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Intellectual Property Issues Affecting Schools

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Intellectual property questions are probably not at the top of a school attorney's "frequently asked questions" list, but they cause angst and consternation simply because intellectual property law has its own unique reasoning that differs considerably from most other legal disciplines. Though not quite as perplexing as real property law, intellectual property is a rapidly developing field, and it seems to parallel technology law in the pace of its development.

The topics below frame discussions of a few more common (or more interesting) areas where intellectual property law affects schools. There are few case law examples of public schools in copyright or trademark infringements, but there are ample examples in a university or governmental context. The appendix to this paper lists some useful intellectual property resources for attorneys and school personnel.

TRADEMARK

Trademarks can be protected and registered under both state and federal laws. *See, e.g.* 15 U.S.C.A. §§ 1051-1141 (West 2013), *and* Tex. Bus. & Comm. Code Ann. §§ 16.001-.107 (West 2013). With the recently amended Texas trademark statute (effective Sept. 1, 2012), Texas law now parallels federal trademark law to a significant extent. Trademarks can be registered of just about anything—words or images— and the words don't even have to be real words. For example, legendary Los Angeles Lakers coach Pat Riley has registered the term "three peat" (in every possible permutation) under his corporate umbrella, Riles & Company.

Trademarks are available in two forms: trademarks and service marks. 15 U.S.C.A. §§ 1052-.1053; Tex. Bus. & Comm. Code Ann. § 16.001. A "trademark" is a word, name, symbol, or device (or any combination thereof) that serves to identify and distinguish goods from those of another person or firm. Tex. Bus. & Comm. Code Ann. § 16.001. A "service mark" is a word, name, symbol, or device (or any combination thereof) that serves to identify and distinguish services from those of another person or firm. *Id.* When referring to trademarks and service marks generally, one typically uses the term "marks." This paper will follow that convention, noting specifically if a comment refers to only a trademark or a service mark.

Registration

Marks may be registered with either the United States Patent and Trademark Office (USPTO) or the Texas Secretary of State (TSOS). A mark registered with the USPTO protects the mark's owner from infringement of that mark anywhere in the United States. (International registration is available at an additional fee, but since it is unlikely that a Texas school mark would need international protection, this paper will not address such registration.) A mark registered with the TSOS protects the owner's mark from infringement of that mark anywhere within the state of Texas. If a mark is registered in Texas by one entity, then the same or similar mark is subsequently registered at the USPTO by a different entity, the Texas mark will have seniority for use of that mark in Texas only.

The fee to register a federal mark varies from \$275 per class in which it is registered to \$375 per class, depending on the method of registration (paper registration being most expensive). 37 C.F.R. §§ 2.6(a)(1)(i)-(iii). The fee to register a mark in Texas is \$50 per class in which it is registered, and marks cannot be registered electronically at this time. 1 T.A.C. § 93.151(a)(1). Because a Texas school's mark is not likely to have value outside the state of Texas, in most cases Texas registration is sufficient for school purposes.

Under Texas law, a mark may not be registered if it is already registered in either the United States (country-wide registration, which includes Texas) or in Texas. Tex. Bus. & Comm. Code Ann. § 16.051(a)(7). A mark may not be registered if it contains any of the following:

- Matter that is immoral, deceptive, or scandalous;
- Matter that might disparage or falsely imply a connection with or bring into contempt or disrepute:
 - Any person, living or dead;
 - An institution;
 - A belief; or
 - A national symbol;
- Depicts or simulates a flag, coat of arms, or insignia of:
 - The United States;
 - A state;
 - A municipality; or
 - A foreign country;
- Includes the name, portrait, or signature of any living individual who has not consented in writing;
- Is merely descriptive or deceptively misdescriptive of the goods or services;
- Is primarily geographically descriptive or deceptively misdescriptive of the goods or services;
- Is primarily a surname; or
- Is likely to cause confusion, mistake, or to deceive because the mark resembles:
 - A mark registered in Texas; or
 - A mark registered in the USPTO.

Tex. Bus. & Comm. Code Ann. § 16.051(a). But for descriptive, geographic, or surname marks that have been in use for 5+ years, a mark might be declared “distinctive” and eligible for registration. Tex. Bus. & Comm. Code Ann. § 16.051(b). This exception can help out a school district wishing to register a mark containing the name of town or district.

Familiarity with the rules and guidelines of the USPTO is required in order to register a Texas mark. For example, an application for a mark must include “a description of the goods or services on or in connection with which the mark is being used.” Tex. Bus. & Comm. Code § 16.052(b)(4). This is generally called the “class” and a mark may apply to more than one class (with a cost per class). Classes of registration are similar between the USPTO and the TSOS. While schools typically fall in class 41, check the USPTO *Acceptable Identification of Goods and Services Manual* (available at: <http://tess2.uspto.gov/netathtml/tidm.html>) for specific required wording. It is not impossible to “tweak” such descriptors slightly. For example, the Texas trademark examiner rejected “K-12 educational services” as an appropriate descriptor,

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