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 ... 1-4
[3] Emergence of Intellectual Property as
   a Single Field of Law ................. 1-14
   Property ................................ 1-21

§ 1.02 Protected Subject Matter ......................... 1-22.3
[1] Patents ..................................... 1-22.3
[2] Copyrights .................................. 1-23
[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

§ 1.04 Duration of Protection ......................... 1-30

§ 1.05 Requirements for Protection .................. 1-34
[1] Patents ..................................... 1-34

§ 1.06 Procedure for Protection ..................... 1-41
[1] Patents ..................................... 1-41
[2] Copyrights .................................. 1-52.15
## Trademarks and Related Property

1-52.21

[a] Choosing Commercial Symbols 1-52.21

[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


### § 1.09 International Protection of Intellectual Property

1-89

[1] Territoriality 1-89


[a] The Paris Convention 1-93

[b] Other Patent Conventions 1-96


[d] The Copyright Conventions 1-106

[e] Modern Treaties 1-110


[a] The Principle of National Treatment—Its Distinction from Reciprocity 1-112

[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


### Chapter 1A

**The TRIPS Agreement and the GATT Uruguay Round**

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

(Rel. 58)
## INTELLECTUAL PROPERTY LAW

<table>
<thead>
<tr>
<th>Section</th>
<th>Title</th>
<th>Page</th>
</tr>
</thead>
<tbody>
<tr>
<td>[b]</td>
<td>Misappropriation.</td>
<td>1A-50</td>
</tr>
<tr>
<td>[c]</td>
<td>Data Submission to Government.</td>
<td>1A-51</td>
</tr>
<tr>
<td>[4]</td>
<td>Specific Requirements for Copyrights</td>
<td>1A-51</td>
</tr>
<tr>
<td>[a]</td>
<td>Idea/Expression Dichotomy</td>
<td>1A-52</td>
</tr>
<tr>
<td>[b]</td>
<td>Protection of Computer Programs and Data Bases</td>
<td>1A-53</td>
</tr>
<tr>
<td>[c]</td>
<td>Rental Rights</td>
<td>1A-55</td>
</tr>
<tr>
<td>[i]</td>
<td>Computer Programs</td>
<td>1A-55</td>
</tr>
<tr>
<td>[ii]</td>
<td>Cinematographic Works</td>
<td>1A-55</td>
</tr>
<tr>
<td>[iii]</td>
<td>Phonograms (Sound Recordings)</td>
<td>1A-56</td>
</tr>
<tr>
<td>[d]</td>
<td>Term of Protection</td>
<td>1A-57</td>
</tr>
<tr>
<td>[e]</td>
<td>Neighboring Rights</td>
<td>1A-58</td>
</tr>
<tr>
<td>[i]</td>
<td>Performers’ Rights</td>
<td>1A-58</td>
</tr>
<tr>
<td>[ii]</td>
<td>Phonogram Producers’ Rights</td>
<td>1A-59</td>
</tr>
<tr>
<td>[iii]</td>
<td>Broadcasters’ Rights</td>
<td>1A-60</td>
</tr>
<tr>
<td>[iv]</td>
<td>Limitation</td>
<td>1A-61</td>
</tr>
<tr>
<td>[5]</td>
<td>Specific Requirements for Semiconductor Chip Protection</td>
<td>1A-62</td>
</tr>
<tr>
<td>[a]</td>
<td>Substantive Norms Derived from WIPO IC Treaty</td>
<td>1A-62</td>
</tr>
<tr>
<td>[i]</td>
<td>Provisions Incorporated</td>
<td>1A-62</td>
</tr>
<tr>
<td>[ii]</td>
<td>Legal Form of Protection</td>
<td>1A-63</td>
</tr>
<tr>
<td>[iii]</td>
<td>Other Issues</td>
<td>1A-64</td>
</tr>
<tr>
<td>[iv]</td>
<td>Interaction Between WIPO IC Treaty and TRIPS Agreement</td>
<td>1A-65</td>
</tr>
<tr>
<td>[b]</td>
<td>Exclusive Rights</td>
<td>1A-67</td>
</tr>
<tr>
<td>[c]</td>
<td>Innocent Purchaser Exemption</td>
<td>1A-68</td>
</tr>
<tr>
<td>[d]</td>
<td>Compulsory Licensing</td>
<td>1A-71</td>
</tr>
<tr>
<td>[e]</td>
<td>Term of Protection</td>
<td>1A-72</td>
</tr>
<tr>
<td>[6]</td>
<td>Specific Requirements for Trademark Protection</td>
<td>1A-73</td>
</tr>
<tr>
<td>[a]</td>
<td>The Subject Matter of Trademark Protection</td>
<td>1A-74</td>
</tr>
<tr>
<td>[b]</td>
<td>Rights in Trademarks</td>
<td>1A-75</td>
</tr>
<tr>
<td>[i]</td>
<td>Likelihood of Confusion</td>
<td>1A-75</td>
</tr>
<tr>
<td>[ii]</td>
<td>Curtailing Trademark Piracy</td>
<td>1A-76</td>
</tr>
<tr>
<td>[iii]</td>
<td>Nonidentical Goods or Services</td>
<td>1A-76</td>
</tr>
<tr>
<td>[iv]</td>
<td>Other Issues</td>
<td>1A-77</td>
</tr>
<tr>
<td>[c]</td>
<td>Term of Protection</td>
<td>1A-77</td>
</tr>
<tr>
<td>[d]</td>
<td>Use of Trademarks and Special Requirements</td>
<td>1A-78</td>
</tr>
<tr>
<td>[e]</td>
<td>Licensing and Assignment of Trademarks</td>
<td>1A-80</td>
</tr>
<tr>
<td>[7]</td>
<td>Specific Requirements for Geographical Indications</td>
<td>1A-80</td>
</tr>
<tr>
<td>[a]</td>
<td>Geographical Indications Generally</td>
<td>1A-80</td>
</tr>
</tbody>
</table>
# TABLE OF CONTENTS

