

Fundamentals of United States Intellectual Property Law: Copyright, Patent, Trademark

**Sheldon W. Halpern,
Craig Allen Nard,
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Second edition

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Fundamentals of United States
Intellectual Property Law:
Copyright, Patent, Trademark

To Dorit and Miki
S.W.H.

To Lillian
C.A.N.

To Elissa, Emily, and Paula
K.L.P.

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 exists independent of any statute.

¹ U.S. CONST., art. I, sec., 8, cl. 8.

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 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.

S.W.H.
C.A.N.
K.L.P.

August, 2006

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).

Summary of Contents

PREFACE	vii
TABLE OF CONTENTS.	xi

PART I: COPYRIGHT

§ 1. Congressional Power.	1
§ 2. Subject Matter of Protection.	5
§ 3. Conditions of Protection.	42
§ 4. Ownership.	55
§ 5. Transfer of Copyright Interests.	64
§ 6. Scope of Exclusive Rights.	70
§ 7. Fair Use As a Limitation on Copyright Protection.	118
§ 8. Duration of Copyright Protection.	139
§ 9. Infringement.	147
§ 10. Remedies.	172
§ 11. Copyright Protection Systems and Copyright Management Information.	182

PART II: PATENT

§ 1. Sources of United States Patent Law.	195
§ 2. Conditions of Patentability.	200
§ 3. Formalities.	246
§ 4. Ownership and Transfer.	265
§ 5. The Rights and Limitations of The Patent Grant.	267
§ 6. Infringement and Remedies.	279
§ 7. Design Patents.	287

PART III: TRADEMARK

§ 1. Sources of Power.	291
§ 2. Subject Matter of Protection.	310
§ 3. Conditions of Protection.	329
§ 4. Formalities.	336
§ 5. Ownership and Transfer	347
§ 6. Scope of Exclusive Rights.	349
§ 7. Rights in Unregistered Marks.	381
§ 8. Infringement and Remedies.	382

INDICES.	405
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Table of Contents

PREFACE	vii
-------------------	-----

PART I: COPYRIGHT

§ 1. Congressional Power.	1
1.1. Constitutional Grant of Power.	1
1.2. The Copyright Act.	1
1.3. Treaties and International Agreements.	4
§ 2. Subject Matter of Protection.	5
2.1. Categories of Protected Works.	5
2.2. National Origin.	5
2.3. Excluded Works.	7
2.3.1. Intangible Expression.	7
2.3.2. Governmental Works.	7
2.3.3. The Idea/Original Expression Continuum.	8
2.3.3.1. Generally.	8
2.3.3.2. Merger.	10
2.3.3.3. Scenes à Faire	12
2.4. Special Categories of Works:.	12
2.4.1. Computer Software.	12
2.4.1.1. Software as a “Literary Work”.	13
2.4.1.2. Protection of the Code Itself.	13
2.4.1.3. Protection of Structure and “Look and Feel”.	14
2.4.2. Compilations and Databases.	17
2.4.3. Historical and Factual Material.	20
2.4.4. Utilitarian Works and Industrial Design.	22
2.4.4.1. “Useful Articles”.. . . .	22
2.4.4.2. Separability of Form and Function.	23
2.4.4.3. <i>Sui Generis</i> Protection for “Mask Works”: The Semiconductor Chip Protection Act	25
2.4.4.3.1. Generally.	26
2.4.4.3.2. Substantive Conditions of Protection.	28
2.4.4.3.3. Formal Conditions of Protection.	29
2.4.4.3.4. Ownership and Transfer.	31
2.4.4.3.5. Nature of the Rights.	32
2.4.4.3.6. Infringement and Remedies.	34
2.4.4.4. <i>Sui Generis</i> Protection for Vessel Hulls.	36
2.4.5. Architectural Works.	36
2.4.6. Sound Recordings.	39

