

Intellectual Property Wypadki Fall 2008



Intellectual Property
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This document has not been reviewed by Prof. Johnson for legal or factual accuracy.

2008 Intellectual Property Wypadki

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COPYRIGHT

Requirements

Originality

Work must be original to qualify for protection: (1) author must have engaged in some intellectual endeavor and not just copied from a preexisting source; and (2) the work must contain a minimal amount of creativity.

mere compilations of data are not copyrightable

de minimis "works" are not copyrightable (words, short phrases, slogans, etc.)

facts are discoverable, not created, therefore they are not subject to copyright (however, an author's original method of expressing facts is copyrightable)

"sweat of the brow" theory rejected

Feist v. Rural Telephone Services

Rural would not give Feist a license to publish phone numbers, so Feist just copied Rural's white pages

compilations of facts are generally not copyrightable

a work must be original to the author

Even a directory that contains absolutely no protectible written expression, only facts, meets the constitutional minimum for copyright protection if it features an original selection or arrangement.

Alphabetical arrangement of names is not original enough to be protected

To establish infringement, two elements must be proven

ownership of a valid copyright

copying of constituent elements of the work that are original

Roth Greeting Cards v. United Card Company

Background: Roth copyrighted greeting cards, and United is selling similar greeting cards, and Roth sues them for copyright infringement

Rule

The White-Smith Music Pub. Co. v. Apollo Co. test

“[W]hether the work is recognizable by an ordinary observer as having been taken from the copyrighted source?”

United failed this test, they were too similar, so Roth won

The art and text were not copyrightable in and of themselves, but the combination of the art and text was copyrightable

Dissent: If neither the art nor text is copyrightable, then the combination is not copyrightable

Fixation requirement

Copyright Act of 1976 - a work is fixed "when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than a transitory duration."

Contemporaneous fixation takes care of fixation

State law can protect unfixated works

Expression (not ideas)

NOT useful articles (conceptually separable): Must distinguish btw aesthetic elements (protectible) and utilitarian elements (no protectible)

Brandir International, Inc. v. Cascade Pacific (bike rack)

"industrial designs not subject to copyright protection"

"the dominant characteristic of industrial design is the influence of nonaesthetic, utilitarian concerns"

Ribbon bicycle rack developed from sculptures

Bicycle rack was not conceptually separable from the sculpture

Bicycle rack was a useful item, not copyrightable

NOT scenes-a-faire: (incidents, characters, settings, or other elements that are indispensable, or at least standard, in the treatment of a given topic) creative works not protected when they are mandated or customary to the genre

Subject Matter

17 USC 102: Spans the broad spectrum of artistic and literary expression

Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

Literary works; musical works (including lyrics); dramatic works (includes music); pantomimes and choreographic works; pictorial, graphic and sculptural works; motion pictures and other audiovisual works; sound recordings; and architectural works (this list is not meant to be exclusive)

Some works might be encompassed by more than one category

Literary works (includes computer databases): includes the story and characters (the less developed they are, the less protected they are) and to non-literal elements such as structure, sequence, and organization

Characters are in that they cannot be revealed in other creative works

Musical works: protects both the author and the performer; subject to compulsory licensing under sect 115 once they have been released to the public.

Dramatic works: cannot copyright simple steps or conventional gestures

Pictorial, graphic and sculptural works:

includes two-dimensional and three-dimensional works of fine, graphic, and applied art:

photographs; prints and art reproductions; maps; globes; charts; diagrams; models; technical drawings; and "works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned."

Motion pictures and other audiovisual works

Soundtracks are treated as integral part of motion pictures and are protectible

Architectural works

Exceptions

can take pictures

can make alterations to buildings

Owner of the building does not need permission to destroy the building from the copyright holder

Derivative Works and Compilations

Derivative works - works based upon one or more preexisting works, such as translations, musical arrangements, dramatizations, fictionalizations, motion picture versions, art reproductions, etc.

Compilations - works formed by collecting and assembling preexisting materials or data.

Extends only to the work contributed by the author, as distinguished from the preexisting material employed in the work

Keep a strong interest in anything that stems from the original work, book, then movie, then TV show, then toy, still has an interest in the toy

Gives the ability to license others to sell in different markets

NOT words and short phrases

Baker v. Selden

Background

Selden got a valid copyright of a book that's purpose was to explain a specific system of bookkeeping

Baker wrote book of forms using Selden's method

Rule

"The novelty of the art or thing described or explained has nothing to do with the validity of the copyright."

Trying to get IP rights on something such as a system of bookkeeping, is a patent claim, not a copyright

Morrissey v. Procter & Gamble

Background

Morrissey created/copyrighted a "sweepstakes" game for people to play for a chance to win a prize

Procter and Gamble created an almost identical "sweepstakes" game with an almost identical rule

Rule: The court found that this matter was too simple, and therefore there was no infringement of the subject matter

Some ideas are so narrow that there are only a few ways to describe them

Granting a copyright would grant an unfair monopoly

Ownership and Duration

OWNERSHIP

Joint Works: basically can do something without asking permission in a joint work, but potentially have to pay royalties

Aalmuhammed v. Lee

Background

For the movie "Malcolm X," Plaintiff submitted evidence that he directed the actors during certain scenes, he created 2 scenes, translated subtitles, supplied his own voice for voice-overs, and edited during post production

He was paid for his services, but was not given a writing credit, so he sued for copyright infringement

Rule

Per, Statutory Language, the 3 requirements for a "joint work" is
Copyrightable work

Two or more authors

The authors must intend their contributions be merged into inseparable or interdependent parts of a unitary whole

Nothing the Plaintiff did showed that he was in charge, or that he was the "inventive or master mind" of the movie

Therefore, Plaintiff loses

Collective Works: work that is put together: i.e., newspaper, album

Works for Hire

must qualify under one of two circumstances

employment: created by an employee in the regular course of employment
commission, if both requirements met

"work for hire" agreement in writing

one of 9 categories of works

collective work

motion picture or other audiovisual work

translation

supplementary work

compilation

instructional text

test

answers to test

atlas

Community for Creative Non-Violence et al. v. Reid

Background

Artist was hired by an organization to create a sculpture, but after it is made, they reach a disagreement and the artist won't return it

They are contesting the determination of copyright

Sculpture was of the Nativity featuring homeless people

CCNV wanted to take sculpture on tour, Reid wanted to take it on a smaller tour

Reid sought copyright to prevent CCNV's tour

Rule

Copyright Act of 1976: Copyright ownership "vests initially in the author or authors of the work"

If it is a work for hire, "The employer or other person for whom the work was prepared is considered the author" and owns the copyright.

