

SKILLS & VALUES: INTELLECTUAL PROPERTY

LEXISNEXIS LAW SCHOOL PUBLISHING ADVISORY BOARD

William Araiza

Professor of Law

Brooklyn Law School

Lenni B. Benson

Professor of Law & Associate Dean for Professional Development

New York Law School

Raj Bhala

Rice Distinguished Professor

University of Kansas, School of Law

Ruth Colker

*Distinguished University Professor & Heck-Faust Memorial Chair
in Constitutional Law*

Ohio State University, Moritz College of Law

David Gamage

Assistant Professor of Law

UC Berkeley School of Law

Joan Heminway

College of Law Distinguished Professor of Law

University of Tennessee College of Law

Edward Imwinkelried

Edward L. Barrett, Jr. Professor of Law

UC Davis School of Law

David I. C. Thomson

LP Professor & Director, Lawyering Process Program

University of Denver, Sturm College of Law

Melissa Weresh

Director of Legal Writing and Professor of Law

Drake University Law School

SKILLS & VALUES: INTELLECTUAL PROPERTY

Courtney G. Lytle

Adjunct Professor of Law
Emory University School of Law

Library of Congress Cataloging-in-Publication Data

Perry, Courtney Lytle.

Skills & values. Intellectual property / Courtney Lytle Perry.

p. cm.

Includes index.

ISBN 978-1-4224-7844-8 (soft cover)

1. Intellectual property—United States. I. Title. II. Title: Intellectual property.
III. Title: Skills and values.

KF2980.P46 2011

346.7304'8—dc22

2011007639

This publication is designed to provide accurate and authoritative information in regard to the subject matter covered. It is sold with the understanding that the publisher is not engaged in rendering legal, accounting, or other professional services. If legal advice or other expert assistance is required, the services of a competent professional should be sought.

LexisNexis, the knowledge burst logo, and Michie are trademarks of Reed Elsevier Properties Inc., used under license. Matthew Bender is a registered trademark of Matthew Bender Properties Inc. Copyright © 2011 Matthew Bender & Company, Inc., one of the LEXIS Publishing companies. All Rights Reserved.

No copyright is claimed in the text of statutes, regulations, and excerpts from court opinions quoted within this work. Permission to copy material exceeding fair use, 17 U.S.C. § 107, may be licensed for a fee of 10¢ per page per copy from the Copyright Clearance Center, 222 Rosewood Drive, Danvers, Mass. 01923, telephone (978) 750-8400.

Editorial Offices

121 Chanlon Rd., New Providence, NJ 07974 (908) 464-6800

201 Mission St., San Francisco, CA 94105-1831 (415) 908-3200

www.lexisnexus.com

MATTHEW  BENDER

(Pub.3305)

Summary of Contents

PART I

Copyright

Chapter 1: Hope, Change and Infringement 3

Copyright – Fair use. Students analyze a fact pattern based on the Obama campaign poster infringement issue. Optional memorandum drafting exercise.

Chapter 2: Jumping Through Hoops 15

Copyright – Copyright Registration. Students complete on-line Copyright Application.

Chapter 3: How Many Years Can a Mountain Exist? 17

Copyright – Term and Termination of Transfers. On-line quiz covering various aspects of copyright duration under 1976 and 1909 Acts.

Chapter 4: My Sweet Lord 43

Copyright – Infringement and Independent Creation. Students draft an original judicial opinion addressing the infamous *My Sweet Lord* infringement case. Optional oral argument exercise.

Chapter 5: Trash, Treasure and Tacky 51

Copyright – Useful items. On-line pictorial review of copyrightability of various useful and functional items.

PART II

Trademark

Chapter 6: Versus 59

Trademark – Infringement and Likelihood of Confusion. On-line collection of marks from trademark lawsuits. Students analyze the marks and try to predict the holding and reasoning.

Chapter 7: Waya Soap 69

Trademark — Registration. Students analyze the relative strengths of a new mark and complete an on line Trademark Application. Optional Opposition Proceeding Exercise.

Chapter 8: By Any Other Name. 85

Trademark — Famous Name Dispute and Domain Name Rights. Students research and analyze client’s rights in response to a “cease and desist” letter.

PART III

Applied IP: Licensing And Software Protection

Chapter 9: Copyleft and Licensing 99

Copyright — Creative Commons, GNU and Standard Licensing. Students review three different examples of license agreements and compare the different strategies and protections.

Chapter 10: CyberAlchemy 165

Patent/Copyright — Protecting Software Rights. Students analyze a fact pattern involving a start up Software Company and devise a strategy for protecting the company’s IP. Optional client interview exercise.

Chapter 11: Where No Man Has Gone Before. 191

Trademark — Name and Likeness Protection. Students review a client’s concerns regarding product endorsement and revise a draft agreement to reflect desired terms.

Chapter 12: Legacy of the Cluefall 201

Copyright /Trademark — Licensing and Negotiation. Students are assigned to opposing sides in a negotiation for rights to create video games based on successful novels. Optional contract drafting exercise.

PART IV

Patent

Chapter 13: FlingWing 233

Patent — Standards and Application. Students analyze a client’s invention for patentability and review a file of prior art.

Chapter 14: Building A Better Mousetrap 295

Patent — Patent Abuse. Students review some unlikely patents collected on line and complete an online search for similar interesting patents.

Chapter 15: Ersatz University. 303

Patent/Combined IP — Protection Strategy. Students review overall business plan of an on line university and provide advice for modifying potential infringing activity and developing a protection strategy for corporate IP.

