

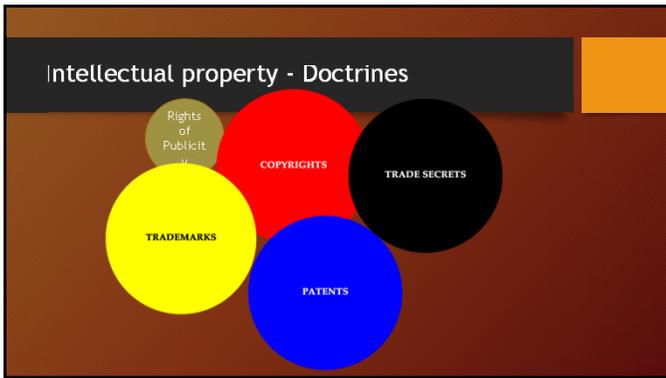
Resort Hotel
Casino Law

Greg Gemignani

Intellectual property

Intellectual property

- IP laws are not gaming laws so this will be a bit of a departure from the basics we have learned
- However, intellectual property rights are key to bringing products to market and protecting investments in such new products



Utility PATENTS

- Any **invention** or discovery of any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.
- Patent law is exclusively federal law and preempts any state law that overlaps federal patent law.

PATENT Elements

- Must be patentable subject matter
- Must have utility
- Must be novel and not on sale or in commerce for a year or more
- Must not be obvious to one skilled in the art

PATENT Rights

- A monopoly granted by the federal government to the inventor to prevent others from making, using, offering for sale, or selling the invention in the United States or importing the invention into the United States

PATENT Prosecution Process

- Patents can only be prosecuted by the inventor, a licensed patent agent or licensed patent attorney
- Patentability search and assessment
- Drafting and filing an application for a patent

PATENT Prosecution Process

- After submission, the patent application will be submitted to an “office” for evaluation
 - Each office has a particular specialty
 - Patent examiners will examine the application and more often than not, reject the application for some reason. Such a rejection is made through an “office action”

PATENT Prosecution Process

- There is a limited amount of time to respond to an “office action”
 - Such a response will often require a legal brief in an effort to persuade the examiner to withdraw the objection or withdraw the objection upon a modification or clarification of the application
 - This can be an iterative process with multiple office actions and responses

PATENT Prosecution Process

- The process, when successful often takes more than a year to complete
- Patent rights are the strongest commercial rights a new technology can have and as such the process to obtain such rights is rigorous

PATENT - Rights Duration

- 20 Years from first filing
 - (some extensions may occur for applications that stayed in examination an extraordinarily long time)
- After the term, the invention is deemed to be in the public domain

PATENT - International Treaties

- Many nations belong to the Patent Cooperation Treaty (PCT)
- Other agreements, GATT-TRIPPS, provide other avenues for international patent protection
- Talk to a patent attorney about obtaining patent protection for your inventions in countries important to your business

PATENT - International Treaties

PATENT - Infringement

- Making, using, offering for sale, or selling” the invention in the United States or “importing” the invention into the United States any claim in an issued patent
- Doing any of the above with the equivalent of any claim of an issued patent
- No such thing as innocent infringement, independent invention is no defense

PATENT - Enforcement

- Patents are not self enforcing
- Patent owners must file suit to enforce their rights
- Patent litigation, particularly with high-tech patents, is among the most expensive litigation to pursue
 - Expert costs
 - Complexities of explaining technologies to judges and juries
 - Complexities of showing infringement
 - Complexities of calculating damages
- Patent litigation is often “bet the company” litigation

PATENT - Damages and relief

- Injunctions
- Damages, reasonable royalties and lost profits
- Seizure of imported goods by U.S. Customs
- Destruction of infringing matter...