[b] Geographical Indications for Wines and Spirits .......................... 1A-83

[8] Specific Requirements for Industrial Designs ............................ 1A-86

[9] Protection of Existing Matter ................................. 1A-88

[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

§ 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

(Rel. 58)
CHAPTER 2
Obtaining Patent Rights

§ 2.01 Introduction ................................... 2-3

§ 2.02 Patenable Subject Matter—Types of Patents 2-12.1
[1] Utility Patents .................................. 2-12.1
[3] Plant Patents ................................. 2-17

§ 2.03 Problematic Subject Matter ....................... 2-22
[1] Introduction .................................. 2-22
[a] The Supreme Court’s Jurisprudence and the Distinction Between Abstract Ideas and Concrete Applications 2-52
[b] The Role of Policy ......................... 2-64
[i] Statutory Considerations ............. 2-64.2
[ii] Other Requirements of Patent Law .......... 2-64.4
[c] Failed Attempts at Finding a Rule .... 2-64.9
[a] The State Street 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] Bilski v. Kappos as a prelude to Alice: No Rigid Test .......... 2-115
[5] The Limited Exception for Medical and Surgical Procedures ............................. 2-128

§ 2.04 The Novelty Requirement ........................ 2-132
[2] The One-Year Statutory Bar ................. 2-147
[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

§ 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 ............................................. 2-230
[4] Novelty and Nonobviousness: The Synergy of Sections 102 and 103 .............................................................................. 2-233
[5] “Obvious to Try”: A Troubling Standard . . . . . . . . . . . . . . . . . . 2-238
[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 ................................................................... 2-263
[3] Relationship of Disclosure and Definiteness to the “Obvious to Try” Doctrine .................................................. 2-285

§ 2.08 The Patent Applicant’s Duty of Candor and Inequitable Conduct in Patent Prosecution ........................................... 2-305
[1] The Duty of Candor and Included Duty to Disclose ................. 2-307
[2] Inequitable Conduct (Formerly “Fraud on the Patent Office”) .................................................. 2-314

§ 2.09 Other Technical Requirements for Valid Patents ..................... 2-324
[1] Double Patenting ......................................................... 2-324
[2] Inventorship ............................................................... 2-330

§ 2.10 The Presumption of Patent Validity .................................... 2-339

[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(c) ........................................ 2-188
[c] Reissue and Novelty ........................................ 2-191

(Rel. 58)
**TABLE OF CONTENTS**

**Volume 2**

**CHAPTER 2A**

Scope of Patent Rights

§ 2A.01 Nature of Exclusive Rights .................................. 2A-3

§ 2A.02 Duration of Exclusive Rights .......................... 2A-16.2
[a] The Basic Rule ...................................... 2A-16.3
[b] Relation Back ....................................... 2A-16.4
[a] Patent Term Adjustment ............................. 2A-20
[b] Extension to Compensate for Federal Regulatory Review .................. 2A-31
[a] Term Computation .................................. 2A-33
[b] Relation Back ....................................... 2A-36
[c] New Reasons for Term Extension ................. 2A-36
[d] Table of Transition Rules .......................... 2A-37

