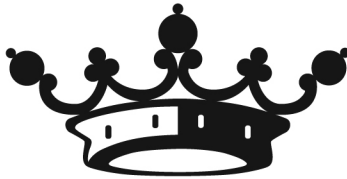


I N S I D E T H E M I N D S

Common Issues in IP Law

*Leading Lawyers on Resolving Disputes, Evaluating
IP Claims, and Achieving Successful Client Outcomes*



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Counseling Clients in the Era of Internet IP Wars

Rose Auslander

Partner

Carter Ledyard & Milburn LLP



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Recent Trends in IP Law

One view of the intellectual property (IP) realm is that it has become a battleground where content owners and users fight—a minefield, where any step can be costly. Another view is that there is unparalleled opportunity to sell more content to more people than ever before. IP lawyers representing either side face the challenge of helping their clients benefit lawfully from these opportunities.

Certainly, more people in more places are aware of the value of IP, and it is increasingly used worldwide—with everyone trying to benefit. And certainly, challenges exist. For example, a hit song uploaded onto the Internet can be shared illegally, royalty-free, by billions of music lovers worldwide who might otherwise have paid to enjoy this music. Content owners have struggled with the challenge of trying to monetize this access and protect their rights from infringement, wrapping music files in digital rights restrictions, suing Internet services, and suing customers—keeping lawyers busy and alienating the public—while sales continue to plummet. As attempted legal remedies have not cured the problem, the recent trend is to explore business solutions, such as paid subscription services and downloads free of digital rights management. Doubtless these new “solutions” will mean new legal issues for IP lawyers. And even off the Web, the IP realm has become much more crowded than it used to be, demanding new strategies and solutions.

At the same time, our clients have become more budget-conscious. Today’s challenge is to work in an area that is increasingly complicated, international, and therefore expensive, with clients who are generally willing to spend less. The goal is to help clients get value for their money—not just IP rights for their own sake, but rights for what they will bring in terms of commercially viable solutions, such as licensing arrangements, rights transfers, and other business solutions. And so we assist our clients to develop cost-efficient IP protection strategies, including by taking advantage of government resources, where available. For example, for clients vulnerable to counterfeiters, we recommend registering their IP with Customs, a cost-effective way of enabling the government to help keep counterfeits from entering the country. If the client is facing Internet violations that are large in scope, or a huge counterfeiting situation, we will

consult with the U.S. attorney's office. It rarely takes on these cases, but if it does, it has access to means unavailable to private litigants, such as the ability to work together with the Federal Bureau of Investigation—and, unlike the usual situation, where the client has to pay for investigation and litigation, the client does not need to pay for these government resources.

Copyright is not the only area affected by the increasingly international—and, at times, contentious—nature of the IP field. The entire process of clearing IP rights has become more complex and expensive, particularly for trademarks, which are territorial. These issues can be particularly difficult for an Internet start-up that needs to clear IP at the outset, when it is still trying to raise money. For example, a U.S. client that obtains a domain name and clears the corresponding trademark in the United States only, but then ends up also doing business on the Web with E.U. consumers, may get a cease-and-desist letter from a trademark owner in the European Union. As a result, that client will need to find a business name and trademarks that are clear in both jurisdictions, as well as everywhere else it does business. E.U. clients need to be similarly cautious about clearing rights in the United States and anywhere else their business activities may reach. With everyone, everywhere fighting for a piece of the pie, trademark registers in the various jurisdictions have grown more crowded, which makes marks increasingly difficult to clear, particularly as most business owners these days want to correlate their primary house mark/business name with a domain name—and most domain names are taken. Moreover, adopting a mark that turns out not to be clear has become increasingly costly, particularly in light of the adoption of electronic discovery by the U.S. federal courts and the U.S. Patent and Trademark Office—an expensive process that is even more difficult in today's tight economy.

Challenging Issues in IP Law

Several areas of IP law can be particularly challenging when advising clients, and the stakes can run high. On the copyright side, user-generated content on the Internet has spawned disputes between content owners and users. Notably, in *Viacom International Inc. v. YouTube Inc.*, No. 07 CV 2103 (S.D.N.Y.), Viacom is claiming \$1 billion in damages for the copyrighted content posted on the YouTube site, and YouTube/Google is asserting a safe harbor defense as a protected service provider under 17 U.S.C. §512(c)

(1999). Until there is a decision in this area, it is difficult to advise clients on the contours of that shelter, and on how user-generated content and other content can be posted on the Web.