PATENT - Practice tips

- Perform an infringement search and analysis prior to implementing new technology or methods
- Upon development of a new technology or method perform a patentability search and analysis
 - Do not disclose such technology or methods without a non-disclosure agreement
 - The one year on-sale bar is a killer
- If you think you have a patentable invention or method, then seek patent counsel promptly

DESIGN PATENTS

- Patents on ornamental designs
- The design must be ornamental, not useful
- The cost of prosecution is relatively low
- They offer some limited protection

PLANT PATENTS

- A plant patent is granted by the United States government to an inventor (or the inventor's heirs or assigns) who has invented or discovered and asexually reproduced a distinct and new variety of plant, other than a tuber propagated plant or a plant found in an uncultivated state
- Ignore this - I cannot think of a single plant patent in use for gaming

PATENT - Myths vs reality

- MYTH: Patents are solely for machines
- REALITY: There are 3 types of patents
 - Utility Patents - Useful Inventions
 - Plant Patents - asexually reproduced distinct new variety of plants
 - Design Patents - ornamental designs embodied in or applied to an article of manufacture

PATENT - Myths vs reality

- MYTH: Everyone that invents something is entitled to patent protection for their inventions
- REALITY: Patents only exist when the federal government issues letters of patent. Merely inventing does not necessarily provide any rights

PATENT - Myths vs reality

- MYTH: Patents stop others from making an invention identified in letters of patent
- REALITY: Patents are not self enforcing. Patent owners must file infringement actions to prevent others from making, selling, offering for sale, or importing their protected inventions.

PATENT - Myths vs reality

- MYTH: Patents give a right to make an invention
- REALITY: Patents are a negative right to seek redress to prevent others from making, selling, offering for sale, or importing protected inventions

PATENT - Myths vs reality

- MYTH: Inventions must work to be patentable.
- REALITY: Not all patented inventions work.



This patented invention for a fire escape apparatus featuring wings is not likely to work

PATENT - Myths vs reality

- MYTH: Provisional patents are as strong as any other patent
- REALITY: **There is no such thing as a provisional patent.** However, there are provisional patent applications. A provisional patent application gives the inventor 1 year to file a utility application from the date of filing the provisional application. It is a place-holder, not an actual patent.

Patent law QUESTIONS

COPYRIGHT

COPYRIGHT BASICS

Copyrights are a bundle of exclusive rights granted to the author(s) of a creative work fixed in a tangible medium

COPYRIGHT BASICS

The author is the person that fixes the creative work in a tangible medium

COPYRIGHT BASICS

- Copyright protects expressions of ideas, but not the ideas themselves



COPYRIGHT BASICS

- Protects creative elements of a work, but not primarily functional or utilitarian elements
- Protects web page content, graphics, animations, sounds, source code...
- Protects system documentation
- Protects gaming device source code
 - To the extent the source code is expressive...

COPYRIGHT BASICS

- Like patents, copyrights are exclusively the domain of federal law
- State laws that grant rights in creative works have been held preempted by federal law and invalidated
 - e.g. A California law that protected live performances and speeches was deemed to be invalid as federal copyright laws exclusively protect creative works and federal copyright laws do not provide protection for live works not fixed in a tangible medium

COPYRIGHT BASICS

- For works created after 1978, works are granted copyright protection the instant they are fixed in a tangible medium
- Rights are not dependent of filing or registration
- Registration is required to file suit and protect certain damages
- For works created before 1978, see a copyright attorney

COPYRIGHT BASICS

- Owned by the author, the one who puts the expression into the tangible medium
- In a true employment situation, the employer is deemed the author if the work was done within the scope of employment
- **Independent contractors retain copyright ownership in work created by them absent a written agreement to the contrary**

COPYRIGHT BASICS - OWNERSHIP

- Works made for hire
 - Often misunderstood
 - In limited circumstances for limited types of works, a party commissioning a work may own the work upon its creation

COPYRIGHT BASICS - RIGHTS

- With respect to the work, copyright law provides an exclusive right to:
 - Reproduce, make copies
 - Create adaptations, enhancements, changes, new versions
 - Distribute publicly
 - Perform or display publicly