§ 2A.03 Scope of Exclusive Rights ............................ 2A-38
[1] Claim Interpretation and “Literal” Infringement ......................... 2A-60
[a] The Importance of Patent Claims ................. 2A-61
[b] Patent Claim Construction ............................ 2A-71
[c] Evidence Used in Construing Claims ........... 2A-81
[d] Procedure for Claim Construction ............... 2A-91
[a] Utility Patents ....................................... 2A-92.8
[ii] The Effect of Prosecution History Estoppel .................. 2A-118
[b] Design Patents ....................................... 2A-131
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

§ 2A.05 Limitations on Exclusive Rights ................... 2A-184
[1] The First-Sale or Exhaustion Doctrine .............. 2A-184
   [a] In General .............................. 2A-184
   [b] Sale in Substance, Not Form ................ 2A-190
   [c] Application to United States
       Process Patents .......................... 2A-192
   [d] Foreign Sales and the Process Patent
       Holder’s Importation Right .............. 2A-193
[2] Prosecution History Estoppel or “File
    Wrapper” Estoppel .......................... 2A-197
   [a] The Traditional Misuse Doctrine .......... 2A-200
   [b] Patent Misuse, the Antitrust Laws
       and Purging ............................. 2A-202
[6] Elimination of Licensee Estoppel:
   The Licensee’s Right to Challenge
   Patent Validity ............................ 2A-215
[8] Defense to Infringement Based on Prior
   Commercial Use ............................. 2A-216.10

§ 2A.06 Some International Aspects of Patent Protection . 2A-217
[1] International Protection in General ............... 2A-217
   Statutes Abroad ............................ 2A-221
   [a] Similarities ............................. 2A-221
   [b] Differences ............................. 2A-224


§ 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
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
  [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
  [3] Permissible Quantity ..................................................... 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
    [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

(Rel. 56)
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” ..................... 4-18
  [a] The Third Restatement’s Definition .......... 4-19
  [b] The Uniform Trade Secret Act’s Definition ........................................... 4-20
  [c] The Differences Between the Third Restatement’s and the Uniform Trade Secrets Act’s Definitions ...... 4-22

[2] The Rejected Exceptions for Transitory and Negative Information ........ 4-23
  [a] The Rejected Exception for Information of Temporary or Transitory Use or Value ........................................... 4-24
  [b] The Rejected Exception for Negative Results ........................................... 4-25

[3] Examples of Trade Secrets .................................. 4-26
[4] Employees and Public Policy ................................ 4-30

§ 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

  [a] Security Measures ......................................... 4-64
  [b] Relationships with Employees, Suppliers, Licensees, and Customers ........ 4-68
  [c] Inadequate Efforts ......................................... 4-72
[4] Contractual Requirements for “Reasonable Efforts” ........................................... 4-73
### TABLE OF CONTENTS

