Volume 1

CHAPTER 1

Overview of Intellectual Property

§ 1.01	What	t 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	Prote	cted 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	Stren	gth 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	Dura	tion of Protection	1-30
§ 1.05	Requ	irements 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		edure 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

	[5]	Trad	emarks 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	Infrir	ngemen	t	1-62.57
	[1]	Infri	nging Activities	1-62.57
		[a]	Limited-Term Intellectual Property	1-62.57
		[b]	Unlimited-Term Intellectual Property	1-66
	[2]	Stan	dards of Infringement	1-67
		[a]	Limited-Term Intellectual Property	1-68
		[b]	Unlimited-Term Intellectual Property	1-73
§ 1.08			gms of Intellectual Property Law	1-76
	[1]	The	Constitutional Paradigm: "Strong"	
			rotection for a Limited Time	1-76
	[2]		Interstate Commerce Paradigm:	
			Weak" Protection for Potentially	1.70
	F2.7		nlimited Time	1-79
0 1 00	[3]	Fede	eral Preemption	1-81
§ 1.09			l Protection of Intellectual Property	1-90
	[1]		itoriality	1-90
	[2]		ties and International Conventions	1-94
		[a]	The Paris Convention	1-94
		[b]	Other Patent Conventions	1-97
		[c]	The Madrid (Trademark) Agreement	1 00
		[4]	and Madrid Protocol	1-99
		[d]	The Copyright Conventions	1-106 1-110
	[2]	[e]	Modern Treaties	1-110
	[3]			1 111
		[6]	onventions	1-111
		[a]	Treatment—Its Distinction	
			from Reciprocity	1-112.1
		[b]	Minimum Standards	1-112.1
		[c]	The Relationship Between Treaties	1-114
		[C]	and Domestic Law	1-115
§ 1.10	Intell	ectual	Property as Collateral	1-119
η 1.10	[1]		rity Interests in Trademarks	1-117
	[2]		rity Interests in Copyrights	1-121
	[2] [3]		rity Interests in Copyrights	1-124
	1 7 1	1 1 1 1 1 1	THE THIRD AND THE CONTRACTOR	

CHAPTER 1A

The TRIPS Agreement and the GATT Uruguay Round

§ 1A.01	Introd	duction: The Importance of the Uruguay		
	Ro	ound Agreements	1A-4	
§ 1A.02		ct 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 U	Jruguay Round Agreements and the		
		orld 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		t of the Uruguay Round Agreements on		
o .		omestic Law	1A-25	
§ 1A.05	Effective Date of the WTO and TRIPS Agreements			
3		d Transition Rules	1A-29	
	[1]	Entry into Force	1A-29	
	[2]	Transition Rules	1A-30	
	[3]	Table of Transition Rules	1A-33	
§ 1A.06		antive Requirements of the TRIPS		
o .		greement	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	1/	
	[~]	Information" (Trade Secrets)	1A-49	
		[a] Requirements for Protection	1A-49	
		[]	1)	

xvi	INTELLECTUAL PROPERTY LAW	
	[b] Misappropriation	. 1A-50
	[c] Data Submission to Government	
[4]	Specific Requirements for Copyrights	
[+]	[a] Idea/Expression Dichotomy	
	[b] Protection of Computer Programs	. 1A-32
	and Data Bases	. 1A-53
	[c] Rental Rights	
	[i] Computer Programs	
	[ii] Cinematographic Works	
	[iii] Phonograms (Sound	. 1A-33
	Recordings)	1A-56
	[d] Term of Protection	
	[e] Neighboring Rights	
	[i] Performers' Rights	
	[iii] Broadcasters' Rights	
	[iv] Limitation	
[5]	Specific Requirements for Semiconductor	. 1A-01
[2]	Chip Protection	. 1A-61
	[a] Substantive Norms Derived from	
	WIPO IC Treaty	. 1A-62
	[i] Provisions Incorporated	
	[ii] Legal Form of Protection	
	[iii] Other Issues	
	[iv] Interaction Between WIPO IC	
	Treaty and TRIPS	
	Agreement	
	[b] Exclusive Rights	
	[c] Innocent Purchaser Exemption	
	[d] Compulsory Licensing	
F.63	[e] Term of Protection	. 1A-71
[6]	Specific Requirements for Trademark	1 4 72
	Protection	. 1A-73
	[a] The Subject Matter of Trademark	1 4 72
	Protection	
	[b] Rights in Trademarks	
	[ii] Curtailing Trademark Piracy	
	[iii] Nonidentical Goods or	. 17-73
	Services	. 1A-76
	[iv] Other Issues	
	[c] Term of Protection	
	[d] Use of Trademarks and Special	, ,

Trademarks.....