EXCEPTION: if there is a written agreement to the contrary

Copyright Act of 1976: A work is for hire under 2 sets of circumstances

It is prepared by an employee within the scope of his or her employment, or

A work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a text, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire

If someone is hired for only one specific task for a small amount of time, worked in their own workplace with their own materials, and is skilled at it, they are an independent contractor, not a work for hire

Artist wins

The Right to Prepare Derivative Works

Anderson v. Stallone

Background

“Rocky IV” (“I must break you) case

Plaintiff wrote/copyrighted a script for Rocky IV, which he claims Stallone used

Rule

Per Nichols v. Universal Pictures: Copyright protection is granted to a character if it is developed with enough specificity so as to constitute protectible expression

Per § 17 USC § 106(2): When one creates a derivative work based upon characters created by someone else without permission, no copyright protection is given

He didn't even have a claim, plus they said that his script wasn't similar enough

Government Works

Court has ruled that the government can't obtain a copyright, but the government can hold a copyright if it acquired by another means

Copyright Act does not expressly limit the protectability of works created by state government officers or employees in their official capacities

courts have held that certain types of government works, such as statutes, opinions, etc. are inherently part of the public domain

DURATION

[life of the author] + 70 years

author unknown

if published, 95 years

if unpublished, 120 years

Infringement

NON LITERAL INFRINGEMENT

Copying

Direct Evidence of Copying

Indirect Evidence

Access

Substantial similarity

Improper

- Substantial similarity
- Ordinary observer standpoint
- Expert testimony sometimes
- Quality of portion taken
- Scenes-a-faire copying ok

Arnstein v. Porter

Arnstein sued Cole Porter for copyright infringement for copying some of his songs
 Arnstein argued Porter could have stolen a copy of a song from his room, or had someone else do it

copying

improper appropriation

Background: Plaintiff is suing, claiming that 3 of their songs was plagiarized by D

Rule

To prove a non literal infringement, 2 elements are required

That D copied from P's copyrighted work

An admission OR

Circumstantial evidence

Access or Substantial Similarity

That the copying went so far as improper appropriation

Requires standard from an ordinary observer

Expert testimony

Quality

The greater the proportion the percentage of the P's work was taken means that there is an increased likelihood of infringement

Increased percentage of D's work comprises of P's work is not relevant

These are issues of fact, and this case was remanded to a jury

Nichols v. Universal Pictures Corporation

Background

P created/copyrighted a play about a Jewish family living in New York and a child gets married to a catholic

D created a movie that was very similar

Rule

When the theme (in this case, the families in NY of Jewish and Catholic faith that have children that marry) is only a part of the copyrighted idea, it is not enough.

Basically ones copyright of a written work does not cover absolutely everything that can be drawn from it

Selle v. Gibb

Chicago band sued the Bee Gees for copying one of their songs

Songs had been played in the Chicago area a few times, band sent demo tapes to 11 record companies

Jury found for the Chicago band, judge entered j.n.o.v. for the Bee Gees

Steinberg v. Columbia Pictures Industries, Inc.

Background

New Yorker cover/"Moscow on the Hudson" case

“Moscow on the Hudson” poster was very similar to and influenced by a New Yorker cover

Rule

With regards to the 2nd Element from Arnstein

It is satisfied when the two works could easily be mistaken for one another

It is also satisfied when someone can only be explained by copying

In this case, they believed that each of the prior two lines were true

Defenses

Fair Use

Four Factor Test

the purpose and character of the use (including whether such use is of a commercial nature or is for nonprofit educational purposes)

Is it commercial?

Public interest

Is it transformative or superceding? If transformative, this favors fair use. If superceding, this favors a finding against fair use. Fair use test on TRANSFORMATIVE vs. SUPERCEDING “the enquiry focuses on whether the new work merely supersedes the objects of the original creation, or whether and to what extent it is "transformative," altering the original with new expression, meaning, or message. The more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use.”

If there is a licensing mechanism, weighs in favor of fair use (Texaco case)

the nature of the copyrighted work

Fact/fiction - fiction gets more protection than factual wks

published/unpublished - unpublished gets more protections than published b/c of rt to control 1st publication

the amount and substantiality of the portion used in relation to the copyrighted work as a whole

a lot or a little? qualitatively important?

the effect on the market for the copyrighted work

Direct substitution: ppl bough this from you rather than me

Derivative wks: evin if your good doesn't complete directly w/mine, you deprived me of the opportunity to sell my good

Presumptive fair use (sec 107): teaching, news reporting, criticism, scholarship, research
Harper & Row, Publishers, Inc. et al. v. Nation

Background

The Nation Magazine received from an undisclosed source an unpublished manuscript of Gerald Ford's autobiography that Time Magazine was going to soon publish

The Nation quickly published it before the Time did, Time sued for copyright infringement

Rule

They applied the four factor rule

You need infringement

There's nothing you can do with copyright doctrine to prevent the publication of facts,

Fair Use is about our “ideas” of what is fair

Sony Corporation of America v. Universal City

Background

Universal is suing VCRs because people could record shows, create libraries, and skip through commercials

They claim Sony is liable for guilty contributory infringement

Rule

You have to prove that your copyrighted work is devalued

One making a product has a chance of being used to infringe, does not make them liable for contributory infringing

VCRs were used mainly for time-shifting, not archiving

American Geophysical Union, et al. v. Texaco Inc.

Background: Texaco employed 500 research scientists who photocopied scientific journals to support their research

Rule

Failed the four factor fair use assessment

The following actions contribute to a violation of Fair use

Multiplying the number of available copies

Using the works substantially

Established a personal library of the copyrighted works

Showing substantial harm to the plaintiff’s copyrights, one is guilty

License

implied

express

Statute of Limitations = 3 years

Remedies

Civil Remedies

Damages: lost profits plus additional defendant's profits

statutory damages

neither willful nor innocent = \$750-\$30,000

willful = up to \$150,000

innocent = down to \$200

fees and costs

impoundment and destruction

injunction

Criminal Sanctions

DMCA

safe harbor: a service provider shall not be liable for monetary relief, or . . . for infringement of copyright by reason of the storage at the direction of a user of material that resides on a system or network controlled or operated by or for the service provider

anti-circumvention: Exemptions are granted when it is shown that access-control technology has had a substantial adverse effect on the ability of people to make non-infringing uses of copyrighted works.

MORAL RIGHTS

Moral rights in copyright law are rights personal to authors, and as such viable separate and apart from the economic aspect of copyright. The modern conception of moral rights is based on the European, particularly French, notion of an author's right to protect the integrity and paternity of their work. A moral right generally requires the author of a work to be attributed for that work and to control all derivative works.

VARA, 17 USC 106A, provides certain moral rights to visual artists

i.e. A painter may sue the owner of his/her painting (under certain circumstances) for destroying it even if the owner lawfully owned it

State legislatures and judicial decisions have created limited moral rights protection

Moral rights include

- Right of attribution

- Right to have work published anonymously

- Right to the integrity of the work

- bars work from

- alteration

- distortion

- mutilation

TRADE SECRET

Definition: information that (1) derives actual or potential economic value from the fact that it is not known or readily ascertainable by others, and (2) is subject to reasonable efforts to maintain its secrecy.