<table>
<thead>
<tr>
<th>Section</th>
<th>Title</th>
<th>Page</th>
</tr>
</thead>
<tbody>
<tr>
<td>[4]</td>
<td>The <em>First Restatement</em>'s Six Factors</td>
<td>4-74</td>
</tr>
<tr>
<td>[5]</td>
<td>Practical Evidentiary Factors</td>
<td>4-76</td>
</tr>
<tr>
<td>[a]</td>
<td>Specificity</td>
<td>4-76</td>
</tr>
<tr>
<td>[b]</td>
<td>Removal of Tangible Records</td>
<td>4-79</td>
</tr>
<tr>
<td>[c]</td>
<td>Inequity</td>
<td>4-80</td>
</tr>
<tr>
<td>§ 4.04</td>
<td>“Exclusive” Rights in Trade Secrets and Misappropriation</td>
<td>4-82</td>
</tr>
<tr>
<td>[1]</td>
<td>Duration of Legal Protection</td>
<td>4-82</td>
</tr>
<tr>
<td>[a]</td>
<td>Misappropriation and the Concept of Improper Means</td>
<td>4-84</td>
</tr>
<tr>
<td>[b]</td>
<td>Proper Means and Shared Ownership</td>
<td>4-90</td>
</tr>
<tr>
<td>[c]</td>
<td>Reverse Engineering</td>
<td>4-93</td>
</tr>
<tr>
<td>[3]</td>
<td>Product Modification and Improvement: Determining Whether a Trade Secret Has Been Used</td>
<td>4-96</td>
</tr>
<tr>
<td>[5]</td>
<td>Indirect and Accidental Misappropriation</td>
<td>4-103</td>
</tr>
<tr>
<td>[a]</td>
<td>The State-of-Mind Requirements</td>
<td>4-104</td>
</tr>
<tr>
<td>[b]</td>
<td>The Timing of Knowledge or Notice</td>
<td>4-105</td>
</tr>
<tr>
<td>[c]</td>
<td>“Reasonable Efforts” to Protect the Secret</td>
<td>4-108</td>
</tr>
<tr>
<td>[6]</td>
<td>Are Trade Secrets “Property”?</td>
<td>4-110</td>
</tr>
<tr>
<td>[7]</td>
<td>Relief from Misappropriation and the “Head Start” Period</td>
<td>4-114</td>
</tr>
<tr>
<td>[a]</td>
<td>Injunctive Relief and the “Head Start” Period</td>
<td>4-115</td>
</tr>
<tr>
<td>[b]</td>
<td>Monetary Relief</td>
<td>4-122</td>
</tr>
<tr>
<td>§ 4.05</td>
<td>Trade Secrets and Contracts</td>
<td>4-128</td>
</tr>
<tr>
<td>[1]</td>
<td>The Effect of Tort Law and Confidential Relationships</td>
<td>4-128</td>
</tr>
<tr>
<td>[a]</td>
<td>The Employee-Employer Relationship</td>
<td>4-131</td>
</tr>
<tr>
<td>[b]</td>
<td>Nonemployee Relationships</td>
<td>4-136</td>
</tr>
<tr>
<td>[c]</td>
<td>No Relationship</td>
<td>4-140</td>
</tr>
<tr>
<td>[2]</td>
<td>Contractual Protection of Confidential Information</td>
<td>4-141</td>
</tr>
<tr>
<td>[3]</td>
<td>The Practical Value of Nondisclosure Covenants</td>
<td>4-143</td>
</tr>
<tr>
<td>[a]</td>
<td>How Nondisclosure Covenants Enhance Trade Secret Protection</td>
<td>4-144</td>
</tr>
<tr>
<td>[b]</td>
<td>Expanding the Scope of Relief</td>
<td>4-146</td>
</tr>
<tr>
<td>[c]</td>
<td>Risk of Impairing Common-Law Protection</td>
<td>4-148</td>
</tr>
<tr>
<td>[d]</td>
<td>Minimum Requirement for Limited Availability</td>
<td>4-149</td>
</tr>
<tr>
<td>[4]</td>
<td>Nondisclosure and Noncompetition Covenants</td>
<td>4-150</td>
</tr>
<tr>
<td>§ 4.06</td>
<td>Trade Secrets and Patents</td>
<td>4-154</td>
</tr>
</tbody>
</table>

(Rel. 56)
CHAPTER 5

What Is Copyrighted?

§ 5.01  Subject Matter of Copyright ....................... 5-2
[1]  General Scope of Subject Matter ................. 5-4
TABLE OF CONTENTS

   [a] The Basic Doctrine....................... 5-10
   [b] Underlying Policies..................... 5-12
   [c] The “Levels of Abstraction” Test ........ 5-15
   [d] Merger of Idea and Expression ........... 5-18

   Substantial Similarity...................... 5-21

§ 5.02 Problematic Categories of Copyrighted Subject
   Matter........................................ 5-25

[1] Computer Programs ......................... 5-25
   [a] The 1980 Software Amendments........... 5-25
   [b] Case Law................................. 5-27
   [c] Computer-Generated Works............... 5-38.8

[2] Compilations and Databases ............... 5-38.9
   [a] Compilations of Data as
      Copyrighted Works ....................... 5-38.9
   [b] The Theoretical Basis of Compilation
      Copyrights: “Sweat of the Brow”
      Doctrine Rejected....................... 5-38.14
   [c] Copyright Protection for Random-Access
      Databases ............................... 5-38.17
      [i] Copying the Arrangement.............. 5-38.18
      [ii] Copying the Selection................. 5-38.26
   [d] Toward a Theory of Database
      Protection ............................... 5-38.29
      [i] The Numbers Approach................. 5-38.30
      [ii] The Categories Approach.............. 5-38.31
      [iii] Congruence of Markets............... 5-38.32
      [iv] An Economic Approach................. 5-38.34
      [v] Conclusion: The Statutory
          Approach................................ 5-38.36

[3] Useful Articles .............................. 5-38.37
   [a] Ornamental Aspects of Useful Articles... 5-39
   [b] Pictures of Useful Articles............. 5-46
   [c] Plans, Drawings, and Models for
      Useful Articles.......................... 5-47
      [i] Eligibility of Plans, Drawings,
          and Models for Copyright
          Protection ............................ 5-48
      [ii] Limits on Protection................... 5-50

   [a] The Separate Legal Regime for
      Building Designs......................... 5-56
   [b] Subject Matter Covered:
      Building Designs ......................... 5-58
   [c] Limitations on Copyright Protection for
      Building Designs ......................... 5-59
   [d] Prospectivity of Protection.............. 5-60.1

