copyrighted work as a whole, and
- 4) The effect of the use upon the potential market for, or value of, the copyrighted work.

While you can use a fair use argument to any alleged copyright infringement issues, the only way a “final” determination can be made is by a judge or jury.

PRACTICAL TIP: Both for-profit and non-profit organizations may apply fair use, but each situation requires its own analysis and judgement call based on specifics of the situation as applied to the four fair use factors. For additional information regarding fair use, please visit the following link: [“Copyright, Fair Use, and the Internet.”](#)

10. Understand Your Organization’s Risk Management

Copyright compliance = understanding your organization’s risk tolerance and making judgment calls.

Managing your copyright portfolio and compliance is really risk management. It is vital to understand your organization’s risk tolerance while making judgment calls for copyrighted works and uses.

PRACTICAL TIP: Learn how to apply the law to your situations while understanding and being aware of your organization’s risk tolerance.

PSA: Avoiding Patent-to-Market Scams



Gregory Lars Gunnerson

Intellectual Property Attorney

MVS has noticed an uptick in “Invention Promotion” scams lately. The United States Patent and Trademark Office (USPTO) puts out a brochure to warn inventors against these scams at <https://www.uspto.gov/sites/default/files/documents/ScamPrevent.pdf>. The Federal Trade Commission (FTC) warns against similar scams here: <https://consumer.ftc.gov/articles/invention-promotion-scams>.

The FTC in particular states Federal law gives you the right to get information about an invention, promotion, firm’s operations and clients before you sign a contract. The firm must give you information about the past five years, including: how many

inventions it evaluated, how many of those inventions got positive or negative evaluations, the total number of clients it served, how many of those clients ended up with a net profit after using the firm’s services, and how many of those clients licensed their inventions through the firm’s services.

You should always consult an attorney to determine the legitimacy of a potential business arrangement. However, know that in our experience, some common red flags we have noticed with recent scams are:

- You are an individual inventor or a small business, *i.e.*, an entity upon which these companies prey upon.
- You have never heard of the company prior to the company sending you a letter.
- In their letter, they conflate your pending patent application with an issued patent.
- The company states they are experts in nearly every field (*e.g.*, protecting your invention, manufacturing your invention, marketing your invention, improving your invention).
- They guarantee outlandish results for too low of a price.
- They make outlandish demands (*e.g.*, ownership of your patent, too high of a price) without proof of results.
- The company mails you only at the address you list in the public patent record and does not attempt to contact you in a more conventional way for conducting business, *e.g.*, a phone call, by visiting you at your place of business, etc.
- The company is not registered with the Secretary of State of a U.S. state despite listing a U.S. mailing address in their letter.
- The company lists physical mailing addresses on their website that are inconsistent with the address they put on the letter they mailed to you.
- The address and/or phone number listed in their letter or the address and/or phone number registered with the Secretary of State in the state in which the business is incorporated are associated with other phony, defunct, or irreputable businesses. Sometimes defunct business with the same address even have similar names with similar objectives.

- Despite finding you in the official patent record, they contact you directly, instead of the attorney of record.
- They tell you to distrust your attorney.
- The company's website has only been active for a short amount of time or has been completely reworked in recent times.
- The company mentions Shark Tank.

It is not uncommon that we get clients that insist on knowing which states we are registered to practice in, whether we are in good standing with the USPTO, whether we carry malpractice insurance, a complete expectation of costs for specific services and/or projects as a whole, etc., which we are happy to provide. If a company cannot provide you with these details or shields from you the name of the attorney who is representing you before the USPTO, the chances that the company is a scam increase exponentially!

If you have any questions on whether a particular opportunity is legitimate, whether the terms of a particular opportunity are fair, or any questions on any type of Intellectual Property, please be sure to reach out to the attorneys of McKee, Voorhees & Sease, PLC, as we serve our clients at the intersections of science and art with the law, to protect their innovations and creations on a worldwide basis.

The USPTO Expands Outreach Programs to Encourage Innovation Nationwide



Ashley Holland

Intellectual Property Attorney

On July 27th, the USPTO director Kathi Vidal announced new programs aimed at expanding participation in innovation. The Council for Inclusive Innovation has created 4 initiatives to expand the work the USPTO has already done. The new initiatives include: an innovation internship program, a first-time filer expedited examination petition, expansion of free legal services, and a community outreach campaign.

