

TABLE OF CONTENTS

Volume 1

CHAPTER 1

Overview of Intellectual Property

§ 1.01	What Is Intellectual Property?	1-3
	[1] Distinctive Aspects of Intellectual Property . . .	1-5
	[2] Subfields of Intellectual Property	1-14
	[3] Emergence of Intellectual Property as a Single Field of Law	1-16.1
	[4] Comparing the Forms of Intellectual Property.	1-21
§ 1.02	Protected Subject Matter.	1-22.4
	[1] Patents	1-22.4
	[2] Copyrights	1-23
	[3] Semiconductor Chip Protection	1-25
	[4] Trade Secrets	1-25
	[5] Trademarks and Related Property	1-26.1
	[6] Exploiting the Overlap	1-26.3
§ 1.03	Strength of Protection	1-26.8
	[1] Patents	1-26.8
	[2] Copyrights	1-26.8
	[3] Semiconductor Chip Protection	1-27
	[4] Trade Secrets	1-28
	[5] Trademarks	1-28
§ 1.04	Duration of Protection.	1-30
§ 1.05	Requirements for Protection	1-34
	[1] Patents	1-34
	[2] Copyrights	1-36
	[3] Semiconductor Chip Protection	1-37
	[4] Trade Secrets	1-38
	[5] Trademarks and Related Property	1-38
§ 1.06	Procedure for Protection.	1-41
	[1] Patents	1-41
	[2] Copyrights	1-52.16
	[3] Mask Works	1-52.18
	[4] Trade Secrets	1-52.20

INTELLECTUAL PROPERTY LAW

	[5]	Trademarks and Related Property	1-52.21
		[a] Choosing Commercial Symbols.	1-52.22
		[b] Securing Legal Protection by Use or Registration	1-52.23
		[c] Federal Registration Procedure	1-52.24
		[i] Bases for Federal Registration.	1-55
		[ii] Requirements for a Filing Date	1-62
		[iii] Requirements for a Complete Application	1-62.10
		[iv] Prosecuting the Application	1-62.22
		[v] Post-Registration “Maintenance” Requirements.	1-62.37
		[d] Statutory Trademark Notice.	1-62.55
§ 1.07		Infringement	1-62.57
	[1]	Infringing Activities	1-62.57
		[a] Limited-Term Intellectual Property	1-62.57
		[b] Unlimited-Term Intellectual Property	1-66
	[2]	Standards of Infringement.	1-67
		[a] Limited-Term Intellectual Property	1-68
		[b] Unlimited-Term Intellectual Property	1-73
§ 1.08		Two Paradigms of Intellectual Property Law	1-76
	[1]	The Constitutional Paradigm: “Strong” Protection for a Limited Time.	1-76
	[2]	The Interstate Commerce Paradigm: “Weak” Protection for Potentially Unlimited Time	1-79
	[3]	Federal Preemption	1-81
§ 1.09		International Protection of Intellectual Property	1-90
	[1]	Territoriality.	1-90
	[2]	Treaties and International Conventions	1-94
		[a] The Paris Convention.	1-95
		[b] Other Patent Conventions	1-98
		[c] The Madrid (Trademark) Agreement and Madrid Protocol	1-100.1
		[d] The Copyright Conventions.	1-106
		[e] Modern Treaties	1-110
	[3]	Effects and Problems of International Conventions	1-111
		[a] The Principle of National Treatment—Its Distinction from Reciprocity	1-112.1
		[b] Minimum Standards.	1-114
		[c] The Relationship Between Treaties and Domestic Law.	1-115
§ 1.10		Intellectual Property as Collateral	1-119
	[1]	Security Interests in Trademarks	1-121
	[2]	Security Interests in Copyrights	1-124
	[3]	Security Interests in Patents	1-126

CHAPTER 1A

The TRIPS Agreement and
the GATT Uruguay Round

§ 1A.01	Introduction: The Importance of the Uruguay Round Agreements	1A-4
§ 1A.02	Impact of the Uruguay Round Agreements	1A-8
	[1] The GATT 1947 and the GATT 1994	1A-8
	[2] Breakthroughs of the Uruguay Round Agreements	1A-10
	[a] Intellectual Property	1A-11
	[b] Nontariff Barriers	1A-12
	[c] Services	1A-13
	[d] Dispute Resolution	1A-13
§ 1A.03	The Uruguay Round Agreements and the World Trade Organization	1A-18
	[1] The World Trade Organization (WTO)	1A-18
	[2] The Multilateral Trade Agreements (Including the TRIPS Agreement)	1A-19
	[a] Identification of the Agreements	1A-19
	[b] Membership in the World Trade Organization (WTO)	1A-22
	[3] The Plurilateral Trade Agreements	1A-23
§ 1A.04	Effect of the Uruguay Round Agreements on Domestic Law	1A-25
§ 1A.05	Effective Date of the WTO and TRIPS Agreements and Transition Rules	1A-29
	[1] Entry into Force	1A-29
	[2] Transition Rules	1A-30
	[3] Table of Transition Rules	1A-33
§ 1A.06	Substantive Requirements of the TRIPS Agreement	1A-34
	[1] General Requirements	1A-34
	[a] National Treatment	1A-35
	[b] Most-Favored-Nation Treatment	1A-36
	[c] Exhaustion or First-Sale Doctrine	1A-38
	[2] Specific Requirements for Patents	1A-39
	[a] Patentable Subject Matter	1A-39
	[i] Near-Universal Coverage	1A-39
	[ii] Product and Process Patents	1A-41
	[iii] The “Public Order” Exception	1A-41
	[b] Exclusive Rights	1A-42
	[c] Compulsory Licensing	1A-44
	[d] Term of Protection	1A-47
	[e] Proof of Process Patent Infringement	1A-47
	[3] Specific Requirements for “Undisclosed Information” (Trade Secrets)	1A-49
	[a] Requirements for Protection	1A-49

INTELLECTUAL PROPERTY LAW

	[b]	Misappropriation	1A-50
	[c]	Data Submission to Government	1A-51
[4]		Specific Requirements for Copyrights	1A-51
	[a]	Idea/Expression Dichotomy	1A-52
	[b]	Protection of Computer Programs and Data Bases	1A-53
	[c]	Rental Rights	1A-54
		[i] Computer Programs	1A-55
		[ii] Cinematographic Works	1A-55
		[iii] Phonograms (Sound Recordings)	1A-56
	[d]	Term of Protection	1A-56
	[e]	Neighboring Rights	1A-58
		[i] Performers' Rights	1A-58
		[ii] Phonogram Producers' Rights	1A-59
		[iii] Broadcasters' Rights	1A-60
		[iv] Limitation	1A-61
[5]		Specific Requirements for Semiconductor Chip Protection	1A-61
	[a]	Substantive Norms Derived from WIPO IC Treaty	1A-62
		[i] Provisions Incorporated	1A-62
		[ii] Legal Form of Protection	1A-63
		[iii] Other Issues	1A-64
		[iv] Interaction Between WIPO IC Treaty and TRIPS Agreement	1A-65
	[b]	Exclusive Rights	1A-67
	[c]	Innocent Purchaser Exemption	1A-68
	[d]	Compulsory Licensing	1A-70
	[e]	Term of Protection	1A-71
[6]		Specific Requirements for Trademark Protection	1A-73
	[a]	The Subject Matter of Trademark Protection	1A-73
	[b]	Rights in Trademarks	1A-74
		[i] Likelihood of Confusion	1A-74
		[ii] Curtailing Trademark Piracy	1A-75
		[iii] Nonidentical Goods or Services	1A-76
		[iv] Other Issues	1A-76
	[c]	Term of Protection	1A-77
	[d]	Use of Trademarks and Special Requirements	1A-77
	[e]	Licensing and Assignment of Trademarks	1A-79
[7]		Specific Requirements for Geographical Indications	1A-79
	[a]	Geographical Indications Generally	1A-80