[5] The Law ..................................... 5-60.3

(Rel. 56)
INTELLECTUAL PROPERTY LAW

[a] Background on the Copyright Status of “the Law” .......................... 5-60.4
   [i] Underlying Policy ........................................ 5-60.4
   [ii] Doctrine .................................................. 5-60.9
[b] Federal Law .................................................. 5-60.14
[c] State and Local Law ......................................... 5-60.17
[d] Just Compensation for Lost Copyrights? ................................. 5-60.25

§ 5.03 Prerequisites for Copyright Protection: Fixation, Originality, and Creativity .......... 5-61

[1] Fixation ...................................................... 5-61
   [a] New Technology .......................................... 5-62
   [b] Communicative Function ................................ 5-64
   [c] What “Fixation” Means .................................. 5-66
      [i] Author’s Authorization ................................. 5-67
      [ii] Tangible Medium and Permanence .................... 5-68
   [d] Fixation and Interactive Systems ......................... 5-68
   [e] Fixation and Copyright Preemption ....................... 5-71

[2] Originality ................................................... 5-72
[3] Creativity ....................................................... 5-84
   [a] The Difference Between Copyright and Patent Standards .............. 5-86
   [b] Content and Copyright Protection .......................... 5-87

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

   [a] Balance in Copyright Law and Policy ........................................ 5A-14
   [b] Preexisting Mechanisms for Balance in Copyright Law ......................... 5A-18.1
   [c] Balance and Section 1201 ............................................ 5A-20

   [a] The Library’s Rulemaking Power ............................................ 5A-31
   [b] The Library’s Exemptions ................................................. 5A-37
§ 5A.03 The Two Anti-Trafficking Rules

[1] The Anti-Trafficking Rule for Means to 
Defeat Access Controls

Defeat Use Controls

[3] The Three Conditions for Anti-Trafficking 
Liability

Amendment

[a] The Reimerdes Decision

[b] A Closer Look at the First Amendment 
as Applied to the Anti-Trafficking 
Rules

[i] Is Binary Executable Code 
“Speech”?

[ii] Some Useful Analogies

[iii] Beyond Binary Executable 
Code

[iv] The Hard Cases: Mixed-Use 
Technology and Linking

§ 5A.04 Exceptions to Anti-Circumvention and Anti-
Trafficking Rules

[1] Subject-Matter Classification


[3] Two Examples: Encryption Research and 
Reverse Engineering

[a] Encryption Research

[b] Reverse Engineering

§ 5A.05 Rules Protecting Copyright Management 
Information


[a] The Three Types of Offenses

[i] Providing or Disseminating 
False CMI

[ii] Removing or Altering CMI 
Without Authorization

[iii] Knowingly Disseminating CMI 
or Works (or Publicly 
Performing Works, Copies, or 
Phonorecords) from Which 
CMI Has Been Removed or 
Altered Without Authorization