Contributory infringement is an area where the stakes are always high, not just in connection with user-generated content, but with all kinds of IP. At issue for the foreseeable future is whether innovation and investment are chilled as the case law continues to develop in the wake of *MGM Studios Inc. v. Grokster Ltd.*, 545 U.S. 913 (2005). It is already increasingly necessary to advise clients on avoiding actions that might be looked on as inducing infringement, such as encouraging others to use otherwise innocent software in infringing ways. There also can be vicarious and/or other contributory liability through funding companies that turn out to infringe, which can possibly even extend to personal liability for certain individuals in connection with such funding. See, e.g., *In re Napster Inc., Copyright Litigation*, 377 F. Supp. 2d 796, 806 (N.D. Cal. 2005). There has even been an unsuccessful effort to extend such liability to credit card companies. See *Perfect 10 Inc. v. Visa Int'l Serv. Ass'n*, 494 F.3d 788 (9th Cir. 2007), cert. denied, 2008 U.S. LEXIS 4523 (June 2, 2008).

Possible class actions should also be kept in mind when advising clients. For example, in the wake of *New York Times v. Tasini*, 533 U.S. 483 (2001), which barred publishers from reproducing freelance works electronically based on a general permission that does not specifically give electronic rights, freelancers filed various class actions against publishers. Recently, however, class status was denied to the owners of unregistered copyrights in *In re Literary Works in Electronic Databases Copyright Litigation*, 2007 WL 4197413 (2d Cir. 2007).

In today's more casual business environment, IP lawyers also must counsel clients in an increasing number of IP ownership disputes as, both on and off the Web, parties often wait to consider formal IP ownership issues until relationships break down and then, unfortunately, their working assumptions about ownership may not conform to reality under U.S. law. For instance, companies and individuals often hire others to create copyrighted works for them, paying the creator on an ad hoc basis (not as an employee), with no written agreement—and yet assume the work will be treated as a work for hire, owned by themselves as the commissioning

party. But without a written agreement confirming that assumption, they will not own the work under U.S. law. 17 U.S.C. §101 (2008) (definition of “work made for hire” at (2)). And even with an agreement, only certain kinds of works can be owned as a work for hire in this way. *Id.*; see 1 Melville B. Nimmer and David Nimmer, *Nimmer on Copyright* §5.03[B][2][a] (4th ed. 1978 & Supp. 2007) (“*Nimmer*”).

Turning to trademarks, a high-stakes issue is whether to advise clients that they are free to buy others’ trademarks as keywords from companies that offer search engine advertising. Courts in the Second Circuit have ruled that such sales do not involve trademark use or liability, although that may change with the ruling on the appeal of *Rescuecom Corp. v. Google Inc.*, 456 F. Supp.2d 393 (N.D.N.Y. 2006), but other courts have found potential liability. See, e.g., *Google Inc. v. American Blind & Wallpaper Factory*, 2007 WL 1159950, at *6 (N.D.Cal. 2007) (ruling that sale of trademarked keywords in Google’s AdWords program constitutes “use in commerce” for purposes of the Lanham Act). Similarly, in *1-800 Contacts v. WhenU.com Inc.*, 414 F.3d 400 (2005), the Second Circuit held that it is not trademark use to place a competitor’s trademark in Web site metatags (computer code words not readily visible to viewers). The Eleventh Circuit recently disagreed in *North American Medical Corp. v. Axiom Worldwide Inc.*, 522 F.3d 1211 (2008).