Licensing and Assignment of

Indications.....

Geographical Indications Generally...

Specific Requirements for Geographical

[e]

[a]

[7]

1A-77

1A-79

1A-79

1A-80

		TABLE OF CONTENTS	XVII
		[b] Geographical Indications for Wind	
	[8]	and Spirits	1A-83
		Designs	
	[9]	Protection of Existing Matter	
		[a] What Is the "Date of Application"	
		[b] General Rule for Pre-Existing Matte[c] Restoration of Copyright in Certa	in
		Public-Domain Works	
		[d] Protection of Patentable Products Fields of Pharmaceuticals and	
		Agricultural Chemicals	
		[i] Interim Applications [ii] Interim Exclusive Marketin	g
		Rights	
§ 1A.07		edial Requirements of the TRIPS Agreemen	
	[1]	Mandatory Remedies	
		[a] Preliminary Relief	
		[b] Injunctions	
		[c] Declaratory Relief	
		[d] Border Measures (Exclusion from	
		Importation)	1A-104.1
		[e] Damages	1A-107
		Contraband	1A-108
		Trademark Counterfeiting and	
		Commercial Copyright Piracy.	1A-109
	[2]	Optional Remedies	1A-110
	[3]	The "Escape Clause"	1A-112
		Clause"	1A-112
		[b] Interpretation of the Clause	
§ 1A.08	Regu	irements for Legal and Administrative	
3 111.00		ocedure	1A-115
	[1]	General Requirements	
	[2]	Rights of Appeal	
	[3]	Transparency	
§ 1A.09		orming Changes in United States Law	
3	[1]	Legislative Changes Under the Uruguay	
	r-1	Round Agreements Act	
		[a] Changes in Patent Law	
		[b] Changes in Copyright Law	
		[c] Changes in Trademark Law	
	[2]	Changes Not Made	
		[a] Patent Law	
		[b] Copyright Law	
		[c] Semiconductor Chip Protection	
		[d] Trademark Law	

CHAPTER 2

Obtaining Patent Rights

§ 2.01	Intro	duction	2-3
§ 2.02		ntable Subject Matter—Types of Patents	
	[1]	Utility Patents	
	[2]	Design Patents	
	[3]	Plant Patents	
§ 2.03		lematic Subject Matter	2-24
·	[1]	Introduction	
	[2]	Fundamental Scientific Principles and	
		Natural Phenomena	2-42
	[3]	Mathematical Formulas and Algorithms .	
		[a] The Supreme Court's Jurisprudence	
		and the Distinction Between	
		Abstract Ideas and Concrete	
		Applications	2-55
		[b] The Role of Policy	
		[i] Statutory Considerations	
		[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 State Street Panel's Invalidatio	n
		of the "Rule" Against Patenting	
		Business Methods	2-97
		[b] The Prior User Defense and Implie	d
		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	
§ 2.04		Novelty Requirement	2-132
	[1]	The First-to-Invent Rule (1952 Act)	
		and First-to-File Rule (2011 Act)	
	[2]	The One-Year Statutory Bar	2-148
		[a] Printed Publication	
		[b] In Public Use or on Sale	
	[3]	Priority of Invention	
		[a] Conception	
		[b] Reduction to Practice	
		[c] Reasonable Diligence	2-176
		[d] Abandonment, Suppression, or	.
		Concealment	
		[e] Evidentiary Factors	2-184

		TABLE OF CONTENTS	xix
	[4]	Other Aspects of the Novelty Requirement	2-187
		[a] Foreign Patents: Section 102(d) [b] United States Patents on	2-187
		Applications Having Priority:	• 100
		Section 102(e)	2-188
	[5]	[c] Reissue and Novelty Novelty Under the 2011 Act's Unified	2-191
		First-to-File Rules	2-193
§ 2.05		Utility Requirement	2-203
§ 2.06		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	Paten	nt Disclosure Requirements: Enablement,	
		efiniteness, Best Mode, and Written	
	\mathbf{D}_{0}	escription	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 1	Patent Applicant's Duty of Candor and	
	In	equitable 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	r Technical Requirements for Valid	
-		atents	2-324.3
	[1]	Double Patenting	2-324.3
	[2]	Inventorship	2-329
§ 2.10		Presumption of Patent Validity	2-339
~		* ·	

Volume 2

CHAPTER 2A

Scope of Patent Rights

§ 2A.01	Natu	re 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	Dura	ation 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	Scop	be 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

