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INTELLECTUAL PROPERTY
IN THE NEW
TECHNOLOGICAL AGE

Revised
Fourth Edition



Wolters Kluwer

Law & Business

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*Intellectual Property
in the
New Technological Age*

Revised Fourth Edition

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For my brothers, Bruce, Paul, and Matt.

R.P.M.

For Claire, Dylan, and Noah.

P.S.M.

For Rose, as always.

M.A.L.

Preface

Rapid advances in digital and life sciences technology continue to spur the evolution of intellectual property law. As professors and practitioners in this field know all too well, Congress and the courts continue to develop intellectual property law and jurisprudence at a rapid pace. For that reason, we have significantly augmented and revised our text yet again.

Here is a synopsis of the principal changes in this Revised Fourth Edition:

Chapter 1. Introduction. We have expanded coverage of theories of intellectual property, including discussion of the open source movement.

Chapter 2. Trade Secret Protection. We have substituted new cases on reverse engineering and remedies.

Chapter 3. Patent Law. We have reorganized the validity materials, moving the materials on written description before novelty and non-obviousness. This chapter contains expanded coverage of patenting of DNA-related inventions (with the addition of *In re Fisher*). We have substantially rewritten and updated the materials on claim construction to take into consideration the Federal Circuit's *en banc* decision in *Phillips v. AWH Corporation*. We also added the important Supreme Court opinion in *eBay v. MercExchange*, and new material on extraterritorial infringement and remedies. Finally, we relocated some of the Problems in this chapter.

Chapter 4. Copyright Law. The past several years have demonstrated the extraordinary potential of the Internet as a distribution medium, and with that, tremendous dynamism in the field of copyright protection. In order to present all of the new developments coherently, we have substantially expanded our coverage of digital copyright law. We have expanded our coverage of indirect liability (*MGM v. Grokster*) and added material on the application of fair use to search engines (*Kelly v. Arriba Soft. Corp.*), as well as

added several new problems relating to Internet copyright issues. We have also expanded coverage of international copyright law.

Chapter 5. Trademark Law. The past three years have seen tremendous growth in what might be called cyber-trademark law. We have added the leading case on the requirement of trademark use (*1-800 Contacts, Inc. v. WhenU.com, Inc.*). We have also updated the materials on trademark dilution, and added comprehensive treatment of the 2006 Trademark Dilution Revision Act and its impact on dilution litigation.

Chapter 6. State Intellectual Property Law and Federal Preemption. This chapter includes expanded coverage of the right of publicity, trespass to chattels, and preemption of state law.

Chapter 7. Protection of Computer Software. We have substantially expanded coverage of open source licensing, patent protection for software-related and business method inventions, and the Semiconductor Chip Protection Act.

Chapter 8. Intellectual Property and Competition Policy. We have updated coverage of the Microsoft antitrust litigation and pharmaceutical patent settlement cases.

Acknowledgments

We are indebted to a great many people who have helped us since this project began in 1991. We would like to thank our many colleagues who reviewed earlier drafts of the book and provided helpful guidance. While many of these reviews were anonymous, we have also benefitted from the advice of Lynn Baker, Paul Heald, and Pam Samuelson, each of whom read several different drafts of the book as it made its way through the editorial process. We gratefully acknowledge the research assistance of Evelyn Findeis, Edwin Flores, Ryan Garcia, Shari Heino, Toni Moore Knudson, Christopher Leslie, and Barbara Parvis. We would also like to thank Michele Co for exceptional secretarial and administrative assistance in completing this text.

We are grateful to many colleagues for providing suggestions for improving this book. In particular, we would like to thank John Allison, Julie Cohen, Ken Dam, Robin Feldman, Terry Fisher, Marshall Leaffer, Glynn Lunney, Ron Mann, David Nimmer, Ruth Okediji, Malla Pollack, Peggy Radin, Jerry Reichmann, Paul Schwartz, Lon Sobel, and several anonymous reviewers for their comments and suggestions in preparing the second, third, and fourth editions. We have also benefitted greatly from the research assistance and proofreading of Brian Carver, Colleen Chien, Will Devries, Tom Fletcher, Ryan Garcia, Ines Gonzalez, David Grady, Victoria H. Kane, Michelle A. Marzahn, Selena R. Medlen, Pilar Ossorio, Ryan Owens, Stephanie N.-P. Pham-Quang, Laura Quilter, John Sasson, Helaine Schweitzer, Shannon Scott, Laurence Trask, Allison Watkins, Emily Wohl, and Tarra Zynda. For the Revised Fourth Edition, we thank Sarah Craven, Tom Fletcher, Jeffrey Kuhn, Roberta Morris, and Malla Pollack.