IP lawyers also need to counsel clients to be vigilant against the trend of genericizing trademarks, which perhaps grows from the spirit of free access to all Web IP. Google recently decided to protest when people use its GOOGLE mark as a noun or verb (such as by referring to “googling” on the Internet). If unchecked, this practice could lead to the “genericide” of this valuable trademark, so the term would no longer indicate a single source for a product or service, but would instead become common parlance for the product or service itself and therefore be deemed free for all to use. See 15 U.S.C. §1064(3) (2006). Infamous examples include “escalator” and “aspirin,” both of which started as trademarks and ended up as generic product identifiers. To help trademark owners be mindful of this issue, today’s IP attorneys need to teach their clients how to use marks properly and communicate that message throughout their companies, reaching every mark and every employee. Because trademarks are so valuable and, today, can be so hard to clear, it is important to guard against

losing them—including loss of rights by “naked licensing,” where the licensor does not control the quality of the licensee’s goods or services, with the result that the mark no longer fulfils its role of indicating goods of uniform quality, and rights will be deemed to be lost by abandonment. 15 U.S.C. §1127 (2006) (definition of “abandoned”); see 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §18:48 at 18-96-99 (4th ed. Thomson 2008) (“*McCarthy*”).

Off the Web, a growing challenge for IP lawyers is stopping others from free-riding by copying the look of their clients’ product packaging or labeling (trade dress infringement), for example, stopping such copying by owners of “private labels” (distributors’ own brands). It has grown increasingly difficult to tackle this activity, as the Second Circuit, in particular, is putting great stock in the ability of house marks to differentiate products. When both the plaintiff and the defendant have distinctive house marks and/or logos on their products, it is now difficult to prevail in that circuit on claims that the defendant has infringed your client’s trade dress, as the courts tend to find that customers will be guided by the other identifiers on the products, and will not be confused. See, e.g., *Playtex Products Inc. v. Georgia-Pacific Corp.*, 390 F.3d 158, 164, 73 U.S.P.Q.2d 1127, 1132 (2d Cir. 2004) (“We have repeatedly found that the presence of a distinct brand name may weigh against a finding of [likelihood of confusion].”); *W.W.W. Pharmaceuticals Co. v. Gillette Co.*, 808 F. Supp 1013, 23 U.S.P.Q.2d 1609 (S.D.N.Y. 1992), order amended (July 14, 1992), and judgment aff’d, 984 F.2d 567, 25 U.S.P.Q.2d 1593 (2d Cir. 1993) (addition of house mark RIGHT GUARD to SPORT STICK for deodorant one strong factor in obviating likelihood of confusion with SPORTSTICK for lip balm); *Pristine Indus. Inc. v. Hallmark Cards Inc.*, 753 F. Supp 140, 18 U.S.P.Q.2d 1214 (S.D.N.Y. 1990) (preliminary injunction denied and no likelihood of confusion found where well-known HALLMARK wording added to conflicting mark); 4 *McCarthy*, §23:43 at 23-183, 184.

Moreover, under *Wal-Mart Stores Inv. v. Samara Bros. Inc.*, 529 U.S. 205 (2000), plaintiffs cannot protect against imitations of the actual configuration of their products unless they can prove that consumers have come to associate the configuration as an identifier of source. Thus, private label owners are likely to think that as long as they use a distinctive house mark/logo, they can get away with trade dress that imitates that of the famous brand.

IP lawyers can suggest an innovative way for brand owners to attack trade dress infringement—by adopting labels and packaging that are sufficiently original in expression (in ways that are non-functional) to be protectable against substantially similar copying under U.S. copyright law.

In light of all these issues, and their expansion internationally by the Internet, strategic planning by IP owners and their counsel has become not just a convenience, but also an imperative to build and protect valuable rights and lower risks of claims of infringement.

Counseling Clients on Key Legal Issues in IP, On and Off the Web

In this often contentious field, IP counsel are uniquely placed to help clients make productive decisions on IP issues. And these decisions are often based on basic IP concepts that are the same both on and off the Web. With respect to litigation, IP counsel should advise not just on whether a case *can* be brought, but whether it *should* be brought. For example, a case against an artist that will generate bad publicity for the client and little to no income may be one to avoid. Perhaps the client might wish to consider a licensing arrangement instead. Similarly, the client may wish to think twice against suing its own consumers and eroding goodwill among its customer base.

After questioning whether a dispute would be productive, or could perhaps be avoided or solved without litigation, the threshold legal issue for claims both on and off the Web is whether the claimant has any IP rights at all. A client may come to you all hot and bothered about an IP issue, but it may be that “their” IP was in the public domain, and therefore nobody had rights to it and they cannot protect it. Or a client may come to you about a “copyright” in a phrase that, in reality, can only be protected as a trademark. Therefore it is always important to find out if the client has any IP rights and exactly what they consist of—is it a trademark, copyright, or patent?