TABLE OF CONTENTS

	[b]	Geographical Indications for Wines and Spirits	1A-83
[8]		Specific Requirements for Industrial Designs	1A-85
[9]		Protection of Existing Matter	1A-87
	[a]	What Is the “Date of Application”?	1A-89
	[b]	General Rule for Pre-Existing Matter	1A-93
	[c]	Restoration of Copyright in Certain Public-Domain Works	1A-96
	[d]	Protection of Patentable Products in Fields of Pharmaceuticals and Agricultural Chemicals	1A-97
		[i] Interim Applications	1A-98
		[ii] Interim Exclusive Marketing Rights	1A-99
§ 1A.07		Remedial Requirements of the TRIPS Agreement	1A-100
	[1]	Mandatory Remedies	1A-101
		[a] Preliminary Relief	1A-101
		[b] Injunctions	1A-102
		[c] Declaratory Relief	1A-104
		[d] Border Measures (Exclusion from Importation)	1A-104.1
		[e] Damages	1A-107
		[f] Disposition or Destruction of Contraband	1A-108
		[g] Criminal Sanctions for Willful Trademark Counterfeiting and Commercial Copyright Piracy	1A-109
	[2]	Optional Remedies	1A-110
	[3]	The “Escape Clause”	1A-112
		[a] Article 44:2 and the “Escape Clause”	1A-112
		[b] Interpretation of the Clause	1A-112
§ 1A.08		Requirements for Legal and Administrative Procedure	1A-115
	[1]	General Requirements	1A-115
	[2]	Rights of Appeal	1A-117
	[3]	Transparency	1A-118
§ 1A.09		Conforming Changes in United States Law	1A-120
	[1]	Legislative Changes Under the Uruguay Round Agreements Act	1A-120
		[a] Changes in Patent Law	1A-120
		[b] Changes in Copyright Law	1A-122
		[c] Changes in Trademark Law	1A-123
	[2]	Changes Not Made	1A-124
		[a] Patent Law	1A-124
		[b] Copyright Law	1A-125
		[c] Semiconductor Chip Protection	1A-126
		[d] Trademark Law	1A-126

CHAPTER 2

Obtaining Patent Rights

§ 2.01	Introduction	2-3
§ 2.02	Patentable Subject Matter—Types of Patents	2-13
	[1] Utility Patents	2-13
	[2] Design Patents	2-14
	[3] Plant Patents	2-18
§ 2.03	Problematic Subject Matter.	2-24
	[1] Introduction	2-24
	[2] Fundamental Scientific Principles and Natural Phenomena	2-42.2
	[3] Mathematical Formulas and Algorithms	2-52
	[a] The Supreme Court’s Jurisprudence and the Distinction Between Abstract Ideas and Concrete Applications	2-55
	[b] The Role of Policy.	2-64.3
	[i] Statutory Considerations	2-64.5
	[ii] Other Requirements of Patent Law	2-64.8
	[c] Failed Attempts at Finding a Rule.	2-64.13
	[4] Business Ideas	2-96.1
	[a] The <i>State Street</i> Panel’s Invalidation of the “Rule” Against Patenting Business Methods	2-97
	[b] The Prior User Defense and Implied Validation of Business-Method Patents	2-105
	[c] <i>Bilski v. Kappos</i> as a prelude to <i>Alice</i> : No Rigid Test.	2-115
	[5] The Limited Exception for Medical and Surgical Procedures	2-128
§ 2.04	The Novelty Requirement.	2-132
	[1] The First-to-Invent Rule (1952 Act) and First-to-File Rule (2011 Act)	2-136
	[2] The One-Year Statutory Bar.	2-148
	[a] Printed Publication	2-149
	[b] In Public Use or on Sale	2-155
	[3] Priority of Invention	2-167
	[a] Conception	2-170
	[b] Reduction to Practice	2-172
	[c] Reasonable Diligence	2-176
	[d] Abandonment, Suppression, or Concealment.	2-177
	[e] Evidentiary Factors.	2-184

TABLE OF CONTENTS

xix

	[4] Other Aspects of the Novelty Requirement . . .	2-187
	[a] Foreign Patents: Section 102(d).	2-187
	[b] United States Patents on Applications Having Priority: Section 102(e)	2-188
	[c] Reissue and Novelty.	2-191
	[5] Novelty Under the 2011 Act’s Unified First-to-File Rules.	2-193
§ 2.05	The Utility Requirement.	2-203
§ 2.06	The Nonobviousness Requirement.	2-210
	[1] The Three-Part Test for Nonobviousness.	2-220
	[2] Objective Factors or “Secondary Considerations”.	2-225
	[3] “Combination” Patents	2-231
	[4] Novelty and Nonobviousness: The Synergy of Sections 102 and 103	2-233
	[5] “Obvious to Try”: A Troubling Standard.	2-238
	[6] The Federal Circuit’s “Suggestion” Test.	2-241
	[7] New Uses for Old Products and Processes.	2-249
§ 2.07	Patent Disclosure Requirements: Enablement, Definiteness, Best Mode, and Written Description	2-260
	[1] Enablement	2-264
	[2] Definiteness of Patent Claims	2-280.3
	[3] Relationship of Disclosure and Definiteness to the “Obvious to Try” Doctrine	2-285
	[4] Best Mode	2-286
	[5] Enablement Through Deposit of Biological Materials.	2-291
	[6] Written Description.	2-295
§ 2.08	The Patent Applicant’s Duty of Candor and Inequitable Conduct in Patent Prosecution.	2-306
	[1] The Duty of Candor and Included Duty to Disclose.	2-309
	[a] Who Has the Duty?	2-310
	[b] What Must Be Disclosed?	2-312
	[i] Knowledge of Materiality	2-312
	[ii] Materiality	2-315
	[c] How to Disclose.	2-316
	[2] Inequitable Conduct (Formerly “Fraud on the Patent Office”)	2-321
§ 2.09	Other Technical Requirements for Valid Patents.	2-324.3
	[1] Double Patenting.	2-324.3
	[2] Inventorship.	2-329
§ 2.10	The Presumption of Patent Validity.	2-339

TABLE OF CONTENTS

Volume 2

CHAPTER 2A

Scope of Patent Rights

§ 2A.01	Nature of Exclusive Rights	2A-3
	[1] The Power to Exclude and Its Strength	2A-9
	[2] The Elusive “Experimental Use” Exception	2A-12
	[3] Patent Suppression and Refusal to License	2A-16
§ 2A.02	Duration of Exclusive Rights	2A-18
	[1] Basic Rules for Computing the Patent Term	2A-20
	[a] The Basic Rule	2A-20
	[b] Relation Back	2A-21
	[2] Patent Term Adjustment and Extension	2A-24
	[a] Patent Term Adjustment	2A-27
	[b] Extension to Compensate for Federal Regulatory Review	2A-38
	[3] Effective Dates and Transition Rules	2A-40
	[a] Term Computation	2A-40
	[b] Relation Back	2A-43
	[c] New Reasons for Term Extension	2A-43
	[d] Table of Transition Rules	2A-44
§ 2A.03	Scope of Exclusive Rights	2A-44.1
	[1] Claim Interpretation and “Literal” Infringement	2A-62
	[a] The Importance of Patent Claims	2A-63
	[b] Patent Claim Construction	2A-74
	[c] Evidence Used in Construing Claims	2A-85
	[d] Procedure for Claim Construction	2A-92.4
	[2] The Doctrine of Equivalents	2A-92.12
	[a] Utility Patents	2A-92.12
	[i] The General Nature of the Doctrine of Equivalents	2A-96
	[ii] The Effect of Prosecution History Estoppel	2A-118
	[b] Design Patents	2A-131
	[3] Means-Plus-Function Claims	2A-133

