Fundamentals of United States Intellectual Property Law

Copyright, Patent, and Trademark

FOURTH EDITION

SHELDON W. HALPERN, SEAN B. SEYMORE & KENNETH L. PORT

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To Dorit and Miki
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To Terone
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To Elissa, Emily, and Paula
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Preface

This book is designed to provide a detailed exposition of the United States laws concerning copyright, patent, and trademark. It offers a thorough analysis of this body of intellectual property law which, we believe, will prove useful to the student, the scholar, and the practitioner. Our aim was neither to supplant the existing compendious treatises in these areas nor to provide a simple introductory handbook. Rather, we have attempted to present and to develop, with appropriate authority, the fundamental concepts essential to an understanding of the law in each of the three fields covered.

Similarly, we have attempted to avoid an all-embracing approach to "intellectual property." While that phrase is used to cover a wide array of activities, it is fundamentally flawed; it both embraces too much and conveys too little information. Our focus, rather, is on the law in the United States of copyright, patent, and trademark, each of which may be considered part of this rather shapeless umbrella. We have chosen to exclude for these purposes the disparate areas of protection of ideas, trade secrets, and the right of publicity, which, although partaking of the flavor of "intellectual property" are the subject of more diffuse common law and state law development.

Copyright, patent, and trademark each are very distinct bodies of law. Their joinder under the rubric of "intellectual property" serves a useful purpose in distinguishing them as a body from other areas of law; it does not, however, support broad generalization about fundamental commonality.

For example, Congressional power to act with respect to copyright and patent is embedded in Article I of the Constitution, an explicit recognition by the founders of the need for the emerging republic to have a single, federal structure governing the nature and scope of copyright protection for the "writings" of "authors" and of patent protection for the "discoveries" of "inventors."[1] Trademark law is inherently different, both in its scope and in its foundation, as Congress' constitutional authority to regulate trademarks derives from its more general power to act with respect to matters affecting interstate commerce. This is why "use" of a trademark in interstate commerce, rather than simply creation of the mark, is essential for federal protection. Indeed, unlike copyright and patent, trademark protection is ultimately a common law concept that

1. U.S. Const., art. I, § 8, cl. 8.

exists independent of any statute. The Supreme Court has reasoned that trademarks do not "depend upon novelty, invention, discovery, or any work of the brain. It requires no fancy or imagination, no genius, no laborious thought. Trademarks are simply founded on priority of appropriation."[2]

Copyright, on the other hand, requires, at bottom, an act of original authorship, crossing a threshold, however minimal, of creativity. Indeed, the Supreme Court has held that such originality and creativity is a constitutional prerequisite to protection.[3] Patent law, for its part, is distinct in being predicated on novelty of invention; originality and creativity themselves are not sufficient if the product of the creative process lacks novelty. In each case—copyright, patent, and trademark—we have attempted to build upon the forces underlying the legal construct to create a coherent and understandable description of the legal principles and the way in which they have been applied.

Much of the law here is counter-intuitive. Much is based upon the need to reconcile conflicting interests—political, economic, and social—and the inevitable compromises may not be consistent with any single, unifying theory or "natural" development. That is the source both of the joy and the pain in dealing with the difficult and absorbing legal issues that characterize these fields of study. We hope that we can, with this volume, ease that pain and share that joy.

This Fourth Edition not only brings up to date the developments in the areas of copyright, patent and trademark since publication of the Third Edition in 2010, but it also provides a comprehensive understanding of the newly enacted United States patent law revision, the America Invents Act of 2011.

This book grew out of a companion study which the authors undertook for Kluwer Law International in connection with Kluwer's International Encyclopaedia of Intellectual Property, and we would like to thank Kluwer for supporting this project.

Sheldon W. Halpern
Sean B. Seymore
Kenneth L. Port
July, 2012

2. The Trademark Cases, 100 U.S. 82, 94 (1879).
3. *Feist Publications, Inc. v. Rural Telephone Service*, 499 U.S. 340, 111 S. Ct. 1282 (1991).

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