Assuming there are any current, valid IP rights in relation to a certain property, you need to find out who owns the rights or what aspects of the bundle of rights. It may be that your client itself is a (hopefully inadvertent) infringer. Could your client, who claims copyright rights,

possibly have copied “its” IP from someone else? Before you go after another party in an infringement suit, you must thoroughly investigate the background facts. If it turns out that another party has rights over your client, the best thing for your client may be to stop its questionable activities, and be very quiet.

So, who has rights? People sometimes assume that whoever thinks up a mark first owns the rights to it. But instead, the general rule in the United States is that ownership goes to whoever first uses the mark in commerce or files a federal intent-to-use application that issues to registration with a priority date. 15 U.S.C. §1127 (2006) (definitions of “use in commerce,” “trademark,” and “service mark”); see also *In re Trade-Marks Cases*, 100 U.S. 82, 94, 1879 WL 16583, at *9 (1879) (“At common law the exclusive right to it grows out of its use, and not its mere adoption...It is simply founded on priority of appropriation.”). If trademark rights exist, you then need to ask, “Are they limited geographically or in terms of a certain field?” In a dispute between a manufacturer and distributor over ownership of a trademark, where there is no contract, unusual factors may apply, such as whether both parties are in the United States, who created the mark and first affixed it to the goods, whose name appeared on the packaging, which party controlled the quality of the goods and paid to advertise them, and which party received any customer complaints. See *2 McCarthy*, §16:48.

As to copyright rights in a work, you need to know who owns what part of the bundle (i.e., is there an individual owner, are there joint authors, was it a work for hire, or has it been assigned). In the case of music, you will need to look for separate owners for the sound recording and underlying composition rights, and which agency collects performance fees. It is also important to consider the chain of title. If ownership has changed, have these changes been properly documented in written contracts recorded with the Copyright Office—and if not, are the necessary signatories available and willing to assist you in doing it now, *nunc pro tunc*?

Assuming your client has ever owned the IP rights at issue, are they still valid? Has the client used, or licensed, a mark in such a way that rights were lost, even if the client did not intend abandonment? If it is a very old work, was it published without notice back when that could divest copyright rights, or was it published so long ago without registration that by now

rights may have lapsed and can no longer be renewed? When dealing with old copyrights, the process of determining whether the rights are still valid can be quite complicated.

Even if your client owns valid IP rights, proving infringement is never simple. Although the other party may have taken certain actions that might arguably be considered infringement, you need to know whether those actions meet the tests for infringement—those tests are not simple, and they vary by jurisdiction. For trademark infringement, you must prove likelihood of consumer confusion, with the court balancing factors such as (1) the strength of your mark (both inherently and in the market), (2-3) the similarities of the parties' marks and goods/services, (4) the likelihood that the senior user will bridge any gap between the goods or services of the parties, and between their channels of trade, (5) whether there has been actual consumer confusion (and/or survey evidence of confusion), (6) the junior user's good faith in choosing its marks, (7) the quality of the junior user's product, and (8) whether the buyers are sophisticated. *See, e.g., Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961). For copyright infringement, you must prove copying of copyrighted material, by showing (a) that the defendant had access to your work, and (b) that its work is substantially similar to yours (with some circuits considering only protectable material in making this analysis, and disregarding stock themes, scenes a faire, etc.). *See, e.g., Walker v. Time Life Films Inc.*, 784 F.2d 44, 48 (2d Cir. 1986).

Even if you can meet the above burdens of proof on your cause of action, you may need to overcome many possible defenses, such as fair use—a defense most common in copyright, where it involves a multi-factor test, balancing factors such as (1) the purpose and character of the use, (2) the nature of the copyrighted work, (3) the amount and substantiality of the work used, and (4) the effect of the use on the market for the original. *See, e.g., Rogers v. Koons*, 960 F.2d 301, 308 (2d Cir. 1992). Copyright misuse is another defense defendants have turned to recently. An example is *Schloss v. Sweeney*, 515 F. Supp. 2d 1068 (N.D. Cal. 2007), where a James Joyce scholar who was denied access to Joyce's copyrighted works claimed the denial was a copyright misuse meant to suppress her point of view.

