

Complimentary Virtual CLE Conference

CLIMATE PRO BONO BOOTCAMP

Learn the skills you need to provide pro bono support to climate-friendly causes, communities, and startups!



Day 1: Wednesday, January 17, 12:30 - 2:30 PM ET Day 2: Thursday, January 18, 12:30-2:30 PM ET

PRESENTED BY:



The planetary lawyer project



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Matthew A. Karmel

Chair,
Offit Kurman Environmental & Sustainability
Law Group

Founder,
The Planetary Lawyer Project

Matthew Karmel is passionate about sustainability and the environment and has been recognized by Best Lawyers in America®, Super Lawyers, Waste360, NJBiz and others for his leadership on climate and environmental issues.

Matthew leads the Environmental and Sustainability Law Group at Offit Kurman, a full-service AM Law 200 law firm, and one of the fastest growing law firms in the United States. The group's seasoned attorneys counsel clients ranging from publicly held companies to individual homeowners on the full range of environmental matters, whether involving transactions and commercial arrangements, litigation and alternative dispute resolution, or regulatory compliance and permitting. The group also provides guidance and support to climate-focused businesses and any company advancing sustainability.

Matthew also is the founder of The Planetary Lawyer Project, a newsletter for lawyers who want to do more for the planet, including a bi-weekly newsletter sharing curated job openings, pro bono opportunities, interviews with industry leaders, and your next climate-friendly client.



the planetary lawyer project

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Week of 1/15 - Climate Pro Bono Bootcamp!

Welcome to the 150+ lawyers that joined this newsletter while signing up for the Climate Pro Bono Bootcamp! My name is Matthew Karme...

JAN 15 • THE PLANETARY LAWYER PROJECT



Week of 10/21 - How to get an in-house job in renewables with Jeff Vercauteren

How can you get an in-house job in the renewables industry? Do you need prior experience in renewables?Thanks for reading the planetar...

OCT 21, 2023 • THE PLANETARY LAWYER PROJECT



Week of 9/9 - The worst article I've ever read on becoming an environmental lawyer

Welcome to the new readers who have subscribed while signing up for our upcoming webinar! If you want to find out how any lawyer ca...

SEP 9, 2023 • THE PLANETARY LAWYER PROJECT



Week of 12/4 - My biggest key to climate career growth

What do I think is the most important key to climate career growth? Consistency. Real growth comes when we work towards a goal...

DEC 4, 2023 • THE PLANETARY LAWYER PROJECT



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OUR FACULTY

- **Leonard Adler** – Green Jobs Network
- **Elizabeth Crouse** - Perkins Coie LLP
- **Stephanie Demetry** - Green Pro Bono
- **Matthew Eisenson** - Columbia Law School, Sabin Center
- **Matthew A. Karmel** - Offit Kurman, P.A.
- **Insung Kim** - Dechert LLP
- **Josh Kim** - Dechert LLP
- **Ellen Mathews** - Burr & Forman
- **Michael Showalter** - Arent Fox Schiff LLP
- **Yana Spitzer** - ENGIE North America
- **Kevin R. Watkins** - RWE Clean Energy



DAY 1

Wednesday, January 17, 12:30 - 2:30 PM ET

12:30 - 1:00 PM ET: How (and why!) to do climate pro bono

Matthew A. Karmel (Offit Kurman), Leonard Adler (Green Jobs Network) and Stephanie Demetry (Green Pro Bono)

1:00 – 2:00 PM ET: Use capitalism to combat climate change! Pro bono perspectives on green corporate formation, tax considerations, and compliance

Josh Kim (Dechert), Insung Kim (Dechert)

2:00 - 2:30 PM ET: Regulating climate? How to interpret (and change!) regulations for the climate good

J. Michael Showalter (ArentFox) and Matthew A. Karmel (Offit Kurman)



DAY 2

Thursday, January 18, 12:30 - 2:30 PM ET

12:30 - 1:30 PM ET: Approaches (and skills) for advancing renewable energy implementation through pro bono
Matthew A. Karmel (Offit Kurman), Elizabeth Crouse (Perkins Coie), Yana Spitzer (ENGIE North America), Kevin R. Watkins (RWE), and Matthew Eisenson (Sabin Center)

1:30 - 2:20 PM ET: Safeguard the planet through IP protections! An overview of IP-related climate pro bono
Ellen Mathews (Burr & Forman)

2:20 - 2:30 PM ET: Closing Takeaways
Matthew A. Karmel (Offit Kurman) and Green Pro Bono

ABOUT THE WEBINAR



- How can you obtain CLE for participating in this event?
- How can you ask questions during the event?
- Will the recording be made available?
- How can you donate to Green Pro Bono?
- What is the case for climate pro bono?

Climate Pro Bono Bootcamp

Leonard Adler

GREEN JOBS NETWORK

FOR A HEALTHIER & MORE JUST WORLD

Why Do Climate Pro Bono?

- Quick Intro
- The Case for Climate Pro Bono
- Example

Quick Intro

Climate Law Jobs

Practice with a Purpose

From Green Jobs Network



The Case for Climate Pro Bono

- Meeting the Moment
- Benefits
 - Professional Development
 - Intrinsic
- Reflect

Meeting the Moment

Applications to Constellations Fellowship



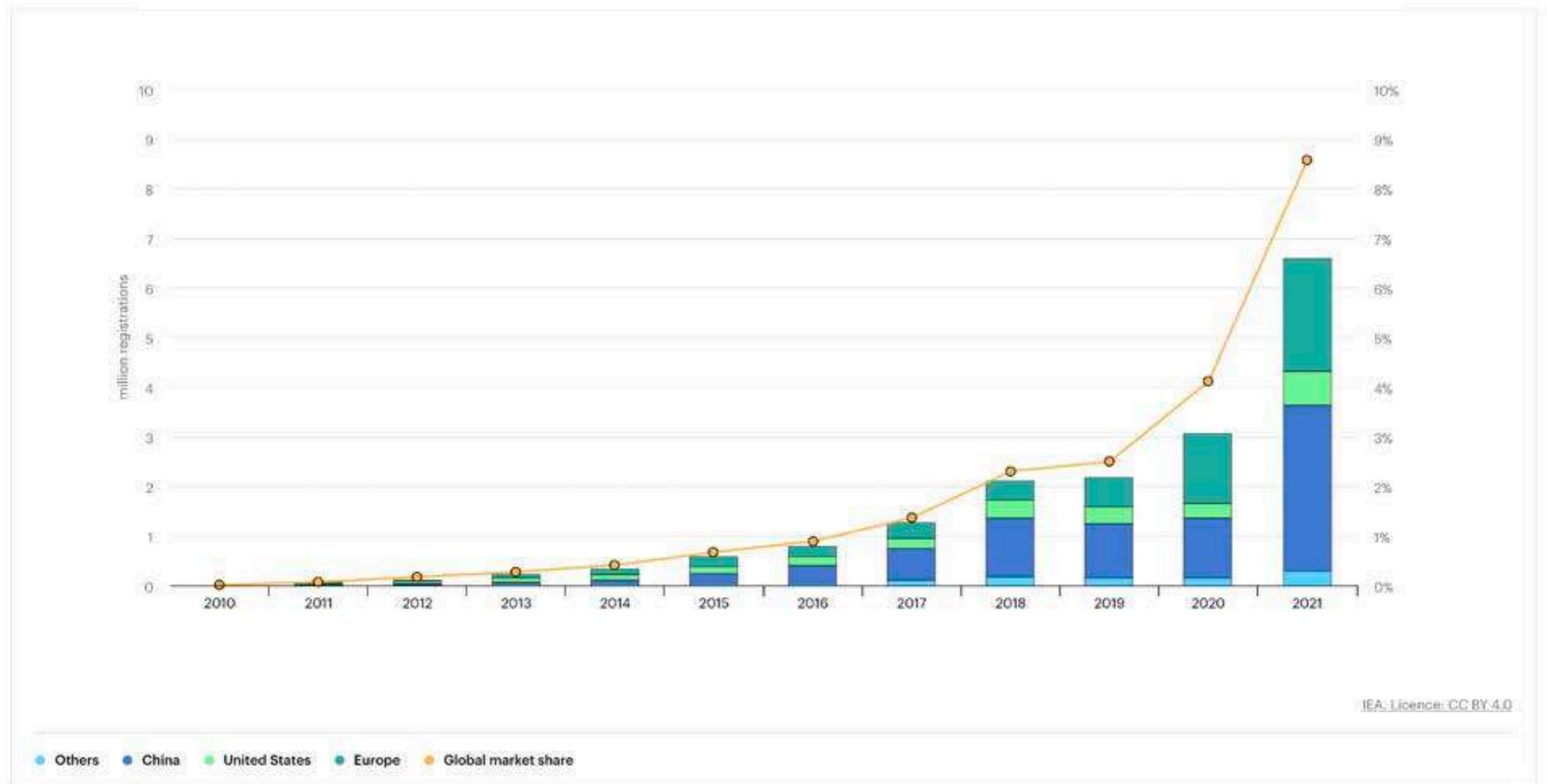
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increase in the number of
fellowship applications this
semester.

