

COPYRIGHT LAW SYMPOSIUM

Number Thirty-Nine

NATHAN BURKAN
MEMORIAL COMPETITION

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Foreword

THE NATHAN BURKAN Memorial Competition continues to pursue its estimable goal of promoting the development and understanding of legal issues in copyright law.

The 1989 National First Prize was awarded to Gregory J. Wrenn of the University of California School of Law at Berkeley for his article "Federal Intellectual Property Protection for Computer Software Audiovisual Look and Feel: The Lanham, Copyright, and Patent Acts." As a preliminary matter, Mr. Wrenn defines the look and feel doctrine and explains how it relates to computer software. Next, he surveys three federal statutes and describes the means and scope of protection of each to the look and feel of computer software. Finally, he proposes that the courts' application of "competitive analysis" would facilitate administration of these statutes consistent with their underlying purpose of rewarding innovation without unduly hindering competition.

Michael Kremen of Rutgers State University of New Jersey School of Law at Newark was awarded the National Second Prize for his article "The Harms-Jem Case: One Court's Attempt to Reconcile the Compulsory Licensing Provision with the 1976 Copyright Act's Expanded Importation Protection." This essay is critical of the decision in *T. B. Harms, Co. v. Jem Records*, in which the United States District Court for New Jersey held that defendant's recording, while subject to compulsory licensing, was nevertheless infringing under the importation clause. Mr. Kremen sets forth case law and

legislative history that the court failed to address but that, he believes, would have supported and strengthened its decision.

Carol Motyka, also of Rutgers Law School at Newark, was awarded the National Third Prize for her article "U.S. Participation in the Berne Convention and High Technology." The author addresses the impact of the United States' participation in the Berne Convention for the Protection of Literary and Artistic Works on the copyright protection accorded computer programs and databases originating in the United States. The author traces the background of the Convention, analyzes and evaluates United States adherence, and ultimately concludes that the Convention will result in few short-term benefits to American innovators.

The National Fourth Prize was awarded to Richard P. Stitt of the University of Missouri School of Law at Kansas City for his article "Copyright Self-Help Protection as Copyright Misuse: Finally, the Other Shoe Drops." Misuse of an intellectual property grant arises when the grantee seeks to enlarge upon his statutorily conferred rights. The author compares and contrasts the defense of misuse in the patent and copyright areas, noting that the courts' standard of anticompetitive effect on the marketplace for patent misuse is innappropriate for copyright misuse because of the differing nature of the protection accorded each. Mr. Stitt demonstrates misuse through examples of copyright owners' self-protective conduct and argues in favor of allowing the misuse defense.¹

Finally, the National Fifth Prize was awarded to Deborah A. Hartnett of New York Law School for her article "A New Era for Copyright Law: Reconstituting the Fair Use Doctrine." Ms. Hartnett discusses the background of the fair use doctrine, analyzes three notable cases where the defense was raised, and proposes refashioning the doctrine with greater emphasis on first amendment principles.

¹ The copyright misuse defense was subsequently upheld in *Lasercomb America, Inc. v. Reynolds*, 911 F.2d 970, 972-77 (4th Cir. 1990).

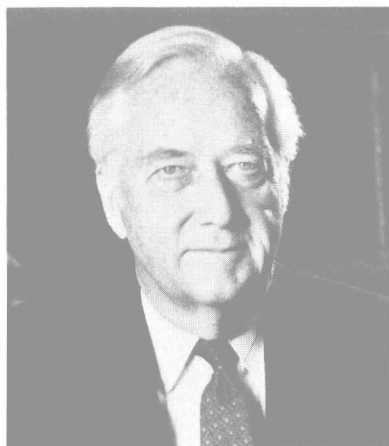
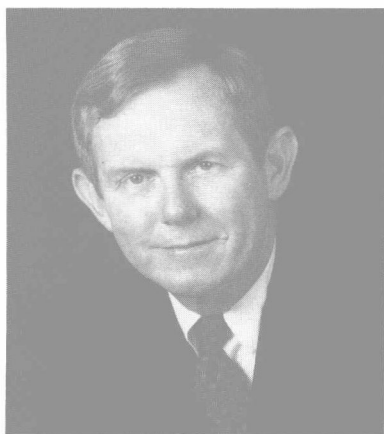
We commend the 1989 National Award winners for their excellent work.

HERMAN FINKELSTEIN
DIRECTOR EMERITUS
NATHAN BURKAN MEMORIAL COMPETITION

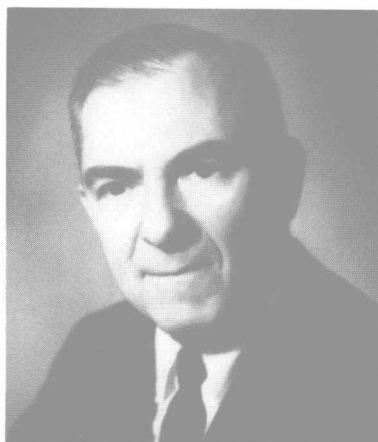
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CHARLES Mc.C. MATHIAS



HERMAN FINKELSTEIN

Preface

SINCE IT BEGAN in 1938, National Prizes in the Nathan Burkan Memorial Competition have been awarded by outstanding legal scholars who give unstintingly of their time to perform the difficult task of choosing only five winners from one hundred or more essays awarded prizes at law schools across the United States.