Any process, etc., that you have and you use in the course of your business and is not generally known

It is ok to reverse engineer some product to figure out how it works

EXAMPLES

- recipes

- the temperature that you heat things at

- the method of manufacturing something

Protects against 2 things

- People who have the secret in confidence and reveal it

- People who try to sneak in and find out your trade secret by trespassing on your property

Trade secrets are indefinite

Requirements

- Secrecy: not generally known or "readily ascertainable"

- Valuable

- Value from Secrecy: gets its value because it is not generally known

- Protection: must take "reasonable efforts" to protect the secret (UTSA)

Misappropriation/Infringement

- Improper means: cannot violate "generally accepted standards of commercial morality"

- Breach in confidential relationship: most typical in the employee context; agent-principal relationship; partnership relationship; or a fiduciary relationship (like attorney-client or doctor-patient) - relationship can be express or implied, or a contractual agreement that the recipient will not disclose the secret without permission

If you enter into a confidential relationship and do not keep information you get secret, you are liable for misappropriation

Elements of misappropriation

Is there a 'secret'?

Did you enter a 'confidential relationship'?

Did you 'use this information in violation of the relationship'?

Defenses

Reverse engineering: reverse engineering is a fundamental public policy good, but the product must be obtained from the open market

Employees

Most courts find a confidential relationship in the employee/employer context. You can't take documents outside the building with you, but you can take "general knowledge" (most states)

non-competitive agreements are enforceable if they are "reasonable"

look at employer's interest, employee's interest, and public policy

CA has developed a rule against non-competitive agreements

Then the doctrine of inevitable disclosure is used: If D goes to work for the competitor, s/he will inevitably disclose our trade secrets, and the only way to prevent that is to have an injunction against that person working for the competitor

Elements

Former employee has knowledge of the plaintiff's trade secrets

New job duties are similar or related to former position and it would be difficult for employee not to rely on or use plaintiff's trade secrets

Cannot rely on former employee or new employer to avoid using the trade secrets

Remedy = injunction

NOTE: Doctrine of inevitable disclosure is controversial

Remedies

Contract remedies: i.e. "reasonable royalty" - reasonable license fee

Tort remedies: baseline monetary remedies of either actual loss to P or actual gain to D

Property remedy: injunction (presumptive entitlement to an injunction)

Criminal punishments: punitive damages awarded for up to 3x loss in case of willful misappropriation

Has a state of mind requirements: knowledge that this is a TS

Jail: states and feds punish TS misappropriation criminally

Related Cases

Metallurgical Industries, Inc. v. Fourtek, Inc.

Background

Metallurgic had a trade secret regarding how to make tungsten carbide

They did this for Therm-O-Vac, which went bankrupt, and some of their former employees formed Fourtek, and used the trade secret

Rule

Wiseman v. Boucher

"Matters of general knowledge in an industry cannot be appropriated by one as his secret"

Per Restatement of Torts, § 757

One may without losing trade secret protection communicate to

employees their trade secret if necessary

Disclosures that don't lead to losing trade secret are:

Disclosures made in hopes to further business

Those to confidential relationships

When the trade secret had time, effort, and money expended on it

Metal won

Rockwell Graphic Systems, Inc. v. DEV

Background

Rockwell is a manufacturer of printing presses used by newspapers

They had drawings that demonstrated their trade secret

Two people given access to the drawings formed a company and used the drawings. Rockwell sued

Rule

Drawings can be a trade secret, as long as reasonable measures are taken to maintain the confidentiality of them

Rockwell won

Misappropriation of Trade Secrets

E.I. DuPont deNemours & Co. v. Rolfe

Background

Aerial photographs are taken of DuPont's facility and obtained trade secrets

Rule

Per Restatement of Torts § 757

"One who discloses or uses another's trade secret, without a privilege to do so, is liable to the other if:

"(a) he discovered the secret by improper means, or

"(b) his disclosure or use constitute a breach of confidence reposed in him by the other in disclosing the secret to him

Brown v. Fowler

The means of discovery may be obvious, but they can't be unfair

Aerial photography is an unfair method of discovering trade secrets.

PATENT

Utility

Jurisdiction and Governing Law: federal, Patent Act of 1952, Federal Circuit

Rights: (exclusive right) To exclude others from making, using, or importing the invention claimed, for a limited term - NOTE: no right is granted to make or use

Utility Cases

Brenner v. Manson (Utility)

Background

Chemical compound case

A patent was applied for a chemical compound, and the creator sought to get a

patent on all possible uses of it

Rule

“A process patent in the chemical field, which has not been developed and pointed to the degree of specific utility, creates a monopoly of knowledge which should be granted only if clearly commanded”

It was not specific enough. He wanted all uses not a specific one. If he had attempted to patent it for a specific use, it would have been patentable.

You cannot get a patent on something that's sole utility is its potential role in the future

In Re Fisher (Utility)

Background

Fisher invented 5 purified nucleic acid sequences

When he applied for the patent, he did not know the precise function of them, and put down several uses

Rule

If the uses alleged on the patent are application are too general, then no patent will be granted

Also, if those uses apply to several other similar items, a patent will not be granted either

The Incandescent Lamp Patent

Background

A patent was obtained that was broad in that it was intent to encompass any fiber/paper that could be used to make it

Rule

Per Rev. Stat. § 48888

The application shall contain a written description of the device “and of the manner and process of making, constructing, compounding, and using it in such full, clear, concise and exact terms as to enable any person, skilled in the art or science or with which it is most nearly connected, to make, construct, compound, and use the same”:

This has to be a specific description with specific materials, one cannot patent all possible materials that could be used

“The fact that the paper happens to belong to the fibrous kingdom did not invest them with sovereignty over the entire kingdom, and thereby practically limit other experiments to the domain of minerals”

Requirements (SEE sections below for in-depth info on each requirement)

Subject Matter

35 USC 101: Any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof. (An invention will be "useful" (or "have utility") if there is a current, significant, beneficial use for the invention or, in the case of patenting a process, the product of the process. An invention may also be denied a patent for lack of usefulness if it does not operate as the application claims it does.)

ISSUE: improvements and blocking patents

Applies to "man-made" things, NOT:
laws of nature

- natural phenomena
- naturally occurring species
- abstract ideas
- useless inventions
- inventions not reduced to practice

Sometimes

- algorithms
- business methods
- medical procedures, with limited remedies

Novelty

35 USC 102(a): entitled to patent unless any of the following: (1) the applicant's invention was known by others before the invention; (2) it was used by others before the applicant's invention; (3) it was described in a printed publication before the applicant's invention; or (4) was patented before the applicant's invention. Focus is on the actions of other persons prior to the date of application.