We're fostering the next generation of climate leaders by connecting students and recent grads to professional opportunities within our global network of climate organizations.

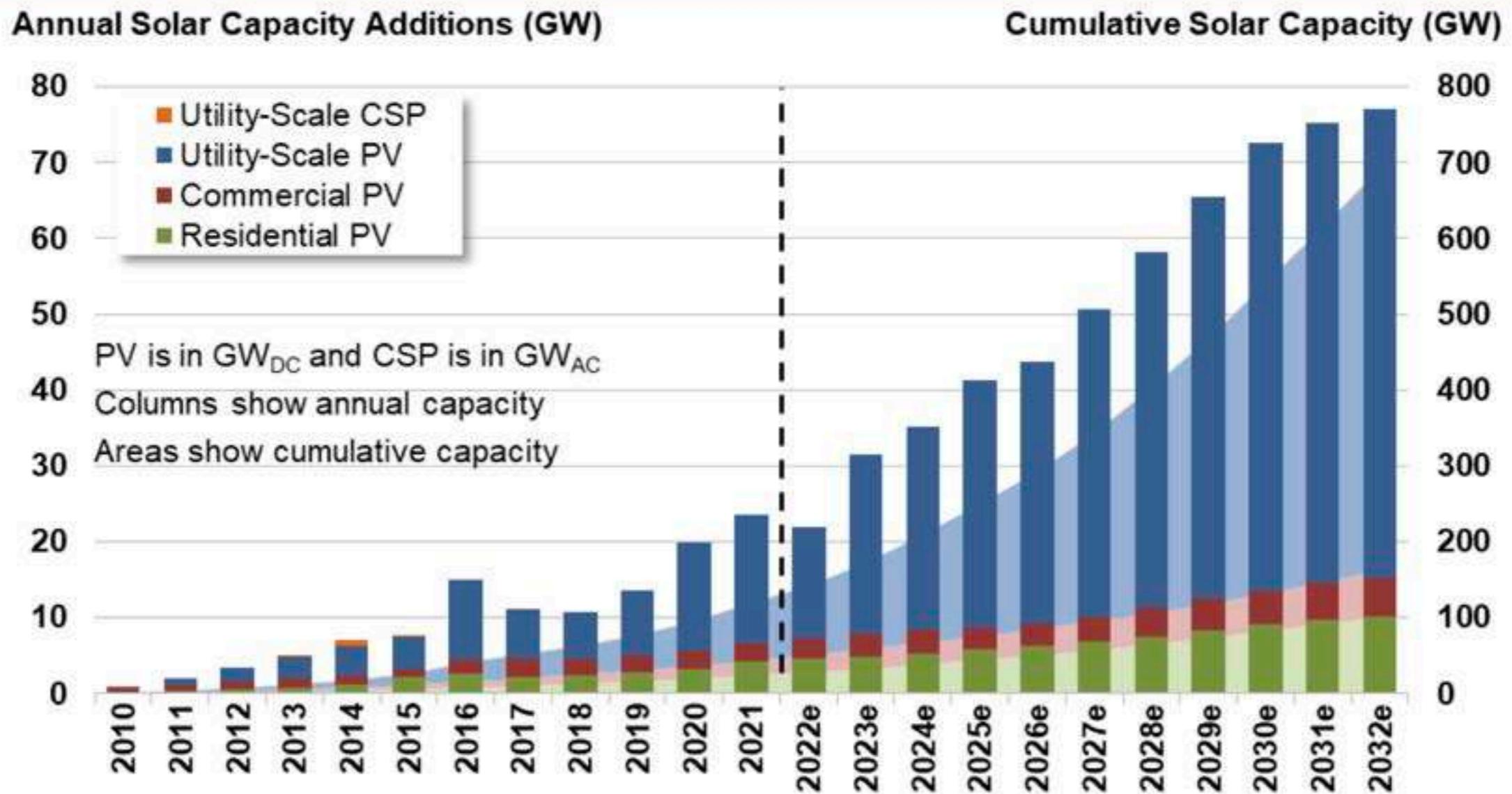
Meeting the Moment

Global sales and sales market share of electric cars



Meeting the Moment

Solar Energy Capacity Growth (U.S.)



Sources: Wood Mackenzie/SEIA Solar Market Insight Reports, Berkeley Lab

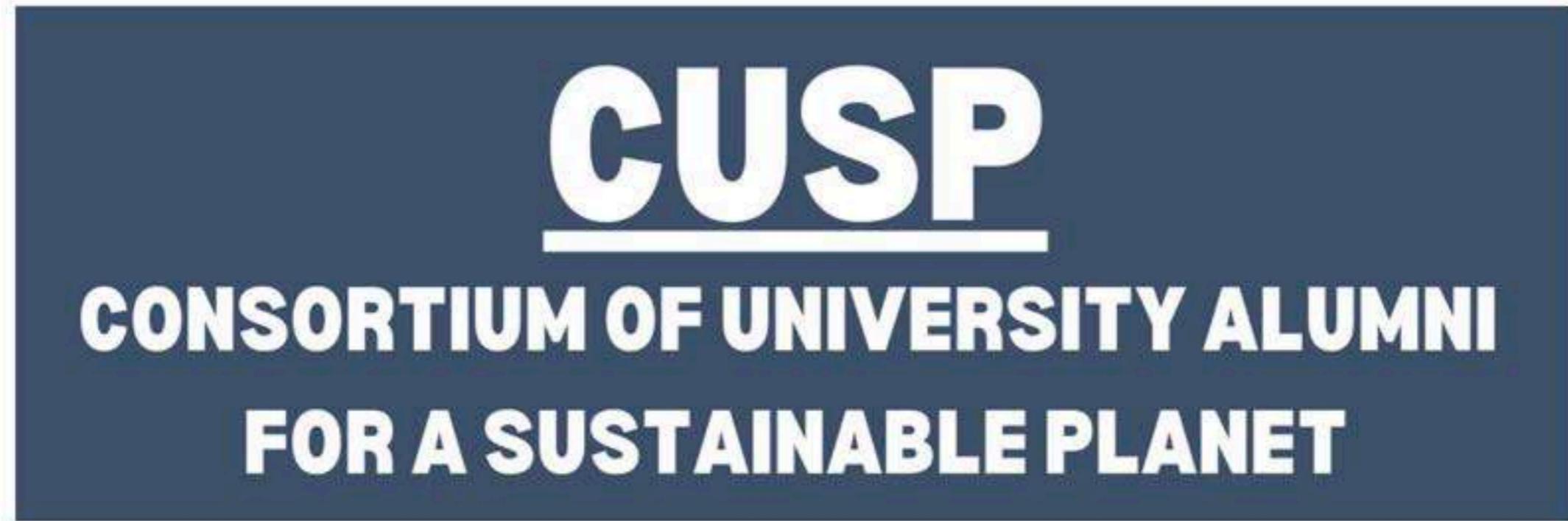
The Case for Climate Pro Bono

- Meeting the Moment
- Benefits
 - Professional Development
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- Reflect