[b] State-of-Mind Requirements

[3] Exceptions and Limitations on Liability

§ 5A.06 Civil Remedies and Criminal Sanctions

[1] Civil Remedies

[2] Criminal Sanctions
# TABLE OF CONTENTS

**Volume 3**

**CHAPTER 6**
The Nature of Copyright Protection

<table>
<thead>
<tr>
<th>§ 6.01</th>
<th>The Copyright Owner’s Exclusive Rights and Moral Rights</th>
<th>6-6</th>
</tr>
</thead>
<tbody>
<tr>
<td>[1]</td>
<td>The Reproduction Right.</td>
<td>6-24</td>
</tr>
<tr>
<td>[a]</td>
<td>Evanescent Copies and Phonorecords</td>
<td>6-24.4</td>
</tr>
<tr>
<td>[b]</td>
<td>What Is “Transient Duration”?</td>
<td>6-24.8</td>
</tr>
<tr>
<td>[c]</td>
<td>The Exception for Computer Maintenance and Repair</td>
<td>6-24.10</td>
</tr>
<tr>
<td>[a]</td>
<td>Definition of “Derivative Work”</td>
<td>6-26</td>
</tr>
<tr>
<td>[b]</td>
<td>Distinction Between Derivative Works and Copies</td>
<td>6-26</td>
</tr>
<tr>
<td>[c]</td>
<td>The Relationship Between Derivative Works and Underlying Works</td>
<td>6-26.3</td>
</tr>
<tr>
<td>[i]</td>
<td>The “Value-Added” Principle</td>
<td>6-26.3</td>
</tr>
<tr>
<td>[ii]</td>
<td>The Independent Copyright Principle</td>
<td>6-26.5</td>
</tr>
<tr>
<td>[iii]</td>
<td>The “Standoff” Principle</td>
<td>6-26.6</td>
</tr>
<tr>
<td>[d]</td>
<td>Scope of the Derivative Work Right</td>
<td>6-26.10</td>
</tr>
<tr>
<td>[a]</td>
<td>Scope of Distribution Right</td>
<td>6-26.23</td>
</tr>
<tr>
<td>[b]</td>
<td>First-Sale Doctrine</td>
<td>6-26.27</td>
</tr>
<tr>
<td>[i]</td>
<td>Codification in Section 109</td>
<td>6-26.30</td>
</tr>
<tr>
<td>[ii]</td>
<td>Exceptions for Phonorecords and Computer Programs</td>
<td>6-26.32</td>
</tr>
<tr>
<td>[iii]</td>
<td>Inapplicability to First Sales of Copies or Phonorecords Lawfully Made Abroad</td>
<td>6-26.37</td>
</tr>
<tr>
<td>[a]</td>
<td>Types of Works Covered</td>
<td>6-26.41</td>
</tr>
</tbody>
</table>
[b] Breadth of Performance Right .......................... 6-26.42
[c] Breadth of Display Right .................................. 6-26.46
   [i] “Public Place” Clause .................................... 6-26.48
   [ii] “Transmission” Clause .................................... 6-26.49
   [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
   [a] Works Covered .................................................. 6-39
   [b] Nature of Moral Rights ....................................... 6-43
      [i] Right of Attribution ......................................... 6-43
      [ii] Right of Integrity ............................................ 6-45
      [iii] Inalienability and Waiver of Moral Rights .................. 6-47
   [c] Duration of Moral Rights ..................................... 6-49
   [d] Enforcement of Moral Rights ............................... 6-49
   [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 .............................. 6-58.24
[2] The Divisibility of Copyright ....................... 6-58.25
   [a] Who Is the Author? ......................... 6-60
   [b] Works Made for Hire ....................... 6-61
      [i] The Two Classes of Works Made for Hire .... 6-62
      [ii] The Causes of Past Judicial Confusion .... 6-63
      [iii] Judicial Interpretation: The Multifactor Agency-Law Test for “Employment” .... 6-64
   [iv] Consequences of Work Made for Hire Status .... 6-67
[c] Joint Works ................................. 6-69
   [i] Definition of Joint Work .............. 6-70
   [ii] Consequences of Joint Work Status .... 6-72
   [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
   [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

(Rev. 57)
<table>
<thead>
<tr>
<th>§ 6.04A</th>
<th>Statutory Termination of Copyright Transfers and Licenses</th>
<th>6-155</th>
</tr>
</thead>
<tbody>
<tr>
<td>[1]</td>
<td>The Evolution of the Termination Right and the Four Kinds of “New Estates”</td>
<td>6-156</td>
</tr>
<tr>
<td>[a]</td>
<td>The Exclusion of Works Made for Hire</td>
<td>6-171</td>
</tr>
<tr>
<td>[b]</td>
<td>The Derivative Works Exception</td>
<td>6-174</td>
</tr>
<tr>
<td>[c]</td>
<td>The Exclusion of Testamentary Transfers</td>
<td>6-182</td>
</tr>
<tr>
<td>[a]</td>
<td>The Time Window for Terminating Pre-1978 Grants</td>
<td>6-189</td>
</tr>
<tr>
<td>[b]</td>
<td>Who May Have Executed a Terminable Pre-1978 Grant</td>
<td>6-194</td>
</tr>
<tr>
<td>[c]</td>
<td>Who May Terminate a Terminable Pre-1978 Grant</td>
<td>6-197</td>
</tr>
<tr>
<td>[i]</td>
<td>Grants by a Sole Author</td>
<td>6-197</td>
</tr>
<tr>
<td>[ii]</td>
<td>Grants by Coauthors in Joint Works</td>
<td>6-198</td>
</tr>
<tr>
<td>[iii]</td>
<td>Grants in Whole or in Part by Nonauthors</td>
<td>6-200.2</td>
</tr>
<tr>
<td>[iv]</td>
<td>Termination Through Agents</td>
<td>6-200.5</td>
</tr>
<tr>
<td>[d]</td>
<td>Procedure for Terminating Pre-1978 Grants</td>
<td>6-200.5</td>
</tr>
<tr>
<td>[e]</td>
<td>The Effect of Terminating a Pre-1978 Grant</td>
<td>6-207</td>
</tr>
<tr>
<td>[i]</td>
<td>Grants by Nonauthors</td>
<td>6-207</td>
</tr>
<tr>
<td>[ii]</td>
<td>Grants by Sole Authors</td>
<td>6-208</td>
</tr>
<tr>
<td>[iii]</td>
<td>Grants by Coauthors</td>
<td>6-211</td>
</tr>
<tr>
<td>[a]</td>
<td>The Time Window for Terminating Post-1977 Grants</td>
<td>6-212.1</td>
</tr>
<tr>
<td>[d]</td>
<td>The Effect of Terminating a Post-1977 Grant</td>
<td>6-218</td>
</tr>
<tr>
<td>[5]</td>
<td>Statutory Protection of the Termination Right</td>
<td>6-221</td>
</tr>
</tbody>
</table>