	[a] Background and Purpose [b] Identifying Means-Plus-Function	2A-134
	Claims	2A-139
	[c] Consequences of Means-Plus-Function	24 142
	Claiming	2A-143
	[d] Infringement of Means-Plus-Function	24 152
c 2 A 0.4	Claims	
§ 2A.04	Statutory Extensions of Exclusive Rights	
	[1] Sale of Components, Material, or Apparatus	
	[2] Foreign Assembly	
c 2 A 05		
§ 2A.05	Limitations on Exclusive Rights	
	[a] In General	
	[b] Sale in Substance, Not Form	2A-192
	[c] Application to United States	24 104
	Process Patents	2A-194
	[d] Foreign Sales and the Process Patent	24 104
	Holder's Importation Right	2A-194
	[2] Prosecution History Estoppel or "File	24 100
	Wrapper" Estoppel	
	[3] Reverse Doctrine of Equivalents	
	[4] Patent Misuse	
	[a] The Traditional Misuse Doctrine [b] Patent Misuse, the Antitrust Laws	
	and Purging	
	[c] The 1988 Patent Misuse Amendments	
	[5] The Repair Doctrine	2A-214.1
	[6] Elimination of Licensee Estoppel: The Licensee's Right to Challenge	
	Patent Validity	
	[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	
	[c] Procedures for Obtaining Foreign	
	Filing Licenses	2A-242

	[d] Scope of Foreign Filing Lic [e] Retroactivity		2A-244 2A-251 2A-253
	CHAPTER 3		
	Products of Patented Pro	ocesses	
§ 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 Co		
	Exemption		3-9
	[3] Coverage or Protection Limited to		
	of Manufacturing Processes		3-12
§ 3.03	Liability of Retailers and Noncommerci	al Users	3-13
§ 3.04			3-15
	[1] Inventory Covered and "Notice of		2.16
	Infringement"		3-16
	[2] Does "Knowledge" Override the I of Remedies?	Limitation	3-18
	[3] Permissible Quantity		3-18
	[4] Full Liability for Those Who Prac		3-19
	Patented Process and Their Co.		
	Persons; Patent Marking		3-19
§ 3.05	Patent Disclosure and Notification of In		3-17
§ 5.05	[1] Requests for Disclosure		3-24
	[a] Timing of Requests and Pra		32.
	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 Disclos		3-28
	[a] Effect on Responder		3-28
	[b] Effect on Requester		3-30
	[i] Adequate Written Ass	urances from	
	Upstream Supplier		3-31
	[ii] Mitigating Circumstan	ces	3-32
	[iii] Good Faith		3-32
	[iv] Reimbursement		3-33
	[3] Written Notification of Infringement		3-34
	[a] Automatic Notice of Infring		3-34
	[b] Cumulative Notice of Infrin		3-36
§ 3.06	Presumption of Use of Patented Process		3-38
	[1] Substantial Likelihood of Use		3-38
			(Rel. 64)

vii

viii	INTELLECTUAL PROPERTY LAW	
	[2] Reasonable Effort to Determine Process	
§ 3.07	Used Effective Date and "Grandfather" Clause	3-39 3-41
	CHAPTER 4	
	Trade Secrets	
§ 4.01	Overview of Trade Secrets	4-3 4-3 4-7
	[3] Sources of Law	4-11 4-11 4-15
§ 4.02	[c] The Defend Trade Secrets Act of 2016 The Subject Matter of Trade Secret Protection [1] The Definition of "Trade Secret"	4-16 4-17 4-18
	[a] The <i>Third Restatement</i> 's Definition [b] The Uniform Trade Secret Act's	4-19
	Definition	4-21
	Trade Secrets Act's Definitions [2] The Rejected Exceptions for Transitory	4-22
	and Negative Information	4-24
	or Value	4-24
	Negative Results	4-25
	[3] Examples of Trade Secrets	4-26
	[4] Employees and Public Policy	4-32
§ 4.03	[5] Customer Lists	4-37
	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 4-57
	[2] Economic Value	4-37
	[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	12
	[4] The First Restatement's Six Factors	. 4-74
	[5] Practical Evidentiary Factors	. 4-76
	[a] Specificity	. 4-76
	[b] Removal of Tangible Records	
	[c] Inequity	
§ 4.04	"Exclusive" Rights in Trade Secrets and	
	Misappropriation	
	[1] Duration of Legal Protection	
	[2] Misappropriation and Improper Means	. 4-83
	[a] Misappropriation and the Concept of	
	Improper Means	
	[b] Proper Means and Shared Ownership	
	[c] Reverse Engineering	. 4-93
	[3] Product Modification and Improvement:	
	Determining Whether a Trade Secret	4.04
	Has Been Used	. 4-96
	[4] Availability Through Proper Means: The "Could Have" Defense	. 4-100
	[5] Indirect and Accidental Misappropriation	
	[a] The State-of-Mind Requirements	
	[b] The Timing of Knowledge or Notice	
	[c] "Reasonable Efforts" to Protect	. 410.
	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	
	[a] The Employee-Employer Relationship	
	[b] Nonemployee Relationships	
	[c] No Relationship	. 4-140
	[2] Contractual Protection of Confidential	
	Information	. 4-141
	[3] The Practical Value of Nondisclosure	4 1 4 2
	Covenants	. 4-143
	[a] How Nondisclosure Covenants Enhance	. 4-144
	Trade Secret Protection	
	[b] Expanding the Scope of Relief [c] Risk of Impairing Common-Law	. 4-140
	Protection	. 4-148
	[d] Minimum Requirement for Limited	. 7-140
	Availability	. 4-149
	[4] Nondisclosure and Noncompetition Covenants	
§ 4.06	Trade Secrets and Patents	
0		0 .

