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OF COUNSEL – Spring 2012
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NORTHEASTERN UNIVERSITY
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University Sharepoint System: Know the Status of your Contracts

- *Read this if you or your designees have forwarded or will forward a contract to our office for review.*

As you know, the Office of University Counsel uses the University's Sharepoint system to notify you and your designees about the status of the contracts you forward to our office for review. To date, when a proposed contract is sent to our office for review, the designated person(s) receives email notices regarding (1) our office's receipt of the contract; (2) if there is a need for additional information; (3) the conclusion of our office's review and submission of the contract for signature; and (4) the execution of the contract by the University's Treasurer and its availability for pick-up at the Treasurer's office.

As part of our ongoing efforts to help keep you informed about the contract you send to our office for review, we are adding some new features to the email notification system:

- Notice of Negotiations: Sometimes, when a proposed contract is on a form other than a University-approved template, or when the other party has made edits to a University-approved template, our office may have to negotiate the terms and conditions of the contract with the other party. In these cases, you and your designees will receive an email notification stating the contract is "Under Negotiations." This communication is in addition to the telephone discussions and meetings we may have with you regarding the contract in question.
- Responsible Attorney: The Notice of Negotiations will also inform you of the attorney handling the particular contract. This attorney will serve as your contact point for matters related to that contract. In most cases, the Responsible Attorney will have contacted you directly, in addition to your receipt of this notice, but the notice will serve as a useful reminder.
- Ongoing Status Updates: When a contract is under negotiations, you and your designees may now also receive brief email updates from the Sharepoint system about your contract. These updates will simultaneously inform you and your designees about, for example, a list of any open items remaining in the negotiations or the results of a conference call with the other party. These notifications will not necessarily replace all of your contact with the attorney handling your matter, but serve simply as another messaging system to update you regarding your contract.

- **Reference Numbers:** All contracts submitted for review will receive a unique identifying **Reference Number** that will be published on all Sharepoint email notifications regarding the contract. It will be helpful if you or your designees use this number when inquiring about the contract.

Please forward this information to those in your department who handle contracts. As always, should you have any questions about this process or about contracts in general, please feel free to contact us at x2157.

Summer Programs for Youth

- *Read this if you are thinking of offering a summer program for youth under age 18.*

If your department is considering hosting a summer program for youth in 2012, please contact the Office of Compliance and Risk Management **prior** to developing or distributing your program applications to prospective participants (youth under age 18). We ask that you make this contact even if you have offered the program in previous years. The Office of Compliance and Risk Management is coordinating summer program initiatives on a University-wide basis and can be reached at x5997. The Office of the University Counsel can also provide guidance about the many ways youth programs are regulated in Massachusetts. We can be reached at x2157. We also can point you in the direction of other departments on campus who may need to be involved in your planning, such as Government Relations.

Intellectual Property Updates: (A) Two Recent Decisions on Trademark Issues in the Age of Web-Based Business; (B) Maintenance of Lab Notebooks at the University

(A) Two Recent Decisions on Trademark Issues in the Age of Web-Based Business

- *Read this if you are thinking of creating a trademark, logo or domain name.*

Two recent legal decisions highlight the importance of exercising caution in the selection of logos, insignia, domain names and other University advertising and marketing materials. The first of these cases involves a trademark application for the term CRACKBERRY™ that was opposed by the company Research in Motion, which owns the BLACKBERRY® trademark.

Research in Motion opposed allowing the mark CRACKBERRY to be trademarked for two main reasons. First, consumers faced with purchasing devices with either the BLACKBERRY or CRACKBERRY designations would likely be confused about the devices in question. Second, allowing the CRACKBERRY mark to issue would dilute the value and fame of the BLACKBERRY mark. In defense, CRACKBERRY argued that the trademark should issue because it is a parody of the term BLACKBERRY. The Trademark Board disagreed because CRACKBERRY was seeking to use the mark to sell merchandise instead of simply as a parody, and use of a CRACKBERRY trademark would confuse consumers and harm BLACKBERRY.

The second decision involves a company that operated a website called faceporn.com. Facebook went to court seeking to shut down the faceporn.com website. Facebook lost the case on jurisdictional grounds, but if those jurisdictional issues were not present, the legal dispute would have been protracted and expensive.

