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Office of General Counsel

Minnesota State Intellectual Property Overview

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MINNESOTA STATE

Next Month's Presentation

October 12, 2023

Legal Update: Cannabis, Affirmative Action, and More

Presented by General Counsel Scott Goings and Assistant General Counsel Kevin Finnerty

For a complete listing of the Fall Second Thursday topics, please

visit the Office of General Counsel's website at

<https://minnstate.edu/system/ogc/index.html>

For more information email Amanda Bohnhoff at

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Intellectual Property Generally



What is “IP?”

- Intellectual Property is a set of rights protecting valuable products of the human intellect.
- Four Subcategories:
 - Trademarks
 - Copyrights
 - Patents
 - Trade Secrets

IP Policies and Agreements

- System IP Policy
 - <https://www.minnstate.edu/board/policy/326.html>
- System Copyright Policy
 - <https://www.minnstate.edu/board/policy/327.html>
- Copyright Clearance Procedure
 - <https://www.minnstate.edu/board/procedure/327p1.html>
- Patent Inquiry Procedure
 - <https://www.minnstate.edu/board/procedure/326p1.html>
- IFO/MSCF Collective Bargaining Agreements

Trademarks



What is a Trademark?

- A word, phrase, or logo used to distinguish a product/business/organization from others.
- Trademarks last for as long as the owner uses a trademark in commerce.
- Bundle of rights include the right to use mark(s) to identify goods and services, the right to license third parties to use the mark(s), the right to protect mark(s).
- Examples include:
 - College and University names
 - Official logos
 - Official seals
 - Athletic logos

Trademark Ownership

- Trademarks are owned by Minnesota State Colleges and Universities and its constituent campuses.
- Under the IP Policy, these are considered “institutional works.”
- Even if a trademark is developed by students or faculty, once a trademark is “used in commerce,” it is owned by Minnesota State.
 - Keep in mind that an image could be protected by copyright, and Minnesota State should clear copyrights before using an image as a trademark.



Trademark Registration

Generally

- Not every trademark requires registration. There are common law trademark rights that provide some protection.
- State registration is available but provides little added protection from the common law.
- However, federal registration gives certain additional rights:
 - Public notice to anyone searching for the trademark
 - Legal presumption of ownership
 - Right to file case in federal court to protect trademarks

What makes a Trademark “Trademarkable?”

- Actual use in commerce to identify a good or service.
- No risk of confusion with similar products or services.
- Distinctiveness or Secondary Meaning

How to Register Your Trademark

- Conduct a search to make sure no one else is using a similar mark/name to refer to the same good or service.
- Contact the Office of General Counsel to discuss what trademarks you would like to register.
- Provide examples of use in commerce (e.g. website links, pictures of merchandise, athletic field images).
- Provide date of first use, or first intended use, in commerce.
- Choose the “class” you would like to register the mark for (e.g. educational services, clothing, drinkware, etc.)
- Pay the fee of \$250 per class of goods/services.



Protecting Your Trademarks

- Make a business determination to devote resources to trademark protection after considering the possibility of infringement.
- Some campuses hire third parties to enforce trademark rights such as Collegiate Licensing Company.
- If you have belief someone is infringing on one of your trademarks and your campus does not have a third party enforcement contractor, contact the Office of General Counsel.
- Use ® for federally registered trademarks, ™ for other trademarks.



Trademark Licensing

- The business teams should carefully consider what trademarks to license and what products to license them for.
- Enter into contracts with licensed merchandise manufacturers.
 - Use pre-approved templates for income contracts and services contracts.
 - If there's a unique template or edits to pre-approved terms, OGC review is needed.

Copyrights



What is a Copyright?

- Property rights in an original work of authorship fixed on a permanent medium.
- Bundle of rights includes reproduction, creating derivative works, first distribution, public performance/display, actions against infringers.
- Examples:
 - Literary works (e.g. poems, novels, articles, some software)
 - Musical works (e.g. recordings, compositions)
 - Dramatic works (e.g. plays, musicals)
 - Pantomimes and choreographies
 - Pictorials, graphics, sculptures
 - Film and video
 - Sound recordings
 - Architectural blueprints

Copyright Ownership

- Minnesota State “works for hire” include contractor created works and works created by non-faculty employees. These works belong to Minnesota State. This does not apply to personal works.
- Faculty created copyrightable works belong to faculty authors unless there was “substantial use of Minnesota State resources” used in its creation. If that is the case, then rights are jointly held.
- Student copyrighted works belong to students.