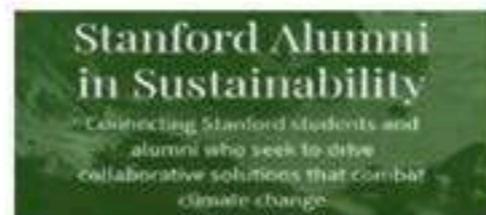
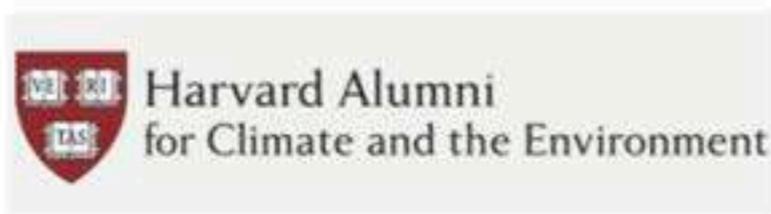
The Case for Climate Pro Bono

- Meeting the Moment
- Benefits
 - Professional Development
 - Intrinsic
- Reflect

Case Study: CUSP



FOUNDING MEMBERS



Thank You!

Leonard Adler
leonard@greenjobs.net
<http://www.greenjobs.net>

GREEN JOBS NETWORK

FOR A HEALTHIER & MORE JUST WORLD

Frequently Asked Questions – Entity Formation

Joshua Kim (Corporate) | Insung Kim (Tax)

January 17, 2024

Dechert
LLP

The Corporate Transparency Act

- New reporting requirements designed to prevent the misuse of legal entities for illicit purposes such as money laundering, financing terrorism and tax fraud.
- Beginning January 1, 2024, “reporting companies” must disclose their “beneficial owners” to the Financial Crimes Enforcement Network (FinCEN) of the U.S. Department of the Treasury (January 1, 2025 for pre-2024 entities).
- **Junior associates:** Please familiarize yourself with the new law and follow your firm’s policy.
- **In-house counsel:** Please discuss with management team.

What structure is best for my business?

Getting to know the client

1. **Ownership** - Number of equityholders
2. **Governance** - Number of managers or directors
3. **Desired level of formality** - Administrative complexity
4. **Business model** - Sales vs. Donation
5. **Tax considerations:**
 - a. Choice of Entity:
 - i. Disregarded entity
 - ii. Partnership/LLC
 - iii. C corporation
 - iv. S corporation
 - b. Nonprofits

Certified B Corporation & Benefit Corporation

1. **Certified B Corporation (“B Corp”)** = Designation
 - a. Take the B Impact Assessment from a nonprofit called B Lab.
 - b. Recertification is needed every two years.
 - c. Increased transparency and accountability.

2. **Benefit Corporation** = Legal business structure
 - a. Either incorporate as a benefit corporation or amend governing documents.
 - b. No assessment (e.g., certification), but reporting is required.
 - c. Traditional corporations’ focus on shareholders and maximizing profit vs. Benefit corporations’ focus on having an impact on all stakeholders (shareholders, employees, community, the environment).

3. In practice, unlikely to be suitable for most pro bono clients (compliance and reporting burdens).

What are the actual steps to forming an entity?

Paperwork: Organizational Documents / Filing Requirements

1. **General Partnership** – not required
2. **LLC** – LLC Agreement and Certificate of Formation
3. **Corporation** – Bylaws and Articles of Incorporation
4. **Non-profit corporation** – Bylaws, Certificate of Incorporation, and *for tax-exempt status*:
 - a. **Certificate of Incorporation** needs to include: a statement of purpose that meets IRS requirements; provision regarding non-qualifying activities or prohibited activities, such as political or legislative activities; a dissolution provision dedicating the corporation's assets to another 501(c)(3) organization or to the government upon dissolution.
 - b. **Form 1023 / 1023-EZ federal tax exemption application** (EZ is a streamlined version that can be used by smaller nonprofits).

Non-Profit Corp Charter – Example Language

Corporation and Purpose. The Corporation shall be a “charitable nonstock corporation” as defined in Section 114(d)(1) of the Delaware General Corporation Law (the “DGCL”; reference to a particular provision of the DGCL shall be deemed to refer to any corresponding successor provision of the DGCL, or successor thereto) and shall be an “exempt corporation” as such term is defined in Section 501(b) of the DGCL. **The Corporation is organized and shall be operated exclusively for charitable, educational, religious, scientific, literary and such other purposes set forth in Section 501(c)(3) of the Internal Revenue Code of 1986, as amended (the “Code”; reference to a particular provision of the Code shall be deemed to refer to any corresponding successor provision of the Code, or successor thereto), including the making of grants and contributions to other organizations that qualify as exempt organizations under Section 501(c)(3) of the Code. More specifically, the Corporation’s purpose is...**

Non-Profit Corp Charter – Example Language

Prohibited Activities. The Corporation may engage in all activities consistent with its purposes set forth in Article III hereof; provided that, at all times, notwithstanding the merger, consolidation, reorganization, termination, liquidation, dissolution or winding-up of the Corporation, whether voluntary or involuntary or by operation of law, or by any other provision of this Certificate:

(a) The Corporation shall not possess or exercise any power or authority, or engage, directly or indirectly, in any activity, that would prevent it at any time from qualifying and continuing to qualify as a corporation described in Sections 501(c)(3) and 170(c)(2) of the Code, contributions to which are deductible under Section 170(a)(1) of the Code;

(b) No substantial part of the activities of the Corporation shall consist of the carrying on of propaganda or otherwise attempting to influence legislation, nor shall the Corporation in any manner participate or intervene in any political campaign on behalf of (or in opposition to) any candidate for public office (including by publication or distribution of statements); and

(c) If in any taxable year the Corporation is a “private foundation” as defined in Section 509 of the Code, the Corporation (i) shall not engage in any act of self-dealing as defined in Section 4941 of the Code; (ii) shall distribute its income for each taxable year at such time and in such manner as not to subject the Corporation to the tax on undistributed income imposed by Section 4942 of the Code; (iii) shall not retain any excess business holdings as defined in Section 4943 of the Code; (iv) shall not make any investments in such a manner as to subject the Corporation to tax under Section 4944 of the Code; and (v) shall not make any taxable expenditures as defined in Section 4945 of the Code.

Prohibited Distributions. No part of the net earnings of the Corporation shall inure to the benefit of or be distributable to its directors, officers, members or other private persons, except that the Corporation shall be authorized and empowered to pay reasonable compensation for services rendered and to make payments and distributions in furtherance of the purposes set forth in Article III above.

Non-Profit Corp Charter – Example Language

Liquidation, Dissolution or Winding Up. In the event of liquidation, dissolution or winding up of the affairs of the Corporation (whether voluntary or by operation of law), the Board of Directors will, after paying or making any provision for the payment of all liabilities of the Corporation, **distribute all of the remaining assets of the Corporation to an organization or organizations organized and operated exclusively for one or more exempt purposes within the meaning of Section 501(c)(3) of the Code**, or to the federal government, or to a state or local government, for a public purpose, in each case, as the Board of Directors shall determine. Any such assets or property not so disposed of shall be disposed by a court of competent jurisdiction of the county in which the principal office of the Corporation is then located to such organization or organizations that are organized and operated exclusively for one or more such purpose, as determined by the court.

Paperwork: Post-Formation

1. **Obtaining EIN** – Application on the IRS website. In addition to tax filing purposes, needed for opening bank accounts, hiring employees.
 - a. Form SS-4 (especially important if you are applying on behalf of client)

2. **Foreign Qualification** – Requirements vary by state.

Tax Considerations

Taxation of Business Entities

- 1. Income Tax**
 - a. Differences among entity types:
 - i. Partnerships/LLCs
 - ii. Corporations
- 2. Sales Tax**
- 3. Employment Tax**
- 4. Nonprofits**
 - a. Compliance Considerations
 - b. Unrelated Business Taxable Income

Any Questions?

