



AUSTIN  
CHARLOTTE  
CHICAGO  
DALLAS  
DALLAS - NORTH  
DENVER  
FORT WORTH  
HOUSTON  
LONDON  
MEXICO CITY  
NEW YORK  
ORANGE COUNTY  
PALO ALTO  
SAN ANTONIO  
SHANGHAI  
THE WOODLANDS  
WASHINGTON, D.C.

## Intellectual Property and Bankruptcy post *Mission Products*

May 2020

haynesboone

© 2020 Haynes and Boone, LLP

### Intellectual Property and Bankruptcy post Mission Products

1. The Basics of Bankruptcy
2. Perfecting Security Interests in Intellectual Property
  - Patents
  - Trademarks
  - Copyrights
  - Trade Secrets
3. Legal Considerations Involving IP Licenses
  - Executory Contracts Generally
  - Assumption of Executory Licenses
  - Rejection of Executory Licenses

## The Basics of Bankruptcy

### An Overview of Bankruptcy Law

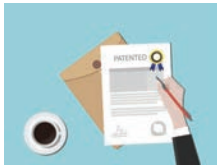
When a debtor files for bankruptcy:

- (i) a bankruptcy estate is automatically created, which encompasses all legal or equitable interests of debtor's property;
- (ii) a trustee (or debtor-in-possession) is appointed to administer the bankruptcy estate; and
- (iii) an automatic stay is imposed to protect the bankruptcy estate from creditors' collection activities.

Property of the estate provides the source of distributions to creditors.

Priority amongst creditors in bankruptcy is determined by applicable state and federal laws governing perfection of security interests.

## Perfecting Security Interests in Intellectual Property



### Patents

#### **File UCC-1 to Perfect Security Interest**

The Patent Act does not address security interests, so a secured creditor should file a UCC-1 financing statement in the state where the debtor is located to provide notice to subsequent lien creditors.

#### **Permissive Recordation with USPTO**

License agreements and security agreements will be accepted and recorded by the USPTO to provide notice of interests in or ownership of patents or applications to bona fide purchasers and mortgagees.

## Perfecting Security Interests in Intellectual Property



### Trademarks

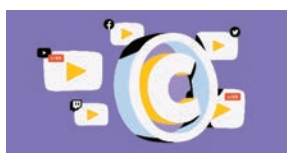
#### File UCC-1 to Perfect Security Interest

The Lanham Act, like the Patent Act, does not address the recordation of security interests, so a secured creditor should file a UCC-1 financing statement in the state where the debtor is located to provide notice to subsequent lien creditors.

#### Permissive Recordation with USPTO

The USPTO also accepts documents that relate to interests in trademarks and trademark applications to provide notice to third-party purchasers and lien creditors.

## Perfecting Security Interests in Intellectual Property



### Copyrights

#### Perfection of Registered Copyrights

Recording a security interest in a registered copyright with the U.S. Copyright Office “gives all persons constructive notice of the facts stated in the recorded document.”

A security interest will prevail over a later-executed transfer if recorded (1) within one month after its execution in the U.S., (2) within two months after its execution outside of the U.S., or (3) otherwise before the later-executed transfer is recorded.

#### Perfection of Unregistered Copyrights (Circuit Split)

- Some courts hold that the correct approach to perfect a security interest in an unregistered trademark requires recordation with the Copyright Office.
- Other courts hold that perfection of unregistered copyrights is a state law issue, and accordingly, can only be achieved by filing a UCC-1 financing statement.

**For Valuable Copyrights:** Register the debtor's unregistered copyright and record the security agreement with the Copyright Office.

Find the full text of this and thousands of other resources from leading experts in dozens of legal practice areas in the [UT Law CLE eLibrary \(utcle.org/elibrary\)](https://utcle.org/elibrary)

## Title search: Intellectual Property and Bankruptcy Post Mission Products

Also available as part of the eCourse

[2020 Technology Law eConference](#)

First appeared as part of the conference materials for the  
33<sup>rd</sup> Annual Technology Law Conference session

"Intellectual Property and Bankruptcy Post *Mission Product Holdings*"