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Note: We have selectively omitted citations and footnotes from cases without the uses of ellipses or other indications. All footnotes are numbered consecutively within each chapter, except that footnotes in cases and other excerpts correspond to the actual footnote numbers in the published reports.

Many of the problems in this text are taken from actual cases. However, in many instances we have altered the facts of the case. In most cases we have also altered the names of the parties involved. In a few cases, however, particularly in the trademark and antitrust chapters, we felt that it was important to the problem to use the name of a product or company with which the reader would be familiar. Readers should understand that the problems are hypothetical in nature and that we do not intend them to represent the actual facts of any case or situation.

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Contents

<i>Preface</i>	xxiii
<i>Acknowledgments</i>	xxv

I	Introduction	1
A.	Philosophical Perspectives	2
1.	The Natural Rights Perspective	2
	John Locke, <i>Two Treatises on Government</i>	2
	Problem	5
2.	The Personhood Perspective	6
	Margaret Jane Radin, <i>Property and Personhood</i>	6
3.	The Utilitarian/Economic Incentive Perspective	10
a.	Prompting Innovation and Creativity	11
	Problem	19
b.	Ensuring Integrity of the Marketplace	20
B.	Overview of Intellectual Property	24
1.	Trade Secret	24
2.	Patent	28
3.	Copyright	28
4.	Trademark/Trade Dress	29
	Problem	30

2	Trade Secret Protection	33
A.	Introduction	33
1.	History	33
2.	Overview of Trade Secret Protection	35
3.	Theory of Trade Secrets	37
B.	Subject Matter	39
1.	Defining Trade Secrets	39

	<i>Metallurgical Industries Inc. v. Fourtek, Inc.</i>	39
	Problems	48
2.	Reasonable Efforts to Maintain Secrecy	49
	<i>Rockwell Graphic Systems, Inc. v. DEV Industries, Inc.</i>	49
	Problems	57
3.	Disclosure of Trade Secrets	58
C.	Misappropriation of Trade Secrets	62
1.	Improper Means	62
	<i>E. I. duPont de Nemours & Co. v. Rolfe Christopher et al.</i>	62
	Problem	67
2.	Confidential Relationship	67
	<i>Smith v. Dravo Corp.</i>	67
	Problems	72
3.	Reverse Engineering	74
	<i>Kadant, Inc. v. Seeley Machine, Inc.</i>	75
	Problems	79
4.	The Special Case of Departing Employees	80
a.	Employee Trade Secrets	82
	<i>Wexler v. Greenberg</i>	82
	Note on the Common Law Obligation to Assign Inventions	87
	Problem	88
	Note on Trailer Clauses	88
b.	Noncompetition Agreements	89
	Note on the "Inevitable Disclosure" of Trade Secrets	94
	Note on Nonsolicitation Agreements	98
	Problem	99
D.	Agreements to Keep Secrets	101
	<i>Warner-Lambert Pharmaceutical Co. v. John</i>	
	<i>J. Reynolds, Inc.</i>	101
E.	Remedies	105
	<i>Winston Research Corp. v. 3M Corp.</i>	106
	Note on Criminal Trade Secret Statutes	112
	Note on Federal Criminal Liability for Trade Secret	
	Misappropriation	113

3 Patent Law 117

A.	Introduction	117
1.	Historical Background	117
2.	An Overview of the Patent Laws	124
a.	Requirements for Patentability	124
b.	Rights Conferred by a Patent	125
3.	Theories of Patent Law	127
B.	The Elements of Patentability	128
1.	Patentable Subject Matter	128
	<i>Diamond v. Chakrabarty</i>	128
	<i>Parke-Davis & Co. v. H. K. Mulford Co.</i>	135

Problem	139
Note on Patenting “Abstract Ideas”	139
Note on Patenting Business Methods and “Printed Matter”	141
Problems	142
2. Utility	144
<i>Brenner v. Manson</i>	144
<i>In re Fisher</i>	149
Note on the Patent Office Utility Guidelines	152
Note on Different Types of Utility	154
Problem	158
3. Describing and Enabling the Invention	158
a. Procedures for Obtaining a Patent	158
b. Disclosure Doctrines: Enablement and Written Description	163
<i>The Incandescent Lamp Patent</i>	164
Note on “Analog” Claims in Chemical and Biotechnology	
Patents: An Exploration of Patent Breadth	169
<i>The Gentry Gallery, Inc. v. The Berklene Corp.</i>	174
Note on “Written Description” and Biotechnology	179
Note on the Best Mode Requirement	182
Problem	183
4. Novelty and Statutory Bars	185
a. The Nature of Novelty	186
<i>Rosaire v. National Lead Co.</i>	186
Note on the Inherency Doctrine	190
Problem	192
b. Statutory Bars: Publications	192
<i>In re Hall</i>	192
Problem	195
c. Statutory Bars: Public Use	196
<i>Egbert v. Lippmann</i>	196
Problem	200
d. The Experimental Use Exception	202
<i>City of Elizabeth v. Pavement Company</i>	202
e. Priority Rules and the First to Invent	206
<i>Griffith v. Kanamaru</i>	207
Note on Recent Changes to Patent Law:	
International Harmonization	211
5. Nonobviousness	212
<i>Graham v. John Deere Co.</i>	212
a. Combining References	224
<i>KSR International Co. v. Teleflex Inc.</i>	224
<i>In re Vaeck</i>	237
<i>In re Dembiczak</i>	240
Note on Nonobviousness and Biotechnology Inventions	246
Problem	247
b. “Secondary” Considerations	248
C. Infringement	250
1. Claim Interpretation	250
a. The Proper Role of Judge and Jury in Patent Cases	250
<i>Phillips v. AWH Corporation</i>	252