2.4.7. Fictional Characters.....	40
§ 3. Conditions of Protection.....	42
3.1. Formal Requirements.....	42
3.1.1. Fixation as the Point of Attachment of Copyright.....	42
3.1.2. Publication.....	44
3.1.3. Notice.....	45
3.1.4. Registration and Deposit.....	46
3.1.4.1. Registration.....	46
3.1.4.2. Registration Procedure.....	47
3.1.4.3. Benefits.....	47
3.1.4.4. Recordation and Registration.....	48
3.1.4.5. Deposit.....	49
3.1.5. Domestic Manufacture.....	49
3.2. Substantive Requirements: “Writings” of “Authors”	
Consisting of “Original Expression”.....	50
3.2.1 “Authors” and their “Writings”.....	50
3.2.2. Original Expression.....	51
3.2.2.1. Generally.....	51
3.2.2.2. Originality in Derivative Works.....	54
§ 4. Ownership.....	55
4.1. Ownership of Copyright v. Ownership	
of the Material Object.....	55
4.2. Divisibility.....	56
4.3. Authorship.....	56
4.4. Joint Works/Multiple Authorship.....	57
4.5. Collective Works.....	59
4.6. Works Made for Hire.....	60
4.6.1. Work Prepared by an Employee	
Within the Scope of Employment.....	61
4.6.2. Specially Commissioned Works.....	62
§ 5. Transfer of Copyright Interests.....	64
5.1. Transfer Defined.....	64
5.2. Requirement of a Writing.....	65
5.3. Termination of Transfers and Grants.....	66
5.3.1. Nature of the Right.....	66
5.3.2. Grants Made Prior to January 1, 1978.....	68
5.3.3. Grants Made from and after January 1, 1978.....	69
5.3.4. The Effect of Termination: Derivative Works.....	69
§ 6. Scope of Exclusive Rights.....	70

6.1. The Right to Reproduce the Work.....	71
6.1.1. The Broadly Defined Right.....	71
6.1.2. Specific Statutory Limitations and Compulsory Licenses..	72
6.1.2.1. Library and Archival Copying:.....	73
6.1.2.2. Ephemeral Recordings:.....	74
6.1.2.3. Certain Copies of Computer Programs.....	76
6.1.2.4. Reproductions for the Blind or Other People with Disabilities.....	77
6.1.2.5. Home Audio Taping.....	77
6.1.2.6. Compulsory License for Mechanical Reproduction. . .	79
6.1.2.7. Compulsory License for Public Broadcasting.	81
6.2. The Right to Prepare Derivative Works.	81
6.3. The Right to Distribute.	84
6.3.1. The Right of First Publication.....	84
6.3.2. The First Sale Doctrine.	85
6.3.3. The Record and Computer Program Rental Exceptions to the First Sale Doctrine.	86
6.3.4. Importation and the First Sale Doctrine.	87
6.4. The Public Performance Right.	89
6.4.1. Generally.....	89
6.4.2. "Performance".	90
6.4.3. "Public".	92
6.4.4. Statutory Exemptions: Generally	93
6.4.5. The Specific Statutory Exemptions:	94
6.4.5.1. Sections 110(1) and 110(2): Classroom Exemption . .	94
6.4.5.2. Section 110(3): Religious Organizations.	96
6.4.5.3. Section 110(4): General Not for Profit Exemption for Nondramatic Works.....	96
6.4.5.4. Section 110(6): Governmental Agricultural Organizations	97
6.4.5.5. Sections 110(8)and (9): Performance and Transmissions to Certain Handicapped Persons.	97
6.4.5.6. Section 110(10): Fraternal and Veterans Organizations, for Charitable Purposes.	98
6.4.5.7. Section110(5): Communication of Transmission of a Performance.	98
6.4.5.7.1. The "Aiken" Exemption for "Home" Type Equipment.	98
6.4.5.7.2. Nondramatic Musical Works in Licensed Broadcast Transmissions.	99