The Innovation Internship Program is aimed at teaching youth and students about the value of innovation and the protection of innovation through intellectual property rights. In addition, the USPTO is encouraging interested students to apply for their paid internships. The internships are geared toward being more inclusive in their candidates and encourage on-the-job training creating a pipeline of talent into the agency.

Director Vidal emphasized that the USPTO "receives approximately 40,000 patent applications" with at least one first-time filer. The First-Time Filer Expedited Examination Petition will require these

first-time micro entity filers to participate in a training program which gives additional support for filings as a prerequisite to participation in the initiative. The USPTO anticipates launching this program sometime this fall and will post a federal register notice when this happens.

Another new initiative announced is the expansion of pro bono services. Currently there are over 60 law schools that participate in the USPTO's Law School Clinic Certification Program. These clinics provide free patent and/or trademark legal services to inventors and small businesses. This year, the USPTO included four new schools to join the pro bono clinics: George Mason University, Case Western University, Wake Forest University, and Brigham Young University. Additionally, the USPTO provides pro bono work through the Patent Pro Bono Program. This program includes 21 regions across the country, which under this initiative will gain increased funding for expansion of their work. The director hopes to "support a wider swath of Americans" with this increased access to free patent and/or trademark legal services.

Finally, the USPTO will pilot a volunteer community outreach program utilizing the more than 9,000 patent examiners and trademark examining attorneys nationwide. These "intellectual property experts" will be encouraged to educate local communities on the importance of intellectual property, and help their communities to pursue invention, entrepreneurship, and creativity to propel innovation forward, which in turn will help foster new businesses and economic activity around the country.

With these new initiatives and areas of USPTO expansion, the Director hopes to encourage intellectual property innovation and outreach. More information about these programs will likely come in the next few months and perhaps more initiatives will stem from the Council for Inclusive Innovation.

Does the New Policy on Free Publication Access to Federally Funded Research Impact My IP Strategy?



Jonathan L. Kennedy

Partner Practicing
Intellectual Property Law
and Litigation

You may have read about the executive [decision](#) to ensure public access to publications and their supporting data when federally funded. This decision is being lauded by folks in the open science community and those who believe the expenditure of public tax dollars should provide publicly available information. On the other side are those concerned this may erode the financial stability of academic journals. Regardless of the arguments for or against this policy, the question arises as to how this impacts patent filing considerations.

This policy expands on a 2013 [policy](#), which required public access to federally funded research. That policy provided for

an optional one year embargo before publications and the supporting data are made publicly available. The Office of Science and Technology Policy states that over 3 million people read the free articles every day. The new policy removes the one year embargo requiring that “all peer-reviewed scholarly publications authored or co-authored by individuals or institutions resulting from federally funded research are made freely available and publicly accessible by default in agency-designated repositories without any embargo delay after publication.” This new policy is to be implemented by December 31, 2024.

With the immediate access to publications, the question arises as to how this may affect IP filing strategy. In short, it is the same as before. The best practice is to file a patent application before your journal article is submitted for review at minimum before publication (or public access). Many journals are now making drafts available during the review and editing process in an effort for transparency and open science, thus the recommendation is to file before submission. While the US provides a one year grace period where your own publication does not constitute prior art against you ([35 USC 102\(b\)\(1\)](#)), it can be a patent bar in foreign jurisdictions.

Plain and simple: whether a publication is publicly available or behind a paywall, it constitutes a publication that can potentially be used as prior art against your patent. Thus, we maintain the strong recommendation to file any patent applications before you submit your manuscript and most certainly before it is published (whether in draft stage or final copy).

Who Owns Your Name?



Nicholas Krob

Intellectual Property Attorney

Trademarks are designed to function as source identifiers. How do they work then for the most fundamental of source identification—our names?

At the most basic level, personal names are theoretically eligible for trademark protection if they are used in commerce and function to identify and distinguish the source of goods or services. Think, for instance, Michael Jordan/Nike’s famous “Jordan” brand. Things get more complicated, however, when questions of ownership come into play.