Finally, in any IP case, if your client is the claimant and has decided it needs to press its rights, you want to act as promptly as possible to avoid exposure to a variety of defenses—one of the worst being the defense of *laches*, under which the court may find the claims are barred by lack of diligence and the defendant’s reliance on your client’s delay. See 6 *McCarthy*, §§31:1-31:37.

Services Offered to Clients

The goal of an IP attorney counseling clients in this era of Internet wars is not only to provide excellent responses to client requests, but also to be a proactive resource. Therefore, when you take client calls, you need to draw out the full problem and suggest all helpful solutions, because the issue the client is consulting you about may not be exactly the same as their overall—and more important—IP-related issues, needs, and problems. To be ready to meet all these client needs, many IP practices, including that of our law firm, handle IP counseling on issues both on and off the Web, IP clearance, and filing and prosecuting applications here in the United States, and coordinate those activities worldwide. Like other practices, we also handle IP maintenance and watch-service surveillance over third-party trademark filings in the United States and worldwide. If any infringement issues arise, we conduct investigations, draft or respond to cease-and-desist letters, and bring or defend Uniform Dispute Resolution Policy proceedings (for domain names), U.S. Trademark Trial and Appeal Board proceedings (for trademarks), and litigation in U.S. courts (for all kinds of IP). In addition, we negotiate and draft agreements, licenses, and coexistence permissions, and we conduct due diligence for deals.

Preliminary Client Research and Meetings

Before I meet with a client or potential client who is dealing with an IP-related issue, the drill is the same whether the issue is on or off the Web. Either way, I want to get a picture of the issue and the business realities underlying it, to help architect the most productive strategy. I also want to understand the underlying facts. For this, I need to obtain any pertinent documents. If the issue is related to IP agreements, I want documentation of the underlying rights, as well as copies of the agreements, any amendments to them, and any related correspondence, both pre-agreement (especially if the agreement does not have a merger clause) and post-

agreement. And I may ask if the client can bring someone to the meeting who has been involved in negotiating and fulfilling those IP agreements, so I can learn what they know of the intent and practice under the agreements.

If we have worked for the client in the past, I can check the client's IP portfolio in our database. Before meeting with a new client, I will check the client's Web site to see what they do, and I will check the Patent and Trademark Office and U.S. Copyright Office Web sites to see what IP they own. In either case, I also will want to update my understanding of the legal issues. For example, if we are dealing with a copyright issue, I will check *Nimmer*, and if it is a trademark issue I will check *McCarthy*, and for all kinds of issues, I will check the advance sheets. In addition, I go on the Web every day to check what is going on in the IP area, and in many cases, I will find information that is related to a client question. I also keep extensive files of projects I have worked on and issues that have come up in the past. If you have devoted some time and effort to an issue, you do not want to lose that work product. Therefore, if the client mentions something that relates to a project I have worked on in the past, I usually can access the pertinent information in my records. Of course, if there is someone in the firm who is more familiar with the client company than I am, I will chat with them, because you always want to learn all you can about the client's overall business issues.

But even with all that preparation, the most important thing when meeting with a client or potential client is to listen. Don't be afraid to ask every pertinent question, follow up on every question, and then listen—really listen—to the answers. And even then, don't necessarily assume everything that is said is correct or that the way the client perceives the issues is complete. You generally will need to ask for and research evidence supporting the client's position, as well as all the legal implications, before giving anything more than preliminary thoughts.

Managing Client Expectations

When taking on a new client, we always provide them with an engagement letter, because it is important to discuss the parameters—at minimum, how much work the client expects you to do, and the expected costs. If the client wants you to provide cost estimates, you have to be clear about

whether there will be a spending cap on what you do, in which case you will need to notify them if you get close to that cap. You should always try to correctly manage the client's expectations with respect to what they will and will not be able to do, and advise the client in a very straightforward way (e.g., this is how we see your rights and your likelihood of success, and these are the risks you would be taking if you were to pursue a certain course of action), and it is important to put all of that advice in writing.

The Role of Today's IP Lawyers

It is important for an IP lawyer to foster a relationship with their client that enables the lawyer to be a productive part of that client's business. IP lawyers need to understand their client's business, and they need to encourage the client to be proactive and not reactive in the IP realm. The client needs to understand that having a consultation with their IP lawyer is an important part of the processes of creating new products and doing deals. The client must constantly make sure to create properties in such a way that they can protect their IP rights, and to focus on protecting those properties that are an important part of their business.