The 1989 National Award winners were selected by a panel of three distinguished leaders in the field of copyright law: the late Herman Finkelstein, Director Emeritus of the Competition and retired General Counsel of ASCAP; former Senator Charles Mc.C. Mathias; and Ralph Oman, the Register of Copyrights.

We at ASCAP who knew him well were very pleased that the 1989 National Award panel included Herman Finkelstein, whose passing on May 20, 1990, was a great loss to the Competition and to ASCAP. Mr. Finkelstein received his B.A. from Clark University and his LL.B. from Yale Law School. He served as the first law clerk to Judges Learned Hand and Thomas Swan of the United States Court of Appeals for the Second Circuit. He was associated with Nathan Burkan, ASCAP's first Counsel, until Burkan's death in 1936. In 1941, he negotiated the agreement with the radio industry ending the 1940-41 radio boycott of ASCAP music. In 1942, he left private practice to establish the Society's Legal Department. He retired as ASCAP's General Counsel in 1973. For more than 50 years, Herman Finkelstein was an active leader in the development of copyright law both nationally and interna-

tionally. As a scholar and as an advocate, Mr. Finkelstein made enormous contributions to the development of copyright law and to the protection of authors' rights.

Charles McCurdy Mathias, Jr., a partner in the international law firm of Jones, Day, Reavis & Pogue, served in the Congress for nearly 30 years. He served four terms in the House of Representatives, and was then elected to the Senate in 1968 where he served until 1987 when he retired. In the Senate he was Chairman of the Judiciary Committee's Subcommittee on Patents, Copyrights and Trademarks and was widely recognized as an expert in copyright matters. He attended Haverford College in 1940 and enlisted in the United States Coast Guard in 1942. Senator Mathias completed his undergraduate requirements at Yale and was graduated from the University of Maryland Law School in 1949. He practiced law in Frederick, Maryland, served as an Assistant Attorney General and as City Attorney of Frederick and in the General Assembly of Maryland. Among his many activities, Senator Mathias is Chairman of the American Council on Germany and the American Committee on the French Revolution; he is also a director of the Council on Foreign Relations. He has been awarded numerous honorary degrees and awards by colleges, universities, and several foreign nations.

Ralph Oman has been the Register since 1985. Mr. Oman received his B.A. degree in history from Hamilton College in 1962 and was graduated from Georgetown University with a Doctor of Laws degree in 1973. Following law school, Mr. Oman served as law clerk to the Honorable C. Stanley Blair of the United States District Court in Baltimore, Maryland. Mr. Oman also served as an attorney in the Antitrust Division of the Department of Justice and saw five years of active duty in the Navy. Before becoming the Register of Copyrights, Mr. Oman was Chief Counsel for the Senate Subcommittee on Patents, Copyrights and Trademarks, chaired by Senator Mathias. In that position he participated in overseeing various aspects of

the Copyright Office, the Patent and Trademark Office, and the Copyright Royalty Tribunal.

The students whose essays were judged in the 1989 Competition were fortunate to have had their papers read by these three copyright experts. It is with great pleasure that the American Society of Composers, Authors and Publishers, its Board of Directors and management express their appreciation to them.

BERNARD KORMAN

Rules Governing the Competition

1. *Participating Law Schools:* All accredited law schools are invited to participate in the Competition.
2. *Eligible Students:* Third-year students. In the discretion of the dean, second-year students may also be eligible, but such students who receive an award are not eligible for an additional award in their third year.
3. *Subject Matter:* Any phase of *Copyright Law*.
4. *Determination of Awards:* The prizes will be awarded to the students who shall, in the sole judgment of the dean—or such other person or committee as he may delegate—prepare the two best papers. The dean may in his discretion withhold the awards entirely, if in his opinion no worthy paper is submitted, or may award only the first or second prize. *Students are not eligible for more than one prize in any Competition.*
5. *Prizes:* A first prize of \$500 and a second prize of \$200 at each participating law school, to be paid through the dean, upon his written certification. Winning papers will be entered in the National Competition, in which the best papers will be considered for awards of \$3,000, \$2,000, \$1,500, \$1,000 and \$500 (see Rule 10, *infra*).
6. *Requirements as to length and form of manuscript:*
 - (a) Manuscript must be typewritten (double-spaced) on 8½ × 11" paper, 1" margin all around. All quotations exceeding four lines must be indented and single-spaced.
 - (b) Manuscript must not exceed 50 pages, including footnotes. No paper which exceeds this limit may receive an award; any paper received which exceeds this limit will be returned.
 - (c) Citations must be in approved law review form.
 - (d) Table of Contents (subject matter) must appear inside front cover.
 - (e) Three copies of manuscript must be submitted.