6.4.5.8. Section 110(7): Performance Ancillary to Retail Sales.	101
6.4.5.9. Section 111: Exemptions for Secondary Transmissions	102
6.4.5.10. Section 118: Noncommercial Broadcasting	104
6.4.6. Performing Rights Societies.	104
6.5. The Display Right.	106
6.5.1. The Nature of The Right.	106
6.5.2. Limitations on the Display Right	107
6.6. The Limited Performance Right for Sound Recordings.	108
6.7. Moral Right.	110
6.7.1. Background.	110
6.7.2. The Visual Artists Rights Act.	112
6.7.2.1. The Attribution and Integrity Rights.	113
6.7.2.2. Exclusions and Limitations.	114
6.7.3. State Moral Rights Statutes.	116
6.7.4. Droit de Suite.	117
§ 7. Fair Use As a Limitation on Copyright Protection.	118
7.1. The Fair Use Concept.	118
7.2. Section 107— Codification of the Doctrine.	121
7.2.1. Scope and Purpose.	121
7.2.2. Parsing the Statute.	122
7.2.2.1. The Preamble: Productive and Transformative Uses.	122
7.2.2.2. The Enumerated Factors.	126
7.2.2.2.1. The First Factor—Commercial or Noncommercial Purpose.	127
7.2.2.2.2. The Second Factor—The Nature of the Copyrighted Work.	129
7.2.2.2.3. The Third Factor—The Amount Taken.	129
7.2.2.2.4. The Fourth Factor—Economic Impact.	130
7.3. Parody as Fair Use.	132
7.4. Fair Use of Utilitarian Works.	136
7.5. Fair Use and Photocopying for Research and Academic Purposes.	136
7.5.1. Library, Archival, and Research Copying.	136
7.5.2. Academic, Classroom Copying.	137
7.6. First Amendment Considerations.	138
§ 8. Duration of Copyright Protection.	139
8.1. General Overview.	139
8.1.1. The Pre-1976 Renewal Right and the Renewal Term.	139
8.1.1.1. Vesting Of The Renewal Right	139
8.1.1.2. The Renewal Term As a New, Independent Term.	140

8.1.1.3. Assignment of the Renewal Right.	141
8.1.1.4. Automatic Renewal.. . . .	141
8.1.2. The 1976 Act Single Term.	142
8.2. Works Created on or After the Effective Date of the 1976 Act (January 1, 1978).. . . .	144
8.3. Works Created but Not Published or Copyrighted Before January 1, 1978.. . . .	145
8.4. Works with Subsisting Copyright Protection As of January 1, 1978	146
8.5. Restoration of Copyright in Certain Foreign Works...	146
§ 9. Infringement.	147
9.1. Procedural Issues in Infringement Actions.	147
9.1.1. Registration.	147
9.1.2. Subject Matter Jurisdiction.	148
9.1.2.1. Exclusive Federal Jurisdiction.	148
9.1.2.2. Pendent Jurisdiction.	150
9.1.2.3. Suits in the United States for Acts of Infringement Abroad.. . . .	150
9.1.3. Personal Jurisdiction and Venue.. . . .	151
9.1.4. Standing.. . . .	151
9.1.5. Statute of Limitations.	152
9.1.6. Actions against State Instrumentalities.	153
9.1.6.1. Sovereign Immunity under the Eleventh Amendment.	153
9.1.6.2. Abrogation of Immunity.	153
9.1.7. Misuse of Copyright.	154
9.2. Substantive Issues in Infringement Actions.. . . .	155
9.2.1. Substantial Similarity.	156
9.2.1.1. Generally.. . . .	156
9.2.1.2. Modes of Analysis.	157
9.2.1.3. Extrinsic/Intrinsic Tests, “Probative Similarity” and the Roles of Experts, Judge, and Jury.. . . .	158
9.2.2. Access.	162
9.3. “Innocent” Infringement.	163
9.4. Criminal Infringement.	164
9.5. Vicarious Liability and Contributory Infringement.	164
9.5.1. Vicarious Liability.. . . .	165
9.5.2. Contributory Infringement.. . . .	166
9.5.3. Online Infringement Liability Limitation.	168
9.5.3.1. Generally.. . . .	168
9.5.3.2. Transmission.. . . .	169