Regulatory State 101:

Using Guidance in the Climate Space for Non-Specialists

Presented by

J. Michael Showalter, ArentFox Schiff





ArentFox
Schiff



Basics

Rarely will you face
"first time"
questions.

- Guidance materials nearly always exist.
- Contacts can provide guidance.
- When in doubt, get help.

Don't go out on a
limb.

- Don't assume risk yourself.

Hierarchies of Authorities

Different Levels of Authority

- Constitution
- Statutes
- Formal regulations
- Guidance materials

Level of Authority Determines What You Can Do.

What is
Possible?

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Questions?

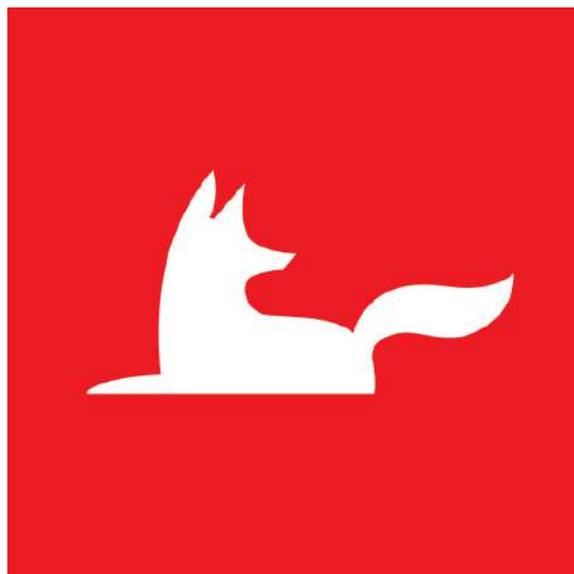
Contact:

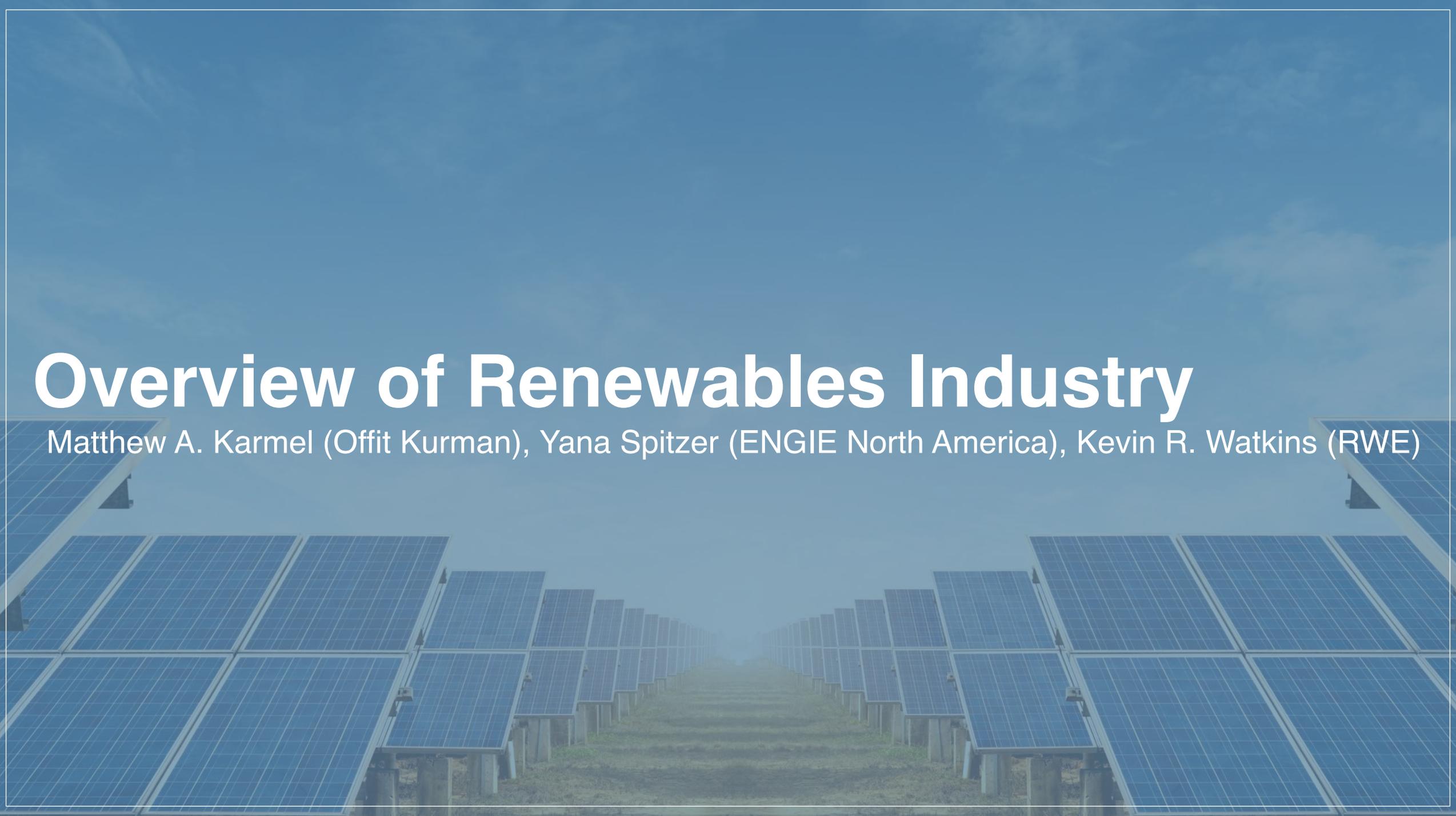
J. Michael Showalter

312.258.5561

j.michael.showalter@afslaw.com







Overview of Renewables Industry

Matthew A. Karmel (Offit Kurman), Yana Spitzer (ENGIE North America), Kevin R. Watkins (RWE)



PROJECT TYPES

- Behind-the-Meter Solar Projects
 - Residential
 - Commercial
 - Net-Metered
 - Zero Export
- Front-of-Meter Solar Projects
 - Community Solar Projects
 - Utility-Scale Solar Projects



OTHER RELEVANT CONCEPTS

- Types of Developers
- Financing
- Tax Credits/Tax Equity
- Transactions
- New Technologies, Battery Storage



OVERVIEW OF LEGAL ASPECTS / AGREEMENTS

Site Control and Real Estate

- Unique Aspects of “Renewables” Real Estate
- Option Agreement
- Lease Agreement
- Easements
- Title Issues