These cases reinforce the need to work closely with appropriate University resources as soon as practicably possible to carefully create a proposed trademark or logo before launching a University project. You should choose proposed trademarks, logos, and domain names cautiously and with an eye toward steering clear of established companies. Once you have developed a proposed plan, contact Vanessa Salas in the University's Department of Marketing and Communications at x5453. That Department must approve any proposed trademark or logo related to the University, including its departments, programs, and centers.

In addition, these cases demonstrate that in order to protect its reputation, the University must remain vigilant of potential unauthorized uses of its name, logo, images and other intellectual property. If you come across any use of the University's intellectual property that you believe may be unauthorized, please contact Marketing and Communications. Examples of such unauthorized uses may include:

- a vendor listing the University as its preferred customer;
- a company incorporating the University's images into its website or marketing materials;
- a photographer offering for re-sale photographs it took for the University, or
- a company incorporating into its own name the University's name or a variation thereof (NU, NEU, etc) in an attempt to appeal to the University's community.

(B) Maintenance of Lab Notebooks at the University

- *Read this if you supervise or work in a University laboratory or teach lab-based courses*

Northeastern University is a major research university, spanning a wide range of scientific research. Maintaining detailed and accurate lab notebooks on behalf of the University is important because lab notebooks are used to determine how, when, and who first discovered an invention.

Lab notebooks serve as organizational tools, memory aids, and are crucial for establishing when something was invented and who was responsible for conceptualizing the invention. Ideally, all experimental data, lab notes, meeting notes, and the like must be entered into a lab notebook, either in paper or electronic form. Researchers must keep a standard, formal record of their work. Paper versions of lab notebooks are usually bound with sequentially numbered pages and spaces for the date, signature of inventors, and signature of witnesses. For electronic versions, there are several vendors which provide software services that meet the required record-keeping formality. Lab notebooks must remain in the University research area and should be stored in a locked place when not in use. Lab notebooks are the property of the University.

The failure to properly document research can result in the loss of rights to an invention. In a recent case, two companies filed competing patent applications claiming rights to a process for making the main ingredient contained in a popular over-the-counter anti-allergy medication. The first company to file its patent application is presumed to have been the first inventor. However, in this case the second successfully established itself as the inventor of the main ingredient. Its successful challenge rested on the fact that it had kept detailed, signed lab notebooks while the first company had not. Even though the first company had actually been first to discover the process for making the key ingredient, its lab notebooks were unsigned and unwitnessed, so the company could not prove that it had been first to make the discovery. This decision underscores the importance of tracking research in formal lab notebooks. Your attention to preparing lab notebooks will help our Office support any claims for an invention on behalf of the University and you.

Coming Soon: Guidance on International Business Visitors

- *You should read this if you are thinking of inviting international colleagues and visitors to Northeastern University.*

Welcoming international business visitors to campus can be an exciting opportunity for you and your visitor. A smooth entry and meaningful visit are our objectives, and to facilitate that, the International Student and Scholar Institute, working with University Counsel and Accounts Payable, will soon be providing you with additional guidance.

A “business visitor” is someone who will be coming to the United States for a conference, to present a paper, to deliver a speech or talk, or to conduct their own independent research. Depending upon their prior presence in the U.S. and the nature of the activities the visitor undertook during any prior visits, he or she may or may not be able to accept an honorarium and reimbursement for expenses. Any payments to the visitor in the form of an honorarium may be subject to tax withholdings. (As a reminder, an international business visitor may not undertake employment as an employee or independent contractor, and may not engage in collaborative research.) Business visitors may enter the U.S. on a B-1 visa or under a visa waiver program (VWB) from certain countries, but the guidelines noted above apply to both B-1 and VWB visitors.

In the coming weeks, we will provide departments who wish to invite international visitors to Northeastern with template letters of invitation and questionnaires for the visitor to help him or her and the University comply with both immigration and tax requirements. It will be important to use these documents routinely to facilitate the visit and any appropriate payments the visit may engender. And, as is always the case with international visitors, all arrangements must be made in advance of the visit.

If you have questions regarding upcoming visits, please contact the Office of University Counsel.

If you have any questions you would like to see answered in this space, please submit them to the Office of University Counsel at 378 Columbus Place. Depending upon the nature of your question, we'll either answer you personally or address your issue in a future edition of this newsletter.

Of Counsel has been prepared as a general summary of important developments. It is not intended as individual legal advice. Should you have any questions or need information concerning a specific situation or any of the content of this advisory, please contact the Office of University Counsel, 378 Columbus Place, x2157.

This edition of Of Counsel was prepared with the assistance of Northeastern University School of Law students Christine Chilingirian and Monica Raj.