Nonobviousness

35 USC 103: invention is not patentable if it would have been obvious to a person having normal skill in the pertinent art at the time invention was made. Must ascertain: (1) the scope and content of the prior art; (2) the difference between the pertinent prior art and the invention; and (3) the ordinary level of skill in the pertinent art.

Enablement

Subject Matter

§ 101: process, machine, article of manufacture, composition of matter, and improvement of thereof

NOT Patentable: manifestations or products of nature (laws of nature, physical phenomena, naturally occurring materials, plants in wild); abstract ideas; in connection w/ atomic weapons; pure mathematical algorithms (e.g., EKG case (bound up on machine)).

But see State Street (data process system was “machine,” practical utility – does it create a ‘useful, concrete, and tangible result?’)

Special Cases: business methods, biotechnology, methods of medical treatment (surgical technique, but no damages)

Case

Diamond v. Chakrabart

Background

A microbiologist made a micro-organism and wants to patent it

Rule

Thomas Jefferson in the Patent Act of 1793 defined statutory subject matter as:

“Any new and useful art, machine, manufacture, or composition of matter, or any new or useful improvement.”

“His discovery is not nature’s handiwork but his own; accordingly it is patentable subject matter”

Novelty and statutory bars

§102(a) **Novelty.** focus on people other than inventor and date of invention.

must not have been known or used in U.S. prior to invention.

must not have been described in printed publication or patented anywhere prior to invention.

§102(b) Statutory Bars. focus on inventor and date of application.

no public use or sale more than one yr prior to appl'n
not described in printed publication or patented anywhere more than one yr prior to appl'n

Cases

In re Hall (Statutory Bar = Publication)

Background

Appellant applied for a patent resissue and tried to include a doctoral thesis which had been publicized.

Hall wanted to patent something that was published in Foldi's dissertation

The application was rejected because it had been previously published

Rule: When something has been publicized such as this, it's not patentable

Egbert v. Lippman (Statutory Bar = Public Use)

Background

Plaintiff made an invention that only his wife used (corset springs), for over two years

The issue was whether or not this constitutes public use

Rule

“To constitute the public use of an invention it is not necessary that more than one of the patented articles should be publicly used. The use of a great number may tend to strengthen the proof, but one well defined case of such use is just as effectual to annul the patent as many.”

(Defining public)

“Whether the use of an invention is public or private does not necessarily depend upon the number of persons to whom its use is known. If an inventor, having made his device, gives or sells it to another, to be used by the donee or vendee, without limitation or restriction, or injunction of secrecy, and it is so used, such use is public, even though use and knowledge of the use may be confined to one person.”

One is also likely to lose on this if they do not go out and get a patent on it, in this case it was 11 years without getting one

Plaintiff loses

§102(g). Priority. “first to invent” system (U.S.). cf. ‘first to file’ everyone else in world

In short: first inventor to reduce to practice the invention unless the rival was:

first to conceive of the invention; and

exercised diligence in reducing the invention to practice

Interference. procedure by which priority is determined b/w two pending applications or a pending application and issued patent.

“**Invention**” starts with “conception” and is completed upon “reduction to practice”

Conception formation in mind of inventor, of definite and permanent idea of complete and operative invention, as it is to be applied in practice.

Reduction to Practice

Actual. building and testing a physical embodiment demonstrating ‘that the claimed invention work for its intended purpose’

Constructive. by filing a patent application.

Invention Priority Rules.

First to RTP is first to invent.

Filing date is presumed invention date.

BUT, an inventor can use evidence to establish a pre-filing invention date

RTP will count as invention date

Second to RTP may nonetheless prevail by proving:

conception prior to other's conception, and

diligent effort toward actual or constructive RTP from date prior to other's conception

The first inventory by actual RTP date loses that date for priority purposes if they abandon, suppress, or conceal the invention.

The inventor thereby having lost benefit of actual RTP is entitled to the resumption date as the invention date.

Once you stop diligent efforts to RTP, you also lose conception date (i.e., conception date = resumption date if ceased diligent efforts).

If an inventor's conception is derived from another person, that other person is entitled to priority, regardless of who reduced the invention to practice.

Limitations.

Activity outside the U.S. cannot be relied upon to establish conception or RTP dates.

Evidence of conception and RTP dates must be corroborated. Testimony of the inventor's recollection alone is legally insufficient to establish conception or RTP dates.

Nonobviousness

§103 Non-Obviousness. Patent may not be obtained if differences b/w subject matter and prior art are such that the subject matter would have been obvious at time invention was made to person having ordinary skill in the art to which said subject matter pertains.

Primary Factors {Combining References}: [i.e., whether one who is aware of all prior art would think to create claimed invention, which involves an analysis of combination of ideas from different sources of prior art (references)]

scope and content of prior art

differences b/w prior art and claims

level of ordinary skill in prior art

Secondary (Objective) Factors: commercial success, long felt but unsolved needs, failure of others, commercial acquiescence (people pay for invention or refrain from practicing it), prof'l recognition (e.g., awards), contrary to teaching of prior art, fact that Δ chose to copy

Obviousness - court may also look at factors including:

the commercial success of the invention;

how long a need for the invention had been felt before it was made;

level of acquiescence of others to the patent;

movement of persons skilled in the art in a different direction from the inventor's;

existence of skepticism on the part of experts regarding the inventor's approach; and

fact that the defendant copied the invention, rather than existing alternatives. A nexus must be demonstrated between the factor and the issue of obviousness.

Cases

Graham v. John Deere Co.

Background

Graham created a clamp that would lead to less damage when plowing.

He obtained a patent and sold it

John Deere, the plow manufacturer, sued him

Rule

Test of Obviousness

Whether “the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

It was not obvious enough, Graham wins

KSR International Co. v. Teleflex Inc.

Background

Teleflex patented a design for a pedal system that included the adding of a modular sensor to make the system compatible with more vehicles

KSR added the sensor to one of their pedals

Teleflex sued, KSR is alleging that it was too obvious

Rule

The marketplace created a strong incentive to convert mechanical pedals to electronic pedals

Also, the claim as the result of ordinary skill and common sense rather than innovation

This made it too obvious

Enablement

§112 Enablement (disclosure).

specification must enable PHOSITA (person having ordinary skill in art) to make/use invention

bargain vis-à-vis trade secret

claims must correspond to disclosure (Lamp case)

must be done correctly in original appl'n (i.e., no 'new matter' in amendments)

must disclose 'best mode' known to inventor for carrying out invention

Infringement

A patent holder can seek to establish patent infringement by:

literally infringed

doctrine of equivalents {i.e., “show presence of every element or its subs'tl equivalent in accused device”}

A person may be liable for infringement if they: (1) directly infringe a patent; (2) induce another to infringe a patent; (3) contribute to infringement; (4) import, sell, offer to sell, or use a product made through a protected process; or (5) manufacture or sell certain components of a patented invention to be assembled abroad.

