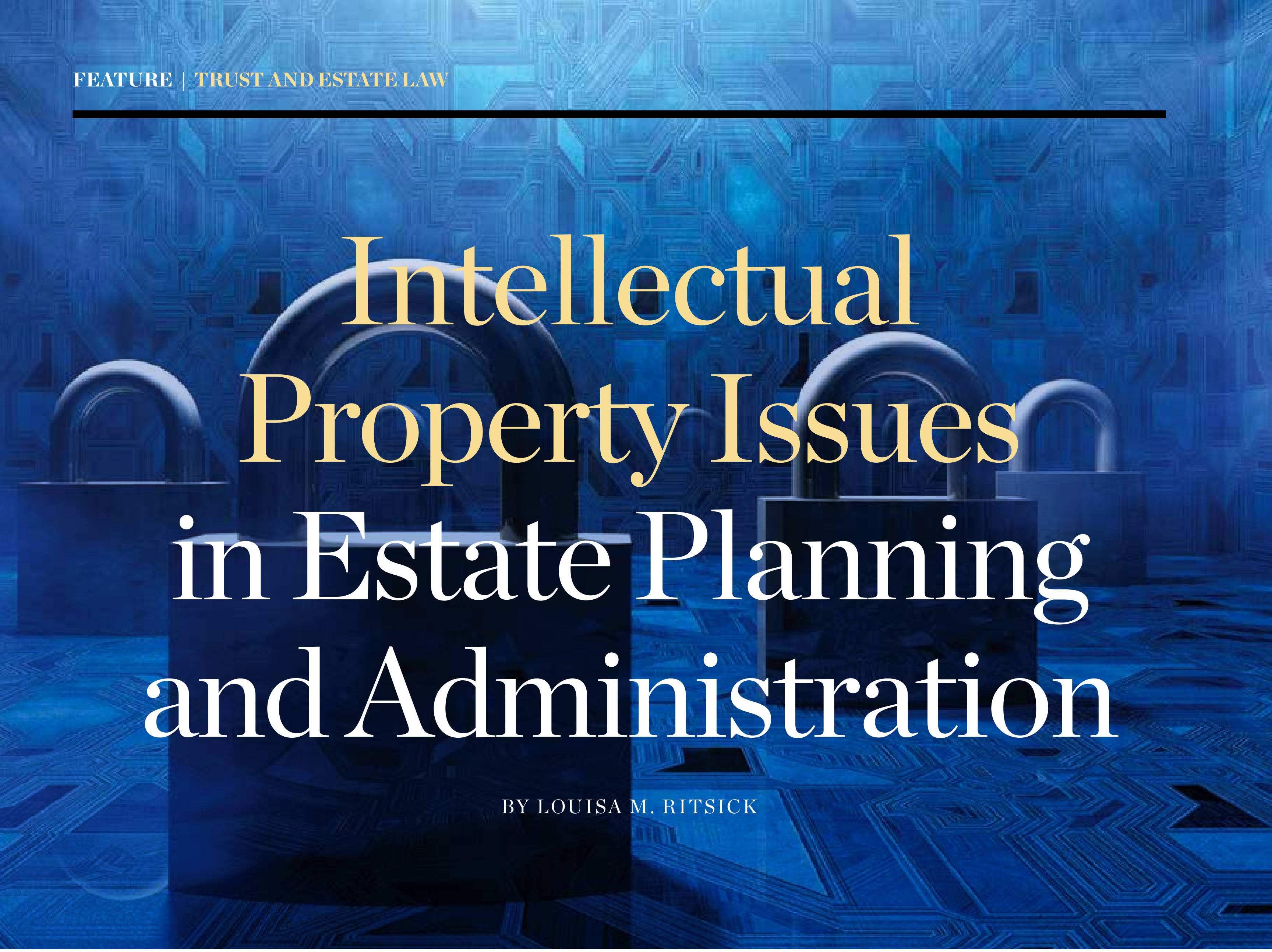

Intellectual Property Issues in Estate Planning and Administration

BY LOUISA M. RITSICK

This article describes intellectual property assets and intellectual property laws that a trust and estate attorney should consider as part of an estate plan or during estate administration.

Known for ironic parody songs like "(You Gotta') Fight for Your Right (to Party!),"[1] Beastie Boys co-founder Adam "MCA" Yauch, who died from cancer in 2012 at age 47, fought for the right to control the future use of his musical creations after death. Yauch's will provided, in part, that "[n]otwithstanding anything to the contrary, in no event may my image or name *or any music or any artistic property created by me* be used for advertising purposes."[2] The terms of Yauch's last will and testament, while not the dispositive factor in litigation between the Beastie Boys and the companies using Beastie Boys songs for advertising purposes after Yauch's death,[3] are a dead-hand attempt to control the use of his intellectual property from the grave. Yauch handwrote the italicized words in the will prepared for him by his lawyers,[4] which highlights the importance of understanding the client's legacy goals with respect to intellectual creations as well as the technical requirements for the transfer, management, and monitoring of intellectual property assets.