COPYRIGHT BASICS - Marking

- Notice removes the innocent infringement defense to infringement.
- Form:
 - © 2023 Greg Gemignani
 - Copyright 2023 Greg Gemignani
 - Copr. 2023 Greg Gemignani
- Must be positioned to give reasonable notice to be effective
- Lack of proper notice may result in a disallowance of damages in a successful infringement suit

COPYRIGHT BASICS - Registration

- Registration is done through the Copyright Office of the Library of Congress
- Registration forms are available via the Library of Congress Web Site (www.copyright.gov)
- Registration must be filed prior to bringing suit
- Registration must be effective prior to filing an infringement law suit in order to be eligible for statutory damages and attorney's fees, unless registration is made within three months of initial publication

COPYRIGHT BASICS - Damages

- Lost profits
 - Proved and related to the infringement
- Disgorgement of profits
 - Proved and related
- Statutory damages of \$750 - \$150,000
 - At the court's discretion and depending on whether or not the infringement was willful.
- Attorney's Fees
 - In some circumstances
- Impoundment and/or destruction of infringing articles
- Injunctions

COPYRIGHT BASICS - DURATION

- For Works Authored By Natural Persons
 - Author's life plus 70 years
- Works For Hire
 - 95 years from first publication or 120 years from creation, whichever occurs first

COPYRIGHT BASICS - DURATION

- Make sure you own what you think you own
 - Have agreements with independent contractors
 - Define the scope of employee activities
 - Have agreements with employees to assign rights
- Protect yourself from infringement
 - Agreements with independent contractors
 - Employee education
- Copyright is the most prevalent type of intellectual property on the web.
- For common infringement (i.e., non-competitive infringement), send a demand letter first or risk good will with the court.

COPYRIGHT BASICS - GAMING CONTEXT

- GAMING DEVICES
 - Source code
 - Game graphics
 - Game sounds
 - Game organization

COPYRIGHT BASICS - GAMING CONTEXT

- Table games
 - Felt design
 - Organization
 - Graphics
 - Game promotional materials

COPYRIGHT BASICS - GAMING CONTEXT

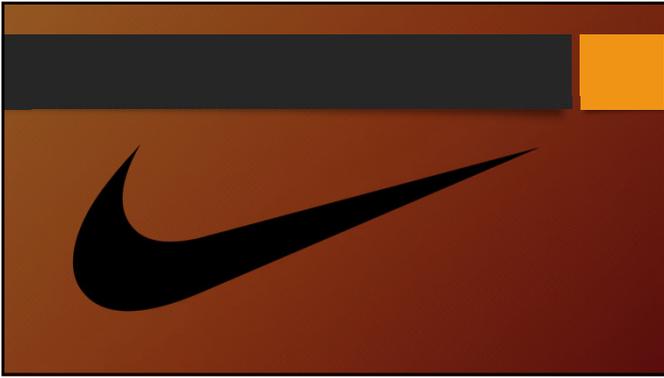
- Casino Marketing
 - Advertisements
 - Web sites
 - Social Media Posts