INTELLECTUAL PROPERTY LAW

	[a]	Background and Purpose	2A-134
	[b]	Identifying Means-Plus-Function Claims	2A-139
	[c]	Consequences of Means-Plus-Function Claiming	2A-143
	[d]	Infringement of Means-Plus-Function Claims	2A-152
§ 2A.04		Statutory Extensions of Exclusive Rights	2A-169
	[1]	Sale of Components, Material, or Apparatus . . .	2A-170
	[2]	Foreign Assembly	2A-173
	[3]	Process Patents	2A-174.6
	[4]	Provisional Rights	2A-174.7
§ 2A.05		Limitations on Exclusive Rights	2A-184
	[1]	The First-Sale or Exhaustion Doctrine	2A-185
	[a]	In General	2A-185
	[b]	Sale in Substance, Not Form	2A-193
	[c]	Application to United States Process Patents	2A-194
	[d]	Foreign Sales and the Process Patent Holder's Importation Right	2A-195
	[2]	Prosecution History Estoppel or "File Wrapper" Estoppel	2A-198
	[3]	Reverse Doctrine of Equivalents	2A-200
	[4]	Patent Misuse	2A-202
	[a]	The Traditional Misuse Doctrine	2A-202
	[b]	Patent Misuse, the Antitrust Laws and Purging	2A-204
	[c]	The 1988 Patent Misuse Amendments . . .	2A-209
	[5]	The Repair Doctrine	2A-214.1
	[6]	Elimination of Licensee Estoppel: The Licensee's Right to Challenge Patent Validity	2A-221
	[7]	Regulatory Testing of Health Care Products . . .	2A-229
	[8]	Defense to Infringement Based on Prior Commercial Use	2A-230.3
§ 2A.06		Some International Aspects of Patent Protection	2A-230.5
	[1]	International Protection in General	2A-230.5
	[2]	Some General Principles of Patent Statutes Abroad	2A-230.9
	[a]	Similarities	2A-230.10
	[b]	Differences	2A-230.12
§ 2A.07		The Patent Cooperation Treaty	2A-230.18
§ 2A.08		Foreign Filing Licenses and Secrecy Orders	2A-234
	[1]	Invention Screening and "Foreign Filing Licenses"	2A-234
	[a]	The Screening Process	2A-235
	[b]	Foreign Filing Licenses	2A-238
	[c]	Procedures for Obtaining Foreign Filing Licenses	2A-242

TABLE OF CONTENTS

vii

[d] Scope of Foreign Filing Licenses 2A-244
[e] Retroactivity 2A-251
[2] Secrecy Orders 2A-253

CHAPTER 3

Products of Patented Processes

§ 3.01 Processes and Their Products 3-2
§ 3.02 Products Not Covered 3-7
 [1] The “Material Change” Exemption 3-7
 [a] The “But for” Test 3-7
 [b] The “Basic Utility” Test 3-8
 [2] The “Trivial and Nonessential Component”
 Exemption 3-9
 [3] Coverage or Protection Limited to Products
 of Manufacturing Processes 3-12
§ 3.03 Liability of Retailers and Noncommercial Users 3-13
§ 3.04 The Inventory Rule 3-15
 [1] Inventory Covered and “Notice of
 Infringement” 3-16
 [2] Does “Knowledge” Override the Limitation
 of Remedies? 3-18
 [3] Permissible Quantity 3-19
 [4] Full Liability for Those Who Practice the
 Patented Process and Their Control
 Persons; Patent Marking 3-19
§ 3.05 Patent Disclosure and Notification of Infringement 3-23
 [1] Requests for Disclosure 3-24
 [a] Timing of Requests and Practical
 Problems for Resellers 3-24
 [b] Patent Marking Limitation 3-25
 [c] Exclusion of Users 3-26
 [d] Mitigating Circumstances 3-27
 [2] Responses to Requests for Disclosure 3-28
 [a] Effect on Responder 3-28
 [b] Effect on Requester 3-30
 [i] Adequate Written Assurances from
 Upstream Supplier 3-31
 [ii] Mitigating Circumstances 3-32
 [iii] Good Faith 3-32
 [iv] Reimbursement 3-33
 [3] Written Notification of Infringement 3-34
 [a] Automatic Notice of Infringement 3-34
 [b] Cumulative Notice of Infringement 3-36
§ 3.06 Presumption of Use of Patented Process 3-38
 [1] Substantial Likelihood of Use 3-38

	[2] Reasonable Effort to Determine Process Used	3-39
§ 3.07	Effective Date and “Grandfather” Clause	3-41

CHAPTER 4

Trade Secrets

§ 4.01	Overview of Trade Secrets	4-3
	[1] Unusual Features of Trade Secrets	4-3
	[2] Underlying Policies	4-7
	[3] Sources of Law	4-11
	[a] Common Law	4-11
	[b] The Uniform Trade Secrets Act	4-15
	[c] The Defend Trade Secrets Act of 2016	4-16
§ 4.02	The Subject Matter of Trade Secret Protection	4-17
	[1] The Definition of “Trade Secret”	4-19
	[a] The <i>Third Restatement’s</i> Definition	4-19
	[b] The Uniform Trade Secret Act’s Definition	4-21
	[c] The Differences Between the <i>Third Restatement’s</i> and the Uniform Trade Secrets Act’s Definitions	4-22
	[2] The Rejected Exceptions for Transitory and Negative Information	4-25
	[a] The Rejected Exception for Information of Temporary or Transitory Use or Value	4-25
	[b] The Rejected Exception for Negative Results	4-26
	[3] Examples of Trade Secrets	4-26.1
	[4] Employees and Public Policy	4-32
	[5] Customer Lists	4-37
§ 4.03	The Fundamental Requirements for a Trade Secret: Limited Availability, Economic Value, and Relative Secrecy	4-41
	[1] Limited Availability	4-48
	[a] Absence of Absolute Standard	4-50
	[b] Availability in the Relevant Industry	4-51
	[c] Ready Ascertainability	4-53
	[2] Economic Value	4-57
	[3] The Requirement for Reasonable Efforts	4-61
	[a] Security Measures	4-64
	[b] Relationships with Employees, Suppliers, Licensees, and Customers	4-68
	[c] Inadequate Efforts	4-72
	[d] Contractual Requirements for “Reasonable Efforts”	4-73

TABLE OF CONTENTS

ix

	[4] The <i>First Restatement’s</i> Six Factors	4-74
	[5] Practical Evidentiary Factors	4-76
	[a] Specificity	4-76
	[b] Removal of Tangible Records	4-79
	[c] Inequity	4-80
§ 4.04	“Exclusive” Rights in Trade Secrets and Misappropriation	4-82
	[1] Duration of Legal Protection	4-82
	[2] Misappropriation and Improper Means	4-83
	[a] Misappropriation and the Concept of Improper Means	4-85
	[b] Proper Means and Shared Ownership	4-91
	[c] Reverse Engineering	4-93
	[3] Product Modification and Improvement: Determining Whether a Trade Secret Has Been Used	4-96
	[4] Availability Through Proper Means: The “Could Have” Defense	4-100
	[5] Indirect and Accidental Misappropriation	4-103
	[a] The State-of-Mind Requirements	4-104
	[b] The Timing of Knowledge or Notice	4-105
	[c] “Reasonable Efforts” to Protect the Secret	4-108
	[6] Are Trade Secrets “Property”?	4-110
	[7] Relief from Misappropriation and the “Head Start” Period	4-114
	[a] Injunctive Relief and the “Head Start” Period	4-115
	[b] Monetary Relief	4-122
§ 4.05	Trade Secrets and Contracts	4-128
	[1] The Effect of Tort Law and Confidential Relationships	4-128
	[a] The Employee-Employer Relationship	4-131
	[b] Nonemployee Relationships	4-136
	[c] No Relationship	4-140
	[2] Contractual Protection of Confidential Information	4-141
	[3] The Practical Value of Nondisclosure Covenants	4-143
	[a] How Nondisclosure Covenants Enhance Trade Secret Protection	4-144
	[b] Expanding the Scope of Relief	4-146
	[c] Risk of Impairing Common-Law Protection	4-148
	[d] Minimum Requirement for Limited Availability	4-149
	[4] Nondisclosure and Noncompetition Covenants	4-150
§ 4.06	Trade Secrets and Patents	4-154

INTELLECTUAL PROPERTY LAW

	[1] The Election Between Patent and Trade Secret Protection	4-154
	[2] “Hybrid” Licensing Agreements	4-160
§ 4.07	International Aspects of Trade Secret Protection	4-164.1
	[1] The Weakness of Trade Secret Protection Abroad	4-164.1
	[2] The Value of Practical Measures Abroad	4-167
§ 4.08	Disclosure of Trade Secrets to and by the Government	4-169
	[1] Government Contracts: Protection of Technical Data and Computer Software	4-169
	[a] Protection of Technical Data	4-174.1
	[i] Noncommercial Regime	4-179
	[ii] Commercial Regime	4-189
	[b] Protection of Computer Software, Documentation, and Databases	4-191
	[i] Commercial Regime	4-191
	[ii] Noncommercial Regime	4-196
	[iii] The Commercial/Noncommercial Distinction for Software	4-200
	[c] Notification, Restrictive Legends and Markings, and Their Validation	4-202
	[i] Identifying Restricted Matter	4-203
	[ii] Restrictive Markings	4-207
	[iii] Validation of Asserted Restrictions	4-211
	[d] Subcontractors’ Rights	4-214
	[e] The Effect of Defense Department Rules	4-216
	[2] Governmental Use or Disclosure of Information	4-220
	[a] Freedom-of-Information-Act Disclosure	4-221
	[b] Notice and Challenge Procedures	4-223
	[c] Disclosure in Litigation	4-226
	[3] Compensation for Disclosure or Use by the Government	4-231
	[a] Compensation Under the Fifth Amendment	4-231
	[b] Compensation Under Federal Statute or State Law	4-234

CHAPTER 5

What Is Copyrighted?