The term "intellectual property" (IP) refers to the ideas, inventions, technologies, processes, and musical, art, and literary works derived from the work of the mind. IP rights apply to the intellectual creation of an object as opposed to the physical object in which the intellectual creation is embodied. Copyright, trademark, patent, and other IP laws protect IP rights by assigning legal rights to produce and control the physical manifestation of the ideas of the creator[5] or other producers and providing an enforcement mechanism if the rights are infringed.

IP rights may not be "assets" in the traditional sense, but IP rights may constitute a valuable share of the client's estate for which proper planning is essential. Although Prince famously fought to protect his intellectual property during his lifetime, he died intestate, without an inventory of the music stored in his vault or a plan for its release.[6] Prince's estate has been beset with claims by purported heirs and disputes over the ownership of his intellectual property, with Universal rescinding a $31 million deal because it claimed that some of the rights purchased from the estate conflicted with rights held by Warner Bros. pursuant to a confidential 2014 transfer.[7]

What is Intellectual Property?

The World Intellectual Property Organization (WIPO)[8] divides IP into two main categories: (1) industrial property such as trademarks, patents for inventions, industrial designs, and geographical indications; and (2) copyright covering literary, artistic, and musical works, films, and architectural design as well as the rights of performing artists, producers of recordings, and broadcasters.[9] A category of intangible personal property,[10] IP has no intrinsic value when created; it is merely representative of value. IP laws offer creators an opportunity to exploit their IP in hopes of realizing a return on their investment of time and capital into the creative process. Any IP asset can be subject to both U.S. and international laws. Unless otherwise noted, this article focuses on IP rights protected by U.S. law.

Legal Protection of IP Rights

Legal protection of IP rights has a long history. As legal systems in different civilizations matured, the legal protections offered, as well as the justifications for those legal protections, evolved. In the 7th century BCE, the Greek colony of Sybaris granted chefs year-long monopolies for inventing extraordinary recipes.[11] From Roman times to the Florentine republic, legal protections generally took the form of franchises and royal favors,[12] with a goal of restricting access to works already in the public domain rather than encouraging innovation. In 1421, the Republic of Florence adopted one of the first statutes instituting an incentive mechanism that is still a feature of IP laws.[13] Our current systems of copyright, patent, and trademark laws, as well as moral rights often protected under state law, are derived from the English system, such as Great Britain's Statute of Anne (1710), which is considered by many legal scholars to be the first modern copyright statute.[14]

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Copyright and Related Works

Copyright protection is generally offered to "original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device."[15] The work must be original to the author and cannot be the result of copying. The owner of a copyright has the exclusive rights to:

1. reproduce the copyrighted work;
2. prepare derivative works based on the copyrighted work (e.g., sequels or merchandising);[16]
3. distribute copies of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
4. perform the copyrighted work publicly; and
5. display the copyrighted work publicly.[17]

Each of these rights may be separately retained or transferred by the copyright owner. Although copyright is automatic, vesting on creation, registration of the copyright with the U.S. Copyright Office is necessary to enforce the exclusive rights of copyright through litigation.[18] Since March 1, 1989, use of the copyright symbol, ©, in the United States has been optional.[19] U.S. law required use of the © on all works first published before that date, and before 1989, failure to use the © generally resulted in a loss of U.S. copyright protection.

Under the 1976 Copyright Act (effective January 1, 1978), as amended, (1976 Copyright Act) and the Sonny Bono Copyright Term Extension Act of 1998, copyrights created after 1978 are generally good for the life of the author plus 70 years.[20] For a joint work, the rights endure for a term consisting of the life of the last surviving author plus 70 years.[21] For works made for hire or works published anonymously or under a pseudonym, the copyright endures for the first to expire of a term of 95 years from the year of its first publication, or a term of 120 years from the year of creation.[22] Once the copyright protection period ends, the copyrighted materials enter the public domain.[23]

Ownership of a copyright or any of the exclusive rights afforded the holder of a copyright is distinct from ownership of any material object, such as a painting or manuscript, in which the work is embodied.[24] Transfer of ownership of any material object does not of itself convey any rights in the copyrighted work embodied in the object; nor, in the absence of an agreement, does transfer of ownership of a copyright or of any exclusive rights under a copyright convey property rights in any material object.

The 1976 Copyright Act not only extended the terms during which copyright protection is available but also instituted other legal protections allowing creators or their successors to terminate a copyright transfer. The copyright owner may not have equal bargaining power or the information necessary to evaluate the value of a copyright interest when a transfer is first contemplated. For example, based on the advice of her editorial team that her book would probably only sell a few thousand copies, Harper Lee reportedly licensed some of her copyright interests to the publisher of *To Kill a Mockingbird* in 1960 for $2,500.[25] When Lee and her publisher originally negotiated the contract, no one, including Lee, predicted the immediate success of the novel, Lee's Pulitzer Prize, or the Oscar-winning movie with the same title released in 1962. Recognizing that the bargaining position of the creator and the value of a creator's work may be nonexistent or difficult to determine when a work is first created, Congress enacted a right of termination under the 1976 Copyright Act.[26] The "exclusive or nonexclusive grant of a transfer or license of copyright or of any right under a copyright, executed by the author on or after January 1, 1978, otherwise than by will" is subject to an immutable right of termination.[27] The termination must occur either 35 years from the date of the transfer or, if the grant covers the right of publication, the earlier of 35 years after publication or 40 years after the execution of the transfer.[28] Notice of the exercise of the termination right must be served no earlier than 10 years before the start of the five-year termination window and not less than two years before the end of the window.[29] The right of termination will irrevocably lapse if it is not exercised within the statutory time limits. The written notice must be served on the transferee and filed with the U.S. Copyright Office along with the required fee.[30] On the termination date, the copyright reverts to the creator or to the successor to the creator's termination rights.