- (f) Cover for manuscript: any standard form stiff cover with label on outside showing title of paper, author's name, and permanent home address.
- 7. *Submission of papers and publication:*
 - (a) Winning papers will be forwarded in *triplicate* by the dean to the Society, which may authorize publication.
 - (b) Papers may appear in Law Reviews, provided their entry in the Nathan Burkan Memorial Competition is duly noted.
- 8. As papers are presumed to represent individual study, collaboration with others in their preparation (other than the usual law review supervision) is not permitted.
- 9. *Closing date:* June 15th—or any earlier date the dean may specify. Winning papers must be certified to the Society not later than June 30th.
- 10. *National Awards:* The five best papers selected by a National Awards Panel will receive awards of \$3,000, \$2,000, \$1,500, \$1,000 and \$500, respectively. Only papers which conform to these rules will be considered for a National Award. The award papers will be printed in the *ASCAP Copyright Law Symposium*.

ASCAP

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NATIONAL FIRST PRIZE

*Federal Intellectual Property Protection
for Computer Software Audiovisual
Look and Feel: The Lanham,
Copyright, and Patent Acts*

GREGORY J. WRENN*

BOALT HALL SCHOOL OF LAW,
UNIVERSITY OF CALIFORNIA, BERKELEY

SOFTWARE AUDIOVISUAL LOOK AND FEEL

THE JUDICIARY should brace itself for a surge of computer software-related litigation in the coming years. The Patent Office, once hostile toward patent claims involving software,¹

*ACKNOWLEDGMENT: The author would like to thank Professor Stephen R. Barnett for his many helpful comments on previous drafts. This comment was published in 4 HIGH. TECH. L. J. 279 (1989).

¹In 1966 the President's Commission on the Patent System recommended that computer programs per se be excluded from patent protection. This recommendation was based primarily on the Patent Office's inability to deal with the administrative burden of examining such claims. REPORT OF THE PRESIDENT'S COMMISSION ON THE PATENT SYSTEM, "TO PROMOTE THE PROGRESS OF . . . USEFUL ARTS" IN AN AGE OF EXPLODING TECHNOLOGY 14 (1966); see also, *Diamond v. Diehr*, 450 U.S. 175, 197 (1981) (Stevens, J., dissenting).

now commonly issues patents for software inventions.² As a result, “[t]he threat of [patent infringement] accusations is casting a pall over software development. . . . More companies are filing patents, and, most likely, will soon turn to litigation to guard them.”³

This imminent litigation is apt to involve the “look and feel”⁴ of computer software audiovisual displays,⁵ as well as legal theories of protection in addition to patent law. The means and scope of protection available for look and feel remains uncertain, yet the “stakes of this debate are enormous.”⁶

This comment reviews the means and scope of protection for computer software look and feel available from federal statutory sources: section 43(a) of the Lanham Act of 1946,⁷ the

²See Maier, *Software Protection—Integrating Patent, Copyright and Trade Secret Law*, 69 J. PAT. & TRADEMARK OFF. SOC’Y 151, 157 (1987). Although the Patent Office does not track software patents as a separate category, attorneys and industry executives claim that top U.S. companies have doubled, and even quadrupled, the number of applications they file. See Bulkeley, *Will Software Patents Cramp Creativity?* Wall St. J., March 14, 1989, at B1, col. 5. IBM alone files approximately two hundred software-related patents each year. *Id.*

³Bulkeley, *supra* note 2, at B1, col. 3.

⁴The second section, *infra*, defines and describes this subject matter in greater detail.

⁵See e.g., the following patents, which, if litigated, are likely to involve issues of computer software look and feel: U.S. Patent No. 4,823,108 issued April 18, 1989, to Gary W. Pope and assigned to Quarterdeck Office Systems for an “improved display system and memory architecture and method for displaying images in windows on a video display”; U.S. Patent No. Re. 32,632, issued March 29, 1988, to William D. Atkinson and assigned to Apple Computer, Inc., for a “display system” comprising pull-down menus used in conjunction with the Apple mouse; U.S. Patent No. 4,646,250 issued February 24, 1987, to John F. Childress and assigned to IBM for a “data entry screen for an interactive data entry system” that provides a means of identifying to the user fields where data may be entered and fields where data must be entered; U.S. Patent No. 4,486,857 issued December 4, 1984, to Paul C. Heckel and assigned to Quickview Partners for “display system for the suppression and regeneration of characters in a series of fields in a stored record.”

⁶Beutel, *Trade Dress Protection for the “Look and Feel” of Software: A New Source of Proprietary Rights Protection for the Software Industry?* 5 COMPUTER LAWYER 1, 2 (October 1988).

⁷15 U.S.C. § 1125(a) (1988).