9.5.3.3. System Caching.	170
9.5.3.4. Storage.	170
9.5.3.5. Links.	171
9.5.3.6. Further Limitations on Liability of Nonprofit Educational Institutions.	171
9.5.3.7. Limitation on Liability for Removal of Material.	172
§ 10. Remedies.	172
10.1. Injunctive Relief.	172
10.2. Damages.	173
10.2.1. Actual Damages and Profits.	173
10.2.1.1. Provable Damages.	174
10.2.1.2. Infringer's Profits.	174
10.2.2. Statutory Damages.	176
10.2.2.1. Registration as a Condition.	176
10.2.2.2. Amount of Damages: Range of Discretion.	177
10.2.2.3. Right to Jury Determination.	179
10.3. Costs and Counsel Fees.	179
10.4. Impoundment and Disposition.	181
§ 11. Copyright Protection Systems and Copyright Management Information.	182
11.1. Generally.	182
11.2. Circumvention of Copyright Protection Systems.	182
11.2.1. Actionable Conduct.	182
11.2.1.1. Circumvention of Access Control.	183
11.2.1.2. Facilitating Circumvention of Technological Protection Measures	184
11.2.1.3. Limitation on Analog Videocassette Recorders.	185
11.2.2. Exceptions and Limitations.	186
11.2.2.1. Non-Profit Libraries, Archives, and Educational Institutions.	187
11.2.2.2. Law Enforcement, Intelligence, and Other Government Activities.	187
11.2.2.3. Reverse Engineering of Computer Programs to Achieve Interoperability.	188
11.2.2.4. Encryption Research on Published Works.	188
11.2.2.5. Protection of Personally Identifying Information.	189
11.2.2.6. Security Testing.	190
11.3. Copyright Management Information.	190
11.3.1. Impairment of Copyright Management Information.	190
11.3.2. Exemptions and Limitations.	191

11.3.2.1. Law Enforcement and Other Government Activities.	191
11.3.2.2. Transmissions.	191
11.4. Enforcement and Remedies.	192
11.4.1. Civil Remedies.	192
11.4.1.1. Injunctive and Related Relief.	192
11.4.1.2. Damages: Actual and Statutory.	192
11.4.1.3. Increasing or Reducing Damages.	193
11.4.1.4. Costs and Counsel Fees.	193
11.4.2. Criminal Penalties.	194

PART II: PATENT

§ 1. Sources of United States Patent Law.	195
1.1. Constitutional Foundation.	195
1.2. Statutory Foundation.	196
§ 2. Conditions of Patentability.	200
2.1. Disclosure Requirements.	202
2.1.1. Enablement.	203
2.1.2. Best Mode.	206
2.1.3. Written Description.	208
2.1.4. Definiteness Requirement.	209
2.2. Novelty.	210
2.2.1. Date of Invention.	210
2.2.2. Identity of Invention in Single Prior Art Reference.	212
2.2.2.1. § 102(a) Prior Art.	213
2.2.2.1.1. “Known or Used by Others”.	213
2.2.2.1.2. “Printed Publication”.	214
2.2.2.1.3. Geographical Limitations.	215
2.2.2.2. Section 102(e) Prior Art.	216
2.2.2.3. Section 102(g)(2) Prior Art.	218
2.2.3. Derivation: Section 102(f).	219
2.2.4. Priority.	219
2.2.4.1. Conception.	220
2.2.4.2. Reduction to Practice.	221
2.2.4.3. Abandonment, Suppression, and Concealment.	223
2.2.4.4. Inventorship.	224
2.2.4.5. Inventive Activity Abroad.	225
2.3. Loss of Right: Statutory Bars.	226
2.3.1. Section 102(b) — On-Sale and Public Use Bars.	226
2.3.1.1. Public Use.	227
2.3.1.2. Experimental Use.	227

