

FORM PTO 1585

07/29/2013

SHEET



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MPD 07-29-13



To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof

1. Name of conveying party(ies):

Walter Geer III and Ellen ToAdditional name(s) of conveying parties attached? ☐ Yes ☒ No

3. Nature of conveyance:

- ☐ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☒ Other: Memorandum of Law to demonstrate proprietary interest
 Execution dates: July 22, 2013 and July 22, 2013

*2. Name and address of receiving party(ies)

Name: VIACOM INTERNATIONAL INC.

Street Address:

1515 BROADWAY
NEW YORK, NEW YORK 10036

4. Application numbers or patent numbers:

A. Patent Applications: 12/940,637 filed on November 5, 2010

B. Patent No.(s)

Additional Numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Oleg F. Kaplun, Esq.
Internal Address: Fay Kaplun & Marcin, LLPStreet Address: 150 Broadway, Suite 702
City: New York State: New York ZIP: 100386. Total number of applications and patents:
Integration of an Interactive Advertising Unit Containing a Fully Functional Virtual Object and Digital Media Content

7. Total fee (37 C.F.R. 3.41) \$ 40.00

- ☒ Enclosed
☐ Authorized to be charged to deposit account

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9. Statement and signature.

*To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.*Oleg F. Kaplun, (Reg. No. 45,559)

Name of Person Signing

Signature

July 23, 2013

Date

Total Number of pages including cover sheet, attachments, and document: 6

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MEMORANDUM OF LAW

To: Stephen Fefferman, Esq.
Vice President, Business and Legal Affairs
Viacom Media Networks
1515 Broadway
New York, NY 10036

From: Oleg F. Kaplun, Esq.
Fay Kaplun & Marcin, LLP
150 Broadway, Suite 702
New York, NY 10038

Date: July 22, 2013

Re: Viacom International Inc. Ownership Issues with Regards to U.S. Patent Application
Serial No. 12/940,637

QUESTION PRESENTED

Whether, under New York Law, Viacom International Inc. (hereafter referred to as "VII") is entitled to ownership rights to U.S. Patent Application Serial No. 12/940,637 (hereafter referred to as the "Patent Application") which name Ms. Ellen To and Mr. Walter Geer III (hereafter collectively referred to as the "Employees") as inventors and where there was no written agreement between VII and the Employees which specifically addresses the ownership of the Patent Application.

SHORT ANSWER

Yes. VII is entitled to the Employees' ownership rights to the Patent Application because the Employees were assigned to a work-related project that yielded the subject matter of the Patent Application.

STATEMENT OF FACTS

VII hired as an employee of VII Ms. To on March 17, 2008 and Mr. Geer on May 19, 2008. The employment location for each of the Employees was New York State. There was no written employment agreement between VII and Ms. To and Mr. Geer. During employment at VII, the Employees with three other employees of VII worked on a project relating to the integration of an interactive advertising unit containing a fully functional virtual object and digital media content which is the subject matter of the Patent Application. On November 5, 2009, U.S. Provisional Application Serial No. 61/258,451 (hereafter referred to as the "Provisional Application") was filed with the United States Patent and Trademark Office (hereafter referred to as the "USPTO"). Subsequently, on November 5, 2010, the Patent Application claiming the priority to and incorporating the subject matter of the Provisional Application was filed with the USPTO. Ms. To and Mr. Geer departed VII on January 29, 2010.

NEW YORK LAW

In determining ownership issues between employers and employees, Courts first look to see if there was a written contract between the disputing parties. Absent a contract, Courts then look at the relationship between the parties. In New York, case law holds that if an employee is 1) hired to invent or 2) given the task of devoting his efforts to a particular problem, the resulting

invention is the employer's, and any resulting patent MUST be assigned to the employer. *Cahill v. Regan*, 5 N.Y.2d 292, 294 (1959).

As long as an employee was assigned to a specific research project, all ownership rights from this project belong to the employer. In *Oliver*, the plaintiff was an employee of the defendant. *Oliver v. Mills*, 163 N.Y.S.2d 317 (1956). During the course of his employment, the employee was asked to look into various problems and his work yielded the subject matter of a number of United States Patents. *Id.* Upon his termination, the employee sued his employer for the rights to those patents, claiming that he had been induced by fraudulent representation to assign them to the employer. *Id.* at 322-323. The Court held that the issue of fraudulent representations was irrelevant. *Id.* at 324. Even if the employee had not been originally 'hired to invent,' as long as he was subsequently assigned to a specific research project which resulted in the making of the invention, all ownership rights to that invention belong to the employer. *Id.* at 323. The Court noted that this rule is based upon the simple proposition that the employee had done the very thing that he had been employed to do and, therefore, the end result belongs to his employer. *Id.* at 324. Further, the Court held that it does not matter in what capacity the employee had originally been hired, but upon the nature of the service in which the employee is engaged at the time he makes the discovery or the invention. *Id.* at 324. Finally, the Court noted that even if the employee had not voluntarily assigned the patent rights to his employer, the employer could have compelled him to do so by suit in equity. *Id.* at 324.

If an employee's work is sufficiently directed towards a particular problem, all ownership rights to any subsequent patents belong to the employer. In *Yeshiva*, an employee tasked with

researching Alzheimer's disease had developed an antibody. *Yeshiva University v. Greenberg*, 255 A.D.2d 576, 577 (1998). After she left her employer, she believed she owned the rights to the antibody and began distributing it to various entities. *Id.* at 577. There was no written agreement between the employer and employee. *Id.* The Court held that if an employee is given the task of devoting his efforts to a particular problem, the resulting invention is the employer's, and any patent obtained by the employee must be assigned to the employer. *Id.* at 577. On the other hand, an employee whose employment is 'general' is entitled to retain any patent and the employee does not need to assign it to their employer. *Id.* at 578. Because the employee's employment was not general and her work was sufficiently directed towards research in Alzheimer's disease, her claim for rights over the antibody was rejected and the employer's claim was upheld. *Id.* at 578.

APPLICATION TO CURRENT FACTS

Here, as in *Oliver*, the Employees along with three other VII employees were tasked to work on various projects and their efforts in these projects yielded the subject matter of the Patent Application. Since the Employees were assigned to a specific research project which resulted in the invention of the subject matter of the Patent Application, all ownership rights to the subject matter therefore belong to VII.

Furthermore, the Employees' employment with VII was NOT general. In their respective capacity, the Employees and the three other VII employees were given the task of devoting their efforts to a particular project, the subject matter of which was incorporated into the Patent Application. *Id.* Therefore, the Employees were entitled to be listed as inventors on the Patent

Application. However, as in *Yeshiva*, because the Employees were given the task of devoting their efforts to a particular project, the Employees are NOT entitled to any ownership rights and all rights must be assigned to VII.

CONCLUSION

For all of the forgoing reasons, under New York Law, VII is entitled to the Employees' ownership rights to the Patent Application.



By _____

Oleg F. Kaplun (Reg. No. 45,559)

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