§ 5.01	Subject Matter of Copyright	5-2
	[1] General Scope of Subject Matter	5-4

TABLE OF CONTENTS

xi

	[2] The Idea/Expression Dichotomy	5-11
	[a] The Basic Doctrine	5-11
	[b] Underlying Policies	5-15
	[c] The “Levels of Abstraction” Test	5-16.2
	[d] Merger of Idea and Expression	5-18
	[3] Assessing Infringement: Access and Substantial Similarity	5-21
§ 5.02	Problematic Categories of Copyrighted Subject Matter	5-25
	[1] Computer Programs	5-25
	[a] The 1980 Software Amendments	5-26
	[b] Case Law	5-27
	[c] Computer-Generated Works	5-38.9
	[2] Compilations and Databases	5-38.10
	[a] Compilations of Data as Copyrighted Works	5-38.10
	[b] The Theoretical Basis of Compilation Copyrights: “Sweat of the Brow” Doctrine Rejected	5-38.15
	[c] Copyright Protection for Random-Access Databases	5-38.18
	[i] Copying the Arrangement	5-38.19
	[ii] Copying the Selection	5-38.27
	[d] Toward a Theory of Database Protection	5-38.30
	[i] The Numbers Approach	5-38.32
	[ii] The Categories Approach	5-38.32
	[iii] Congruence of Markets	5-38.33
	[iv] An Economic Approach	5-38.35
	[v] Conclusion: The Statutory Approach	5-38.37
	[3] Useful Articles	5-38.38
	[a] Ornamental Aspects of Useful Articles	5-39
	[b] Pictures of Useful Articles	5-46
	[c] Plans, Drawings, and Models for Useful Articles	5-48
	[i] Eligibility of Plans, Drawings, and Models for Copyright Protection	5-48
	[ii] Limits on Protection	5-50
	[4] Architecture	5-54
	[a] The Separate Legal Regime for Building Designs	5-56
	[b] Subject Matter Covered: Building Designs	5-59
	[c] Limitations on Copyright Protection for Building Designs	5-60
	[d] Prospectivity of Protection	5-60.3
	[5] The Law	5-60.5

INTELLECTUAL PROPERTY LAW

	[a]	Background on the Copyright Status of “the Law”	5-60.5
		[i] Underlying Policy	5-60.6
		[ii] Doctrine	5-60.11
	[b]	Federal Law	5-60.15
	[c]	State and Local Law	5-60.18
	[d]	Just Compensation for Lost Copyrights?	5-60.27
§ 5.03		Prerequisites for Copyright Protection: Fixation, Originality, and Creativity	5-61
	[1]	Fixation	5-62
		[a] New Technology	5-62
		[b] Communicative Function	5-65
		[c] What “Fixation” Means	5-67
		[i] Author’s Authorization	5-68
		[ii] Tangible Medium and Permanence	5-68
		[d] Fixation and Interactive Systems	5-69
		[e] Fixation and Copyright Preemption	5-72
	[2]	Originality	5-73
	[3]	Creativity	5-86
	[4]	What Copyright Does Not Require	5-88
		[a] The Difference Between Copyright and Patent Standards	5-88
		[b] Content and Copyright Protection	5-90

CHAPTER 5A**Technological Protection for Copyrighted Works**

§ 5A.01		Introduction	5A-2
§ 5A.02		The Anti-Circumvention Rule	5A-9
	[1]	Definitions Under the Anti-Circumvention Rule	5A-10
	[2]	The Anti-Circumvention Rule’s Legal and Practical Impact	5A-12
		[a] Balance in Copyright Law and Policy	5A-15
		[b] Preexisting Mechanisms for Balance in Copyright Law	5A-19
		[c] Balance and Section 1201	5A-23
		[d] Effects of the New “Balance”: Unintended Consequences?	5A-29
	[3]	The Exemptions Promulgated by the Library of Congress	5A-30.2
		[a] The Library’s Rulemaking Power	5A-32
		[b] The Library’s Exemptions	5A-37

TABLE OF CONTENTS

xiii

§ 5A.03	The Two Anti-Trafficking Rules.....	5A-50
	[1] The Anti-Trafficking Rule for Means to Defeat Access Controls.....	5A-52.3
	[2] The Anti-Trafficking Rule for Means to Defeat Use Controls	5A-52.7
	[3] The Three Conditions for Anti-Trafficking Liability	5A-52.13
	[4] Anti-Trafficking Liability and the First Amendment	5A-56.2
	[a] The <i>Reimerdes</i> Decision.....	5A-56.3
	[b] A Closer Look at the First Amendment as Applied to the Anti-Trafficking Rules.....	5A-67
	[i] Is Binary Executable Code “Speech”?	5A-67
	[ii] Some Useful Analogies.....	5A-73
	[iii] Beyond Binary Executable Code	5A-76
	[iv] The Hard Cases: Mixed-Use Technology and Linking	5A-80
§ 5A.04	Exceptions to Anti-Circumvention and Anti- Trafficking Rules.....	5A-86
	[1] Subject-Matter Classification.....	5A-87
	[2] The “Target Rules” of the Exceptions	5A-90
	[3] Two Examples: Encryption Research and Reverse Engineering	5A-94.1
	[a] Encryption Research.....	5A-94.1
	[b] Reverse Engineering.....	5A-98
§ 5A.05	Rules Protecting Copyright Management Information	5A-102
	[1] What Is CMI?	5A-105
	[2] The Basic Rules Protecting CMI.....	5A-113
	[a] The Three Types of Offenses	5A-114
	[i] Providing or Disseminating False CMI.....	5A-114
	[ii] Removing or Altering CMI Without Authorization	5A-115
	[iii] Knowingly Disseminating CMI or Works (or Publicly Performing Works, Copies, or Phonorecords) from Which CMI Has Been Removed or Altered Without Authorization ...	5A-116.1
	[b] State-of-Mind Requirements.....	5A-117
	[3] Exceptions and Limitations on Liability.....	5A-126
§ 5A.06	Civil Remedies and Criminal Sanctions.....	5A-128.1
	[1] Civil Remedies.....	5A-129
	[2] Criminal Sanctions	5A-135

TABLE OF CONTENTS

Volume 3

CHAPTER 6

The Nature of Copyright Protection

§ 6.01	The Copyright Owner’s Exclusive Rights and Moral Rights	6-6
[1]	The Reproduction Right.	6-26.2
	[a] Evanescent Copies and Phonorecords	6-26.7
	[b] What Is “Transient Duration”?	6-26.11
	[c] The Exception for Computer Maintenance and Repair	6-26.12
[2]	The Derivative Work (Adaptation) Right	6-26.16
	[a] Definition of “Derivative Work”	6-26.16
	[b] Distinction Between Derivative Works and Copies	6-26.17
	[c] The Relationship Between Derivative Works and Underlying Works.	6-26.19
	[i] The “Value-Added” Principle.	6-26.19
	[ii] The Independent Copyright Principle	6-26.21
	[iii] The “Standoff” Principle	6-26.22
	[d] Scope of the Derivative Work Right.	6-26.26
	[e] The “Outer Limits” of the Derivative Work Right: Uncopyrighted Derivative Works	6-26.30
[3]	The Distribution Right	6-26.39
	[a] Scope of Distribution Right	6-26.39
	[b] First-Sale Doctrine	6-26.44
	[i] Codification in Section 109	6-26.47
	[ii] Exceptions for Phonorecords and Computer Programs	6-26.49
	[iii] Inapplicability to First Sales of Copies or Phonorecords Lawfully Made Abroad	6-26.54
[4]	The Rights of Public Performance and Public Display	6-26.58
	[a] Types of Works Covered	6-26.58