Land Use and Permitting

- Zoning and Land Use
- Environmental Permitting



OVERVIEW OF
LEGAL
ASPECTS /
AGREEMENTS

Interconnection

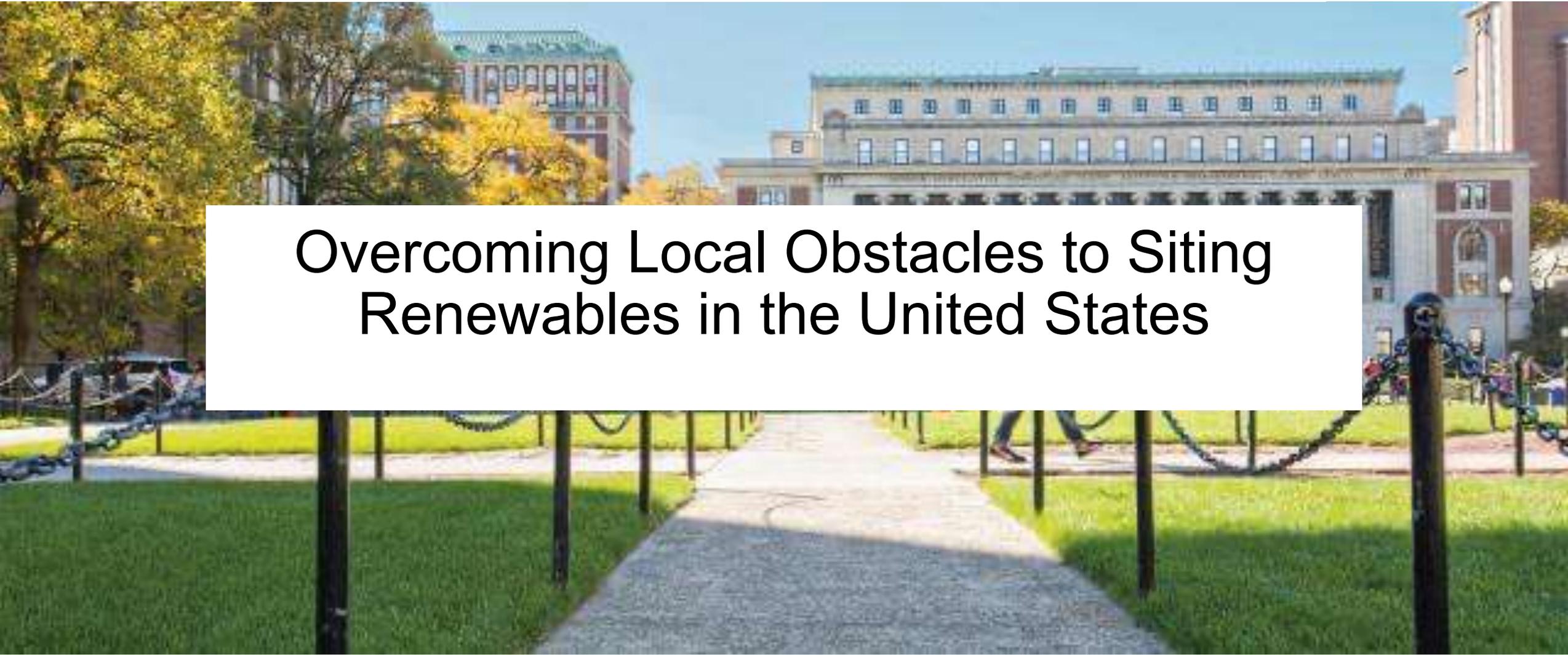
- Utilities and Interconnection Authorities
- Interconnection Stages/Agreements

Offtake Agreements/Power Purchase Agreements

Construction and O&M Contracts

QUESTIONS





Overcoming Local Obstacles to Siting
Renewables in the United States

Renewable Energy Legal Defense Initiative (RELDI)

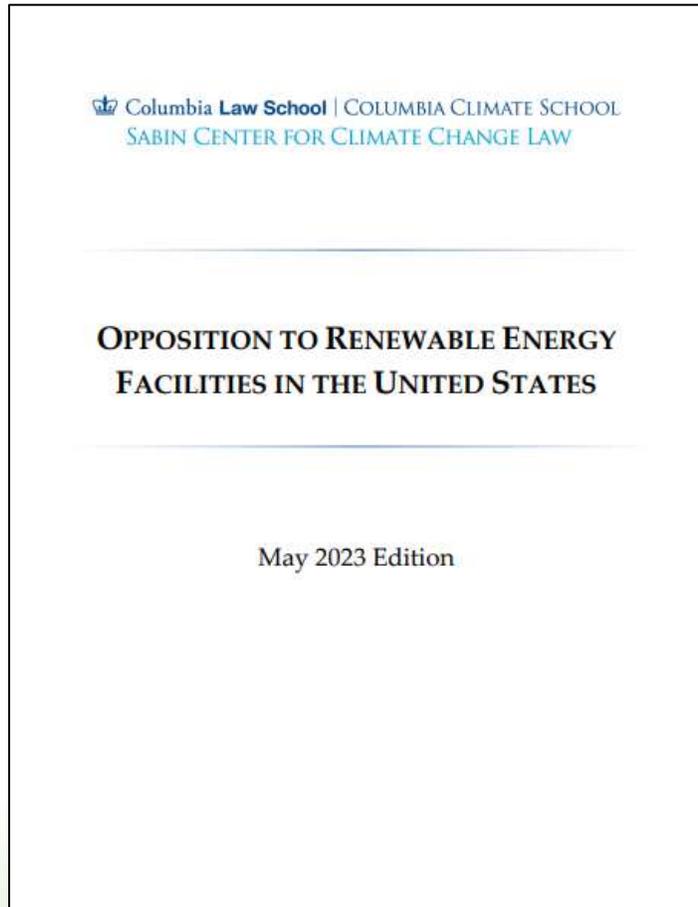
- **Research** on legal obstacles to siting renewables
- Assist in providing **pro bono legal support** to landowners and community groups who support individual wind and solar projects



Topics to cover

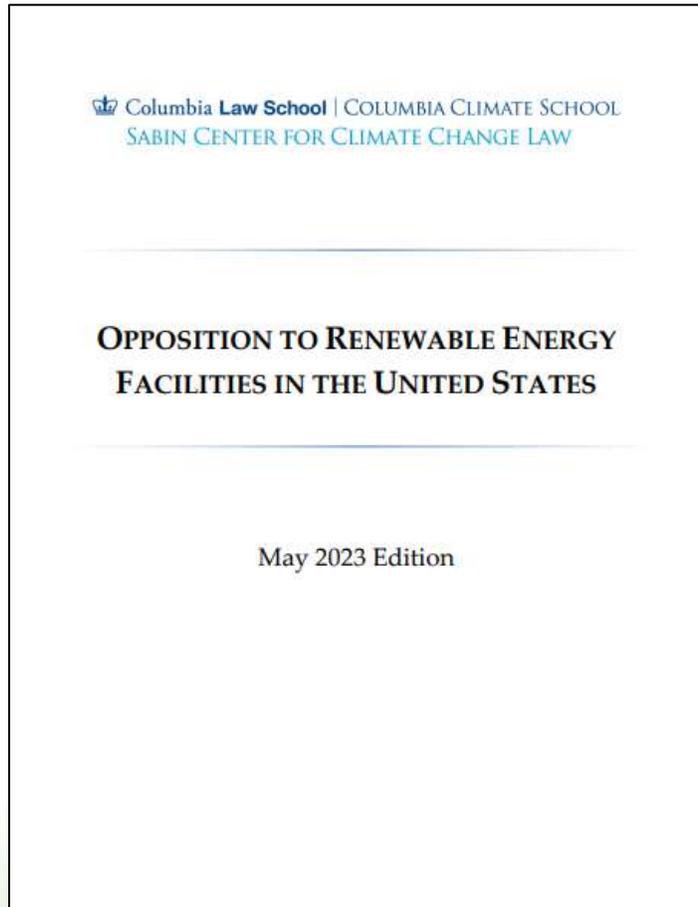
1. How big of a problem is opposition to renewable energy facilities?
2. What are states doing to make the siting process easier—or harder?
3. What can lawyers do?

