CONTENTS

Preface Acknowledgments	xxiii xxv
•	
CHAPTER I	•
Introduction	1
A. Intellectual Property Regimes	2
1. Patent Law	2
Matt Richtel, Edison Wasn't He the Guy	
$Who\ Invented\ Everything?$	3
2. Copyright Law	5
Tom Zeller, Link by Link; the Imps of File Sharing	
May Lose in Court, but They	
Are Winning in the Marketplace	6
3. Trademark Law	7
Michael Wilson, Chinatown Stores	
Raided in Counterfeit-Goods Sweep	8
Omega, S.A. v. S & N Jewelry Inc.	9
4. Copyright and Patent Law's Common Foundation	12
5. Trade Secret Law	15
B. The Structure of This Book	16
CHAPTER 2	
Acquiring Patent Rights	19
Introduction	19
A. Claiming and Disclosing the Invention	28
1. Claim Interpretation	28
Phillips v. AWH Corp.	29
Comments	42
2. Enablement	46
O'Reilly v. Morse	46
Comments	50
Policy Perspective: Optimal Claim Scope	
and Patent Law's Delicate Balance	54
Automotive Technologies International,	-
Inc. v. BMW of North America, Inc.	55
\mathbf{J}	

ix

x Contents

	Comments	61
	Comparative Perspective: The Enablement	
	Requirement in Europe and TRIPs	65
	3. Written Description	66
	Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co.	66
	Comments	73
	4. Definiteness	77
	Nautilis, Inc. v. Biosig Instruments, Inc.	77
	Comments	84
В.	Statutory Subject Matter and Utility	86
	1. Statutory Subject Matter	86
	Comparative Perspective: Subject Matter	
	Eligibility Under the European Patent Convention	87
	Diamond v. Chakrabarty	88
	Comments	96
	Mayo Collaborative Services v. Prometheus	
	Laboratories, Inc.	97
	Comments	107
	Association for Molecular Pathology v.	
	Myriad Genetics, Inc.	111
	Comments	118
	Comparative Perspective: Patentable	
	Subject Matter, Morality, and Biotechnology in Europe	123
	Alice Corporation Pty. v. CLS Bank International	124
	Comments	132
	Comparative Perspective: Software and	
	Business Method Patents in Europe	142
	2. Utility	143
	Brenner v. Manson	143
	Comments	148
C.	Novelty and Priority	149
	1. Proving Date of Invention	150
	Problem	152
	2. "Known or Used"	152
	Rosaire v. Baroid Sales Div.	152
	Comments	155
	Patent Reform Perspective: Novelty Under the AIA	158
	Comparative Perspective: Defining Prior Art and	
	Geographical Limitations	163
	3. Priority	163
	Griffith v. Kanamaru	164
	Fujikawa v. Wattanasin	169
	Comments	176
D.	Nonobviousness	178
	1. The Graham Test	180
	Graham v. John Deere Co.	180
	Comments	186

Contents xi

		Comparative Perspective: Section 103's	
		European Counterpart—"Inventive Step"	189
	2.	Determining Obviousness (or Not)	190
		KSR International Co. v. Teleflex, Inc.	191
		Comments	203
Ε.	Sta	atutory Bars	214
	1.	On-Sale Bar	216
		Space Sys./Loral, Inc. v. Lockheed Martin Corp.	21e
		Comments	218
	2.	Public-Use Bar	223
		Egbert v. Lippmann	223
		Comments	226
		Problem	229
		Patent Reform Perspective: Statutory Bars and	
		Exceptions Under the AIA	230
		Comparative Perspective: Third-Party Activity in	
		Europe and Japan	233
	3.	Experimental Use	233
		Lough v. Brunswick Corp.	233
		Comments	238
		Problem	239
	4.	"Printed Publication"	240
		In re Klopfenstein	240
		Comments	245
		2	
		PTER 3	940
		orcing Patent Rights	249
		duction	249
Α.	Li	teral Infringement	253
		Larami Corp. v. Amron	255
		Comments	256
В.	Do	octrine of Equivalents	258
		Graver Tank & Manufacturing	
		Co. v. Linde Air Prods. Co.	259
		Comparative Perspective: Non-Literal Infringement in Europe	263
		Warner-Jenkinson Co. v. Hilton Davis Chem., Inc.	265
_		Comments	270
С.		mitations on the Doctrine of Equivalents and Claim Scope	275
	1.	Prosecution History Estoppel	275
		Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.	275
		Comments	282
	2.	Disclosure-Dedication Rule	287
		Johnson & Johnston Assocs., Inc. v. R.E. Serv. Co., Inc.	287
		Comments	293
_		All-Limitations Rule	294
D.	In	direct Infringement	296
		Lucent Technologies, Inc. v. Gateway, Inc.	297