INTELLECTUAL PROPERTY LAW

	[b]	Breadth of Performance Right	6-26.60
	[c]	Breadth of Display Right	6-26.63
	[d]	What “Publicly” Means	6-26.65
		[i] “Public Place” Clause	6-26.65
		[ii] “Transmission” Clause	6-26.66
[5]		The Special Regime for Sound Recordings and Phonorecords	6-26.67
	[a]	Definition of Sound Recordings	6-27
	[b]	Limitations on Exclusive Rights: “Mechanical” Reproduction Rights and Performance Rights Limited to Digital Audio Transmissions	6-27
	[c]	Phonorecord Compulsory Licensing of Nondramatic Musical Works	6-32.1
	[d]	Jukebox Licensing	6-32.6
	[e]	Performing Rights Societies	6-34
	[f]	Nonprofessional Reproduction of Musical Recordings	6-35
		[i] Noncommercial Copying by Consumers	6-36.1
		[ii] Restrictions and Royalties on Recording Equipment and Media	6-36.9
		[iii] Enforcement: Civil Actions and Remedies	6-36.13
	[g]	The Digital Audio Transmission Right	6-36.17
[6]		Moral Rights	6-36.19
	[a]	Works Covered	6-39
	[b]	Nature of Moral Rights	6-44
		[i] Right of Attribution	6-44
		[ii] Right of Integrity	6-46
		[iii] Inalienability and Waiver of Moral Rights	6-47
		[iv] Moral Right in Joint Works	6-49
	[c]	Duration of Moral Rights	6-49
	[d]	Enforcement of Moral Rights	6-50
	[e]	Preemption of Moral Rights	6-50
[7]		Performers’ Rights	6-52
	[a]	Limitations of Section 1101	6-55
	[b]	Exclusive Rights	6-58
		[i] Fixation Right	6-58
		[ii] Transmission or Communication Right	6-58.1
		[iii] Distribution and Trafficking Right	6-58.2
	[c]	Remedies	6-58.4
	[d]	Satisfaction of TRIPS Agreement Obligations	6-58.5
[8]		Fair Use	6-58.6

TABLE OF CONTENTS

vii

§ 6.02	Ownership of Copyright	6-58.28
	[1] Copyright and Copy Distinguished	6-58.29
	[2] The Divisibility of Copyright	6-58.30
	[3] Who Owns the Copyright?	6-58.36
	[a] Who Is the Author?	6-59
	[b] Works Made for Hire	6-59
	[i] The Two Classes of Works Made for Hire	6-60
	[ii] The Causes of Past Judicial Confusion	6-61
	[iii] Judicial Interpretation: The Multifactor Agency-Law Test for “Employment”	6-63
	[iv] Consequences of Work Made for Hire Status	6-66
	[c] Joint Works	6-68
	[i] Definition of Joint Work	6-69
	[ii] Consequences of Joint Work Status	6-71
	[iii] Joint Works Compared with Derivative Works and Works Made for Hire	6-73
	[d] Collective Works	6-74
	[4] Open Source	6-76
§ 6.03	Transfer of Copyright	6-76.9
	[1] Transfers Permissible	6-76.9
	[2] Expropriation	6-76.17
	[3] Requirements to Effect a Transfer	6-76.17
	[a] The Statute of Frauds	6-76.18
	[b] Recordation	6-76.22
	[i] Effects of Recordation	6-76.22
	[ii] Requirements for Recordation	6-76.23
§ 6.04	Duration of Copyright	6-77
	[1] Term of Copyright: Works Created on or After January 1, 1978	6-96
	[a] Works by Identified, Individual Authors	6-96
	[b] Anonymous and Pseudonymous Works	6-96.3
	[c] Works Made for Hire	6-96.5
	[d] Records Aiding Fact Finding	6-96.5
	[2] Works Created Before January 1, 1978	6-96.6
	[a] Works Not Published Before January 1, 1978	6-96.6
	[b] Works in Their Initial Term on January 1, 1978	6-96.7
	[c] Works in Their Renewal Term on October 27, 1998	6-96.14
	[d] The Ninety-Five-Year Rule for Works Published Before 1978	6-96.16

INTELLECTUAL PROPERTY LAW

[3]	Restoration of Copyright in Certain Works of Foreign Origin	6-96.17
[a]	Works Subject to Restoration of Copyright	6-96.25
[i]	National Eligibility Requirements	6-100
[ii]	Nonexpiration of Putative Term of Copyright in the United States	6-105
[iii]	Nonexpiration of Foreign Copyright Term and the “Source Country”	6-107
[b]	The General Nature of Copyright Restoration	6-112
[i]	Automatic Operation and Benefits of Registration	6-114
[ii]	Date of Restoration	6-114
[iii]	General Effects of Restoration	6-116.1
[iv]	Renewal of Restored 1909 Act Copyrights	6-116.3
[c]	Remedies with Respect to Persons Other Than Reliance Parties	6-126
[i]	Grace Period for Disposal of Pre-Manufactured Copies	6-127
[ii]	The Rule of Prospectivity of Remedies	6-130
[d]	Remedies with Respect to Reliance Parties	6-131
[i]	Notice of Intent to Enforce Copyright and Its Effect	6-134
[ii]	Compulsory Licensing of Certain Derivative Works	6-150.1
[iii]	Statutory Damages and Attorneys’ Fees	6-150.9
[e]	Who Is a Reliance Party?	6-150.10
[i]	Continuing Infringers	6-150.11
[ii]	Makers or Acquirers of Copies or Phonorecords	6-150.12
[iii]	Successors, Assignees, and Licensees	6-150.13
[iv]	Other Reliance Parties and the Limited Role of Actual Reliance	6-150.15
[v]	Timing Issues and the Phrase “Becomes an Eligible Country”	6-150.17
[f]	Effect of Copyright Restoration on Agreements Relating to Restored Copyrights	6-150.20

TABLE OF CONTENTS

ix

	[i] License Agreements	6-150.21
	[ii] Licensees' Status as Reliance Parties	6-150.21
	[iii] Warranties and Indemnification and Agreements to Infringe.....	6-152
	[g] Ownership of Restored Copyrights	6-153
§ 6.04A	Statutory Termination of Copyright Transfers and Licenses	6-155
	[1] The Evolution of the Termination Right and the Four Kinds of "New Estates".....	6-156
	[2] What Grants Are Terminable?.....	6-166
	[a] The Exclusion of Works Made for Hire.....	6-169
	[b] The Derivative Works Exception.....	6-172
	[c] The Exclusion of Testamentary Transfers...	6-180
	[3] Termination of Pre-1978 Grants	6-184
	[a] The Time Window for Terminating Pre-1978 Grants	6-187
	[b] Who May Have Executed a Terminable Pre-1978 Grant.....	6-194
	[c] Who May Terminate a Terminable Pre-1978 Grant.....	6-197
	[i] Grants by a Sole Author.....	6-197
	[ii] Grants by Coauthors in Joint Works	6-198
	[iii] Grants in Whole or in Part by Nonauthors	6-200.2
	[iv] Termination Through Agents	6-200.5
	[d] Procedure for Terminating Pre-1978 Grants.....	6-200.5
	[e] The Effect of Terminating a Pre-1978 Grant.....	6-207
	[i] Grants by Nonauthors.....	6-207
	[ii] Grants by Sole Authors	6-208
	[iii] Grants by Coauthors.....	6-211
	[4] Termination of Post-1977 Grants	6-212
	[a] The Time Window for Terminating Post-1977 Grants	6-212.1
	[b] Who May Terminate Post-1977 Grants: Authors and Their Statutory Successors.....	6-213
	[c] The Procedure for Terminating Post-1977 Grants	6-216
	[d] The Effect of Terminating a Post-1977 Grant	6-218
	[5] Statutory Protection of the Termination Right...	6-221
	[6] Effect of Termination on Contractual Provisions.....	6-223
§ 6.05	Copyright Misuse.....	6-226