Opposition to Renewable Energy Facilities in the United States (May 2023 Edition)



- **228 local restrictions** in 35 states that pose a significant obstacle to wind and solar development
- **293 contested projects** in 45 states that encountered serious organized opposition, including lawsuits

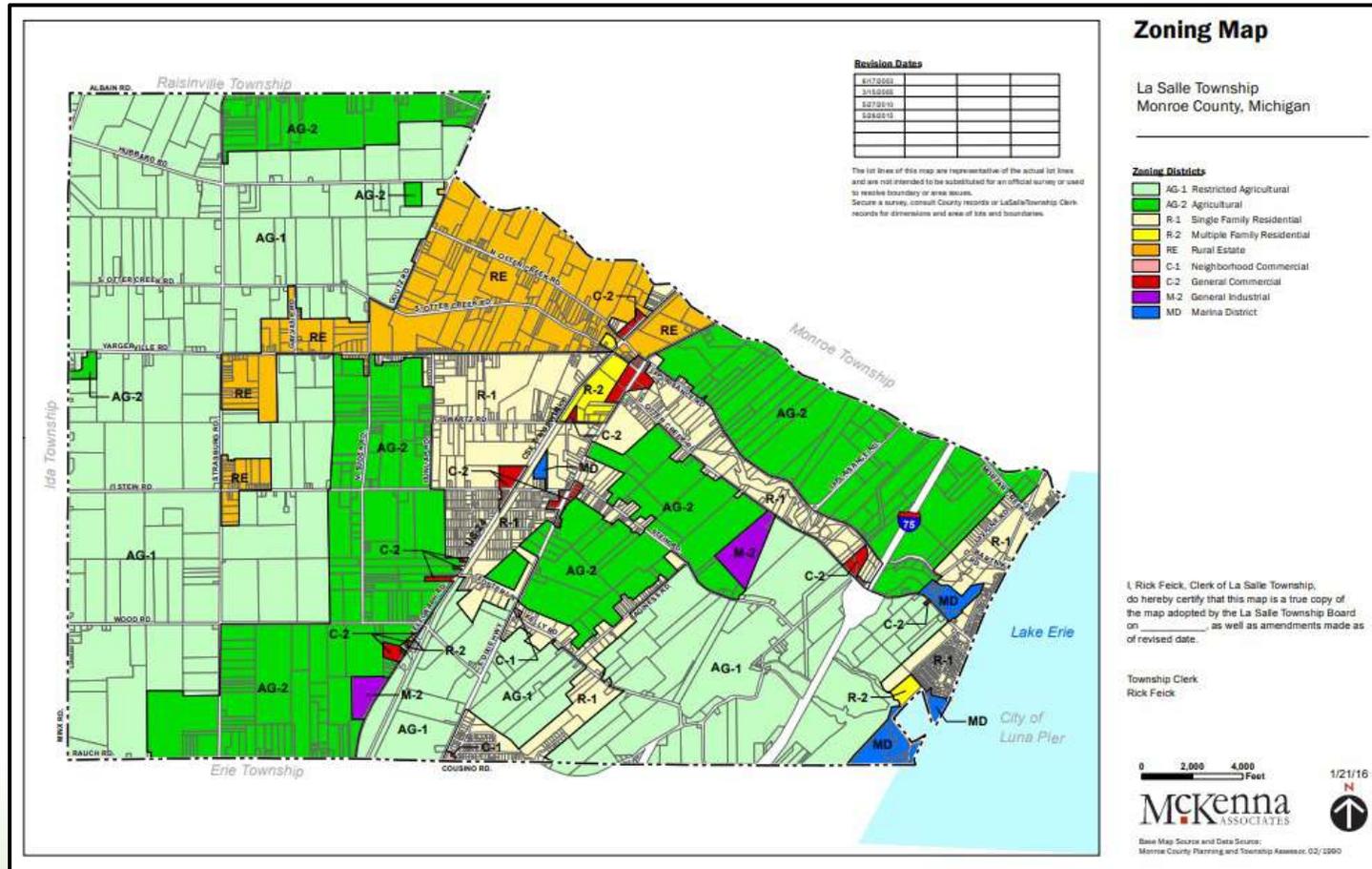
Opposition to Renewable Energy Facilities in the United States (May 2023 Edition)



- Massive increase in **outright bans** on renewable energy projects, especially in Ohio
- **Extreme setbacks** for wind turbines (3+ miles), especially in Nebraska
- Many new restrictions aimed at **prohibiting solar from agricultural land**, especially in Michigan

LaSalle Township, Michigan

Solar farms are now prohibited everywhere except the industrial zone (purple)



State-level Siting Reforms, 2020-2023

California (2022):
State approval for projects 50MW+

Illinois (2023):
Guardrails on local restrictions

Michigan (2023):
State approval for solar 50MW+ and wind 100MW+

Ohio (2021):
Counties can veto and ban renewables

New York (2020):
State approval for projects 20MW+

Florida (2021):
Solar permitted by right on farmland



New York Siting Reform (2020)

In deciding whether to grant a permit, the state Office of Renewable Energy Siting (ORES):

“may elect not to apply, in whole or in part, any local law or ordinance which would otherwise be applicable if it makes a finding that, as applied to the proposed major renewable energy facility, it is **unreasonably burdensome** in view of **the [state’s legislative climate] targets and the environmental benefits** of the proposed major renewable energy facility.”

New York Executive Law 94-c(5)(e)

Florida Siting Reform (2021)

Fla. Stat. 163.3205(3): “A solar facility **shall be a permitted use in all agricultural land use categories** in a local government comprehensive plan and all agricultural zoning districts within an unincorporated area”

Fla. Stat. 163.3205(4): “A county may adopt an ordinance specifying buffer and landscaping requirements for solar facilities. Such requirements **may not exceed the requirements for similar uses** involving the construction of other facilities that are permitted uses in agricultural land use categories and zoning districts.”

California Siting Reform (2022)

“The issuance of a certificate by the [California Energy] commission for a site and related facility pursuant to this chapter **shall be in lieu of** any permit, certificate, or similar document required by any state, local, or regional agency, or federal agency to the extent permitted by federal law, for the use of the site and related facilities, and **shall supersede** any applicable statute, ordinance, or regulation of any state, local, or regional agency, or federal agency to the extent permitted by federal law.”

Cal. Pub. Res. Code 25545.1(a)

Illinois Limits on County Setback Requirements (2023)

Setback Distances and Measurement Locations Standardized:

	Wind	Solar
School, place of worship, daycare, library, community center	2.1 times the maximum blade tip height	150 feet
Nonparticipating residences	2.1 times the maximum blade tip height	150 feet
Boundary lines of nonparticipating property	1.1 times the maximum blade tip height	50 feet
Public rights of way	1.1 times the maximum blade tip height	50 feet

Michigan Siting Reform (2023)

“If a certificate is issued [by the Michigan Public Utilities Commission], the certificate and this part **preempt a local policy, practice, regulation, rule, or other ordinance** that prohibits, regulates, or imposes additional or more restrictive requirements than those specified in the commission’s certificate.”

Mich. Public Act 233 of 2023, Sec. 231(3).

Ohio SB 52 (2021)

Counties may

1. Veto specific wind and solar projects
2. Designate a “**restricted area**” to prohibit or limit wind and solar development