Table of Contents

PART I COPYRIGHT	1
Chapter 1: Hope, Change and Infringement – Fair Use and Derivative Works	3
Overview: Copyright Infringement, Fair Use and Derivative Works	3
1. Copyright Law in the Digital Era	3
2. Fair Use Defense to Copyright Infringement	4
A. The First Factor: The Purpose and Character of the Use	7
B. The Second Factor: The Nature of the Copyrighted Work	9
C. The Third Factor: The Amount Used	9
D. The Fourth Factor: The Effect on the Market	10
E. Balancing the Factors	10
Exercise	11
Assignment	13
Chapter 2: Jumping Through Hoops – Copyright Registration	15
Exercise	15
Chapter 3: How Many Years Can A Mountain Exist? Copyright Term and Termination of Transfers	17
Overview: Duration of Copyright	17
1. The Politics of Term Limits – Copyright Style	17
A. Lawrence Lessig on <i>Eldred v. Ashcroft</i>	17
B. Justice Ginsburg on <i>Eldred v. Ashcroft</i>	25
2. The Mechanics	33
A. Duration of Copyright	33
i. Duration of Copyright – 1976 Act	33
ii. Duration of Copyright – 1909 Act	33
iii. Duration of Copyright – Gap Works	35
B. Termination of Transfers	36
i. Section 203	36
ii. Section 304	37
iii. Derivative Works and Termination of Transfers	38
3. Summary of the 1909 Act Rules	39

4. Summary of the 1976 Act Rules.....	39
5. Important Dates.....	40
Exercise.....	41
Chapter 4: My Sweet Lord – Copyright Infringement . . .	43
Overview: Infringement	43
1. Elements of Infringement.....	43
A. Copying – Probative Similarity.....	44
B. Illicit Copying – Substantial Similarity.....	45
2. Independent Creation	47
Exercise.....	49
Chapter 5: Trash, Treasure and Tacky – Useful Items and Copyright	51
Overview : Pictorial, Graphic and Sculptural Works.....	51
Exercise.....	55
PART II TRADEMARK	57
Chapter 6: Versus – Infringement and Likelihood of Confusion	59
Overview: Likelihood of Confusion.....	59
Exercise.....	68
Chapter 7: Waya Soap – Trademark Registration	69
Overview: Trademark Registration Standards	69
1. Strength of a Proposed Mark.....	69
A. Generic Marks	69
B. Descriptive Marks	69
C. Suggestive Marks	70
D. Arbitrary, Fanciful and Coined Marks.....	70
2. Doctrine of Foreign Equivalents.....	70
3. Filing a Trademark Application.....	74
4. Opposition Proceedings.....	75
Exercise.....	77
Waya Soap: Part One.....	77
Waya Soap: Part Two.....	79
Waya Soap: Part Three	80
Chapter 8: By Any Other Name – Domain Name and Trademark Infringement	85
Overview: Domain Name Disputes	85
1. Primary Source – UDRP	86
2. Primary Source – ACPA/Lanham Act	89

3. Recent Developments	93
Exercise.....	94

**PART III APPLIED INTELLECTUAL PROPERTY:
LICENSING AND SOFTWARE PROTECTIONS . . . 97**

Chapter 9: Copyleft and Licensing 99

Overview: Approaches to Licensing	99
1. The Creative Commons	99
A. Creative Commons Materials – “About Licenses”	101
B. The “Legal Deed”	103
C. License Agreement	105
D. Conclusion	110
2. GNU General Public License	111
A. GNU in a Nutshell	114
B. The Current Version (3.0) of the GNU GPL	122
3. Copyright License – Standard Approach	134
A. Traditional Copyright Licensing Issues	134
B. Traditional Approach License – Lexis/Nexis Form	136
C. License Drafting Checklist	146
Exercise.....	164

**Chapter 10: CyberAlchemy – Protecting Software:
Copyright, Patent and Other Options 165**

Overview: Software Protection	165
1. Copyright Protection for Software	165
A. Historical Background	166
B. Current Status	177
2. Patent Protection for Software	178
3. Trade Secret Protection for Software	179
4. Grass Roots Protection Options – Anarchy and Copyleft	180
A. The GPL Trap	181
5. Ownership of Rights – Employee/Employer Relationships.....	181
A. Patent Law and Employee Issues	181
B. Copyright Law and Employee Issues	182
i. Scope of Employment.....	182
ii. Written Work Made For Hire Agreement.....	183
6. Client-Focused Legal Advice.....	184
Exercise.....	187
CyberAlchemy: Part One	187
CyberAlchemy: Part Two.....	189

**Chapter 11: Where No Man Has Gone
Before – Licensing 191**

Exercise.....	191
---------------	-----

Chapter 12: Legacy of the Cluefall — Negotiating a Licensing Agreement	201
Overview: Licensing Terms and Negotiation Tactics	201
1. Negotiation: The Basic Steps	201
A. Preparation.....	201
B. Introduction and Information Exchange	203
C. Offer and Counter-Offer.....	204
D. Agreement	205
Exercise.....	206
PART IV PATENT	231
Chapter 13: FlingWing — Patent Application	233
Overview: Filing a Patent	233
1. Patent Standards.....	233
A. Patentable Subject Matter.....	233
i. Process claims	233
ii. Product claims.....	236
B. Originality	237
i. Novelty.....	237
ii. Utility.....	238
iii. Non-obviousness	238
2. Role of the Patent Attorney.....	239
Exercise.....	240
Chapter 14: Building A Better (or Patenting a Worse) Mousetrap — Patent Abuse	295
Overview: Business Method and Software Patents	295
Exercise.....	297
Chapter 15: Ersatz University — Patent/Combined IP Strategy	303
Exercise.....	303