2.3.1.3. On-Sale Bar.	228
2.3.1.4. Third-Party Activity.	230
2.3.2. Section 102(d) Bar on Foreign Applicants.	231
2.4. Utility.	232
2.5. Nonobviousness.	234
2.5.1. Scope of the Prior Art.	235
2.5.2. Content of the Prior Art.	236
2.5.3. Persons of Ordinary Skill in the Art.	238
2.5.4. Secondary Considerations.	238
2.5.4.1. Commercial Success.	239
2.5.4.2. Long-Felt Need and Failure of Others.	240
2.5.4.3. Copying.	240
2.5.4.4. Licensing/Acquiescence.	241
2.6. Statutory Subject Matter.	241
2.6.1. Products.	242
2.6.1.1. Machines, Articles of Manufacture, Compositions of Matter.	242
2.6.1.2. Living Organisms.	243
2.6.2. Processes.	244
§ 3. Formalities.	246
3.1. The Patent Application & Issued Patent	247
3.1.1. The Written Description.	249
3.1.1.1. Background of the Invention.	249
3.1.1.2. Summary of the Invention.	249
3.1.1.3. Detailed Description of the Invention.	250
3.1.1.4. The Drawings.	250
3.1.2. The Claims.	251
3.1.2.1. Composition Claims.	252
3.1.2.2. Process Claims.	253
3.1.2.3. Apparatus Claims.	254
3.1.2.4. Product-by-Process Claims.	254
3.1.2.5. Means-Plus-Function Claim Elements.	255
3.2. Procedures Before the Patent and Trademark Office.	256
3.2.1. Initial Processing of the Application.	256
3.2.2. Examination and Prosecution.	257
3.2.2.1. Formalities and Search by the Examiner.	257
3.2.2.2. Office Action.	257
3.2.2.3. Applicant's Response.	257
3.2.2.4. Reconsideration and Allowance.	258
3.2.2.5. Responses to a Final Office Action.	259

3.2.2.5.1. Appeals..	259
3.2.2.5.2. Cancellation of claims.	259
3.2.2.5.3. Continuing applications	260
3.2.2.6. Publication.	261
3.2.2.7. Foreign Priority..	262
3.2.2.8. Interferences.	263
3.2.3. Appeals to the Courts.	263
3.3. Post-Issuance Procedures.	264
3.3.1. Reissue.	264
3.3.2. Reexamination..	265
§ 4. Ownership and Transfer.	265
§ 5. The Rights and Limitations of The Patent Grant.	267
5.1. Scope of the Right to Exclude..	267
5.1.1. Temporal Scope: The Patent Term.	267
5.1.2. Geographic Scope.	269
5.1.2.1. Exporting a Claimed Invention..	269
5.1.2.2. Importing a Claimed Invention or Products Made By a Claimed Process Invention.	270
5.2. Limitations of the Right to Exclude..	271
5.2.1. The Defense of Patent Misuse..	271
5.2.2. First Sale, Implied License, and Repair/Reconstruction.	273
5.2.3. Experimental Use Doctrine.	274
5.2.4. Governmental Use..	276
5.2.4.1. Federal Government.	276
5.2.4.2. State Government.	277
§ 6. Infringement and Remedies.	279
6.1. Infringement.	279
6.1.1. Claim Interpretation.	279
6.1.2. Literal Infringement..	280
6.1.3. Infringement Under the Doctrine of Equivalents.	281
6.1.4. Indirect Infringement..	283
6.2. Remedies.	284
6.2.1. Compensatory Damages.	284
6.2.2. Exemplary Damages.	286
6.2.3. Injunctive Relief.	286
§ 7. Design Patents..	287