§ 6.05 Copyright Misuse | 6-226

(Rel. 57)
CHAPTER 7
Copyright Formalities: Notice, Registration and Deposit

§ 7.01 Introduction: The International Copyright Conventions and United States Copyright Formalities

§ 7.02 Copyright Notice
[a] When Was Notice Required?
[b] Form of Notice
[i] General Form Requirements
[ii] Compilations, Derivative Works, Useful Articles, and Government Works
[iii] Phonorecords
[iv] Collective Works and Contributions to Them
[c] Placement and Affixation of Notice
[d] The Unit Publication Doctrine
[e] Omission of Notice and Saving Provisions
[i] Relatively Small Number of Copies
[ii] Reasonable Effort to Cure Omission
[iii] Licensee’s Use of Notice
[f] Omitted Notice and the “Innocent Infringer”
[g] Defective Copyright Notice
[i] Incorrect Name in Copyright Notice
[ii] Incorrect Year-Date in Notice

§ 7.03 Registration
[1] Overview of Registration
[2] Effects of Registration
[a] Evidence of Ownership and Validity of Copyright
[b] Prerequisite to Infringement Suit
[i] Berne Accession Changes
[ii] Works Still Subject to the Registration Prerequisite: Overview
TABLE OF CONTENTS

[iii] Works Still Subject to the Registration Prerequisite:
Unpublished Works ............... 7-43

[iv] Works Still Subject to the Registration Prerequisite:
Published Works ................. 7-43

[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 ............... 7-55

[i] The “Commencement” Rule for Statutory Damages and Attorneys’ Fees ........ 7-56

[ii] When Registration is Effective ... 7-58

[iii] Expediting Registration ............... 7-59


§ 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


[5] Economics of Semiconductor Chip Production ............... 8-10

(Rel. 57)
§ 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 Sui Generis Protection 8-21

§ 8.03 Protected Subject Matter 8-24
   [a] Semiconductor Chip Products 8-24
   [b] Mask Works 8-26
   [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
   [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

<table>
<thead>
<tr>
<th>Section</th>
<th>Title</th>
<th>Page</th>
</tr>
</thead>
<tbody>
<tr>
<td>[2]</td>
<td>The Innocent Purchaser Exception</td>
<td>8-63</td>
</tr>
<tr>
<td>[a]</td>
<td>The Statutory Exemption</td>
<td>8-64</td>
</tr>
<tr>
<td>[i]</td>
<td>Nature of Notice</td>
<td>8-65</td>
</tr>
<tr>
<td>[ii]</td>
<td>Notice of Authorization</td>
<td>8-65</td>
</tr>
<tr>
<td>[iii]</td>
<td>Effect of Notice</td>
<td>8-67</td>
</tr>
<tr>
<td>[b]</td>
<td>Reasonable Royalty</td>
<td>8-68</td>
</tr>
<tr>
<td>[c]</td>
<td>Downstream Purchasers and Use of Chips in Products</td>
<td>8-69</td>
</tr>
<tr>
<td>[3]</td>
<td>First-Sale Doctrine</td>
<td>8-70</td>
</tr>
</tbody>
</table>

## § 8.06 Term and Nature of Protection | 8-72

| [1] | Term of Protection | 8-72 |
| [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 |
| [a] | Recordation of Transfers | 8-92 |
| [b] | Nonexclusive Licenses | 8-93 |
| [4] | Standing to Sue for Infringement | 8-93 |
| [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 |

(Rel. 58)
## CHAPTER 9

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

### § 9.01 Trade Symbols: The Subject Matter of Protection Under Trademark Principles

- [1] Technical Trademarks ........................................ 9-4
- [3] Titles and Characters ......................................... 9-12
- [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

- [2] Distinctiveness ............................................. 9-21
  - [a] Arbitrary and Fanciful Marks ....................... 9-22
  - [b] Suggestive Marks ................................... 9-23
  - [c] Descriptive Marks .................................. 9-24
  - [d] Generic Marks ....................................... 9-29
  - [e] Legal Effect of Place in Distinctiveness Spectrum .... 9-33
  - [f] The Relativity of Distinctiveness ................. 9-34
  - [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
  - [a] The Basic Doctrine ................................ 9-61
  - [b] “Aesthetic” Functionality ......................... 9-71
- [5] Other Statutory Restrictions ......................... 9-83
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