Difficult as it can be in the daily press of business, clients need to step back and take a long-term view, and develop an approach to IP that will foster and protect their business for many years to come. Clients need to use their IP in ways that are productive in the long term, and that will help them resolve litigation strategically. And IP counsel can play a very productive role in that process—such as by helping clients adopt, register where necessary, license properly, and police inherently distinctive marks like KODAK and EXXON that can become hugely valuable over time; making sure clients enter into and record ownership agreements and register their important copyrighted works, so statutory damages and attorneys' fees are available in case of infringement; and keeping the client informed on the latest case law in areas like contributory infringement, to help avoid any potential exposure.

Helpful Resources for Managing IP Issues

The Internet isn't just a hotbed of IP issues. It also is a huge free resource/research tool for IP lawyers, and we use it all the time, consulting

copyright.gov, uspto.gov, and the searchable online registers of other jurisdictions, as well as csusa.org, the member-accessible publications at inta.org, and cases available online at uscourts.gov. Off the Web, I love having access to treatises. I train young associates to check the treatises at the outset of any research project, so they spot and thoroughly look at all possible issues in this area and identify leading cases in a way you cannot do by feeding keywords into a computer database. This method also lowers searching costs, although you may need to pay a fee to shepardize treatises, find other cases, and make sure your findings are valid.

The Lexis and Westlaw databases may also be tapped, although our clients will typically require us to get their permission before using those types of paid research methods. Therefore, we do not use those databases automatically. We also use investigators extensively. In many instances, we need to learn the factual background of an IP matter, and we can learn more by having an external expert look into the facts.

Of course, we also maintain a database in our office for tracking all of our client's IP and deadlines, and we can use this resource to create docket summaries and charts of their various IP properties for them. On the trademark side, we like to keep records of our clients' trademark data, with searches, priority dates, specimens of use, and evidence of the fame of numerous marks. On the copyright side, we like to have records on authorship, dates of creation, and records of publication. And for all rights, we like to have chain of title information.

Final Thoughts: Developing Key Legal Skills in the IP Area

I believe IP practice ends up being an art and not a science. It takes many years of working in this field to get a handle on it, because we are dealing with very arcane and complicated issues, and there is a lot of history to absorb as well. New associates should make use of the electronic subscription services and circulation lists, and read all they can about issues that are affecting the IP area. To keep up with what is going on in this field, you need to take the time each morning to check out the latest IP news in the newspapers and on the Web—what is happening and developing in this area. Part of the value-added experience you are giving your client is your feeling for the field, based on the many years you have spent in it, and your immersion in its practices.

Of course, it is not as if you can learn the language of IP and then rest complacently. The field, and the technology it protects, all change too rapidly for that. A good way to keep up with developing issues and case law in this fast-moving field is to become involved in bar associations that have IP committees, and join other organizations in the field, like the International Trademark Association and the Copyright Society of the USA. These organizations have working committees and hold annual and quarterly events, as well as roundtables and lunches where litigators, practitioners, and businesspeople speak on the hot issues in this area.

Few of us are born knowing how to use IP productively—and I do not think we all come out of law or business school knowing it either. It is a mutual, ongoing education process. You teach your clients the IP law they need to know, while yourself learning enough about the clients' needs and businesses to help them maximize the effectiveness of their IP. Indeed, part of the fun of being an IP lawyer is getting a glimpse into many different kinds of businesses, and, over time, crafting the most beneficial IP strategies for them.

Rose Auslander is a partner in the intellectual property department of Carter Ledyard & Milburn LLP in New York. She represents a variety of fashion and media clients in copyright, trademark, domain name, and other Internet-related matters. She is vice chair of the publication committee of the International Trademark Association and co-chair of the New York chapter of the Copyright Society of the USA. She is an avid speaker on her areas of expertise.

Ms. Auslander received her B.A., magna cum laude, from the City University of New York and her J.D., magna cum laude, from New York University School of Law, where she was articles editor for the New York University Law Review, a member of the Order of the Coif, winner of the Morton Geller Award, and winner of the American Jurisprudence Prize for Civil Procedure. She was the October 2003 “Alumni of the Month” recipient at New York University School of Law.

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