Literal Infringement D's process or product must have every element set forth in the claim

Compare the claims of the patent to the accused product

If D's matter contains only some of the elements, it is not infringement

If D's matter has all of the elements plus more, D is liable for infringement (BUT may be able to get an improvement patent)

Case Law

Larami Corp. v. Amron

Background

Larami made “Super Soakers”

TTMP is suing them for infringement, when 7 of the 35 claims on their patent for a watergun are being used by Larami

Rule

London v. Carson Pirie Scott & Co.

“A patent holder can seek to establish patent infringement in either of two ways

(a) is literally infringed or

(b) Is infringed under the doctrine of equivalents”

If something is not an exact duplicate or close to it, it will not encompass literal infringement or under the Doctrine of Equivalents.

Doctrine of Equivalents. “if it performs substantially the same function in substantially the same way to obtain the same result.”

Doctrine of Equivalents prevents a defendant from avoiding liability through insubstantial changes that take a device or process outside the literal language of the patent claims.

Infringement occurs if it is determined that the defendant's device or process contains an element that corresponds (either identical or equivalent) to each element described in the patent claim.

Equivalency is an objective determination made on an element-by-element basis from the perspective of a person with ordinary skill in the art as of the time of the infringement.

Four Limitations:

prosecution history estoppel. if you amend claims during prosecution, and surrender a ground, then you cannot reclaim such ground through the doctrine. i.e., “file-wrapper estoppel” (estopped from claiming infringement suit later if it literally infringes on earlier claim)

prior art restriction. cannot use doctrine to encompass matter in prior art. (e.g., wood in prior art)

public dedication doctrine. that which is described in specification of patent, but not expressly claimed, then its assumed dedicated to public domain.

all-elements rule. must be equivalent to all elements in claim. that is, cannot say “whole invention is my invention,” rather doctrine only allows to substitute chunks out of your claim.

Defenses

i. Laches.

Equivalent to s/l, but more flexible, in that if wait too long lose right.

versus estoppel, which requires reliance.

ii. Shop Rights.

E’ee invents using E’or shop (e.g., tools), absent express K to contrary, inventor (e’ee) gets patent right to invention, but e’or has shop rights to use invention in their business.

iii. The “Experimental Use” Defense.

Case law indicates you can practice invention if purely for philosophical inquiry, but not okay if done in connection to make money. Incredibly tiny defense.

City of Elizabeth v. Pavement Co. (Experimental Use Exception)

Background

Pavement Company invented a new and improved pavement, and to test it, they laid it down in a city

The pavement was in the process of being patented

The issue is once again whether or not this is public use

Rule

When a machine/technology is in experimental use, the public can incidentally receive

a benefit from it without it constituting public use

When no one is allowed to use a machine/technology such as this, and it is not being sold, it is not public use

Pavement won

iv. First-Inventor Defense.

Applies only to business methods.

v. Patent Misuse. (i.e., abuse patent)

E.g., attempting to make patent monopoly into more than were granted under the law.

Ownership

Duration

20 years from the date of application
previously, 17 years from date of issue

Ownership

absent pre-issuance K (e.g., employ't agrmt), patents are owned by inventor(s)
multiple inventors results in tenants-in-common, each owning an undivided interest in whole
each joint owner may exploit patent w/o permission of or acct'g to any other joint owner (i.e.,
permission of one owner is complete defense) (versus copyright law, in which may exploit, but
must share profits) (versus trademark law, no co-owners)

each and every owner must consent to bringing any infringement action

Remedies

reasonable royalties

lost profits: principal of lost profits, but in no instances should a patentee get less than a reasonable royalty

To get lost profits must show: (1) demand for the good, (2) that there are non-infringing substitutes for the good, (3) market share, and (4) components of profit

injunction

Prosecution

Prosecution defect that can invalidate patents is inequitable conduct (e.g., failure to disclose relevant prior art during prosecution invalidate patent if proved in litigation)

DESIGN PATENT

35 USC sect. 171-173, with 102, 103, 112, and other sections applicable as well

Enabling statute: 35 USC 171 Patents for designs: "Whoever invents any new, original, and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title. The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided."

Requirements:

Ornamental (not dictated by function)

Novelty

Non-obviousness

On a functional article

Enabling disclosure

Statutory bars apply

Term: 14 years from issuance

Can include:

Configuration/shape of article

Surface ornamentation

Combination of shape and surface ornamentation

I.e. fonts and computer icons

Not per se excluded from overlapping TM protection: Can get TM and design patents at the same time if it is the right thing (i.e. can get a design patent for 20 years and then establish a secondary meaning in order to get a TM)

PLANT PATENT

Asexually produced strain

Plant Patent Act (1930).

Requirements: 1] Subject Matter: {1) asexually produced (grafting); and 2) plant (macro fungi, but not bacteria)} 2] Distinct. 3] New.

Can be invented or discovered if discovered in cultivated area

Covers entire plant (BUT, not infringement to sell fruit, flowers, seeds)

Administered through USPTO

Infringement:

Sports are non-infringing of parent patent and potentially separately patentable

Infringing plant must be vegetative descendant of patented plant.

Duration: 20-yr term from filing of application

PLANT VARIETY PROTECTION

Sexually produced variety

Plant Variety Production Act (1970). (Ag Section)

Requirements: 1] Subject Matter: {1) sexually producing; and 2) plant (not bacteria, fungi)}. 2] New. 3] Distinct. 4] Uniform. 5] Stable

Covers first-generation hybrids

Comparison to Patents.

Administered through USDA, not PTO

Protects against creation of derivative plant lines

Allows farmers to save and plant seeds (but seed sales are infringement)

Research exemption allows use for breeding to develop new variety

Duration: 20-yr generally, 25-yr for tree and vines.

MASK WORK PROTECTION

Semiconductor Chip Protection Act (1984)

17 USC sect. 901-904

Protects original mask works for making semi-conductor chips

A mask work is a 2- or 3- dimensional layout of an integrated circuit on a semiconductor chip

Must be registered with the Copyright Office for protection to commence

Duration of protection is 10 years

Computer chips made by special lithographic process

VESSEL HULL PROTECTION

17 USC sect. 1301-1332

Requirements

Subject matter: vessel-hull designs

Must be embodied in an actual vessel hull (no protection for designs existing only in models, drawings, or representations)

Staple or commonplace designs cannot be protected

Must be registered with the Copyright Office for protection to commence

Made-public bar: An application for registration must be filed no later than 2 years after the hull was publicly exhibited, or distributed or offered to the public for sale with the design owner's consent

Duration of protection is 10 years

Only 396 have been registered

Another boat manufacturer cannot buy one of your boats, create a mold, and use it to make new hulls identical to yours

TRADEMARK

Serves as an identifier of source

Actions

Passing/passing off

Reverse passing off - no credit given

Dilution

Subject Matter

Names, symbols, logos, slogans, phrases, 'trade dress', certifications, collective marks, product configuration/design

Color, Fragrance, Sounds

Qualitex Co. v. Jacobson Products Co.: Dry-cleaning press pads w/ distinctive green-gold color. Ct held this was protectible, but only upon showing of secondary meaning. Color over time could signify a brand.