2. Literal Infringement	268
<i>Larami Corp. v. Amron</i>	269
3. The Doctrine of Equivalents	274
a. Basic Issues	274
b. Prosecution History Estoppel	279
<i>Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.</i>	279
c. Subject Matter “Disclosed but Not Claimed”	291
<i>Johnson & Johnston Associates Inc. v. R.E. Service Co., Inc.</i>	292
d. After-Arising Technologies	300
Problem	303
4. The “Reverse” Doctrine of Equivalents	304
5. Equivalents for Means-Plus-Function Claims	308
6. Contributory Infringement	311
<i>C. R. Bard, Inc. v. Advanced Cardiovascular Systems, Inc.</i>	311
Note on Inducement	314
Problem	315
7. Infringement Involving Foreign Activities	316
<i>Microsoft Corp. v. AT & T Corp.</i>	318
D. Defenses	321
1. The “Experimental Use” Defense	321
2. Inequitable Conduct	325
<i>Kingsdown Medical Consultants, Ltd. v. Hollister Inc.</i>	325
3. Patent Misuse	331
<i>Motion Picture Patents Company v. Universal Film Manufacturing Company et al.</i>	331
Problem	338
Note on the Scope of the Patent Misuse Doctrine	338
E. International Patent Law	343
1. Procedural Rules	343
2. Substantive Harmonization and GATT-TRIPS	346
F. Remedies	348
1. Injunctions	351
<i>eBay Inc. v. MercExchange, LLC</i>	351
2. Damages: Reasonable Royalty and Lost Profits	356
a. Reasonable Royalty	359
b. Lost Profits Damages	361
3. Willful Infringement	364
<i>Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corporation</i>	364
G. Design and Plant Patents	371
1. Design Patents	371
a. Introduction	371
b. Requirements for Patentability	371
c. Claim Requirements and Procedure	374
d. Infringement	375
2. Plant Patents	376
a. The Plant Patent Act	376
b. The Plant Variety Protection Act	377

4	Copyright Law	383
A.	Introduction	383
1.	Brief History of Copyright Protection	384
2.	An Overview of the Copyright Regime	388
3.	Philosophical Perspectives on Copyright Protection	390
B.	Requirements	392
1.	Original Works of Authorship	392
	<i>Feist Publications v. Rural Telephone Service</i>	394
	Problem	402
2.	Fixation in a Tangible Medium of Expression	402
3.	Formalities	405
a.	Notice	405
b.	Publication	406
	Problem	408
c.	Registration	409
d.	Deposit	410
	Note the Restoration of Foreign Copyrighted Works	410
C.	Copyrightable Subject Matter	411
1.	Limitations on Copyrightability: Distinguishing Function and Expression	411
a.	The Idea-Expression Dichotomy	411
	<i>Baker v. Selden</i>	412
	Problem	417
	<i>Morrissey v. Procter & Gamble</i>	418
	Problems	421
b.	The Useful Article Doctrine	421
	<i>Brandir International, Inc. v. Cascade Pacific Lumber Co.</i>	423
	Problems	431
c.	Government Works	431
	Problem	435
2.	The Domain and Scope of Copyright Protection	436
a.	Literary Works	436
b.	Pictorial, Graphic, and Sculptural Works	437
	Problem	438
c.	Architectural Works	438
d.	Musical Works and Sound Recordings	440
e.	Dramatic, Pantomime, and Choreographic Works	441
	Problem	441
f.	Motion Pictures and Other Audiovisual Works	442
g.	Derivative Works and Compilations	442
	<i>Roth Greeting Cards v. United Card Company</i>	443
	Problems	446
D.	Ownership and Duration	446
1.	Initial Ownership of Copyrights	447
a.	Works Made for Hire	447
	<i>Community for Creative Non-Violence et al. v. Reid</i>	447