



NEWSLETTER

Golf Outing, Take Two.



Above: John Grimes participates in the putting contest. Top right: Gail Boggio, Hon. Joan Lefkowitz, James Fine and Ray Farrelly. Below right: Hon. Linda Jamieson, John Frucco, Whit Wells and Michele Silva.

On Monday, September 15, the WCBA held its 49th Annual Golf Outing and Fundraiser. More than 150 members of the Bar and Judiciary enjoyed a day of golf and comraderie while raising some money for the Westchester County Bar Foundation (WCBF).

“Members of the Bar and Judiciary were able to hone their golf skills and enjoy a beautiful day together,” said WCBA Golf Committee Chairman Hon. George A. Sirignano, Jr. “We are especially pleased that we were able to raise money for our Bar Foundation. The WCBF is sponsoring a two-year public interest law fellowship, which is an amazing accomplishment for a bar association of our size.”

Stay tuned for exciting changes to next year’s event! With input from this year’s golfers, we have decided to make the 2009 Golf Outing a scramble format. This will allow us to diversify play as well as speed up the round as a whole.

Thanks to all our golfers, dinner attendees and sponsors for making this year’s event a success! ■

— For more photos and a complete list of winners, see pages 21-23.



INSIDE...

President’s Message5
Intellectual Property Law6
WCBA Seeks Nominations	10
CLE Center	12-13
Surrogate Court Mediation	15
Members on the Move	18
Classifieds	19

WCBA Past Presidents Dinner

We invite you to attend the Westchester County Bar Association’s 12th Annual Past Presidents Dinner on Thursday, November 20, 2008. The Honorable Peter P. Rosato will be our guest of honor.

Judge Rosato’s career as a jurist started in 1980 as a Judge on the Yonkers City Court. In 1983, he was elected Westchester County Court Judge. Judge Rosato was elected to the New York Supreme Court in 1988 and was then appointed to the position of



Hon. Peter P. Rosato

— Continued on page 4

Three Important Things That Every Attorney Should Know About Intellectual Property Law

BY YUVAL H. MARCUS, ESQ.



Your client's most valuable assets may be the knowledge, creative concepts, innovations and brands that give it a competitive advantage. These assets, which are known as "intellectual property," or "IP," often account for 70% or more of the average company's value. The most common ways to protect IP assets are through the use of trademarks, patents and copyrights. In general, trademarks protect brands, patents protect inventions and copyrights protect creative expression. There are three important things that every attorney should know about IP law:

1. TRADEMARKS

Just because a name is available for incorporation or for registration as a domain name does not mean that your client will not be sued if it uses that corporate or domain name.

The owner of a trademark or service mark has the right to

prevent others from using a word, name, phrase, symbol or design, or combination thereof, that is likely to cause confusion in the marketplace as to the source of a product or service. The trademark or service mark owner need not establish that the word, name, phrase, symbol or design used by a competitor is identical to its trademark or service mark, only that it is likely to cause confusion in the marketplace.

In general, trademarks protect brands, patents protect inventions and copyrights protect creative expression.

Problems can arise when a client who is starting or expanding a business forms a corporation or other legal entity and/or registers a domain name for the new business. The Secretary of State, for an entity, and the registrar, for a domain name, will permit the registration of a name that is not identical to a name

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previously registered. However, if the owner of a trademark or service mark can demonstrate that the newly registered, non-identical, corporate or domain name is likely to cause confusion in the marketplace, the trademark owner can obtain injunctive relief to prevent the use of that corporate or domain name. As a result, the fact that a corporate name or a domain name is available for registration does not necessarily mean that your client can use that name.

Practice Tip: Prior to incorporation of a business entity or the registration of a domain name, and prior to any use of a name, logo or slogan in connection with a business, it is important to conduct a thorough trademark search to determine whether there might be any conflict with prior users of the same or similar trademarks. Such a search should include prior federal trademark registrations and applications, trademark registrations in the 50 states (each state maintains its own register of trademarks and service marks), and unregistered “common law” uses, such as trade and telephone directories and domain names.

2. PATENTS

Patent rights in the United States are lost if your client does not file for patent protection within one year of the publication, public use or sale of the invention.

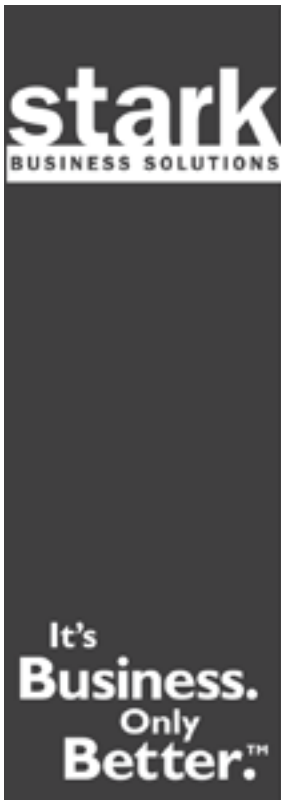
A patent owner has the right to exclude others, for a certain number of years, from making, using, selling, offering to sell or importing the invention claimed in the patent. Patents offer

your clients an extremely potent weapon against their competitors. There are, however, many ways to challenge the validity of a patent. For example, a patent that does not name all of the inventors who conceived of the invention covered by the patent may be invalidated on that basis. Similarly, if the invention that is the subject of the patent was publicly known or used by others prior to the filing of the patent application, a patent may be invalidated on this basis as well.

Further, if certain steps are not taken early on during the patenting process, even before a patent attorney is consulted, your clients may lose their ability to obtain patent protection or their patents may be vulnerable to attack. For example, if the inventor does not file a patent application within one year of the inventor’s publication, public use or sale of the invention, any ensuing patent application filed in the United States will be vulnerable to challenge. In certain other countries, there is no one year window and a patent application must be filed prior to the publication, public use or sale of the invention or patent rights are forfeited in that country.

Practice Tip: Any client that has conceived of an invention that might be protected by a patent should take every precaution to safeguard and maintain the confidentiality of the invention. For example, prior to the disclosure to any third party, the inventor should require such third party to sign a non-disclosure agreement. The inventor should file a patent application or a provisional patent application as soon as possible and certainly within

— continued on page 8.



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Intellectual Property

— continued from page 7.

one year of the publication, public use or sale of the invention if the United States is where protection is to be sought.

3. COPYRIGHTS

If your client hires someone else to create or redesign a logo, a website, photographs or written materials, and a written agreement does not expressly transfer copyright ownership to your client, your client will not own the copyrights in the works created.

A copyright owner can prevent third parties from copying certain “original works of authorship.” Many types of works are protected by the copyright laws, including: brochures, websites, logos, photographs and software.

Under the U.S. copyright laws, the general rule is that a person who creates a copyrightable work owns the copyright in that work unless there is an agreement to the contrary. One notable exception to this rule is that works created by employees within the scope of their employment are owned by the employer. If your client hires a non-employee to design a logo or create a brochure,

and the contract with the non-employee does not provide that the client owns the copyrights in the works created, even if that non-employee was paid in full and delivered the work to your client, your client does not own the copyrights in the works created.

Practice Tip: Before your clients enter into any agreements with third parties to create materials for the clients, such as a logo, brochure, or website, the contract with the non-employee should be reviewed to confirm that it provides that your clients own all copyrights in the works to be created. For works that already have been created without a contract specifying ownership by your clients, a written assignment of the rights to your clients should be obtained.

These are just three representative examples of IP issues that should be taken into consideration when advising your clients on business matters. ■

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