Functionality prevents odor and taste from being trademark

Unless its for something that doesn't require odor for functionality, bubblegum scent for industrial lubricant

Trade Dress

Two Pesos v. Taco Cabana: P sought trade dress protection for colorful Mexican restaurants.

Ct holds this protectible trade dress b/c it is inherently distinctive

If trade dress is inherently distinctive, trade dress will be protected

If the trade dress is descriptive, must look for secondary meaning for protection

Wal-Mart Stores v. Samara Bros: Product design (i.e. children's clothes) can only be protected if it has secondary meaning

Distinctiveness

Fanciful: something made up that didn't exist before (i.e. Exxon)

Arbitrary: marks that have existence in the real world but nothing to do with product (i.e. Apple Computers)

Suggestive: marks that suggest something about the product (i.e. Coppertone sun tan lotion)

Merely descriptive: makes that suggest something about the product (i.e. Joe's Crab Shack). NOTE: Can only be TM if the name has acquired secondary meaning

Generic (NO TM): works that are standard (i.e. car, computer)

Priority and ownership

Priority: First to use in commerce wins

Authorship irrelevant

Only one owner per trademark (SOURCE)

To Establish Rights: Must Use In Commerce!

Questions to ask in a priority dispute

Use: Did he make use of the TM in commerce (or register w/ intent to use in commerce)?

Where did he use the mark?

Priority is measured with respect to a given geographical market

If mark is registered, you get nationwide protection except where people are already using the mark (i.e. UND logo and Notre Dame logo)

In what products and/or in what goods?

TMs do not extend to the universe of all goods, but rather to goods you are going to sell

NO confusion if the marks are in different categories

Zazu Hair Designs v. L'Oreal: L'Oreal was sued for using a mark for its hair products that was already used by a hair salon. L'Oreal won on the grounds that the mark was not in extensive use. Today with an intent to use standard, L'Oreal would have lost.

How similar are the marks?

Is there inherent or acquired distinctiveness?

Prosecution and registration

Categories

Trademark

Service mark

Certification mark: a mark where someone is certifying other people's goods and services

Collective mark: a mark that means that you belong to a certain organization or certain collective

Principal (all the rights from registration) and secondary register (pretty much useless)

Intent-to-use: Reserve, commence use within 6 months or file for extensions

Incontestability: If you register your mark, and continue to have it for 5 years, eventually people cannot contest the mark

Park N Fly v. Dollar Park and Fly

Rule: All an incontestable status gives a TM holder is the right to be protected from challenges on the grounds that the mark lacks secondary meaning.

Infringement

Trademark Use

1-800 Contacts v. WhenU.com

Background

WhenU used proprietary software to create pop-ups advertising 1-800 Contacts' competitors when people were visiting their website
1-800 in alleging that this was infringing on their trademarks by including 1-800's website address (which is similar to the trademark) in their software

Rule

Including a website address that is nearly identical to a trademark in an unpublished directory does not trigger trademark infringement
Neither does causing popup ads to appear

Likelihood of Confusion (Test from Sect. 43 (a) of the Lanham Act)

Source Confusion: confusion as to the source of the product

Relationship/Affiliation Confusion: confusion about the relationship of D to P's goods

Post-Sale Confusion: people making a negative association with the product after the sale

Initial Interest Confusion: the TM makes consumers lured to a particular place/product

Reverse Confusion: small TM owners infringed upon by big companies. Is actionable if P can show that D adopted the same TM in the same good.

AMF Incorporated v. Sleekcraft Boats: Ct issued 8 factor test and concluded that, given that the markets overlap, there was likelihood of confusion even if there was no evidence of actual confusion. **8 Factor Test:**

Strength of the mark: Where is the mark on the inherent distinctiveness scale? Is there secondary meaning?

Similarity of the mark: Total commercial impression, evaluated w/ sight, sound, and meaning
Type of goods

If the marks are identical and the goods are very similar, then there is infringement

If the marks are identical and the goods are unrelated, there is no infringement

If it's in the middle, must do other elements of the test

Proximity of the goods

Marketing channels used: How are goods sold? Will the way they are sold make it more/less likely that consumers will be confused?

D's intent in selecting the mark: If there is an intent to deceive, this is a powerful factor in favor of finding infringement.

Likelihood of expansion of product lines: How likely are these marks to come into conflict w/ one another in the future?

Evidence of actual confusion

Dilution

Famous marks (prerequisite): The mark must be famous to come under the dilution statute

Factor test: (1) degree of inherent or acquired distinctiveness, (2) duration and extent of use of the mark in connection with the goods or services with which the mark is used, (3) duration and extent of publicity and advertising of the mark, (4) geographical extent of the trading area in which the mark is used, (5) channels of trade for the goods or services with which the mark is used, (6) degree of recognition of the mark in the trading

areas and channels of trade used by the mark's owner and the person against whom injunction is sought, (7) nature and extent of use of the same or similar marks by 3rd parties

Injury

Tarnishment: Creating a negative association with a product

Blurring: loss of uniqueness or distinctiveness

Nabisco v. PF Brands: Another company wants to introduce crackers in the shape of fish. P sues a dilution/tarnishment theory. Ct holds that the product configuration is distinctive and that the junior use will dilute.

Pepperidge Farm Goldfish v. Nabisco CatDog fish-shaped crackers

There is a danger of post-sale confusion

Cyber-squatting: If I grab your TM as a domain name, this is dilution in circumstances where the mark is famous. NOTE: The statute requires "commercial use in context", and if the website is not used (but merely reserved), cybersquatting should not come under dilution law.

Five necessary elements to a claim of dilution

Senior mark must be famous

Must be distinctive

Junior must be a commercial use in commerce

It must begin after the senior mark has become famous

Must only show dilution, very easy to get at

Defenses

Fair use:

A junior user of the term is not liable for infringement of an established mark if the mark is being used in its descriptive sense

The fair use defense is available vis-à-vis descriptive TMs w/p secondary meaning as long as there is no consumer confusion

Laches: equitable version of SoL

License: consented to allow me to use the trademark

Improper licensing: Trademark is an indication of course so if you blanket someone to use your TM, you will lose it. Licensor must have control of the quality of the product.