Section 2(a) of the Lanham Act bars registration of any trademark which may “falsely suggest a connection with persons, living or dead[.]” To this end, Section 2(c) of the Lanham Act states that trademarks consisting of or comprising “a name . . . identifying a particular living individual” shall be refused registration on the principal register unless consented to by such individual.

Notably, a “name” need not be an individual’s full name but can instead include “first names, surnames, shortened names, pseudonyms, stage names, titles, or nicknames” provided that the particular name “identifies a specific living individual who is publicly connected with the business in which the mark is used, or who is so well known that such a connection would be assumed.”

If a trademark includes a name that identifies a particular living person, the applicant must provide

the USPTO with both “(1) a statement that the name identifies a living individual whose consent is of record” and “(2) a written consent personally signed by the individual named or shown in the mark.” As the USPTO explains, the reasoning for this requirement “is to protect an individual’s rights of privacy and publicity to control the commercial use of his or her identity.”

Pretty simple, right? If someone wants to obtain a trademark registration bearing another person’s name, they need that person’s consent. If a person is seeking a trademark bearing their own name, they should be good to go. However, like many things in the law, it unfortunately isn’t always that simple. Just ask Luka Doncic.

Over the past year, the Dallas Mavericks star has applied for a variety of trademarks bearing his name. These include the marks “ORIGINAL HOOPS OF LUKA DONCIC” and “LUKA DONCIC” for use in connection with goods and services that include software, books, clothing, basketball hoops, beverages, candy, and charitable fundraising. Despite being filed on behalf of, and having the consent of, Luka Doncic, the USPTO has refused registration of each of these marks due to a pre-existing registration owned by...Doncic’s mother.

During his rookie season in 2018, Doncic provided his mother Mirjam Poterbin consent to file a trademark for a stylized “LUKA DONCIC 7” in connection with a variety of goods and services. He has since sought to negotiate a transfer of control of this registration and allegedly provided written notice to his mother in July 2021 revoking his consent. On September 6 of this year, Doncic (through his Luka99, Inc. company) filed a Petition to Cancel the “LUKA DONCIC 7” mark.

The Petition states that Doncic originally “relied upon his mother, Ms. Poterbin, to provide assistance and guidance for his off-court business opportunities” but that his “maturation . . . on and off the basketball court and his strong interest in pursuing philanthropic endeavors, along with the retention of a personal team of athletic and business professionals, has increased his own business acumen such that [his mother’s] assistance in [his] business affairs has become unnecessary.” As indicated in the Petition, Doncic is seeking to “consolidate his business interests and take control of his name and identity.”

Doncic states that he is not affiliated or associated with, and does not approve or sponsor, his mother or her goods and services and that, because the “LUKA DONCIC 7” mark “points uniquely and unmistakably to [Doncic],” his mother’s use of the mark falsely suggests a connection to Doncic in violation of Section 2(a) of the Lanham Act. Furthermore, Doncic asserts that while he provided written consent for the use and registration of his name as a trademark when he was 19, he has since “specifically and expressly revoked” the consent and has not consented to any future use or registration by his mother and that such use is thus improper under Section 2(c) of the Lanham Act.

It is unclear how this matter will play out, but Doncic will surely hope to be as successful in the courtroom as he has been on the court. After all, it’s his name at stake.



Where We'll Be

October 4 & 5, 2022

Luke T. Mohrhauser, Patent Attorney and Chair, MVS **Mechanical-Electrical Practice Group**, **Gregory Lars Gunnerson** and **Joseph M. Hallman**, Intellectual Property Attorneys, MVS **Mechanical-Electrical Practice Group**, and **Richard Marsolais**, Business Development Director will be attending the **ABI Legends in Manufacturing Awards Dinner** and the **Manufacturing Conference** in Ankeny, Iowa. The firm is also a sponsor of these events.