CHAPTER 7

**Copyright Formalities:
Notice, Registration and Deposit**

§ 7.01	Introduction: The International Copyright Conventions and United States Copyright Formalities	7-2
§ 7.02	Copyright Notice	7-6.1
	[1] The 1909 Act Regime	7-6.1
	[2] The Pre-Berne 1976 Act Regime	7-8
	[a] When Was Notice Required?	7-9
	[b] Form of Notice	7-12
	[i] General Form Requirements	7-12
	[ii] Compilations, Derivative Works, Useful Articles, and Government Works	7-14
	[iii] Phonorecords	7-14
	[iv] Collective Works and Contributions to Them	7-14
	[c] Placement and Affixation of Notice	7-16.7
	[d] The Unit Publication Doctrine	7-17
	[e] Omission of Notice and Saving Provisions	7-18
	[i] Relatively Small Number of Copies	7-19
	[ii] Reasonable Effort to Cure Omission	7-20
	[iii] Licensee's Use of Notice	7-23
	[f] Omitted Notice and the "Innocent Infringer"	7-24
	[g] Defective Copyright Notice	7-26
	[i] Incorrect Name in Copyright Notice	7-26
	[ii] Incorrect Year-Date in Notice	7-28
	[3] The Post-Berne 1976 Act Regime	7-29
§ 7.03	Registration	7-31
	[1] Overview of Registration	7-33
	[2] Effects of Registration	7-36
	[a] Evidence of Ownership and Validity of Copyright	7-38
	[b] Prerequisite to Infringement Suit	7-39
	[i] Berne Accession Changes	7-40
	[ii] Works Still Subject to the Registration Prerequisite: Overview	7-41

TABLE OF CONTENTS

xi

	[iii] Works Still Subject to the Registration Prerequisite: Unpublished Works	7-43
	[iv] Works Still Subject to the Registration Prerequisite: Published Works	7-44
	[v] Works Still Subject to the Registration Prerequisite: Audiovisual Works	7-46
	[vi] Works Still Subject to the Registration Prerequisite: Works Incorporated in Buildings or Structures	7-48
	[vii] Works Still Subject to the Registration Prerequisite: The Effect of the Work-Made-for-Hire Doctrine	7-49
	[viii] The Exception for Simultaneously Recorded Live Transmissions	7-50
	[c] Prerequisite to Recovery of Statutory Damages and Attorneys' Fees	7-51
	[d] Timing of Registration	7-56
	[i] The "Commencement" Rule for Statutory Damages and Attorneys' Fees	7-57
	[ii] When Registration is Effective	7-59
	[iii] Expediting Registration	7-60
	[3] The Mechanics of Registration	7-61
§ 7.04	The Deposit Requirements	7-63
	[1] "Mandatory" Deposit	7-63
	[2] Registration Deposit	7-64
	[a] Exceptions: Overview	7-66
	[b] Computer Program Deposits	7-67
	[i] Protection of Trade Secrets	7-68
	[ii] Protection of Screen Displays	7-69

CHAPTER 8

Semiconductor Chip Protection

§ 8.01	Technical Background	8-3
	[1] Semiconductor Chip Products	8-4
	[2] Chip Fabrication	8-6
	[3] The Manufacturing Process	8-7
	[4] Chip Design	8-8
	[5] Economics of Semiconductor Chip Production	8-10

§ 8.02	Legislative History of the Chip Act	8-15
	[1] Need for the Chip Act	8-15
	[2] Outline of Legislative History	8-18
	[3] The Switch from Copyright to <i>Sui Generis</i> Protection	8-21
§ 8.03	Protected Subject Matter	8-24
	[1] The Nature of Protected Designs	8-24
	[a] Semiconductor Chip Products	8-24
	[b] Mask Works	8-26
	[2] Fixation	8-27
	[a] Fixation Other Than in a Chip	8-28
	[b] Fixation in Nonvolatile Chip Memory	8-30
	[c] Authorization of Mask Work Owner	8-30
	[3] Originality	8-31
	[a] The Statutory Requirement	8-31
	[b] Absence of Copying	8-32
	[c] Creativity	8-32
	[d] Prior Art	8-32
	[e] The No-Dissection Rule	8-33
	[f] Independent Creation	8-33
	[g] Burden of Proof	8-35
	[h] Mask Work Genericide	8-36
	[4] Idea/Layout Dichotomy	8-36
	[a] The Basic Doctrine	8-37
	[b] Merger of Idea and Layout	8-37
§ 8.04	Exclusive Rights in Mask Works	8-39
	[1] The Reproduction Right	8-39
	[a] Types of Reproduction Covered	8-39
	[b] Substantial Similarity	8-40
	[2] The Distribution Right	8-42
	[3] The Importation Right	8-43
	[4] Contributory Infringement	8-44
§ 8.05	Limitations on Exclusive Rights	8-45
	[1] Reverse Engineering	8-45
	[a] Statutory Language	8-45
	[i] Copying as a First Step	8-46
	[ii] Objects of Reverse Engineering	8-46
	[iii] Commercial Exploitation of Results	8-48
	[b] Reverse Engineering and Copying Distinguished	8-49
	[i] What the Reverse Engineering Exemption Seeks to Permit	8-50
	[ii] The Assumption of No Middle Ground	8-52
	[iii] The Analytical Tool Kit	8-53
	[c] Cells and Cell Libraries	8-60.1
	[i] Cells and Substantial Similarity	8-61
	[ii] Cells and Reverse Engineering	8-62

TABLE OF CONTENTS

xiii

	[2]	The Innocent Purchaser Exception	8-63
	[a]	The Statutory Exemption	8-64
		[i] Nature of Notice	8-65
		[ii] Notice of Authorization	8-65
		[iii] Effect of Notice.	8-67
	[b]	Reasonable Royalty	8-68
	[c]	Downstream Purchasers and Use of Chips in Products.	8-69
	[3]	First-Sale Doctrine	8-70
§ 8.06		Term and Nature of Protection	8-72
	[1]	Term of Protection	8-72
	[2]	Commercial Exploitation	8-73
		[a] Statutory Definition	8-73
		[b] Delivery of Prototypes	8-74
		[c] Written Offers.	8-75
	[3]	Retroactivity	8-75
	[4]	Constitutional Authority.	8-76
	[5]	Effect on Other Laws.	8-77
		[a] General Effect on Other Federal Laws . . .	8-77
		[b] Patents	8-77
		[c] Copyrights.	8-78
		[d] State Laws.	8-80
		[i] The Equivalency Test	8-80
		[ii] Trade Secrets and Preemption	8-81
		[e] Trademark and Trade Dress Protection . . .	8-83
§ 8.07		Mask Work Registration, Notice, Ownership, and Transfer	8-85
	[1]	Registration of Mask Works	8-85
		[a] The Registration Process	8-86
		[b] Evidence of Validity.	8-88
	[2]	Ownership of Mask Works	8-90
	[3]	Transfer and Licensing of Mask Works	8-91
		[a] Recordation of Transfers	8-92
		[b] Nonexclusive Licenses	8-93
	[4]	Standing to Sue for Infringement	8-93
	[5]	Mask Work Notice.	8-94
		[a] Form and Placement of Notice	8-94
		[b] Effect of Notice	8-95
§ 8.08		International Considerations	8-98
	[1]	Requirements for Protection of Foreign Mask Works.	8-99
		[a] First Commercial Exploitation in the United States	8-100
		[b] Nationality or Domicile Requirements . . .	8-100
	[2]	Statutory Incentives for Reciprocity	8-101
		[a] Presidential Proclamation	8-101
		[b] Interim Orders.	8-102
	[3]	International Treaties	8-105