RULE: IF you license your TM to someone else, you must police their use of the mark to ensure that they are making products that retain characteristics and quality the public has come to associate with the mark

Dawn Donut v. Hart's Food Stores: Allegation of abandoned TM due to inadequate quality control/supervision on part of licensee.

Abandonment: Sect. 45 of Lanham Act. If you stop using a trademark, it is not longer yours as a trademark.

Abandonment under the Lanham Act requires both non-use and intent not to resume use presumptive abandonment after 3 years

Functionality: Functional trade dress is not protectible under TM

What is functional? Any attribute that is essential to the function of the product or that is related to price or quality

TrafFix Devices v. Marketing Displays: A wind-spring system for traffic signs is not protected by TM b/c it is functional.

Genericide: When a term refers to a general class of products, it is deemed "generic" and cannot serve as a TM

2 ways a TM can become generic:

- they were born that way and refused registration b/c they are generic
- they become generic over time through "genericide"

Murphy Bed Co. v. Interior Sleep System: Murphy Bed is a generic term b/c the mark has entered the public domain

RULE: The consumer rules. If the consumer is using the term generically, it is generic

Related Cases

Mattel v. MCA

Background

Aqua made the "Barbie Girl" song

In this song they spoke of being blonde and stupid and whatnot

Mattel is suing, claiming that there will be a likelihood for confusion

Rule

LL Bean

"Trademark rights do not entitle the owner to quash an unauthorized use of the mark by another who is communicating ideas or expressing their Point of View."

Rogers" v. Grimaldi

Titles are not Trademark infringement unless it misleads the source of the work

If you do a parody, that does not try to make up any claims about the subject being parodied, there is no trademark infringement

Lindy v. Bic Pen

Background

Lindy was making pens, they were in the process of getting the word "Auditors" trademarked, and Bic started using it, Lindy contacted them and Bic sopped

14 years later, Bic adopted the legend "Auditors Fine Print" to describe a certain model

Lindy sued for trademark infringement, unfair competition, breach of contract, and trademark dilution

Rule

If one proves trademark infringement, they still have to prove that it led to damages

If one cannot prove damages, they will not be awarded any

In a nutshell, the court said, "Lindy, no one cares about you, and Bic using your pen, while infringing, cost you no money"

Big O

Background

Big O is making "Big O Big Foot" which they have a trademark on

Goodyear announced they were selling their own tires with the title "Big Foot" on them

Big O contacted them, Goodyear spent millions advertising and marketing on it anyway

Big O sued

Rule

There is nothing really to get out of this case. Big O won, Goodyear had to give them the amount of money needed to reverse the advertising that

Goodyear did, and they were awarded punitive damages since Goodyear infringed on the copyright knowingly

Remedies

Injunction: You are entitled to an injunction, not damages.

Damages (Limited to cases where D acted willfully - point is to deter the D)

Under Lanham Act, P can recover (1) D's profits; (2) any actual damage sustained by P; and (3) the costs of the action

Infringer's Gain and Mark Owner's Loss: *Lindy Pen v. Bic Pen*

Corrective Advertising: *Big O Tire Dealers*: The ct orders 25% of the money spent on infringing advertising to be spend on corrective advertising to correct the consumer confusion.

Non-trademark/nominative use, parody, 1st Amend.

Non-Trademark/Nominative Use: Descriptive use of the TM is ok. The nominative fair use defense applies when D uses a TM to refer to the P's product. If the use of the trademark is non-deceptive, it is acceptable.

Parody: Non-commercial parody use of a TM is protected free speech. BUT if the parody does not convey the message that its a parody (making consumers think it is the real thing), then it is vulnerable under TM law to dilution.

Mattel v. MCA Records

DOMAIN NAMES AND CYBERSQUATING

"Cybersquatting." the bad faith, abusive registration and use of distinctive trademarks of others as Internet domain names, w/ intent to profit from goodwill of trademarks.

Anticybersquatting Consumer Protection Act. ACPA. illegal to register or use domain name that corresponds to trademark where the domain name registrant has no legitimate interest in using the name and acts in bad faith to deprive trademark owner of the use of the name.

Shields v. Zuccarini

Background

Shields is a graphic artist who has a popular website, joecartoons.com

Zuccarini was a wholesaler of domain names, and got 5 world wide variations:

Joescartoon.com, joecartoon.com, joescartons.com, joescartoons.com, and cartoonjoe.com

They were "mousetrapped" sites which meant that when you went there, you had to close a lot of popup advertisements

Shields is suing

Rule

To prove an ACPA (Anticybersquatting Consumer Protection Act) claim, Shields had to prove that

1 "Joe Cartoon" is a distinctive or famous mark entitled to protection

2 That Zuc's domain names were "identical or confusingly similar"

3 Zuc registered the domain names with bad faith intent to profit from them

Shields won

If it's blatant bad faith, it's a violation

PETA v. Doughney

Background

PETA had Peta.com

Defendant registered peta.org, which he entitled "People Eating Tasty Animals" as a parody of PETA

Rule

If a domain name is made purposely to confuse Internet users from accessing another's website, it is in bad faith, and is a violation of ACPA

GEOGRAPHICAL DESIGNATIONS OF ORIGIN

allows monopoly for appellations of geographic origin; monopoly inures to place (not firm, as w/ TM) e.g., Champagne (a.k.a. sparkling wine).

might be protected in U.S. as collective mark or certification mark, if not generic.

RIGHT OF PUBLICITY

Applicable when someone's name or image is used in a commercial context w/o consent

RULE: An individual has the right to control his/her name/likeness in a commercial context. The right is violated by unauthorized exploitation of likeness for commercial purposes.

What is protected? Name, picture, voice, context

Midler v. Ford

Background

In a campaign, Ford got someone who sounded like Bette Midler to sing a Bette Midler song

Bette Midler sued

Rule

Using a sound-alike to give the impression that it is someone else singing, is actionable and protected from appropriation

Elements

Commercial Context

Identity used via an identifiable likeness

Limitations: 1st Amend. concerns

Protects an individual's marketable image or persona.... It affords a property-type interest in the use of their name, likeness, photograph, portrait, voice, and other personal characteristics in connection w/ marketing of products and services.

1st Caveat: use in book, newspaper, magazine, topical tv show is okay b/c protected by 1st Amendment, but beyond that, such as merchandising photo on tee-shirt is violation of publicity.

2nd Caveat: use in adv'g is violation unless adv'g something that is not right of publicity violation. e.g., cannot put Micheal Vick image on billboard to adv'g dog food, but adv'g dvd is okay

Bottom Line: Law is fuzzy, but has effect of shying people away from violation. i.e., footprint of law is bigger than the law itself.

MISAPPROPRIATION

International News Service v. Associated Press: P sued D for taking P's new reporting and selling it

as D's own. Ct found D guilty of the tort of misappropriation.