If the creator dies after giving the required notice but before the termination date, the copyright should revert to the creator's estate and pass by intestate succession or pursuant to the client's estate plan.[31] However, if a creator dies before the end of the termination window, the creator cannot devise his termination rights to a recipient of his choice and his heirs are forced to rely on the statutory list of who succeeds to the right of termination upon the creator's death.[32] Because the termination right is immutable, it cannot be altered by the creator or the creator's statutory heirs. The statutory heirs are the creator's surviving spouse, who owns the entire termination interest unless there are any surviving children or grandchildren of the creator, in which case the surviving spouse owns one-half of the interest. The surviving children of the creator, and the surviving children of any dead child of the creator, own the creator's entire termination interest unless there is a surviving spouse of the creator, in which case the ownership of one-half of the creator's interest is divided among the children and grandchildren, per stirpes. The share of multiple heirs can only be exercised by the action of a majority.[33] If there is no surviving spouse and there are no children or grandchildren, the author's personal representative or trustee owns the author's termination interest. Because notices of termination could be served, at the earliest, 25 years after a 1978 transfer, 2013 was the first year in which notices of termination could be filed for transfers occurring after the effective date of the 1976 Copyright Act termination provisions. Because the ability to exercise termination rights is relatively new, estate planners should stay abreast of relevant cases involving termination rights as they make their way through the court system.[34]

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Although a creator or her successors may successfully regain the copyrights, the transferee may still be able to receive continuing revenue from derivative works, such as mechanical licenses for sound recordings. Works that are classified as "works made for hire" cannot be terminated. For example, if a songwriter, as an employee of a movie studio, writes a song for a motion picture, the grant cannot be terminated. Current transferees may contest termination notices by arguing that the work in question is a work made for hire, and the burden will be on the creator or the creator's successors to prove otherwise. Moreover, the termination right only affects copyright grants under U.S. copyright law, so a publisher assigned a worldwide copyright will retain its rights outside of the United States. Duran Duran recently sought to exercise termination rights with respect to "Hungry Like the Wolf" and other songs transferred by the band years ago to Gloucester Place Music Ltd., which is now owned by Sony.[35] A court in the United Kingdom ruled that the termination notices were void because the original publishing contracts were subject to British contract law.[36] After the Duran Duran case, Paul McCartney filed suit against Sony in New York seeking a declaratory judgment regarding the existence of his termination rights under U.S. law.[37] Because McCartney and Sony reached a confidential settlement and the case was dismissed, the issues raised with respect to U.S. termination rights exercised by multinational artists are still undetermined.[38]

Patents

A patent is a grant by the U.S. Patent and Trademark Office (USPTO) that allows the patent owner to maintain a monopoly for a limited period of time on the use and development of an invention.[39] To obtain a patent, the new invention must be both (1) novel, meaning the invention is different from the prior art (i.e., all devices, products, methods, and documents describing these things); and (2) nonobvious, meaning generally remote or surprising to one skilled in the art.[40] Patents granted by the USPTO are assigned a unique patent number and are only effective within the United States, U.S. territories, and U.S. possessions.

Under the first-to-file system effective March 12, 2013, the USPTO generally gives priority to the first applicant to file for protection on an idea.[41] To get the benefit of an earlier filing date, an inventor may file an interim patent application—a Provisional Patent Application—that requires less information than a regular patent application.[42] During the inventor's lifetime, the inventor may transfer ownership of the patent to another entity or party through an assignment. The original owner should record the assignment with the USPTO's Assignment Recordation Branch by filing a Recordation Cover Sheet along with a copy of the actual assignment. Patents are usually non-renewable, although an exception exists for some pharmaceutical inventions if pending regulatory approval may adversely affect the inventor's ability to realize gain from the invention.[43] When expired, the underlying subject of the patent falls into the public domain.

The three predominate types of patents—utility, design, and plant patents—have different term lengths and maintenance fee requirements.[44]

Utility patent. A utility patent issued for the invention of a new and useful process or machine generally permits its owner to exclude others from making, using, or selling the invention for a period of up to 20 years from the date of patent application filing, subject to the payment of maintenance fees. For example, frustrated by the burnt toast served in the cafeteria in the manufacturing plant where he worked during World War I, Charles P. Strite invented the pop-up toaster with a timer and received a utility patent issued as U.S. Patent No. 1,394,450.[45]

Design patent. If issued from an application filed on or after May 13, 2015, a design patent permits its owner to exclude others from making, using, or selling a new, original, and ornamental design for a term of 15 years from the issue date.[46] Design patents are not subject to the payment of maintenance fees. One notable design patent is U.S. Patent D11,023 awarded to Frédéric Auguste Bertholdi's design for the Statue of Liberty in 1879.