xii Contents

	Comments	301
	Global-Tech Appliances, Inc. v. SEB S.A.	303
	Comments	308
СН	APTER 4	
	efenses to Patent Infringement	311
Int	roduction	311
A.	The Scope of Patent Exhaustion and the	
	Repair-Reconstruction Doctrine	311
	Keurig, Incorporated v. Sturm Foods, Inc.	<i>3</i> 12
	Comments	315
В.	The Use (and Misuse) of Contracts in Patent Law	318
	1. Patent Misuse	319
	Morton Salt Co. v. G.S. Suppiger Co.	<i>319</i>
	Comments	321
	2. Field-of-Use Restrictions	323
	Mallinckrodt v. Medipart	<i>323</i>
	Quanta Computer, Inc. v. LG Electronics, Inc.	<i>3</i> 29
	Lexmark International, Inc. v. Impression Products, Inc.	<i>336</i>
	Comments	345
C.	Antitrust	351
	Nobelpharma AB v. Implant Innovations, Inc.	<i>352</i>
	Comments	361
	Federal Trade Commission v. Actavis, Inc.	<i>367</i>
	Comments	378
D.	Inequitable Conduct	381
	Therasense, Inc. v. Becton, Dickinson & Co.	<i>382</i>
	Comments	389
СН	APTER 5	
	emedies for Patent Infringement	393
Int	roduction	393
	Money Damages	393
	1. Lost Profits	393
	Micro Chemical, Inc. v. Lextron, Inc.	394
	Comments	397
	2. Reasonable Royalty	398
	Lucent Technologies, Inc. v. Gateway, Inc.	399
	Comments	411
В.	Equitable Relief	412
	Amazon.com, Inc. v. Barnesandnoble.com, Inc.	413
	Celsis In Vitro, Inc. v. Cellzdirect, Inc.	418
	Comments	428
	eBay Inc. v. MercExchange, L.L.C.	429
	Comments	433

Contents xiii

	HAPTER 6	40
	cquiring Copyrights	437
In	troduction	437
	Policy Perspective: The Theories	
	and Policies of Copyright Law	439
A.	Requirements for Copyright Protection	441
	1. Originality and Authorship	441
	Bleistein v. Donaldson Lithographing Co.	441
	Comments	443
	Problem	445
	Feist Publications, Inc. v. Rural Telephone Service Co.	446
	Comments	455
	Problem	457
	Comparative Perspective: Database Protection	458
	Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.	459
	Comments	467
	2. Fixation	468
	Historical Perspective: The	
	Origins of Modern Copyright Law	469
	Williams Electronics, Inc. v. Artic International, Inc.	470
	Comments	473
	Garcia v. Google, Inc.	475
	Comments	484
	3. Expression	487
	Baker v. Selden	487
	Comments	490
	Nash v. CBS, Inc.	492
	Comments	497
	Bikram's Yoga College of India, L.P. v. Evolation Yoga,	
	LLC	500
	Problem	509
В.	Limitations on Copyrightability	510
	CCC Information Services, Inc. v. Maclean	
	Hunter Market Reports, Inc.	510
	Comments	516
	Problem	519
C.	Classifying Copyrightable Works	519
	1. Distinguishing the Work of Authorship from the Copy	520
	2. The Statutory Categories	521
	a. Pictorial, Graphic, and Sculptural Works	521
	Varsity Brands, Inc. v. Star Athletica, LLC	522
	Comments	540
	Problem	542
	b. Derivative Works	542