COPYRIGHT BASICS - PRACTICE TIPS

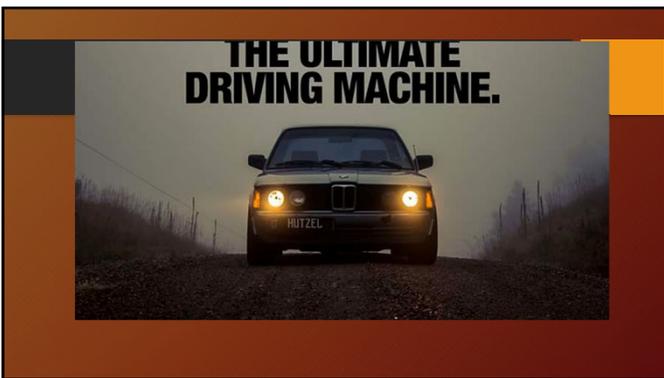
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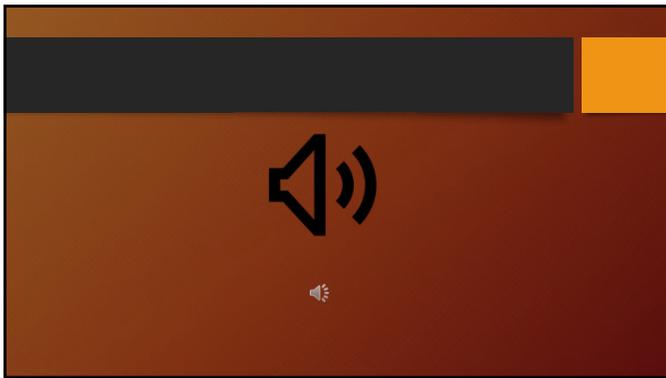
COPYRIGHT QUESTIONS

TRADE MARKS











Trademark Basics

- Any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify and distinguish his goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown. 15 U.S.C. § 1127.

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Words/Phrases/Terms	XEROX
Designs	
Colors	Pink for Fiberglass
Sounds	
Product Configuration	

Trademark - Obtaining rights

- USE is the key for obtaining trademark rights.
- Common law rights begin when the mark is used in commerce in a particular geographic area
- State Registration
- In most states, use in the state and state registration provides a presumption that the registrant is entitled to exclusive use of the mark throughout the state
- Federal Registration
- Can secure an initial date based on a bona-fide intention to use a mark
- Federally registered mark rights only vest after interstate commercial use and the Patent and Trademark Office's issuance of a registration

Trademark - Obtaining rights

- Type Of Use.**
 - Use of the mark must be sufficiently public to identify or distinguish the goods or services in the public's mind as those goods or services of the owner of the mark
 - A trade name or corporate name used merely to identify a business entity is not protectable as a trademark
 - The use must also be a bona fide use in the ordinary course of trade. Token uses merely to establish trademark rights are not sufficient and, given the availability of the intent-to-use application, should not be necessary
- Common Law.**
 - Use must be within the particular geographic territory within which protection is claimed
- State Registration**
 - Usually requires actual use in commerce within the state
- Federal Registration.**
 - The use must be in interstate commerce

Trademark - Obtaining rights

- Initial Search
 - Check the federal database for infringement
- Full Search
 - Check state, federal, common law and internic databases
- Prepare and File an Application
- Interact with the United States Patent & Trademark Office to prosecute registration

Trademark - Federal Registration

- Presumption of an exclusive right to national use
- Availability of enhanced damages
- Presumed nationwide notice

Trademark - Registrations

- Federal
 - File Affidavits of Continued Use
 - Between the 5th and 6th years and every 10 years thereafter
 - File Renewals
 - Every 10 Years
- State
 - File Periodic Renewals
- All
 - Police your mark to preserve the source indicating quality of the mark.

Trademark - marking

- Federally REGISTERED marks
 - ®, “Registered in the U.S. Patent and Trademark Office” or “Reg. U.S. Pat. & Tm. Off.”
 - Without notice monetary damages may be unavailable
- State Registered or Common Law Marks
 - TM or SM above and to the right of the mark.

Trademark - Duration

- Perpetual
 - So long as source identifying quality is maintained
 - For registered marks, maintenance must be performed in order to retain registration benefits..

Trademark - Loss of Rights

XEROX

Once a trademark, not always a trademark.

They were once proud trademarks, now they're just names. They failed to take precautions that would have helped them have a long and prosperous life. We need your help to stay out of them. Whenever you use our name, please use it as a proper adjective in connection with our products and services only. Xerox copiers or Xerox financial services. And never as a verb.

With your help and a pronunciation or two on our part, we'll keep the Xerox trademark, always the Xerox trademark.

Team Xerox. We document the world.

XEROX

Not even Xerox can Xerox.

In fact, nobody can Xerox. Or have something Xeroxed. You can copy or have something copied, but you just can't Xerox.