Plant patent. Plant patents are issued for new and distinct, invented, or discovered asexually reproduced plants. Issued less frequently than utility or design patents, a plant patent permits its owner to exclude others from making, using, or selling the plant for a period of up to 20 years from the date of patent application filing, without the payment of maintenance fees.[47] For example, in August 2015 the USPTO awarded the first-ever patent for a plant containing significant amounts of THC to a group of California breeders,[48] touching off what could be a lucrative area within the marijuana industry.

Trademarks, Service Marks, Trade Dress, Trade Secrets, and Domain Names

A trademark is a word, phrase, symbol, or design, or a combination of words, phrases, symbols, or designs, that identifies and distinguishes the source of the goods of one party from those of another.[49] A trademark is the exclusive right to use a mark in commerce. Examples of trademarks are the Nike swoosh, the Gatorade lightning bolt, and the Microsoft "window" logo. A service mark is the same as a trademark except that it identifies and distinguishes the source of a service rather than a product. FedEx is an example of a service mark. A mark used by a company can function as both a service mark and a trademark. A trademark does not prevent others from making the same goods or from selling the same goods or services under a different mark. "Trade dress" refers to the distinctive, identifying features that form a trademark or service mark, such as the unique design elements found in most Starbucks locations.[50]

The rights of a trademark owner may be granted under common law, state law, and federal law. Common law protection is established solely on use of the mark in commerce by placing ™ next to a mark for goods or ℠ next to a mark for services. State trademark registrations provide notice throughout the state of registration. Trademark law addresses the conflicting uses of trademark, service mark, and trade dress by different businesses.[51] The rules generally favor the first to use in a geographic area. Federal registration of a trademark provides notice to the public of the registrant's claim of ownership of the mark and the exclusive right to use the mark on or in connection with the goods or services, or both, listed in the registration. If a trademark isn't registered with the USPTO, the rights of the owner may be limited by the geographic extent of the use. An ® after a mark may be used only if the mark is registered with the USPTO. After registration, the USPTO will place the mark on the list of trademarks and service marks known as the Principal Register.[52]

Unlike copyrights and patents, trademark rights can last indefinitely as long as the owner continues to use the mark commercially and files the maintenance documents with the required fees at the appropriate times. The owner must file the first maintenance document between the 5th and 6th year after the registration date and a renewal application within the year before the end of every 10-year period after the date of registration.[53]

Trade secrets are the confidential information on which companies rely for a competitive advantage, such as chemical formulas, competitive pricing structures, source code, and customer lists.[54] If an owner does not take reasonable steps to keep the information secret, such as requiring employees to sign a non-disclosure agreement, disclosure will not be actionable under state or federal law. Trade secrets are protected indefinitely, without registration, as long as the information constituting the trade secret remains secret and has commercial value because it is a secret.[55] By creating a federal cause of action for trade secret misappropriation, the Defend Trade Secrets Act of 2016 (DTSA)[56] is intended to provide uniformity to the patchwork of state laws that offered limited remedies to trade secret owners before 2016.

Domain names are the words, letters, or numbers that refer to an Internet address, such as Google.com.[57] Domain names are registered with a domain registrar, and details of the domain registration can be discovered through a "WHOIS" service.[58] Domain names are issued for terms up to 10 years.[59] If the registration is not renewed, the domain name will be released for registration by third parties. If a domain name is stolen in bad faith, a federal court judge may order the return of the domain name under the Anticybersquatting Consumer Protection Act (ACPA),[60] which protects both registered and unregistered domain names. A trademark can be used as a domain name but a domain name cannot become a trademark because a domain name is only licensed to be used as an address by the registrar for a limited time.[61]

Estate Planning for and Estate Administration of IP

As discussed above, IP rights vary according to their category and are subject to different means of protection and enforcement. Attorneys involved in planning and administering estates must be aware of clients' IP and be prepared to advise them on how to transfer, manage, and monitor these assets.

Transferring IP

An IP owner may transfer IP ownership during his life by any means of conveyance and, after death, ownership may be transferred by will, trust agreement, or the applicable laws of intestate succession. Although ensuring the transfer of IP assets to a creator's intended beneficiaries is an important aspect of a creator's estate plan, the estate plan should also attempt to maximize the value of the IP rights.

Cataloguing and Valuing IP

Questions regarding IP assets should be included on the estate planning questionnaire completed by potential clients before the initial meeting and on the estate administration inventory. If the client or the estate owns IP, the estate planning or probate attorney should catalogue all copyrights, trademarks, patents, domain names, and trade secrets, as well as any IP assignments or licenses. IP counsel should be consulted for assistance, if necessary. The client may create a separate file for each IP asset that includes all certificates, registrations, and agreements for the asset. The file should also include a docket for relevant dates (e.g., the date on which maintenance documents should be filed for trademarks) and a payment schedule for any fees.