[a] “Likelihood” as Neither Possibility Nor Certainty
[b] Confusion as to What?
[i] Confusion as to Affiliation, Approval, or Sponsorship
[ii] Post-Sale Confusion
[iii] Initial Interest Confusion
[iv] Application to Licensing
[2] Considering All the Circumstances
[a] Strength of the Plaintiff’s Mark
[b] Similarity of the Marks
[c] Similarity of Products
[d] Channels of Trade
[e] Advertising and Promotion
[f] Nature of Customers
[g] Intent or “Bad Faith”
[h] Actual Confusion

§ 10.02 Strength and Duration of Trade Symbol Protection

[1] Use and Registration
[2] Abandonment
[a] Nonuse
[b] Loss of Trademark Significance

§ 10.03 Trademark Dilution

[1] Sources of Trademark Dilution Law
[a] Federal Dilution Law
[b] State Dilution Law
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
[2] Nature of Use.............................................. 11-6
[3] Sources of Common Law................................. 11-7
§ 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
[i] Nature of Application.................................. 11-18.4
[ii] Statement of Use........................................ 11-20
[iii] Bona Fide 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

### [2] Advantages of Federal Registration on the Principal Register
- [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] *Prima Facie* Evidence .................. 11-32.4
- [f] Federal Remedies .......................... 11-32.4
- [g] Incontestability .......................... 11-32.5

### [3] Import Exclusion, Parallel Imports, and Gray Goods
- [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
- [i] The *Katzel* 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

- [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

### [6] Registration on the Supplemental Register
- [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
CHAPTER 12

Monetary Remedies

§ 12.01 Introduction ........................................ 12-3
§ 12.02 Actual Damages ........................................ 12-4
  [1] Causation. ........................................ 12-5
    [a] Patents ........................................ 12-5
    [b] Copyright. ..................................... 12-10
    [c] Semiconductor Chip Protection ............... 12-11
    [d] Trade Secrets .................................. 12-12
    [e] Trademarks ..................................... 12-14
§ 12.03 Reasonable Royalties and Statutory Damages ....... 12-26
  [1] Reasonable Royalty .................................. 12-26
    [a] Patent Cases ................................... 12-27
    [b] Trade Secret Cases .............................. 12-34.1
    [c] Trademark Cases ................................ 12-34.2
    [d] Copyright Cases ................................ 12-34.3
TABLE OF CONTENTS

§ 12.04 The Infringer’s Profits ........................................ 12-44
[1] Apportionment of Profits ........................................ 12-48
[2] Deductions from Gross Revenue .............................. 12-54
[3] Double Counting .................................................. 12-54.4

§ 12.05 Augmented and Punitive Damages ..................... 12-55
   [a] Patent Cases .............................................. 12-57
   [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
[2] The District Courts’ Discretion .......................... 12-98.2
   [a] Discretion as to Grant or Denial of Award .............. 12-99
   [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
   [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 ............. 12-112.20

(Rel. 58)
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

[6] Prevailing Party ........................................... 12-112.25
[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.............................. 12-112.28

§ 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] Postjudgment Interest .................................... 12-129

CHAPTER 13
Nonmonetary Relief

§ 13.01 Injunctive Relief................................. 13-3
 [1] Preliminary Injunctions ............................ 13-4.1
 [a] The Traditional, Four-Part Test ........ 13-7
 [i] Likelihood of Success ...................... 13-9
 [ii] Balance of Harm ......................... 13-14
 [iii] Irreparable Harm ...................... 13-19
 [iv] The Public Interest .................. 13-35
 [b] The Modern, Sliding-Scale Test .... 13-37

[2] Permanent Injunctions ............................... 13-41

 [a] Trademark Cases ............................ 13-48
 [b] Trade Secret Cases ......................... 13-52
 [c] Internet Copyright Cases .............. 13-53

§ 13.02 Exclusion from Importation................. 13-54.3
 [1] Statutory Exclusion by the Customs Service . . 13-54.4
 [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

  [a] Protection for Defendants .................... 13-96
  [i] Pre-Seizure Procedure ..................... 13-96
  [ii] Post-Seizure Procedure ................. 13-100.1
  [b] Substantive Requirements for an Ex Parte 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 Sine Qua Non ............ 13-118
  [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

  [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

     [i] Overview .................................. 13-140
     [ii] Elements of a 1996 Act Offense ...... 13-147
     [iii] Kinds of Offenses and Related Legal Problems .......... 13-161

(Rel. 58)
INTELLECTUAL PROPERTY LAW

[iiv] 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