What is Copyrightable?

- An original idea or concept affixed in a permanent format.
- “Original idea or concept” or “work of authorship” does not include generalized information (e.g. recipes), lists of facts, definitions, etc.
- It also does not include items in the “public domain” such as works created before January 1, 1928, most government public data, or software created using “open source” code.

Copyright Registration

- Copyright attaches immediately upon creation. No formal registration is required.
- Federal registration is unnecessary unless you plan on mass commercialization of a copyrighted work.
 - Federal Court enforcement
 - Easier to obtain injunction
 - Public notice of ownership
 - Statutory damages and attorney fees
- Copyrights have long timelines. A copyright on a newly created work lasts for the life of the author plus 70 years for the author's heirs/estate.

What is “Fair Use?”

- Limited ability to use copyrighted works without permission from the author.
- Includes teaching, criticism, commentary, reporting, scholarship, and research.
- Fair use is a defense to infringement. It is not a right, and a judge would ultimately determine if use of a work is “fair use” or not.
- If you have questions about whether your use of a work is fair use, contact OGC.

Can I use Copyrighted Materials in Class?

- A single copy can be made for the purposes of use in the classroom.
- Multiple copies may be used in some circumstances. Use must be brief, spontaneous, and have a limited cumulative effect.
- You may use examples, clips, etc. in class, even in distance learning classes.
- You may use copyrighted materials with permission and public domain materials.

Can I use Copyrighted Materials Online?

- Fair use exception exists, but permission is better.
- Be careful of posting images from online searches, make sure you have rights or image is in the public domain.
- Links are okay, content needs legal ability to use.
- If someone contacts you stating you infringed on a copyright, contact OGC. Do not pay requested fees, no matter how scary the letter sounds.

Protecting Your Copyrighted Work

- The Minnesota Government Data Practices Act requires us to respond to public data requests regardless of whether the requested data is protected by copyright. However, we can verify that the requestor will only use the materials for “fair use.”
- Use © symbol on any copyrighted work, regardless of registration.
- Make sure permissions are in writing.
- Assignments of ownership require written contracts.

Patents



What is a Patent?

- Only “inventions” are patentable.
- To be patentable, an invention must be:
 - Able to be used (it must work, not be theoretical)
 - Manufacturing and use must be clearly described
 - Novel, not something done before
 - Not obvious, as in not too closely related to an existing invention
- Bundle of rights includes excluding others from using, offering for sale, or selling; exclusive right to commercialize; enforcement rights.
- Patent rights in the United States extend for 20 years for most patents, 15 for “design patents.”

Invention/Patent Ownership

- Students own their inventions and any resulting patents.
- Faculty own, or have joint ownership to, their inventions and any resulting patents.
- The Colleges or Universities may have “joint rights” if they provided substantial College/University support for an invention.
- Inventions and resulting patents created by non-faculty employees or contractors within the course of employment or contract are “work for hire” and generally belong to Minnesota State.

Invention Disclosure

- We have an invention disclosure process at Minnesota State, set forth in System Procedure 3.26.1.
- Disclose inventions to OGC or to internal campus Research/Sponsored Programs Administration.
- Why disclose?
 - Obligations of federal grants
 - Obligation of non-faculty employment
 - Opportunity to work with College/University to commercialize.

Technology Transfer

- Term used in higher education industry to describe the process by which copyrights and patents are commercialized.
- College or university should own or jointly own patentable or copyrightable work to move forward with this process.
- Find licensor, buyer by marketing to industry, inventor and college or university share in proceeds.
- Not typically something Minnesota State does, but if you're interested, contact me separately.

Trade Secrets



What is a Trade Secret?

- Information that has either actual or potential independent economic value by virtue of not being generally known,
- Has value to others who cannot legitimately obtain the information, and
- Is subject to reasonable efforts to maintain its secrecy.
- Examples include most software code, secret recipes (Coca-Cola), secret processes that are not subject to other IP protection.
- Pricing, most RFP responses, vendor contracts are NOT trade secrets.

Protecting Trade Secrets

- Minnesota Statutes 13.37 requires that Minnesota State protect third party trade secrets as non-public data.
- Minnesota State may have its own trade secrets, but this is unusual.
- Vendors must disclose trade secrets during the RFP process. The entire proposal is not a trade secret, neither is pricing.
- We typically do not need to enter into non-disclosure agreements -- they are duplicative with state law.

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