"Attorneys involved in planning and administering estates must be aware of clients' IP and be prepared to advise them on how to transfer, manage, and monitor these assets."

After cataloguing the IP, the attorney should confirm the ownership of the IP assets. In many cases, the client or the client's estate does not singularly own the rights to the IP. Joint inventors may be listed on the face of a patent and multiple authors registered as creating copyrighted works. The estate planner should review contracts and agreements between the parties to determine what percentage of rights the client owns. In the absence of an agreement, the rights of joint owners may vary based on the type of IP. For example, under U.S. law, any contributor to a patent claim owns an undivided interest in the whole patent, regardless of contribution. A 1% contributor will be a joint owner with full rights to operate under the patent. Absent an agreement to the contrary, each joint owner can exploit the patented invention without the permission of the other joint owner and without accounting. In contrast, the joint owner of a U.S. copyright has a legal obligation not to decrease the value of the copyright as well as a duty to account, which is an obligation to share in profits from exploiting the copyright.

An invention or creative work can also belong solely to the creator's employer. An employee may not have any IP rights in "works-for-hire." Works for hire may be created by the employee within the scope of her employment, or the work may be commissioned by the employer for a specific project. The attorney should review the creator's employment agreements to determine whether the work is a "work for hire" and what rights, if any, the client can transfer to anyone not a party to the employment contract.

Copyright

The owner of a copyright should specifically mention both the original work *and* the copyright in his estate planning documents. A painter may make a specific devise of a painting, but if the copyright is not addressed, the unmentioned copyright will pass as part of the residuary estate. The fair market value of a copyright on the date of death is often determined based on the future earnings from the property.[62] Especially in the case of a copyright with the potential for significant future revenue, the attorney should also consider the tax apportionment issues that may result from the unintended transfer of a copyright as part of the residuary clause.

Estate planning attorneys should also advise clients about termination rights and how to address such rights in the client's estate plan. The right of termination is an automatic right of inheritance that the creator cannot change. The termination right appears to apply to any transfer made during the creator's lifetime, including lifetime gifts, charitable donations, and transfers to trusts or other management entities. The law granting termination rights includes a specific exception for transfers by "will." Although Congress may not have intended to exclude transfers by other means, the statutory language provides that any transfer other than a testamentary transfer may be terminated. Given the exception for transfers by will, specific devises of copyright interests should always be included in the client's will or pour-over will, even if the client disposes of the rest of the estate via a revocable trust or other will substitute.

The statutory right of termination can frustrate the creator's dispositive intent for a copyright. For example, consider an impoverished songwriter who toils away in obscurity, writing a one-hit wonder that the songwriter sells to a record label for a small sum of money. After a famous singer records the song and ends each concert with a rousing rendition, the record label realizes huge profits on the song. Before the right of termination vests, the unmarried songwriter dies. The songwriter's trust excludes his children from a previous marriage and gives the songwriter's estate to his significant other, without specific mention of the copyright. The surviving children—not the significant other—are the statutory heirs and will have the ability to terminate the sale of the copyright to the record label, take possession of it, and exploit it.

The existence of statutory heirs for purposes of copyright termination rights raises questions about whether the personal representative or trust, or the attorney representing either, has a fiduciary duty to inform the statutory heirs of the termination rights, even though the termination rights are not part of the probate or trust estate. What if statutory heirs are not devisees or beneficiaries of the estate plan? If the songwriter in the above example died one year after transferring the copyright, is the fiduciary obligated to notify the children or anyone else who might be a statutory heir that they have a right to terminate that begins more than 20 years in the future? What are the ethical considerations for a lawyer representing the significant other in her capacity as trustee, especially if the significant other does not want the right disclosed? In a few cases, looming termination rights may provide an opportunity for the personal representative or trustee to proactively negotiate a new agreement with the original transferee. However, those same termination rights can make it difficult for a fiduciary to manage assets on behalf of the creator's beneficiaries when the beneficiaries are not statutory heirs.

Patents

Either the inventor or an assignee can file the patent application. If the inventor dies before filing a patent application or during the application review process, the personal representative of the inventor's estate may apply for the patent or be issued the patent. A legal representative may file the patent application on behalf of an incapacitated inventor.

The inventor's dispositive document should clearly state the unique patent number, who owns the patent, who has the right to license the patent, and who has the responsibility for making maintenance payments. Documents should also be filed with the USPTO to record a transfer to the new owner. If privacy is a concern for the inventor, consider using a trust as the dispositive document as opposed to a will.