xiv Contents

Contents xv

	Problem	650
	4. The Right to Distribute Copies of the Work	650
	London-Sire Records, Inc. v. Doe 1	650
	Comments	662
	Problem	665
	5. The Public Display and Public Performance Rights	665
	Columbia Pictures Industries v. Redd Horne, Inc.	666
	Comments	669
	American Broadcasting Corporation, Inc. v. Aereo, Inc.	672
	Comments	687
	Comparative Perspective: Patent Infringement and	
	Trademark Infringement Compared	689
В.	Secondary Liability	689
	Fonovisa, Inc. v. Cherry Auction, Inc.	690
	Flava Works, Inc. v. Gunter	694
	Comments	701
	Note on Sony Corp. of America v.	
	Universal City Studios, Inc.	703
	Problem	703
	Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.	704
	Comments	713
	Perfect 10, Inc. v. Amazon.com, Inc.	714
	Comments	724
	Problem	725
C.	The Digital Millennium Copyright Act	725
	1. Anti-Circumvention and Technological Protection Measures	726
	RealNetworks, Inc. v. Streambox, Inc.	726
	Comments	733
	2. Protection for Copyright Management Information	735
D.	Moral Rights	736
	Cheffins v. Stewart	738
	Comments	748
	Note on Gilliam v. American Broadcasting Companies, Inc.	748
CH	HAPTER 8	
	efenses to Copyright Infringement	751
A.	Copyright Licensing	752
	1. Express Licenses	753
	Random House v. Rosetta Books	753
	Comments	756
	Policy Perspective: New Use Problems	757
	2. Implied Licenses	758
	Asset Marketing Systems, Inc. v. Gagnon	758
	Comments	764
	Problem	767
R	Fair Use	767

xvi Contents

His	storical Perspective: The Curious and	
]	Limited Life of Personal Use as Fair Use	772
Car	mpbell v. Acuff-Rose Music, Inc.	775
	mments	785
Co	unseling Perspective: Fair Use and	
	Copyright Counseling	788
Bil	l Graham Archives v. Dorling Kindersley Ltd.	789
~	mments	796
Th	e Authors Guild v. Google, Inc.	799
	mments	819
Pro	oblems	821
Co	mparative Perspective: Fair Use and Fair Dealing	822
C. First Sale		822
Lee	ev. A.R.T. Co.	824
Co	mments	826
Pro	oblem	828
Kir	tsaeng v. John Wiley & Sons, Inc.	829
	mments	839
D. Safe Harbors	For ISPs Under the Digital Millennium Copyright Act	841
Via	acom International, Inc. v. Youtube, Inc.	842
Co	mments	855
Ler	nz v. Universal Music Corp.	857
Co	mments	865
E. Compulsory	Licenses and Regulatory Copyright	866
1. Compulso	ory Licenses	867
a. Mecha	nical Licensing	867
Pol	licy Perspective: Cover Recordings	868
No	te on the Digital Performance	
]	Right in Sound Recordings Act	869
No	te on Collective Rights Organizations	870
b. Cable a	and Satellite Systems	871
2. Special Ex	temptions for Libraries, Not-for-Profit	
Organizat	ions, and Intermediaries	872
No	te on U.S. Compliance with TRIPs and	
the	e Berne Convention	873
CHAPTER 9		
	· Copyright Infringement	875
A. Injunctive Re	1. 5	876
0	linger v. Colting	876
	mments	884
	iversal City Studios, Inc. v. Reimerdes	885
_	mments	890
	te on Suntrust Bank v. Houghton Mifflin Co.	892
	oblem	893

Contents		xvii
В.	Damages	893
	1. Actual Damages and Profits	894
	Dash v. Mayweather	894
	Comments	916
	Hamil America, Inc. v. GFI	917
	Comments	924
	2. Statutory Damages	925
	Engel v. Wild Oats, Inc.	926
	Comments	928
	Bryant v. Media Right Productions, Inc.	929
	Columbia Pictures Television v. Krypton	
	Broadcasting of Birmingham, Inc.	934
	Comments	936
C.	Additional Remedies	938
	1. Seizure and Impoundment	938
	2. Attorneys' Fees	938
D.	Other Remedial Concerns	939
	1. Criminal Penalties	939
	United States v. Liu	940
	Comments	947
	2. Remedies for Violations of Related Rights	949
	a. Digital Millennium Copyright Act	949
	b. Visual Artists Rights Act	950
	HAPTER 10	
A	equiring Trademark Rights	951
A.	The Concept of Distinctiveness	952
	1. Classification of Word Marks	952
	Abercrombie & Fitch Co. v. Hunting World, Inc.	953
	Comments	959
	a. Descriptiveness	960
	Zatarain's, Inc. v. Oak Grove Smokehouse, Inc.	960
	Comments	969
	b. Genericness	972
	Horizon Mills Corp. v. QVC, Inc.	972
	Comments	979
	Problems	981
	Theoretical Perspective: Justifications for	
	Varying Degrees of Protection of Marks	982
	2. Non-Word Marks and Trade Dress	983
	a. Distinctiveness of Non-Word Marks	983
	Amazing Spaces, Inc. v. Metro Mini Storage	983
	Comments	996
	b. Trade Dress Distinctiveness	997
	Two Pesos, Inc. v. Taco Cabana, Inc.	997