That's because the Xerox trademark is not a verb. It's a proper adjective that should always be followed by a word or phrase describing one of our products. As in Xerox copiers, Xerox electronic typewriters, Xerox laser printers, etc.

We're proud of our trademark. It's valuable to us. And to you. It's how you can be sure that when you ask for a Xerox product, you'll get a Xerox product. Not something else.

So, if you would, make a copy of this advertisement and place it near your Xerox copier. Then everyone who copies will know that no one can Xerox.

Not even Xerox.

XEROX® is a trademark of XEROX CORPORATION.

Trademark - Infringement

- Likely to cause confusion in the minds of consumers as to the source, affiliation or endorsement of goods and services
- Common Factors
 - the strength of the plaintiff's mark and whether it is protectable;
 - the degree of similarity between the marks;
 - the similarity of the products and services offered by the parties;
 - evidence of actual confusion;
 - the similarity of the marketing channels of the parties;
 - the sophistication of the buyers in the relevant market and the degree of care likely to be exercised by the buyer;
 - the defendant's intent in adopting the mark; and
 - the likelihood of expansion of the product line or services

Trademark - DAMAGES

- Monetary Relief
 - Lost profits
 - Infringer's profits
 - Statutory damages for domain name related infringement of up to \$150,000
 - Attorney's fees
- Injunctions
- Destruction of Infringing Articles

Trademarks - Tips

- If your just starting, select a strong protectable mark.
 - Tell consumers what your product or service is using a tag line.
- Don't use the mark of another on your site, in your domain name or in your URL path.
- Preserve the source indicating quality of your marks.
- If a domain name is available grab it, then do the search. For about \$20 it is cheaper to get it an not use it than negotiate the acquisition later.

Trademark Questions

TRADE SECRETS

Trade Secrets

- PRIMARILY STATE LAW BASED INTELLECTUAL PROPERTY
 - Information, (including a formula, pattern, compilation, program, device, method, technique, product, system, process, design, prototype, procedure, computer programming instruction or code) that (1) is economically valuable due to it not being generally publicly known and (2) is the subject of efforts that are reasonable under the circumstances to maintain its secrecy.
- Federal laws will assist in theft of trade secrets in interstate and foreign commerce

Trade Secrets - Economic Value From Secrecy

- Trade secret protections are a commercial protection
 - Does not protect non-commercial information
 - Must have actual economic value, in whole or in part, due to its secrecy



Trade Secrets - Economic Value From Secrecy

- MUST BE SUBJECT TO REASONABLE EFFORTS TO KEEP IT SECRET



Trade Secrets - Economic Value From Secrecy

- MUST BE SUBJECT TO REASONABLE EFFORTS TO KEEP IT SECRET
 - Use reasonable efforts to prevent disclosure
 - Use non-disclosure agreements to protect the information prior to making a disclosure
 - Educate employees
 - Have written employment agreements
 - Perform employee exit interviews

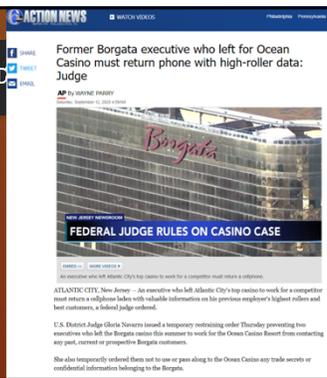
Trade Secrets

- Through Employees
 - Perform hiring interviews and identify any potential employees with prior agreements
 - Do not hire employees to perform jobs that will inevitably require them to rely on the trade secrets of another
 - Do not engage in questionable methods to obtain information

Trade Secrets - Damages

- (Depends on the law of the state)
- Monetary damages
- Lost profits, unjust enrichment
 - In Nevada, it may be double damages in some cases
- Reasonable royalty
- Attorney's fees
- Federal - prison not to exceed 10 years for trade secret theft, prison not to exceed 15 years for economic espionage, plus monetary damages and fines in the court's discretion