	[1] T	he Election Between Patent and Trade				
		Secret Protection	4-154			
		Hybrid" Licensing Agreements	4-160			
§ 4.07	Internat	4-164.1				
	[1] T	The Weakness of Trade Secret Protection Abroad	4-164.1			
	[2] T	The Value of Practical Measures Abroad	4-104.1			
§ 4.08		sure of Trade Secrets to and by the	4-107			
0	Government					
	[1] G	Sovernment Contracts: Protection of Technical				
		Data and Computer Software	4-169			
	[8	a] Protection of Technical Data	4-174.1			
		[i] Noncommercial Regime	4-179			
		[ii] Commercial Regime	4-189			
	[1]	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			
		Restrictions	4-211			
	Γα	d] Subcontractors' Rights	4-211			
	-	e] The Effect of Defense Department	7-217			
	Ĺ	Rules	4-216			
	[2] G	Governmental Use or Disclosure of	7 210			
	[-]	Information	4-220			
	ſa	a] Freedom-of-Information-Act				
	Ľ	Disclosure	4-221			
	ſŀ	Notice and Challenge Procedures	4-223			
	-	Disclosure in Litigation	4-226			
		Compensation for Disclosure or Use by				
		the Government	4-231			
	[8	a] Compensation Under the Fifth				
		Amendment	4-231			
	[1]	o] Compensation Under Federal Statute or				
		State Law	4-234			
		CHAPTER 5				
		What Is Copyrighted?				
0.7.01	0.1.	M. (CC . 11)				
§ 5.01		Matter of Copyright	5-2 5-4			
	\mathbf{H}	ICHCIAL ACODE OL AHDICCI MAHCI	.)-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		blematic Categories of Copyrighted Subject Matter	5-25
	[1]	Computer Programs	5-25 5-25
	[1]	[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
	[-1	[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	5 20 20
		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 5-38.35
		[v] Conclusion: The Statutory	3-36.33
		Approach	5-38.37
	[3]	Useful Articles	5-38.38
	[2]	[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	5.56
		Building Designs	5-56
		[b] Subject Matter Covered:	5-59
		Building Designs	3-39
		[c] Limitations on Copyright Protection for Building Designs	5-60
		[d] Prospectivity of Protection	5-60.3
	[5]	The Law	5-60.5
	[-]		
			(Rel. 64)

[b]

5A-37

	TABLE OF CONTENTS	xiii					
§ 5A.03	The Two Anti-Trafficking Rules	5A-47					
	Defeat Access Controls	5A-51					
	Defeat Use Controls	5A-52.3					
	Liability						
	Amendment	5A-56.2					
	[a] The <i>Reimerdes</i> Decision.	5A-56.3					
	[b] A Closer Look at the First Amendment	JA-30.3					
	as Applied to the Anti-Trafficking	5A-67					
	Rules[i] Is Binary Executable Code	3A-07					
	"Speech"?	5A-67					
	[ii] Some Useful Analogies.	5A-73					
	[iii] Beyond Binary Executable	311 /3					
	Code	5A-76					
	[iv] The Hard Cases: Mixed-Use	011 / 0					
	Technology and Linking	5A-80					
§ 5A.04	Exceptions to Anti-Circumvention and Anti-						
v	Trafficking Rules	5A-86					
	[1] Subject-Matter Classification	5A-87					
	[2] The "Target Rules" of the Exceptions[3] Two Examples: Encryption Research and	5A-90					
	Reverse Engineering	5A-94.1					
	[a] Encryption Research	5A-94.1					
	[b] Reverse Engineering	5A-98					
§ 5A.05	Rules Protecting Copyright Management						
0	Information	5A-102					
	[1] What Is CMI?	5A-105					
	[2] The Basic Rules Protecting CMI	5A-112					
	[a] The Three Types of Offenses	5A-113					
	[i] Providing or Disseminating						
	False CMI	5A-113					
	[ii] Removing or Altering CMI						
	Without Authorization	5A-114					
	[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					
	[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					