16 Ohio Counties with Restricted Areas on Solar Power



Allen County Renewable Energy Development Zones



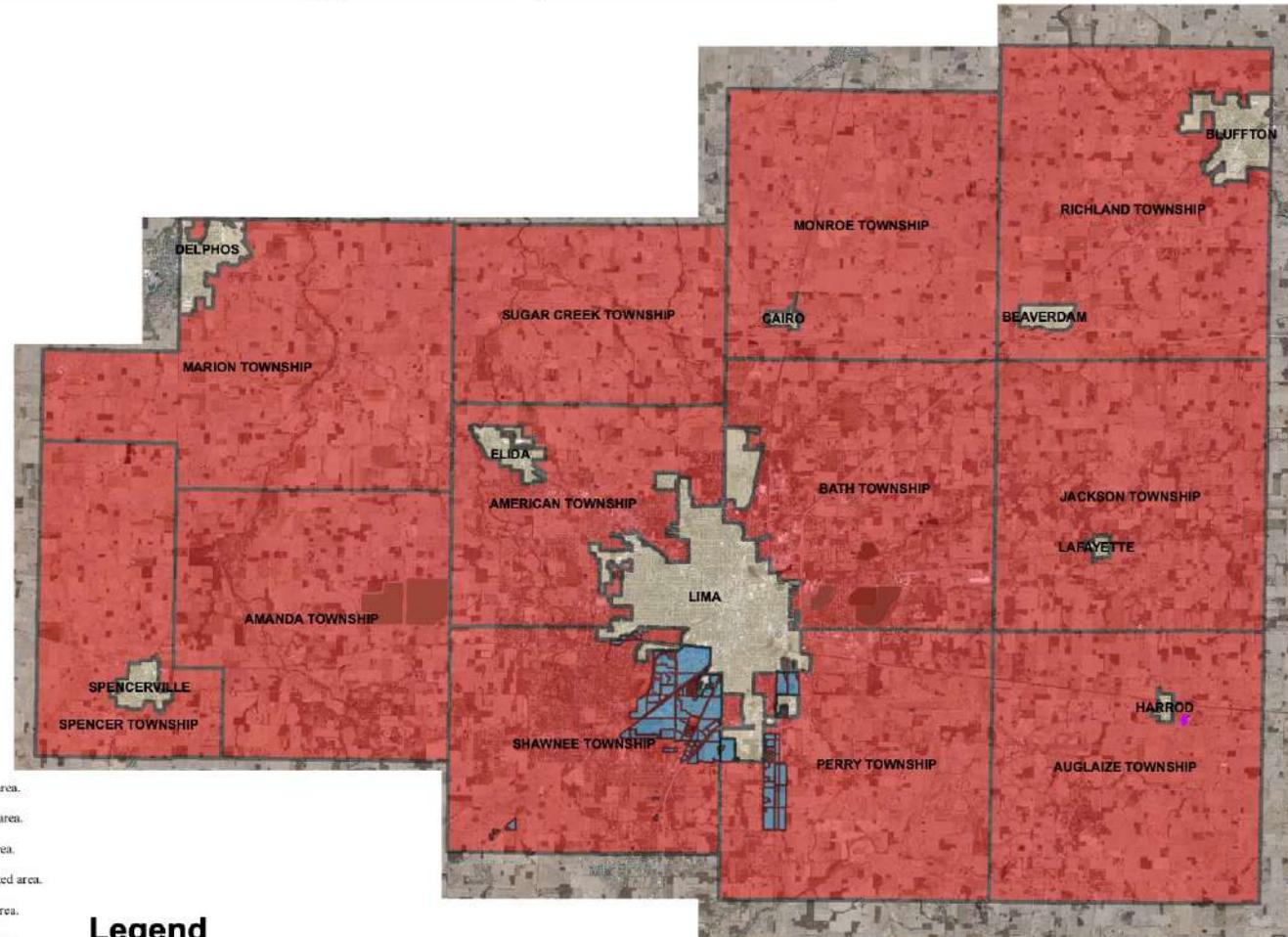
**Board of County Commissioners
Allen County, Ohio**

_____ Cory Noonan

_____ Beth Seibert

_____ Brian Winegardner

1. Amanda – All areas of the township designated as a restricted area.
2. Auglaize – All areas of the township designated as a restricted area.
3. Marion – All areas of the township designated as a restricted area.
4. Sugar Creek – All areas of the township designated as a restricted area.
5. Spencer – All areas of the township designated as a restricted area.
6. Monroe – All areas of the township designated as a restricted area.
7. Jackson – All areas of the township designated as a restricted area.
8. Richland – All areas of the township designated as a restricted area.
9. American – All areas of the township designated as a restricted area.
10. Bath – All areas of the township designated as a restricted area.
11. Perry – All areas of the township designated as a restricted area except for areas zoned general Industrial.
12. Shawnee – All areas of the township designated as a restricted area except for areas zoned Industrial.



Legend

- Incorporated Areas
- Restricted Zones
- Development Zones

0 1.25 2.5 5 7.5 10 Miles

Opposition in Ohio

“Ask yourself, if several thousand acres of agricultural land is converted to industrial solar facilities, who will grow your food? Bill Gates? Mark Zuckerberg?”

-No Solar In Logan County (Ohio)

What can lawyers do?

1. Intervene in siting proceedings
2. Negotiate community benefits agreements (CBAs)
3. Advise local governments not to adopt unlawful restrictions

Intervention in Siting Proceedings

In Ohio, in deciding motion to intervene in state siting board proceeding, ALJ may consider:

- (a) The nature and extent of the person's interest.
- (b) The extent to which the person's interest is represented by existing parties.
- (c) The person's potential contribution to a just and expeditious resolution of the issues involved in the proceeding.
- (d) Whether granting the requested intervention would unduly delay the proceeding or unjustly prejudice an existing party.

Ohio Administrative Code Rule 4906-2-12(B)(1)

Ohio Siting Standard

The [Ohio Power Siting Board] shall not grant a certificate for the construction, operation, and maintenance of a major utility facility . . . unless it finds and determines

(6) That the facility will serve the **public interest, convenience, and necessity**

Ohio Revised Code 4906.10(A)

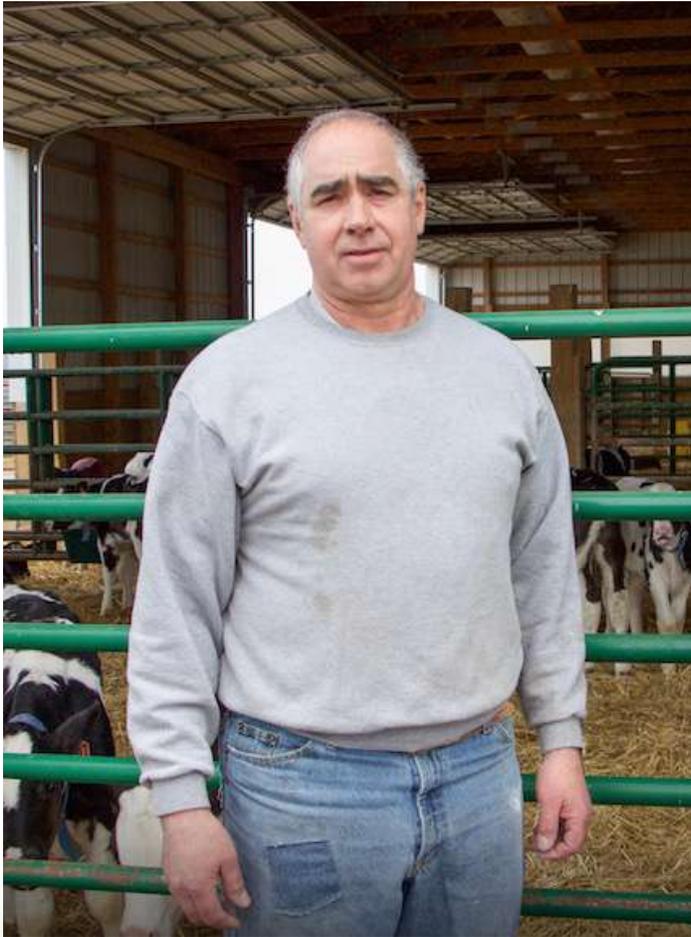
Recent OPSB decisions

- Until October 2022, OPSB had never rejected a solar application
- Since then, OPSB has rejected 3 applications:
 - ❑ Birch Solar (300 MW)
 - ❑ Kingwood Solar (175 MW)
 - ❑ Cepheus Energy (68 MW)

Recent OPSB decisions

- Until October 2022, OPSB had never rejected a solar application
- In the last 8 months, OPSB has rejected 3 applications:
 - ❑ Birch Solar (300 MW) **2 counties, 2 townships opposed; 80% comments opposed**
 - ❑ Kingwood Solar (175 MW) **7 local governments expressed concern/opposition**
 - ❑ Cepheus Energy (68 MW) **1 county, 3 townships opposed; 76% testimony opposed**