Trade Secrets - D



Trade Secrets



Trade Secrets

Trade Secrets - tips

- Treat valuable information as you would a valuable tangible asset
- Limit access to information
- Limit use of information
- Limit technology that can access information
- Employee manuals and agreements
- Employee education

Trade Secret questions

RIGHTS OF Publicity

Rights of Publicity

- Varies by state and country
 - Not every state or country provides protection for commercial rights in someone's persona

Rights of Publicity

RIGHT OF PUBLICITY

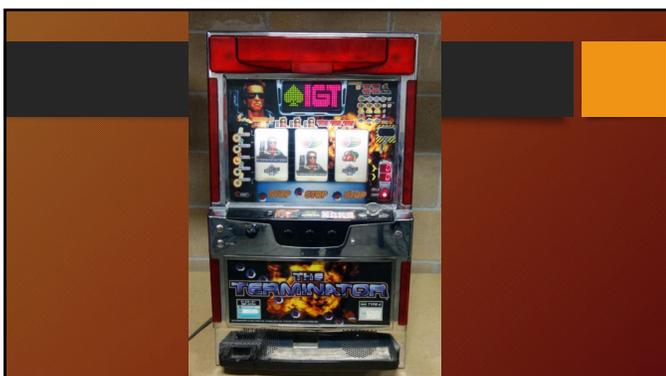
[SRS 597.770](#) Definitions.
[SRS 597.780](#) Scope.
[SRS 597.790](#) Existence and term of right; written content required for commercial use; exceptions.
[SRS 597.800](#) Transferability of right; commercial use upon death; rights of successors in interest; registration of claim; fee.
[SRS 597.810](#) Remedies for unauthorized commercial use; liability of owner or employee of medium used for advertising.

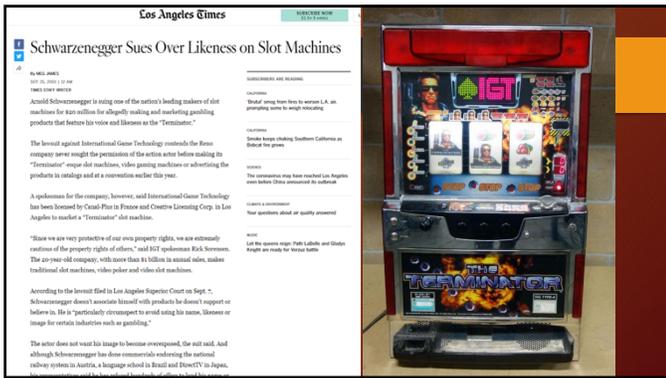
Rights of Publicity

- NRS 597.790 Existence and term of right; written consent required for commercial use; exceptions.
 - 1. There is a right of publicity in the name, voice, signature, photograph or likeness of every person. The right endures for a term consisting of the life of the person and 50 years after his or her death, regardless of whether the person commercially exploits the right during his or her lifetime.

Rights of Publicity

- NRS 597.810 Remedies for unauthorized commercial use; liability of owner or employee of medium used for advertising.
- 1. Any commercial use of the name, voice, signature, photograph or likeness of another by a person, firm or corporation without first having obtained written consent for the use is subject to:
 - (a) Injunctive relief to prevent or restrain the unauthorized use; and
 - (b) An action at law for any injuries sustained by reason of the unauthorized use. In such a suit, the plaintiff may recover:
 - (1) Actual damages, but not less than \$750; and
 - (2) Exemplary or punitive damages, if the trier of fact finds that the defendant knowingly made use of the name, voice, signature, photograph or likeness of another person without the consent required by NRS 597.790.





RIGHTS OF PUBLICITY
questions

Primary Areas of Concern

- Trademarks
 - New products
 - New services
 - New offerings
- Copyright
 - Infringement in promotions
 - Infringement in marketing materials
- Trade Secrets
 - Infringement by new employees
 - Infringement by departing employees