Trademark, Trade Secrets, and Domain Names

Because common law trademark vests on the first use of a trademark, even if the trademark is not registered with the USPTO, a client may not know that he has common law rights. However, common law trademark rights may be limited to the location where the trademark is used in commerce and may prohibit recovery of statutory damages and other benefits. If the client's IP inventory includes common law trademark rights, the attorney should advise the client to register the trademarks if the common law rights are not sufficient. If the owner assigns the ownership of a registered trademark during her lifetime, the assignment should be recorded with the USPTO. If federal or state trademark registration is included in a decedent's estate, the personal representative should file documents with the appropriate agency to record the transfer of the registration. During the estate administration period, the personal representative should monitor for potential infringement and continued use of the mark. An owner may designate a manager to be responsible for creative or licensing work with respect to a trademark in the event of incapacity or death.

Trade secret information is subject to legal protection and holds its value only if the owner takes the necessary steps to preserve secrecy.[63] The owner's estate plan should include provisions to ensure continued secrecy, and the client should consider whether to delegate the power to monitor and enforce any potential disclosures to a third party. If an estate owns trade secrets, the fiduciary should consider requiring the recipient of the trade secrets to sign a confidentiality or nondisclosure agreement before receiving the trade secrets.

If an individual owns a domain name, the individual's fiduciary should determine the renewal deadline of the domain name soon after incapacity or death. Most domain names have little or no value to third parties, but a domain name can have significant value if it is a popular Internet search word or phrase, a word or phrase useful for selling goods and services, or a company brand name. The registration of domain names with commercial value must be kept current or the registration may lapse. A domain name is valued separately from the content of the web page or other services offered through that domain name. If the fiduciary or successors want to sell the individual's domain names, the names can be sold on Internet sites dedicated to domain name sales.

Legacy Planning

The term "moral rights" refers to the ability of creators to control the eventual fate of their work.[64] Moral rights protect the personal and reputational value of the work to its creator[65] and may receive protection through judicial interpretation of federal and state privacy, defamation, publicity, unfair competition, copyright, and trademark laws.[66] Moral rights are not transferrable, but they may be waived in writing.

Visual artists may use the protections set forth in the Visual Artists Rights Act of 1990 (VARA).[67] VARA protects the artist's rights of attribution and integrity. The right of attribution prevents misattribution and, if desired, the artist's anonymity. The right of integrity prevents intentional defacement of an artist's works.[68] VARA protection ends with the death of the author.

Unless the state in which the artist died offers posthumous protection for rights of publicity, the estate may not be able to capitalize on the value of the celebrity's name and likeness. The IRS is challenging the estate of Michael Jackson over its valuation of his name and likeness at death under California law. The estate reported a value of $2,105, but the IRS asserted a value of more than $434 million.[69] Although moral rights traditionally end with the death of the artist, computer-generated imagery (CGI) can be used to bring a deceased actor back to life on the big screen.[70] A celebrity may want to consider her public persona after death and specifically address the right to her digital re-creation through contract.

Valuation and Tax Treatment

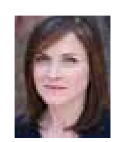
IP valuation may be required for many purposes, such as pricing and strategic purposes, securing financing, and transferring IP. For patents and copyrights, the number of years left in the term will be a factor in valuation. The potential for indefinite use of trademarks, service marks, and trade secrets may increase the value of these assets. Even so, the possibility for indefinite use does not guarantee that the IP asset will endure in the marketplace. For example, the value of the Walkman name and the actual portable tape player is significantly less today than it was when Sony introduced the Walkman in 1979.[71] Because it is challenging to value IP assets, attorneys should consider hiring an independent valuation expert to determine what IP rights are worth so that the income, gift, and estate tax consequences of a transfer can be analyzed.

Factors affecting the income tax treatment of income related to IP include whether the creative activity is classified as a trade or business; the timing and characterization of income received; and who owns the property.[72] A "royalty" is a payment for a right to use a patent, copyright, goodwill, trademark, or other similar intangible personal property.[73] Generally, a royalty is paid to the IP creator by an assignee or licensee with respect to sales or income generated from the property. An assignment is an unconditional transfer of the IP rights without limitations on how long the transfer lasts or the conditions under which the right may be used,[74] whereas a license gives permission for a party to use the right under specified conditions for a defined period.[75] Unless otherwise specified, the transfer of a royalty does not include the property or property right that produces it. A royalty may be classified as either business or nonbusiness income depending on whether the creator is in the trade or business of writing, performing, or inventing.[76]

Self-created copyrights and literary, musical, or artistic compositions are generally not treated as capital assets.[77] All income that a work generates, even in a sale, is ordinary income. If an individual is hired to create a work as part of his employment, the employer owns the IP rights, and payments to its employee are treated as compensation.[78] The holder of a patent treats the income from sale as a long-term capital asset, regardless of the time that it is actually held. If an IP right is not a capital asset in the hands of a creator, the right will not be a capital asset in the hands of a taxpayer, whose basis is determined by reference to the basis of the creator. Thus the recipient of a gift of an IP right during the creator's lifetime will have the creator's basis. A disposition of IP may produce ordinary income, capital gain or loss, or a charitable contribution deduction. The primary factor in determining whether a sale or transfer has occurred is to what extent the creator has given up rights to the IP under the contract as opposed to the form of payment.[79]

Conclusion

An estate plan that includes IP should contain provisions to ensure the effective transfer and maintenance of the IP. The creator's personal preferences for the ongoing use of the IP after the transfer should always be considered. Although the attorney may not have many clients with valuable IP, cases involving celebrities demonstrate on a large scale the problems that may arise when an estate plan does not exist or fails to properly account for IP and the desired legacy of the original creator.