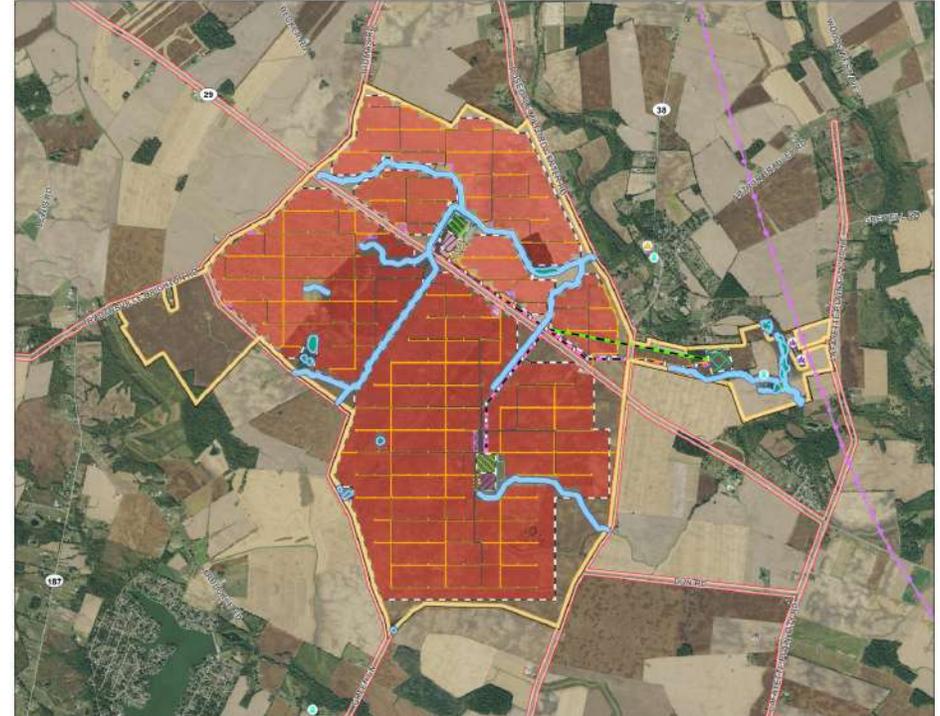
Ohio Ex. A: Emerson Creek Wind Farm



- Two local farmers who plan to lease out land for 300-MW wind farm
- OPSB issued permit in June 2021
- Ohio Supreme Court affirmed issuance of permit in July 2023

Ohio Ex. B: Oak Run Solar Project

- Local resident who lives 1,000 feet from site of planned 800-MW project.
- U.S. Air Force research scientist.
- Prefers living near solar farm than mega-dairy farm.
- Matter is fully briefed and awaiting decision from OPSB.



CBA's Required for State Approval in California



No state approval unless:

"the applicant has entered into one or more legally binding and enforceable agreements with, or that benefit, a coalition of one or more community-based organizations"

Cal. Gov. Code Section 25545.10.

CBA's Required for State Approval in Michigan

No state approval unless developer enters into host community agreement with local government

OR

“a community benefits agreement with 1 or more community-based organizations within, or that serve residents of, the affected local unit”

Pub. Act No. 233 of 2023



Advise local governments not to adopt unlawful restrictions

- Severe local restrictions may constitute a regulatory taking or they may be unlawful:
 - Substantive due process
 - Exclusionary zoning
 - Violation of state statutes that restrict unreasonable restrictions on renewable energy

BURR 
FORMAN LLP

results matter

This information has been prepared for informational purposes only. It is general in nature. It should not be construed as legal advice or a legal opinion on any specific facts or circumstances. It should not be relied upon to make legal decisions.

Identifying and Protecting Your Client's Intellectual Property to Maximize Value and Minimize Risk

Types of Intellectual Property (“IP”)

- Patents
- Trade Secrets
- Copyrights
- Trademarks / Service Marks
- Contractual Protection

PATENTS

“A patent is an intellectual property right granted by the Government of the United States of America to an inventor ‘to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States’ for a limited time in exchange for public disclosure of the invention when the patent is granted.”

(<http://www.uspto.gov/patents/index.jsp>).

What is covered by a Patent?

- Patentable Subject Matter
 - Products of Nature v. Man made
- Novel
 - “New” compared to prior art
 - Statutory “on sale” bar
- “Non-obvious”

Identifying Patentable Inventions

- Newly developed inventions
- Novel and Nonobvious?
- Application appropriate?

Scope of Patent Protection

- “Limited Monopoly”

- Right to Exclude from Making, Using, Offering for Sale, or Selling

- 20 Years from Date of Filing Application

- Requirement to Disclose

How to Obtain Patent Protection in the United States

- Register with the U.S. Patent & Trademark Office
 - Patent Center (<https://patentcenter.uspto.gov>)
- Available to inventor(s) and registered patent attorneys
- Provisional application
- PCT application for international patents (within 12 months, buys an additional 18 months)

TRADE SECRETS

“A ‘trade secret’ is information that: a. Is used or intended for use in a trade or business; b. Is included or embodied in a formula, pattern, compilation, computer software, drawing, device, method, technique, or process; c. Is not publicly known and is not generally known in the trade or business of the person asserting that it is a trade secret; d. Cannot be readily ascertained or derived from publicly available information; e. Is the subject of efforts that are reasonable under the circumstances to maintain its secrecy; and f. Has significant economic value.” (Ala. Code § 8-27-2(1)).

What are Trade Secrets?

- Information
- Economic Benefit
- Not Known to Public or Industry
- Difficult to Recreate
- Efforts to Maintain Secrecy Reasonable Under the Circumstances

Identifying Trade Secrets

- What items are critical to your client's business but not known outside of the company?
- Consider processes, formulas, methods, etc.

Protection of Trade Secrets

- State Law
- No Registration
- Reverse Engineering

COPYRIGHTS

“Copyright is a form of protection provided by the laws of the United States (title 17, U. S. Code) to the authors of ‘original works of authorship,’ including literary, dramatic, musical, artistic, and certain other intellectual works.” (www.copyright.gov/circs/circ01.pdf).

What is covered by Copyright?

- Protects expression of idea, NOT the idea
- Rights to control copying, reproduction, distribution, publication, presentation, performance, modification or creation of derivative works

Identifying Copyrightable Materials

➤ Manuals/Instructions

➤ Websites

➤ Software

➤ Artwork

➤ Sound Recordings

➤ Videos

Key Issue for Copyrights

- **MAKE SURE YOUR CLIENT OWNS IT**
 - Ownership v. Implied License
 - Work for Hire

Registration of Copyrights

- Not required for copyright to exist
- Required prior to lawsuit being filed
- Required at time of infringement for statutory damages to apply, and for recovery of attorneys' fees

How to Register Copyrights

- Register with the U.S. Copyright Office
 - Electronic Copyright Office or eCO
(<https://copyright.gov/registration>)
- Available to all
- Complete online application & upload or mail deposit

TRADEMARKS

“A trademark is a brand name. A trademark or service mark includes any word, name, symbol, device, or any combination, used or intended to be used to identify and distinguish the goods/services of one seller or provider from those of others, and to indicate the source of the goods/services.”

(<http://www.uspto.gov/trademarks/index.jsp>).

What are Trademarks and Service Marks?

- Word, phrase, logo, design, sound, or smell
- Identify sources of goods and/or services

Identifying Trademarks and Services Marks

- Company Names
- Product Brands
- Services Names
- Tag Lines
- Other

Rights in and Registration of Trademarks

- Rights through use not registration
- Registration helps with enforcement
 - Federal and State registration
- Rights to stop confusingly similar uses

How to Register Trademarks

- Register with the U.S. Patent & Trademark Office
 - Trademark Electronic Application System or TEAS (<https://www.uspto.gov/trademarks/login>)
 - Available to all
 - Select, complete appropriate form & submit specimen
- Register with applicable Secretary of State office
 - Available to all
 - Complete designated form(s), electronically or on paper & submit specimen

How does Contractual Protection Fit In?

“An agreement between two or more parties creating valid obligations that are enforceable or otherwise recognizable at law <a binding contract>.” (Black’s Law Dictionary (11th ed. 2019)).

Contractual Protection

- Employee Agreements
- Independent Contractor Agreements
- Vendor/Supplier Agreements
- Customer Agreements
- Business Partner Agreements

Lessons Learned

Selection of New Trademarks

- Consider Strength and Protectability of Mark
- Infringement of Others' Marks

Copyright

- Use care in dealing with copyrightable material
 - Music
 - Clip Art
 - Photos
 - Graphics
 - Software
- Accessible does not mean free to use

Contractual Obligations

➤ Living Documents

- Has your client agreed to maintain confidentially?
- Who owns jointly developed works?
- Has client agreed not to reverse engineer or design around?

Contact Information

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