Volume 3

CHAPTER 6

The Nature of Copyright Protection

§ 6.01		Copyright Owner's Exclusive Rights and	
		Ioral Rights	6-6
	[1]	The Reproduction Right	6-24.3
		[a] Evanescent Copies and Phonorecords	6-24.9
		[b] What Is "Transient Duration"?	6-24.12
		[c] The Exception for Computer	
		Maintenance and Repair	6-24.14
	[2]	The Derivative Work (Adaptation) Right	6-25
		[a] Definition of "Derivative Work"	6-26
		[b] Distinction Between Derivative Works	
		and Copies	6-26
		[c] The Relationship Between Derivative	
		Works and Underlying Works	6-26.2
		[i] The "Value-Added" Principle	6-26.2
		[ii] The Independent Copyright	
		Principle	6-26.4
		[iii] The "Standoff" Principle	6-26.5
		[d] Scope of the Derivative Work Right	6-26.10
		[e] The "Outer Limits" of the Derivative	
		Work Right: Uncopyrighted	
		Derivative Works	6-26.13
	[3]	The Distribution Right	6-26.23
		[a] Scope of Distribution Right	6-26.23
		[b] First-Sale Doctrine	6-26.27
		[i] Codification in Section 109	6-26.31
		[ii] Exceptions for Phonorecords and	
		Computer Programs	6-26.33
		[iii] Inapplicability to First Sales of	
		Copies or Phonorecords	
		Lawfully Made Abroad	6-26.37
	[4]	The Rights of Public Performance and	0 = 0.00
	Γ.1	Public Display	6-26.42
		[a] Types of Works Covered	6-26.42
		[m] Types of World Covered	3 20.12

	[b]	Breadth of Performance Right	6-26.43
		Breadth of Display Right	6-26.47
	[d]	What "Publicly" Means	6-26.48
		[i] "Public Place" Clause	6-26.49
[5]	The S	[ii] "Transmission" Clause	6-26.50
[0]		d Phonorecords	6-26.50
		Definition of Sound Recordings	6-27
		Limitations on Exclusive Rights:	0 = 7
	F-3	"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
		Performing Rights Societies	6-34
		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
		The Digital Audio Transmission Right	6-36.17
[6]		Rights	6-36.19
		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	6-48
	[c]	Duration of Moral Rights	6-49
	[d]	Enforcement of Moral Rights	6-49
		Preemption of Moral Rights	6-50
[7]	Perfor	rmers' Rights	6-52.1
	= = =	Limitations of Section 1101	6-55
	[b]	Exclusive Rights	6-58
		[i] Fixation Right	6-58
		[ii] Transmission or Communication	(50 1
		Right	6-58.1
		[iii] Distribution and Trafficking	(50.2
	F-1	Right	6-58.2
		Remedies	6-58.4
	[d]	Satisfaction of TRIPS Agreement	6 50 5
FQ1	Eci. I	Obligations	6-58.5 6-58.6
[8]	ган (Jse	U-J8.0

			TABLE OF CONTENTS	vii	
§ 6.02	Owr	nership	of Copyright	6-58.28	
	[1] Copyright and Copy Distinguished				
	[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]		1 Source	6-76	
§ 6.03			f Copyright	6-76.9	
8 0.03	[1]	6-76.9			
	[2]		sfers Permissible	6-76.17	
	[3]		irements to Effect a Transfer	6-76.17	
	[2]	[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	Dura	ation o	of Copyright	6-77	
	[1] Term of Copyright: Works Created on or				
		A	fter 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]		ks Created Before January 1, 1978	6-96.6	
		[a]	Works Not Published Before		
		п.	January 1, 1978	6-96.6	
		[b]	Works in Their Initial Term on	(0 (7	
		F.1	January 1, 1978	6-96.7	
		[c]	Works in Their Renewal Term on	6 06 14	
		[4]	October 27, 1998	6-96.14	
		[d]	The Ninety-Five-Year Rule for Works Published Before 1978	6-96.16	
			I dollared Delote 17/0	0-20.10	