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NOTES

1. Beastie Boys, "(You Gotta) Fight for Your Right (To Party!)" (Def Jam-Columbia 1986).

2. *See* Cubarrubia, "Adam Yauch's Will Prohibits Use of His Music in Ads," *Rolling Stone* (Aug. 9, 2012), www.rollingstone.com/music/news/adam-yauchs-will-prohibits-use-of-his-music-in-ads-20120809.

3. *See, e.g., Beastie Boys v. Monster Energy Co.*, 66 F.Supp.3d 424 (S.D.N.Y 2014); Blistein, "Beastie Boys Settle Lawsuit Over 'Girls' Toy Commercial," *Rolling Stone* (Mar. 18, 2014), www.rollingstone.com/music/news/beastie-boys-settle-lawsuit-over-girls-toy-commercial-20140318.

4. *See* Goffe, "Part of Beastie Boy Adam Yauch's Will, Banning Use of Music in Ads, May Not be Valid," *Forbes* (Aug. 13, 2012), www.forbes.com/sites/deborahljacobs/2012/08/13/part-of-beastie-boy-adam-yauchs-will-banning-use-of-music-in-ads-may-not-be-valid/#3ff840837698.

5. This article refers to the "creator" for simplicity, but such references could also include inventors, artists, authors, and IP owners.

6. *See* Cullins, "Prince's Estate: No Will Could Mean Chaos, Tax Bills and Lawsuits, Say Experts," *The Hollywood Reporter* (Apr. 27,

2016), www.hollywoodreporter.com/thr-esq/princes-estate-no-will-could-887717.

7. *See id. See also* Sisario, "Disputes Over Prince's Estate Throw the Future of His Vault Into Question," *The New York Times* (June 25, 2017), www.nytimes.com/2017/06/25/arts/music/new-disputes-over-princes-estate-cloud-the-future-of-his-vault.html?_r=0.

8. WIPO is a specialized agency of the United Nations, created as a global forum for intellectual property services, policy, information, and cooperation.

9. World Intellectual Property Organization, "What is Intellectual Property?" www.wipo.int/edocs/pubdocs/en/intproperty/450/wipo_pub_450.pdf.

10. 26 USC § 936(h)(3)(B).

11. *See* Weyl and Tirole, "Materialistic Genius and Market Power: Uncovering the Best Innovations" 2 (Aug. 4, 2010), www.researchgate.net/publication/239807722_Materialistic_Genius_and_Market_Power_Uncovering_the_Best_Innovations.

12. *See* Stanford University, "Intellectual Property," *Stanford Encyclopedia of Philosophy* (substantially rev. Sept. 22, 2014), plato.stanford.edu/entries/intellectual-property/#HisIntPro.

13. *Id.*

14. *Id.*

15. 17 USC § 102(a).

16. A "derivative work" is one based on preexisting material to which enough original creative work has been added so that the new work represents an original work of authorship. *See* Stim, *Patent, Copyright & Trademark* 222–23 (13th ed. NOLO 2014).

17. 17 USC § 106.

18. U.S. Copyright Office, Circular 1 at 4 (Sept. 2017), www.copyright.gov/circs.

19. U.S. Copyright Office, Circular 3 at 1 (Sept. 2017), www.copyright.gov/circs.

20. 17 USC § 302(a).

21. 17 USC § 302(b).

22. 17 USC § 302(c).

23. Circular 1, *supra* note 18, at 6.

24. 17 USC § 202.

25. *See* Duffy, "Rights That Go Bump in the Night—Planning and Administering Copyrights in an Artist's Estate," *Probate and Property Magazine* (Sept./Oct. 2017).

26. 17 USC § 203. For pre-1978 copyright transfers, which have a total duration of 95 years, it takes at least 56 years from the initial copyright assignment for the termination right to arise.

27. *Id.* The House Report accompanying the 1976 Act provides that the right of termination is necessary because of the unequal bargaining position of authors and the difficultly in determining the value of the work until it has been exploited.

28. 17 USC § 203(a)(3).

29. 17 USC § 203(a)(4)(A).

30. *Id.*

31. *See* Duffy, *supra* note 25.

32. 17 USC § 203(a)(2).

33. A joint owner who separately transfers his copyright interest may unilaterally terminate that grant, but if two or more joint authors join in transferring the copyright interests, a majority of the authors are needed to terminate the grant.

34. *See, e.g., Brumley v. Albert E. Brumley & Sons, Inc.*, 822 F.3d 926 (6th Cir. 2016) (holding that four of six siblings could exercise termination right over copyright transferred to another sibling by parent); Field and Feldman, "Termination Rights—Explained," Association of Independent Music Publishers (Feb. 13, 2011), www.aimp.org/copyrightCorner/2/Termination_Rights_-_Explained.