Elements

P generates or gathers information *at a cost*

The information is *time sensitive*

A D;s use of the info constitutes *free riding* on the P's efforts

The D is in *direct competition* with a produce or service offered by P

The ability of other parties to free ride on the efforts of P or others would *so reduce the incentive to produce the product* that its existence or quality would be substantially threatened

[i.e., passing off, yet called misappropriation, or "HOT NEWS].

Note: misappropriation doctrine does not have continuing validity b/c it is now common to credit sources (e.g., if credit its ok, otherwise 'passing off', BUT: as to sports-casting, it is misappropriation to radio play-by-play of game, but it is ok to announce 'scores,' etc.

CONTRACT AND IDEA SUBMISSION

Nadel v. Play by Play Toys

Background

Nadel had a toy idea and told Wasserman, an executive for a toy manufacturer

Wasserman used an idea of Nadel's and did not ask him for any permission and did not compensate him at all

Rule

If an idea is not original, damages cannot be awarded upon the idea being stolen

An idea is original, if it is novel to the person who stole the idea

This is an issue of material fact

FEDERAL PREEMPTION

The 1976 Copyright Act includes a federal preemption of state common law, which did not exist in the 1909 Act.

17 U.S.C. § 301(a) On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.

Bonito Boats v. Thunder Craft Boats

In 1976, a Florida company created a hull design, no federal patent application was ever filed for either the design aspects of the hull or the manufacturing process.

In 1984, the company brought an action for an injunction, accounting of profits, damages, and attorney's fees, under a Florida statute against a Tennessee company in the Circuit Court of Florida.

The Circuit Court dismissed the complaint, on the ground that the Florida statute conflicted with the federal patent law and was therefore invalid.

The US Supreme Court affirmed. The unanimous view of the court held that under the Federal Constitution's supremacy clause, the operation of the federal patent system preempted the state law.

ProCD, Inc. v. Zeidenberg

Background

Appellant sells software, which includes a shrink-wrap license

Appellee ignored the license and the Appellant is suing

Rule

If a license is in shrink wrap, it's still valid

INTERNATIONAL ASPECTS

PATENTS

Territoriality

Internationally in order for a patent to be valid one must get the patent in that jurisdiction.

FOREIGN FILING LICENSES:

Invention Secrecy Act:

In the US one must get a foreign filing license to get an "International Patent" from USPTO.

This stems from a national security concern.

The Gov must allow you to get a license, ostensibly to keep secret info out of the hands of undesirable countries.

If the PTO denies the license then the inventor can seek compensation.

A US Patent Application is deemed to include an application for a foreign filing license.

THE PARIS CONVENTION of 1884:

Has 173 signatories compared to the 193 currently recognized sovereign countries.

Requires its members to give each other National Treatment.

There had been a Foreign Dependence implemented against foreign inventors prior to this treaty. The Treaty requires an independence of patents for its signatories

A question to consider with regard to National Treatment or IP enforcement, To what extent do "reprisals" play a part in a State's motivation for compliance?

NATIONAL TREATMENT: treat foreign inventors as you would your own domestic inventors. Eg: same patent length and no extra fees.

INDEPENDENCE OF PATENTS: if a patent expires in one country it means nothing in the other countries. The victories or defeats in one country have no effect on the validity of the patent in other countries.

FOREIGN DEPENDENCE: Any foreign patent was invalid or expired the domestic one was as well.

INTERNATIONAL PRIORITY:

If a Patent application is filled in any signatory State, all subsequent applications in other signatories within one year are given priority back to the first-country filing date.

However, in the US if the product is offered for sale more than 1 year prior to patent application – it is not viable

The most ground gained internationally is in the Procedural aspects of IP

THE PATENT COOPERATION TREATY:

139 signatories

It deals with Procedural Aspects of obtaining a Patent

It Provides a Partially Internationalized process: One international application begins the process in all signatories

Essentially the PCT starts the process in all the countries, giving it the initial filing date across the board, but not really useful otherwise

CHAPTER ONE PROCEEDINGS: The applicant gets an international search report and a non binding preliminary report on patentability

CHAPTER TWO PROCEEDINGS:

Used by those who received an unfavorable report in Chapter 1.

The applicant can make amendments and communicate with examiner before obtaining the 2nd report, but it is still not a binding decision.

EUROPEAN PATENT CONVENTION:

Single European Patent office can make decision for all 34 European Patents – but you get 34 different patents.

It also consolidates the prosecution and filing process, however Independence still applies this is simply to eliminate the need to file separately in 34 countries.

TRIPS:

Came out of GATT, the precursor to World Trade Organization, meeting in Uruguay in 1994.

Covers Multiple forms of IP

TRIPS is required for WTO members

153 WTO members

creates national min. standard obligations for national patent laws

MINIMUM STANDARDS:

There is a 20 year term from filing date, this is the min term.

Applicants must provide an enabling disclosure

Subject Matter: all fields of tech provided it is new, have an inventive step (non-obvious), and are capable of industrial application

Exceptions – Macro organisms like trees, certain methods of medical treatment, and immoral inventions

Must have Judicial Review

Enforce TRIPS through World Intellectual Organization

Compulsory license must be revocable. No room for adjustment in TRIPS, it is what it is

COPYRIGHT

THE BERNE CONVENTION: Berne revised 6 times most recent: 1971 in Paris.

The Convention is Euro-Centric. The US joined in '89.

Subject matter protected: Architecture (US got around to it eventually), compilations and derivatives, moral rights are included

In the US remedies for moral rights can generally be found in contract or tort law - such as unfair competition.

Doesn't include "news of the day" or facts

Precludes formalities – like notice

Min term: life + 50 yrs, 50 for anonymous works

Retroactive protection of foreign copyright

TRADEMARK:

PARIS CONVENTION: (same as patent) mostly procedural but priority period is 6 months instead of

1 year. US is a signatory

TRADEMARK LAW TREATY:

Harmonizes and simplifies application requirements

US is a signatory

MADRID AGREEMENT:

Effectively an "International Trademark" because registration provides automatic protection in all signatories

Allows Central Attack: provision permits an international application for registration to be canceled, within five years of filing, if the national registration upon which it is based was canceled.

Use is not a requirement

Because of these two provisions the US not a signatory

MADRID PROTOCOL:

got rid of those two provisions, then the US signed

Under the Madrid Protocol, however, a modified central attack provision now permits the trademark applicant to reapply in each designated foreign country while retaining the priority date of the original international application. This modification to the central attack provision was paramount in convincing the United States to finally become a signatory to the Protocol.

Effective in US in Nov. 2003

NOT RECOGNIZED IN THE US:

Database rights

Geographical Indications

GEO INDICATION:

Allows a monopoly for appellations of geographic origin

Monopoly privileges inure to a place, not a firm as with TM

Examples:

Champagne (Sparkling Wine)

Parmesan cheese

Might be protected in the US as collective marks or certification marks, if not currently generic