October 5, 2022

Luke T. Mohrhauser, Patent Attorney and Chair, MVS **Mechanical-Electrical Practice Group**, **Joseph M. Hallman**, Intellectual Property Attorney, MVS **Mechanical-Electrical Practice Group**, **Richard Marsolais**, Business Development Director, **Joann Tucker**, Director of Finance and Business Operations and other MVS attorneys will be attending the **Business Record Envision Iowa** Event in West Des Moines, Iowa. The firm is also a sponsor of this event.

October 7, 2022

Luke T. Mohrhauser, Patent Attorney and Chair, MVS **Mechanical-Electrical Practice Group**, and **Richard Marsolais**, Business Development Director will be attending the **Ames Chamber of Commerce Manufacturing Breakfast** in Ames, Iowa.

October 11, 2022

Cassie J. Edgar, Patent Attorney and Chair, MVS **Regulatory Law Practice Group** and Co-Chair, **Data Privacy and Cybersecurity Practice Group** and **Charles P. Romano, Ph.D.**, Senior Patent Agent, MVS **Biotechnology and Chemical Practice Group** will be attending the Fostering Innovation via Collaborative Partnerships featuring Wells Fargo Innovation Incubator (IN2) Companies program in St. Louis, Missouri.

October 11-13, 2022

Cassie J. Edgar, Patent Attorney and Chair, MVS **Regulatory Law Practice Group** and Co-Chair, **Data Privacy and Cybersecurity Practice Group** and **Charles P. Romano, Ph.D.**, Senior Patent Agent, MVS **Biotechnology and Chemical Practice Group** will be attending the **AgTech Next** Event in St. Louis, Missouri. The firm is also a sponsor of this event.

October 13, 2022

Jonathan L. Kennedy, Partner practicing in **Intellectual Property Law and Litigation** will be attending the **South Dakota School of Mines Innovation Expo** in Sioux Falls, South Dakota. The firm is also a sponsor of this event.

October 14, 2022

Luke T. Mohrhauser, Patent Attorney and Chair, MVS **Mechanical-Electrical Practice Group** and other MVS attorneys will be attending the **Ag Innovators Unconference** in Ames, Iowa.

October 18-20, 2022

Heidi S. Nebel, Managing Partner and Chair, MVS **Biotechnology and Chemical Practice Group**, **Cassie J. Edgar**, Patent Attorney and Chair, MVS **Regulatory Law Practice Group** and Co-Chair, **Data Privacy and Cybersecurity Practice Group**, **Melissa M. Mitchell**, Intellectual Property Attorney, MVS **Biotechnology and Chemical Practice Group** and **Brian D. Keppler, Ph.D.**, Patent Agent, MVS **Biotechnology and Chemical Practice Group** will be attending the **World Food Prize Norman E. Borlaug International Dialogue** in Des Moines, Iowa.

October 20, 2022

MVS Attorneys will be attending the Polk County Women Attorneys Seasons of Change Charity Basket Auction in Des Moines, Iowa. The firm is also a sponsor of the event.

October 21, 2022

MVS will be taking part in the **Mark S. Cady Day of Public Service** honoring the late Iowa Supreme Court Justice Mark S. Cady. The firm will be participating in a virtual food drive and in-person event through the Food Bank of Iowa.

October 27-29, 2022

Kirk M. Hartung, Patent Attorney in the MVS **Mechanical-Electrical Practice Group** and **Joseph M. Hallman**, Intellectual Property Attorney, MVS **Mechanical-Electrical Practice Group** will be attending the **Legus International Fall Meeting** in Sacramento, California.

November 3, 2022

MVS will be attending the Technology Association of Iowa Prometheus Awards in Des Moines, Iowa. **Heidi S. Nebel**, Managing Partner and Chair, MVS Biotechnology and Chemical Practice Group is a finalist for CEO of the Year.

November 4, 2022

MVS attorneys will be attending the 2022 IIPLA Conference in West Des Moines, Iowa.

November 11, 2022

MVS will be sponsoring and attending the NUtech Ventures' Innovator Celebration in Lincoln, Nebraska.

December 4-6, 2022

Kirk M. Hartung, Patent Attorney in the MVS Mechanical-Electrical Practice Group and **Jonathan L. Kennedy**, Partner practicing in Intellectual Property Law and Litigation will be attending the Marcus Evans IP Law Summit in Amelia Island, Florida.



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