[3]			n of Copyright in Certain Works	6-96.17	
			Foreign Origin		
	[a]		ks Subject to Restoration		
			f Copyright	6-96.25	
		[i]	National Eligibility		
			Requirements	6-100	
		[ii]	Nonexpiration of Putative Term of		
			Copyright in the United		
			States	6-105	
		[iii]			
			Copyright Term and the		
			"Source Country"	6-107	
	[b]		General Nature of Copyright		
		R	estoration	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]	Rem	edies with Respect to Persons Other		
		T	han 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]	Rem	edies with Respect to		
	F J		eliance Parties	6-131	
		[i]	Notice of Intent to Enforce		
		F-3	Copyright and Its Effect	6-134	
		[ii]	Compulsory Licensing of Certain		
		[]	Derivative Works	6-150.1	
		[iii]	Statutory Damages and	0 10 0.1	
		[]	Attorneys' Fees	6-150.9	
	[e]	Who	Is a Reliance Party?	6-150.10	
	[c]	[i]	Continuing Infringers	6-150.11	
		[ii]	Makers or Acquirers of Copies	0 130.11	
		[11]	or Phonorecords	6-150.12	
		[iii]	Successors, Assignees, and	0 130.12	
		[111]	Licensees	6-150.13	
		[iv]	Other Reliance Parties and the	0-150.15	
		[11]	Limited Role of Actual		
			Reliance	6-150.15	
		[v]	Timing Issues and the Phrase	0-130.13	
		[v]	"Becomes an Eligible		
			Country"	6-150.17	
	ΓfΊ	Effec	ct of Copyright Restoration on	0-130.1/	
	[f]		greements Relating to Restored		
			opyrights	6-150.20	
			opyrigins	0-130.20	

			TABLE OF CONTENTS	ix
			[i] License Agreements	6-150.21
			Reliance Parties	6-150.21
			[iii] Warranties and Indemnification and Agreements to Infringe	6-152
		[g]	Ownership of Restored Copyrights	6-153
§ 6.04A		utory 7	Termination of Copyright Transfers	
			enses Evolution of the Termination Right and	6-155
	[1]		e Four Kinds of "New Estates"	6-156
	[2]		t Grants Are Terminable?	6-166
	[2]	[a]	The Exclusion of Works Made for	0 100
		[]	Hire	6-169
		[b]	The Derivative Works Exception	6-172
		[c]	The Exclusion of Testamentary Transfers	6-180
	[3]		nination 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	6 105
			Pre-1978 Grant.	6-197
			[i] Grants by a Sole Author	6-197
			Works	6-198
			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
	F 43		[iii] Grants by Coauthors	6-211
	[4]		nination of Post-1977 Grants	6-212
		[a]	The Time Window for Terminating	(212 1
		[h]	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	(21/
		F.13	Post-1977 Grants	6-216
		[d]	The Effect of Terminating a	6 210
	[5]	Statu	Post-1977 Grant	6-218 6-221
	[5]		et of Termination on Contractual	0-221
	[6]		rovisions	6-223
§ 6.05	Con		Misuse	6-226
	- °P	,		0

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				
o .	[1] The 1909 Act Regime					
	[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				

		TAI	BLE OF CONTENTS	xi
		[iii]	Works Still Subject to the	
			Registration Prerequisite:	7 42
		[iv]	Unpublished Works Works Still Subject to the	7-43
		[iv]	Registration Prerequisite:	
			Published Works	7-43
		[v]	Works Still Subject to the	7-43
		[,]	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]		quisite to Recovery of Statutory	
	F 13		mages and Attorneys' Fees	7-51
			g of Registration	7-55
		[i]	The "Commencement" Rule for	
			Statutory Damages and	7.56
		rii i	Attorneys' Fees	7-56
			When Registration is Effective Expediting Registration	7-58 7-59
			nics of Registration	7-60
§ 7.04			uirements	7-63
y 7.04			" Deposit	7-63
			Deposit	7-64
			otions: Overview	7-66
			outer Program Deposits	7-67
			Protection of Trade Secrets	7-68
			Protection of Screen Displays	7-69
			CHAPTER 8	
	Se	emico	onductor Chip Protection	
§ 8.01			ound	8-3
			ctor Chip Products	8-4
	[2] Chip	Fabric	cation	8-6
			acturing Process	8-7
	[4] Chip [5] Econo	Designomics	n	8-8
			on	8-10