xviii Contents

	Qualitex Co. v. Jacobson Products Co.	1001
	Comments	1008
	Wal-Mart Stores, Inc. v. Samara Bros., Inc.	1009
	Comments	1013
	International Perspective: International Protection	
	of Nontraditional Marks	1014
В.	The Functionality Doctrine	1015
	Qualitex Co. v. Jacobson Products Co.	1016
	TrafFix Devices, Inc. v. Marketing Displays, Inc.	1017
	Comments	1020
	1. Mechanical Functionality After <i>TrafFix</i>	1022
	Valu Engineering, Inc. v. Rexnord Corp.	1022
	Apple Inc. v. Samsung Electronics Co., Ltd.	1029
	Comments	1035
	2. Aesthetic Functionality	1036
	Au-Tomotive Gold, Inc. v. Volkswagen of America, Inc.	1036
	Christian Louboutin S.A. v. Yves Saint	
	Laurent America Holding, Inc.	1046
	Comments	1056
	3. Putting Functionality Together	1057
	Jay Franco & Sons, Inc. v. Franek	1057
	Comments	1062
	Problems	1063
	Theoretical Perspective: Availability	
	of Alternatives and Promoting Competition	1064
C.	Acquisition, Use, and Priority	1065
	1. Acquisition of Common Law Rights by Use in Commerce	1065
	Blue Bell, Inc. v. Farah Manufacturing Co.	1065
	Comments	1071
	Hana Financial, Inc. v. Hana Bank	1072
	2. Use-Based Registration and Priority	1075
	Allard Enterprises, Inc. v. Advanced	
	Programming Resources, Inc.	1076
	Comments	1081
	3. Intent to Use	1081
	WarnerVision Entertainment Inc. v.	
	Empire of Carolina, Inc.	1082
	Comments	1085
	Problem	1086
D.	Geographic Scope of Rights	1086
	United Drug Co. v. Theodore Rectanus Co.	1087
	Comments	1092
	National Association for Healthcare	
	Communications, Inc. v. Central	
	Arkansas Area Agency on Aging, Inc.	1093
	Comments	1097

Contents xix

	Problem	1098
E.	Federal Registration	1099
	1. The Registration Process	1099
	International Perspective: Trademark Registration	
	in Foreign Countries	1102
	2. Substantive Grounds for Refusing Registration	1103
	a. Actual Use in Interstate Commerce	1103
	b. Deceptive, Misdescriptive, and Deceptively	
	Misdescriptive Marks	1104
	Problems	1105
	c. Geographic Marks	1105
	In re California Innovations, Inc.	1105
	Comments	1108
	Problems	1110
	International Perspective: Geographic	
	Marks for Wines and Spirits	1111
	d. Scandalous, Immoral, and Disparaging Marks	1111
	In re Simon Shiao Tam	1113
	3. Opposition and Cancellation	1142
	Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.	1143
	Comments	1147
F.	Loss of Rights	1148
	1. Abandonment Through Non-Use	1148
	Emergency One, Inc. v. American FireEagle, Ltd.	1149
	Comments	1155
	2. Naked Licensing and Assignment in Gross	1156
	Stanfield v. Osborne Industries, Inc.	1157
CI	HAPTER 11	
	ights of Trademark Owners	1163
A.	Trademark Infringement	1163
	1. The Likelihood of Confusion Standard	1164
	Virgin Enterprises Ltd. v. Nawab	1164
	Comments	1173
	Problems 2. Amount of Confusion	1181 1182
	3. Confusion as to What?	1183
		1183
	a. Sponsorship or Affiliation	1184
	Warner Bros., Inc. v. Gay Toys, Inc. Comments	1186
	b. Reverse Confusion	1180
	A&H Sportswear, Inc. v. Victoria's Secret Stores, Inc.	1187
	Comments	1100
	Problem	1195
	4. Confusion Away from the Point of Sale	1195
	T. Comusion Away from the Follit of Sale	1190