35. *See* Sallito, "Duran Duran 'shocked' after losing legal copyright battle," BBC News (Dec. 2, 2016), www.bbc.com/news/entertainment-arts-38182418.

36. *See* Flanigan, "Duran Duran Loses Case, Brought in Britain, Over American Copyrights," *The Hollywood Reporter* (Dec. 2, 2016), www.hollywoodreporter.com/thr-esq/duran-duran-loses-case-brought-britain-american-copyrights-952271.

37. *See* Gardner, "Paul McCartney Sues Sony to Regain Rights to Beatles Songs," *The Hollywood Reporter* (Jan. 18, 2017), www.hollywoodreporter.com/thr-esq/paul-mccartney-sues-regain-rights-beatles-songs-965684.

38. *See* Stempel, "Paul McCartney settles with Sony/ATV over Beatles music rights," Reuters (June 30, 2017), www.reuters.com/article/us-people-paulmccartney/paul-mccartney-settles-with-sony-atv-over-beatles-music-rights-idUSKBN19L2ET.

39. *See* Stim*, supra* note 16 at 1.

40. *Id.* at 10.

41. 35 USC § 102.

42. Stim*, supra* note 16 at 126.

43. 35 USC § 156.

44. *See* Types of Patents, USPTO (Mar. 31, 2016), www.uspto.gov/web/offices/ac/ido/oeip/taf/patdesc.htm.

45. *See* "Patent for Bread-Toaster Issued October 18, 1921," USPTO (Oct. 17, 2001), www.uspto.gov/about-us/news-updates/patent-bread-toaster-issued-october-18-1921.

46. *See* USPTO*, supra* note 44. Design patents issued from applications filed before this date are valid for a term of 14 years from the issue date.

47. *See* Stim*, supra* note 16 at 10.

48. *See* Walters, "What a Looming Patent War Could Mean for the Future of the Marijuana Industry," *Vice News* (Apr. 20, 2016), news.vice.com/article/a-patent-for-cannabis-plants-is-already-a-reality-and-more-are-expected-to-follow.

49. *See* "Trademark basics," USPTO, www.uspto.gov/trademarks-getting-started/trademark-basics.

50. *See* Stim*, supra* note 16 at 344.

51. *See id.*

52. *See id.* at 442.

53. *See id.* at 393–94.

54. *See* Rahne and Shapiro, "Practical Considerations for Valuing Intellectual Property Assets in Estate Planning," *Probate and Property Magazine* (July/Aug. 2017).

55. *See* "How are Trade Secrets Protected??" WIPO, www.wipo.int/sme/en/ip_business/trade_secrets/protection.htm.

56. 18 USC § 1836.

57. Lamar, "Estate Planning for Domain Names" (Sept. 2, 2010), www.digitalpassing.com/2010/09/02/estate-planning-domain-names.

58. *Id.*

59. *See* "Life Cycle of a Typical gTLD Domain Name," ICANN, www.icann.org resources/pages/gtld-lifecycle-2012-02-25-en.

60. 17 USC § 1125(d).

61. *See* Koonjoobeeharry, "Are Domain Names Contract of Services or Property Rights?" *Circle ID* (Feb. 2, 2017), www.circleid.com/posts/20170202_are_domain_names_contract_of_services_or_property_rights.

62. *See* Kelley and Kowalczyk, "Tax Issues for Individuals Who Create Intellectual Property," The Tax Advisor (Nov. 30, 2013), www.thetaxadviser.com/issues/2013/dec/kelley-dec2013.html.

63. *See* Stim*, supra* note 16 at 491.

64. *See* Rosenblatt, "Moral Rights Basics," Harvard Law School (Mar. 1998), cyber.harvard.edu/property/library/moralprimer.html.

65. *See id.*

66. *See id.*

67. 17 USC § 106A.

68. *See* Rosenblatt, *supra* note 64.

69. *See* Morris, "Michael Jackson's Estate Valuation ($2,105) vs. IRS's MJ Valuation ($434 Mil.): Guest Post," billboardbiz (Nov. 11, 2013), www.billboard.com/biz/articles/news/legal-and-management/5785834/michael-jackson-estates-valuation-2105-vs-irs-mj.

70. *See* Cullins, "Carrie Fisher, 'Star Wars' and the Legal Issues of Dead But In-Demand Actors," *The Hollywood Reporter* (May 1, 2017), www.hollywoodreporter.com/news/carrie-fisher-star-wars-legal-issues-dead-but-demand-actors-997335.

71. *See* Lidor, "Sony Trademark Takes a Walk, Man," *Wired* (June 7, 2002), www.wired.com/2002/06/sony-trademark-takes-a-walk-man.

72. *See* Kelley and Kowalczyk, *supra* note 62.

73. *See id.*

74. *See* Stim*, supra* note 16 at 186.

75. *See id.* at 186–87.

76. *See id.*

77. *See* Kelley and Kowalczyk, *supra* note 62.

78. *See id.*

79. *See id.*