§ 8.02			e History of the Chip Act	8-15
	[1]	Need	d for the Chip Act	8-15
	[2]	Outl	line of Legislative History	8-18
	[3]		Switch from Copyright to Sui Generis	
	_		Protection	8-21
§ 8.03			Subject Matter	8-24
	[1]	The	Nature of Protected Designs	8-24
		[a]	Semiconductor Chip Products	8-24
		[b]	Mask Works	8-26
	[2]	Fixa	tion	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]	Orig	ginality	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	Excl	usive	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]	Cont	tributory Infringement	8-44
§ 8.05	Limi		s on Exclusive Rights	8-45
	[1]		erse 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	Terr	m 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	Mas	k Work Registration, Notice, Ownership, and	
	T	ransfer	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	Inte	rnational 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	Trac	le 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	Trac	lemark Policies and Requirements for	
		rotection	9-15
	[1]	Trademark Policies	9-16
	[2]	Distinctiveness	9-21
		[a] Arbitrary and Fanciful Marks	9-25
		[b] Suggestive Marks	9-26
		[c] Descriptive Marks	9-27
		[d] Generic Marks	9-32
		[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	9-71
	[5]	Other Statutory Restrictions	9-83

Volume 4

CHAPTER 10

Scope of Legal Protection of Trademarks and Other Trade Symbols

§ 10.01	The S	Stand	ard for Infringement: Likelihood	
	of	Conf	fusion	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]	Cons	sidering All the Circumstances	10-27
	[3]	Appl	lying the "Likelihood of Confusion"	
		S	tandard	10-30
		[a]	Strength of the Plaintiff's Mark	10-30
		[b]	Similarity of the Marks	10-32.5
		[c]	Similarity of Products	10-32.9
		[d]	Channels of Trade	10-32.12
		[e]	Advertising and Promotion	10-32.14
		[f]	Nature of Customers	10-32.15
		[g]	Intent or "Bad Faith"	10-32.16
		[h]	Actual Confusion	10-32.22
§ 10.02	Stren	gth a	nd Duration of Trade Symbol Protection	10-32.26
	[1]	Use	and Registration	10-32.27
	[2]		ndonment	10-32.29
		[a]	Nonuse	10-32.30
		[b]	Loss of Trademark Significance	10-40
§ 10.03	Trade	emark	Dilution	10-42.2
	[1]	Sour	ces of Trademark Dilution Law	10-45
		[a]	Federal Dilution Law	10-46
		[b]	State Dilution Law	10-52

	[2] What Is Dilution?	10-56
	[a] Defining the Term "Dilution"	
	[b] Kinds of Dilution	
	[i] Blurring	
	[ii] Tarnishment	
	[iii] Confusion	
	[iv] Unauthorized Alternation of	10 00
	Trademark	10-68
	[c] Federal and International Significance	10-00
	of the Branches of Dilution Doctrine	10-72
	[b] State Law	
	[4] Other Requirements for Protection	
	[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	
	[5] A Multifactor Test for Dilution?	
	[6] Federal Preemption	
§ 10.04	Trademark Fair Use	10-83
	[1] The Descriptiveness Branch of Fair Use	10-84
	[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	
§ 11.02	Protection Through Use	
	[1] The Common-Law Rule	
	[2] Nature of Use	
	[3] Sources of Common Law	
	[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
	[i] Nature of Application	
	[ii] Statement of Use	
	[iii] Bona Fide Intention to Use	
	[c] Registration Based Upon Foreign Filing	
	or Registration	11-25
	[d] Registration Based on Foreign	
	Pagistration	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] Prima Facie Evidence	11-32.4
		[f] Federal Remedies	11-32.4
		[g] Incontestability	11-32.5
	[3]	Import Exclusion, Parallel Imports, and	11 32.0
	[2]	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	11-30.1
		of Confusion Required?)	11-36.2
		[iii] Treatment of Foreigners	11-36.2
		[iv] The Customs Service's	11-30.6
			11-36.9
		Regulations	11-36.13
			11-30.13
		[i] The <i>Katzel</i> Decision and Its Aftermath	11-36.13
		[ii] Independent, Unrelated Foreign	11-30.13
		Owner of Trade Symbol	11-36.16
		[iii] Affiliated Foreign Owner of	11-30.10
			11-36.18
		Trade Symbol [iv] Licensed Foreign Owner of Trade	11-30.16
			11-36.24
		Symbol	
		[v] Same Entity	11-36.28
		[vi] Matters of Degree	11-36.30
	Γ <i>4</i> 1	[d] Impact of the Paris Convention The "Limited Area" Defense	11-36.34
	[4]		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
	F. 6.1	[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	11 46
		Register	11-46
		[b] Effect of Registration on the	11 47
0 11 04	04.4	Supplemental Register	11-47
§ 11.04		Registration	11-48
§ 11.05		rnational Protection	11-53
	[1]	International Conventions and Priority	11-54