xx Contents

	a. Initial Interest Confusion	1196
	1-800 Contacts, Inc. v. Lens.com	1196
	Multi Time Machine, Inc. v. Amazon.com, Inc.	1209
	Comments	1221
	Problem	1222
	Policy Perspective: Trademark Rights,	
	Search Costs, and Competition	1223
	b. Post-Sale Confusion	1224
	General Motors Corp. v. Keystone	
	Automotive Industries	1224
	Comments	1228
	c. Secondary Liability	1229
	Tiffany (NJ), Inc. v. eBay, Inc.	1229
	Comments	1241
	Problem	1243
В.	Trademark Dilution	1243
	Moseley v. V Secret Catalogue, Inc.	1244
	1. Dilution by Blurring	1246
	Starbucks Corp. v. Wolfe's Borough Coffee, Inc.	1246
	Visa International Service Association v. JSL Corp.	1253
	Comments	1257
	2. Dilution by Tarnishment	1259
	V Secret Catalogue, Inc. v. Moseley	1259
	Comments	1267
	Policy Perspective: Trademark Infringement	
	and Dilution	1268
	International Perspective: Comparative	
	Treatment of Dilution	1269
C.	Cybersquatting	1269
D.	Unfair Competition/Passing Off	1271
	1. Passing Off	1271
	Coca-Cola Co. v. Ed E. Dorris	1272
	Comments	1274
	2. Reverse Passing Off	1274
	Smith v. Montoro	1275
	Comments	1277
	Problem	1278
	3. Limits on the Scope of Unfair Competition Law	1279
	Dastar Corp. v. Twentieth Century Fox Film Corp.	1281
	Comments	1287
E.	Section 43(a) and the State Right of Publicity	1288
	Waits v. Frito-Lay, Inc.	1289
	Comments	1301
	Theory Perspective: Right of Publicity and	
	First Amendment Concerns	1302

Contents xxi

CI	HAPTER 12	
Trademark Defenses		
	Trademark Use	1304
11.	Rescuecom Corp. v. Google Inc.	1304
	Comments	1320
	Problem	1321
B.	The First Sale Doctrine	1321
٠.	Nitro Leisure Products, L.L.C. v. Acushnet Co.	1321
	Comments	1332
C.	Descriptive Fair Use	1333
	KP Permanent Make-Up, Inc. v.	
	Lasting Impression I, Inc.	1334
	Comment	1340
	Sunmark, Inc. v. Ocean Spray Cranberries, Inc.	1340
	Comment	1343
	Problem	1344
	Theoretical Perspective: Balancing	
	Tests and Classic Fair Use	1344
D.	Comparative Advertising and Nominative Fair Use	1345
	August Storck K.G. v. Nabisco, Inc.	1345
	Comments	1347
	Century 21 Real Estate Corp. v. LendingTree, Inc.	1348
	Toyota Motor Sales U.S.A., Inc. v. Tabari	1366
	Comments	1375
	Problems	1376
E.	First Amendment/Speech Concerns	1376
	Brown v. Electronic Arts, Inc.	1376
	Comments	1385
	In re NCAA Student-Athlete Name & Likeness Litigation	
	(Keller v. Electronic Arts Inc.)	1387
	Comments	1403
CI	HAPTER 13	
	rademark Remedies	1405
	Availibilty of Injunctive Relief	1405
л.	Herb Reed Enterprises, LLC v. Florida Entertainment	1403
	Management, Inc.	1405
	Comments	1411
В.	Scope of Injunctive Relief	1412
	King-Seeley Thermos Co. v. Aladdin Industries, Inc.	1412
	Charles Jacquin et Cie, Inc. v. Destileria Serralles, Inc.	1415
	Comments	1420
C.	Monetary Relief	1421

xxii	i	Contents

	Maltina Corp. v. Cawy Bottling Co.	1422	
	Comments	1428	
	Problems	1431	
	Tamko Roofing Products, Inc. v. Ideal Roofing Co., Ltd.	1433	
	Comments	1437	
СН	IAPTER 14		
	Trade Secrets		
Int	Introduction		
A.	Defining a Trade Secret	1440	
	Learning Curve Toys, Inc. v. Playwood Toys, Inc.	1440	
	Bondpro Corp. v. Siemens Power Generation, Inc.	1452	
	Comments	1456	
	Problem	1457	
B.	Reasonable Steps to Preserve Secrecy	1457	
	Incase, Inc. v. Timex Corp.	1457	
	Comments	1460	
C.	Misappropriation of Trade Secrets: "Improper Means"	1461	
	E.I. DuPont de Nemours & Co. v. Christopher	1462	
	Comments	1465	
D.	The Employer-Employee Relationship	1466	
	Procter & Gamble Co. v. Stoneham	1466	
	RLM Communications, Inc. v. Tuschen	1471	
	PepsiCo, Inc. v. Redmond	1478	
	Comments	1485	
Tal	Table of Cases		
Ind	Index		