CHAPTER 9

**Trademarks and Unfair Competition:
What Qualifies for Protection**

§ 9.01	Trade Symbols: The Subject Matter of Protection	
	Under Trademark Principles	9-2
	[1] Technical Trademarks	9-4
	[2] Trade Dress	9-9
	[3] Titles and Characters	9-12
	[4] Trade Names	9-14.1
	[5] Service Marks	9-14.3
	[6] Geographic Trademarks	9-14.6
	[a] Geographic Trademarks Generally	9-14.6
	[b] Geographical Indications for Wines and Spirits	9-14.17
	[7] Internet Domain Names	9-14.20
	[a] The Technical Regime	9-14.22
	[b] The Regime of Private Dispute Resolution	9-14.29
	[c] The Regime of Law	9-14.52
§ 9.02	Trademark Policies and Requirements for Protection	9-15
	[1] Trademark Policies	9-16
	[2] Distinctiveness	9-22
	[a] Arbitrary and Fanciful Marks	9-25
	[b] Suggestive Marks	9-26
	[c] Descriptive Marks	9-27
	[d] Generic Marks	9-33
	[e] Legal Effect of Place in Distinctiveness Spectrum	9-34.3
	[f] The Relativity of Distinctiveness	9-34.7
	[3] Secondary Meaning	9-35
	[a] Verbal Trademarks and Trade Names	9-35
	[b] Nonverbal Trademarks and Trade Dress	9-36
	[i] Product Design or Configuration	9-38
	[ii] Packaging and Other Forms of Trade Dress	9-48
	[c] Secondary Meaning in the Making	9-55
	[d] Demonstrating Secondary Meaning	9-57
	[e] Geographic Scope of Secondary Meaning	9-60
	[4] Nonfunctionality	9-61
	[a] The Basic Doctrine	9-61
	[b] “Aesthetic” Functionality	9-75
	[5] Other Statutory Restrictions	9-88

TABLE OF CONTENTS

Volume 4

CHAPTER 10

Scope of Legal Protection of Trademarks and Other Trade Symbols

§ 10.01	The Standard for Infringement: Likelihood of Confusion	10-2
[1]	The Nature of “Likelihood of Confusion”	10-7
[a]	“Likelihood” as Neither Possibility Nor Certainty	10-8
[b]	Confusion as to What?	10-8
[i]	Confusion as to Affiliation, Approval, or Sponsorship.	10-9
[ii]	Post-Sale Confusion	10-16
[iii]	Initial Interest Confusion	10-17
[iv]	Application to Licensing.	10-24
[2]	Considering All the Circumstances	10-27
[3]	Applying the “Likelihood of Confusion” Standard	10-30
[a]	Strength of the Plaintiff’s Mark.	10-30
[b]	Similarity of the Marks	10-38
[c]	Similarity of Products.	10-42
[d]	Channels of Trade.	10-45
[e]	Advertising and Promotion.	10-46.2
[f]	Nature of Customers.	10-46.2
[g]	Intent or “Bad Faith”	10-46.3
[h]	Actual Confusion	10-46.9
§ 10.02	Strength and Duration of Trade Symbol Protection	10-46.13
[1]	Use and Registration	10-46.14
[2]	Abandonment	10-46.17
[a]	Nonuse.	10-46.18
[b]	Loss of Trademark Significance	10-46.30
§ 10.03	Trademark Dilution	10-46.34
[1]	Sources of Trademark Dilution Law.	10-46.37
[a]	Federal Dilution Law	10-46.38
[b]	State Dilution Law	10-52

INTELLECTUAL PROPERTY LAW

	[2]	What Is Dilution?	10-56
	[a]	Defining the Term “Dilution”	10-57
	[b]	Kinds of Dilution	10-58
		[i] Blurring	10-59
		[ii] Tarnishment	10-63
		[iii] Confusion	10-66
		[iv] Unauthorized Alternation of Trademark	10-68
	[c]	Federal and International Significance of the Branches of Dilution Doctrine	10-72
	[3]	The Requirement of Distinctiveness	10-76
		[a] Federal Law	10-76
		[b] State Law	10-80
	[4]	Other Requirements for Protection	10-81
		[a] Similarity of Trade Symbols Used	10-82
		[b] Association with Plaintiff’s Mark (or Trade Name)	10-82.2
		[c] The Defendant’s Intent	10-82.3
	[5]	A Multifactor Test for Dilution?	10-82.5
	[6]	Federal Preemption	10-82.6
§ 10.04		Trademark Fair Use	10-83
	[1]	The Descriptiveness Branch of Fair Use	10-85
	[2]	The Comparison Branch of Fair Use	10-88

CHAPTER 11

Protecting and Transferring Trade Symbols: Use, Registration, Assignment, Licensing, and Counterfeiting

§ 11.01	Perfecting Protection by Use or Registration		11-3
§ 11.02	Protection Through Use		11-5
	[1]	The Common-Law Rule	11-5
	[2]	Nature of Use	11-6
	[3]	Sources of Common Law	11-8
	[4]	Geographic Extent of Priority	11-9
§ 11.03	Federal Registration		11-16
	[1]	Requirements for Federal Registration	11-16
		[a] Registration Based on Actual Use	11-17
		[b] Registration Based on Intent to Use	11-18.3
			11-18.4
		[i] Nature of Application	11-18.4
		[ii] Statement of Use	11-20
		[iii] <i>Bona Fide</i> Intention to Use	11-22
		[c] Registration Based Upon Foreign Filing or Registration	11-25
		[d] Registration Based on Foreign Registration	11-27

TABLE OF CONTENTS

vii

[2]	Advantages of Federal Registration on the Principal Register	11-28
[a]	Nationwide Priority	11-28
[i]	Limitations on Filing Priority	11-29
[ii]	Relief During Pendency of Application	11-30
[b]	Foreign Priority	11-32.3
[c]	Exclusion of Infringing Imports	11-32.3
[d]	Trademark Counterfeiting Remedies	11-32.3
[e]	<i>Prima Facie</i> Evidence	11-32.4
[f]	Federal Remedies	11-32.4
[g]	Incontestability	11-32.5
[3]	Import Exclusion, Parallel Imports, and Gray Goods	11-32.8
[a]	Common Fact Patterns and Terminology	11-33
[b]	The Legal Framework	11-35
[i]	Trade Symbols Protected	11-36.1
[ii]	Standard for Similarity (Is Likelihood of Confusion Required?)	11-36.2
[iii]	Treatment of Foreigners	11-36.8
[iv]	The Customs Service’s Regulations	11-36.9
[c]	Application of the Law	11-36.13
[i]	The <i>Katzel</i> Decision and Its Aftermath	11-36.13
[ii]	Independent, Unrelated Foreign Owner of Trade Symbol	11-36.16
[iii]	Affiliated Foreign Owner of Trade Symbol	11-36.18
[iv]	Licensed Foreign Owner of Trade Symbol	11-36.24
[v]	Same Entity	11-36.28
[vi]	Matters of Degree	11-36.30
[d]	Impact of the Paris Convention	11-36.34
[4]	The “Limited Area” Defense	11-36.44
[a]	Nature of the Defense	11-37
[b]	Freezing of Defender’s Trade Area	11-39
[c]	Knowledge of Prior Use	11-40
[d]	Effect of Stronger State Law	11-41
[5]	Concurrent Use	11-41
[6]	Registration on the Supplemental Register	11-45
[a]	Marks Registrable on the Supplemental Register	11-46
[b]	Effect of Registration on the Supplemental Register	11-47
§ 11.04	State Registration	11-48
§ 11.05	International Protection	11-53
[1]	International Conventions and Priority	11-54

INTELLECTUAL PROPERTY LAW

	[2]	Protection Against Unfair Competition Abroad	11-54.2
	[3]	International Registration Under the Madrid Protocol	11-55
	[a]	Advantages and Limitations of Madrid-Protocol Protection	11-56.3
	[i]	General Advantages	11-56.3
	[ii]	The Principles of Central Attack and Local Refusal.	11-56.5
	[b]	“Outbound” Registration	11-56.12
	[c]	“Inbound” Registration	11-56.17
	[d]	Renewal and Transfer of Registration	11-56.23
§ 11.06		Trademarks and Goodwill	11-56.26
	[1]	Goodwill	11-56.26
	[2]	The Lanham Act’s Abandonment and “Related Company” Rules.	11-57
§ 11.07		Assignment and Transfer of Trademarks	11-61
	[1]	The Rule Against Assignments in Gross (Without Goodwill)	11-61
	[2]	Statute of Frauds and Recordation	11-63
§ 11.08		Trademark Licensing	11-66
§ 11.09		Trademark Counterfeiting	11-72.3
	[1]	Congressional Aims and Purposes.	11-74.5
	[2]	Marks Protected Against Counterfeiting	11-74.6
	[3]	Definition of “Counterfeit”	11-75
	[4]	State of Mind Requirements	11-80
	[5]	Extenuating Circumstances	11-84