	[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	Trad	lemarks and Goodwill	11-56.26
	[1]	Goodwill	11-56.26
	[2]	The Lanham Act's Abandonment and	
		"Related Company" Rules	11-57
§ 11.07	Assi	gnment 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	Trad	lemark Licensing	11-66
§ 11.09	Trad	lemark 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	Intro	oduction	12-3
§ 12.02	Actu	ual Damages	12-5
	[1]	Causation	12-6
		[a] Patents	12-6
		[b] Copyright	12-12
		[c] Semiconductor Chip Protection	12-14
		[d] Trade Secrets	12-14
		[e] Trademarks	12-16
	[2]	Patent and Trademark Marking	12-18
	[3]	Amount of Damages	12-25
§ 12.03	Reas	sonable 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] Convright Cases	12-44.2

		[iii] The Nonmoving Party's Fair and	
		Courteous Conduct in the	12 112 22
		Litigation	12-112.22
		[iv] Lack of Substantial Harm to the	
		Intellectual Property Owner's	10 110 00
	F 4 7	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	10 110 07
	FO.3	Augmented or Punitive Damages	12-112.27
	[8]	The Effect of Fee-Award Statutes on Rule 68	10 110 00
0 10 07	т 4	Settlement Offers	12-112.29
§ 12.07		Period I would be to see	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	10 105
	[2]	Interest	12-125 12-129
	[2]	Post-judgment Interest	12-129
		CHAPTER 13	
		Nonmonetary Relief	
0 12 01	Tariana	ostino Daliof	12.2
§ 13.01		nctive Relief	13-3 13-6
	[1]	Preliminary Injunctions	13-0
		[a] The Traditional, Four-Part Test [i] Likelihood of Success	13-9
			13-11
		[ii] Balance of Harm	13-10
		[iv] The Public Interest	13-21
		[b] The Modern, Sliding-Scale Test	13-37
	[2]	Permanent Injunctions	13-41
	[3]	The Scope of Injunctive Relief	13-47
	[2]	[a] Trademark Cases	13-49
		[b] Trade Secret Cases	13-52.1
		[c] Internet Copyright Cases	13-53
§ 13.02	Excl	usion from Importation.	13-54.3
3 10.02	[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	15 50
		Section 337 Proceedings	13-67
		<i>5</i>	

		TABLE OF CONTENTS	X1
§ 13.03	Impo	oundment and Destruction	13-70
	[1]	Impoundment and Destruction in General [a] Impoundment and Destruction Under	13-70
		the Copyright Act	13-71
		[i] Impoundment	13-72
		[ii] Destruction and Other Disposition	13-83
		[iii] Items Covered	13-86
		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 Ex Parte Seizure Order	12 102
			13-102
		[c] Damage Action for Wrongful Seizure	13-104
		[i] Amounts Recoverable	13-104
e 12 04	Cuina	[ii] Which Seizures Are Wrongful	13-105
§ 13.04		inal Sanctions.	13-108 13-112
	[1]	Criminal Sanctions for Copyright Infringement	13-112
		[a] Civil Liability: the Sine Qua Non	
		[b] The State-of-Mind Requirement[c] Numerical Thresholds for Felony	13-122
		Offenses	13-126.2
		[d] Criminal Penalties	13-126.6
		Disposition)	13-126.7
	Γ1Δ]	Criminal Sanctions for Violation of Performers'	13 120.7
	[171]	Rights	13-126.8
		[a] The First Prerequisite: a Civil Case	13-126.10
		[b] Required State of Mind	13-126.10
		[c] Criminal Penalties for Violating	13-120.12
		Performers' Rights	13-126.13
		[d] Forfeiture and Destruction	13-126.13
		[e] Border-Control Measures	13-126.14
	[2]	Criminal Sanctions for Trademark Offenses	13-126.17
	[4]		
			13-126.18
			13-126.18
			13-120.18
		[iii] Seizure and Forfeiture	13-131
			13-131
	[2]	[c] Trademark Offenses Under State Law Criminal Offenses Relating to Trade Secrets	13-136
	[3]		13-130
		[a] Federal Crimes under the 1996 Act	13-137
			13-140
		[ii] Elements of a 1996 Act Offense [iii] Kinds of Offenses and Related	13-14/
		Legal Problems	13-161

xii	I	INTELLECTUAL PROPERTY LAW				
		[iv] Protective Orders and Related Civil Proceedings	13-172			
		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			