CHAPTER 12**Monetary Remedies**

§ 12.01		Introduction	12-3
§ 12.02		Actual Damages	12-5
	[1]	Causation.	12-7
	[a]	Patents	12-7
	[b]	Copyright.	12-12
	[c]	Semiconductor Chip Protection	12-14
	[d]	Trade Secrets.	12-15
	[e]	Trademarks	12-17
	[2]	Patent and Trademark Marking	12-19
	[3]	Amount of Damages	12-26
§ 12.03		Reasonable Royalties and Statutory Damages	12-32
	[1]	Reasonable Royalty	12-32
	[a]	Patent Cases	12-33
	[b]	Trade Secret Cases	12-44
	[c]	Trademark Cases.	12-44.1
	[d]	Copyright Cases	12-44.2

TABLE OF CONTENTS

	[2] Statutory Damages	12-44.3
	[a] Copyright Cases	12-44.4
	[b] Semiconductor Chip Protection Cases	12-44.15
	[c] Trademark Counterfeiting Cases	12-44.16
§ 12.04	The Infringer’s Profits	12-44.20
	[1] Apportionment of Profits	12-48
	[2] Deductions from Gross Revenue	12-55
	[3] Double Counting	12-59
	[4] The Exception for Utility and Plant Patents	12-60.3
	[5] The Lanham Act’s Equitable Overlay	12-60.4
§ 12.05	Augmented and Punitive Damages	12-60.8
	[1] Augmented Damages for “Willful” Infringement	12-60.8
	[a] Patent Cases	12-60.10
	[b] Federal Trademark Cases	12-67
	[i] Ordinary Trademark Infringement	12-67
	[ii] Trademark Counterfeiting	12-72
	[c] Uniform Trade Secrets Act Cases	12-74
	[2] Punitive Damages	12-75
	[a] Statutory Exclusivity	12-77
	[b] Punitive Damages for Common-Law Violations	12-79
§ 12.06	Attorneys’ Fees	12-82
	[1] The <i>Fogerty</i> Decision and the Demise of the Double Standard	12-90
	[2] The District Courts’ Discretion	12-100
	[a] Discretion as to Grant or Denial of Award	12-100
	[b] Discretion as to Amount of Award	12-106
	[c] Virtually Mandatory Fee Awards in Trademark Counterfeiting Cases	12-108
	[d] Procedural Prerequisite in Copyright Cases	12-109
	[3] How Discretion Is Exercised	12-109
	[a] Purposes of Fee Awards	12-111
	[b] Factors Justifying Fee Awards	12-112.1
	[i] “Willful” Infringement	12-112.2
	[ii] Objectively Meritless (Frivolous) Claims or Defenses	12-112.8
	[iii] Bad Faith or Improper Motive, Such as Delay, Harassment, or Financial Attrition	12-112.11
	[iv] Misconduct in the Litigation Process	12-112.16
	[c] Factors Justifying Denial of Fee Awards	12-112.18
	[i] The Infringer’s Innocence	12-112.19
	[ii] Closeness or Complexity of Legal Issues	12-112.21

INTELLECTUAL PROPERTY LAW

	[iii] The Nonmoving Party’s Fair and Courteous Conduct in the Litigation.	12-112.22
	[iv] Lack of Substantial Harm to the Intellectual Property Owner’s Interests.	12-112.22
[4]	Semiconductor Chip Protection	12-112.24
[5]	Trade Secret Cases	12-112.24
[6]	Prevailing Party	12-112.26
[7]	Relationship between Attorneys’ Fees and Augmented or Punitive Damages.	12-112.27
[8]	The Effect of Fee-Award Statutes on Rule 68 Settlement Offers.	12-112.29
§ 12.07	Interest	12-113
	[1] Prejudgment Interest.	12-113
	[a] Patent Cases	12-114
	[b] Trademark Counterfeiting Cases	12-116
	[c] Other Nonpatent Cases.	12-117
	[d] Interest on Noncompensatory Awards.	12-123
	[e] The Rate and Terms of Prejudgment Interest	12-125
	[2] Post-judgment Interest	12-129

CHAPTER 13

Nonmonetary Relief

§ 13.01	Injunctive Relief.	13-3
	[1] Preliminary Injunctions	13-6
	[a] The Traditional, Four-Part Test	13-9
	[i] Likelihood of Success.	13-11
	[ii] Balance of Harm.	13-16
	[iii] Irreparable Harm.	13-21
	[iv] The Public Interest	13-35
	[b] The Modern, Sliding-Scale Test	13-37
	[2] Permanent Injunctions	13-41
	[3] The Scope of Injunctive Relief	13-47
	[a] Trademark Cases.	13-49
	[b] Trade Secret Cases	13-52.1
	[c] Internet Copyright Cases	13-53
§ 13.02	Exclusion from Importation.	13-54.3
	[1] Statutory Exclusion by the Customs Service	13-54.4
	[2] Tariff Act Exclusion: Section 337.	13-61
	[a] USITC Proceedings	13-61
	[b] Substantive Requirements for Relief.	13-62
	[i] The “Industry” Requirement.	13-63
	[ii] The “Injury” Requirement	13-66
	[c] Disadvantages and Advantages of Section 337 Proceedings	13-67

TABLE OF CONTENTS

§ 13.03	Impoundment and Destruction	13-70
[1]	Impoundment and Destruction in General	13-70
[a]	Impoundment and Destruction Under the Copyright Act	13-71
[i]	Impoundment	13-72
[ii]	Destruction and Other Disposition	13-83
[iii]	Items Covered	13-86
[b]	Cases of Ordinary Trademark Infringement	13-88
[c]	Patent and Trade Secret Cases	13-90
[2]	Seizure in Trademark Counterfeiting Cases	13-93
[a]	Protection for Defendants	13-96
[i]	Pre-Seizure Procedure	13-96
[ii]	Post-Seizure Procedure	13-100.1
[b]	Substantive Requirements for an <i>Ex Parte</i> Seizure Order	13-102
[c]	Damage Action for Wrongful Seizure	13-104
[i]	Amounts Recoverable	13-104
[ii]	Which Seizures Are Wrongful	13-105
§ 13.04	Criminal Sanctions	13-108
[1]	Criminal Sanctions for Copyright Infringement	13-112
[a]	Civil Liability: the <i>Sine Qua Non</i>	13-118
[b]	The State-of-Mind Requirement	13-122
[c]	Numerical Thresholds for Felony Offenses	13-126.2
[d]	Criminal Penalties	13-126.6
[e]	Seizure and Destruction (or Other Disposition)	13-126.7
[1A]	Criminal Sanctions for Violation of Performers' Rights	13-126.8
[a]	The First Prerequisite: a Civil Case	13-126.10
[b]	Required State of Mind	13-126.12
[c]	Criminal Penalties for Violating Performers' Rights	13-126.13
[d]	Forfeiture and Destruction	13-126.14
[e]	Border-Control Measures	13-126.16
[2]	Criminal Sanctions for Trademark Offenses	13-126.17
[a]	Trademark Counterfeiting	13-126.18
[i]	Penalties	13-126.18
[ii]	Defenses	13-126.18
[iii]	Seizure and Forfeiture	13-131
[b]	Trafficking in Certain Counterfeit Labels	13-131
[c]	Trademark Offenses Under State Law	13-135
[3]	Criminal Offenses Relating to Trade Secrets	13-136
[a]	Federal Crimes under the 1996 Act	13-137
[i]	Overview	13-140
[ii]	Elements of a 1996 Act Offense	13-147
[iii]	Kinds of Offenses and Related Legal Problems	13-161

INTELLECTUAL PROPERTY LAW

[iv]	Protective Orders and Related Civil Proceedings	13-172
[v]	Exceptions and Relation to Other Laws	13-176
[b]	Release of Private Trade Secrets by Federal Employees	13-177
[c]	State Sanctions for Theft of Trade Secrets	13-180
INDEX	I-1