

UNDERSTANDING INTELLECTUAL PROPERTY LAW

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Third Edition

by

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PREFACE TO THE THIRD EDITION

During the past four years, there have been a number of important developments in U.S. intellectual property law. Foremost among them was the adoption, in September 2011, of the America Invents Act, the most significant change to U.S. patent law since the 1952 Patent Act. Before the AIA, if two parties applied to patent the same invention, the patent was granted to the person who first conceived the invention or reduced it to practice (first-to-invent). The first-to-invent principle still applies to all applications filed before March 16, 2013, and to all patents granted on those applications. For applications filed on or after March 16, 2013, however, the AIA grants the patent to the first person to file a patent application on the invention. This change means that patent lawyers will have to know and apply two different standards when litigating patents for the next 20 years or so. The AIA also implemented a number of other changes, including de-emphasizing the best-mode requirement and post-grant review of patents.

The Supreme Court has been unusually active in reviewing intellectual property cases in the past four years. During that period, it has reviewed and decided 15 patent cases (including three cases on patentable subject matter), four copyright cases, and four trademark or false advertising cases. In addition, the federal Courts of Appeals have decided more than 750 patent cases, 250 copyright cases, and 400 trademark and false advertising cases during that time. While not all of these decisions warrant mention in a student hornbook, all had to be considered in deciding what material needed to be updated.

Once again, this volume would not have been possible without the combined efforts of many people. Tyler Ochoa updated Chapters 1, 4, and 6; Shubha Ghosh updated Chapters 2 and 3, and Mary LaFrance updated Chapter 5. The authors would like to thank Elisabeth (Biz) Ebben, our editor at LexisNexis Publishing, for all of her work in reviewing our submissions and her careful attention to the page proofs.

We hope that find the hornbook helpful in navigating the fascinating but complex world of intellectual property law.

Tyler T. Ochoa
Shubha Ghosh
Mary LaFrance

March 15, 2015

PREFACE TO THE SECOND EDITION

Nineteen years is a long time in any field of law, but it is a lifetime in the fast-changing world of intellectual property law. So when we undertook to revise and update Don Chisum and Michael Jacob's landmark hornbook *Understanding Intellectual Property Law*, we knew we were in for a challenge. Not only did two decades worth of new developments have to be added to the text, but the length had to be shortened from over 1200 pages to a more manageable size.

Not surprisingly, the task required more than one person. While the original hornbook was largely the effort of a single individual, Donald Chisum, aided and abetted by six colleagues from Morrison & Foerster who wrote one of the chapters (on trade secret law) and six shorter sections, the Second Edition is largely the product of three authors, with some assistance from three other contributors. Tyler Ochoa revised and updated Chapter 1 (Introduction) and Chapter 4 (Copyright), and the majority of Chapter 6 (Other IP Rights), and also edited all of the other submissions for style and consistency. Shubha Ghosh was primarily responsible for updating Chapter 2 (Patent) and Chapter 3 (Trade Secret). For Chapter 5 (Trademark), we retained only some introductory language from Chisum's text; the rest was adapted by Mary LaFrance from her own hornbook, *Understanding Trademark Law* (2d ed. 2009). In Chapter 6, the section on Design Patents was revised by Daniel Brean; the section on Plant Patents was revised by Keith Aoki; and the section on Idea Submission was revised by Ganka Hadjipetrova.

The authors would like to thank all of the contributors who made the Second Edition possible, and to thank our editor at LexisNexis Publishing, Christine Frost, and her staff. We also owe a big note of thanks to Tyler's administrative assistant, Channing McCabe, who spent many tedious hours correcting formatting errors in the conversion from the previous edition. We hope you enjoy the product of our combined efforts.

Tyler T. Ochoa
Shubha Ghosh
Mary LaFrance

February 1, 2011

PREFACE TO THE FIRST EDITION

Donald Chisum began work on his basic intellectual property text in 1987. Mr. Chisum became of counsel to Morrison & Foerster in 1990, and the firm's Intellectual Property Group brought the project to fruition. Mr. Chisum wrote the major chapters on patent, copyright, and trademark law, and sections on design protection, plant protection, unfair competition and misappropriation. Michael Jacobs, San Francisco, the Group's co-chairman, wrote the trade secrets chapter with Neal Stender's substantial assistance. Mr. Jacobs also reviewed portions of the copyright chapter. Kim Landsman, New York, wrote the false advertising and trademark remedies sections. Mr. Landsman also reviewed portions of the trademark chapter. Jonathan Band, Washington, D.C., wrote the publicity rights section. Laurie Hane, San Francisco, wrote the copyright remedies and idea submission sections. Grant Kim, San Francisco, wrote the semiconductor chip protection section.

Mr. Chisum's academic background and Morrison & Foerster's spirit of inquiry, professionalism, and extensive intellectual property practice combined to make this book possible. The authors collected the relevant statutes, regulations, and court decisions and describe intellectual property law's evolution up to mid-1991 as accurately and objectively as possible. The book does not present personal views or the position of Morrison & Foerster or its clients on any particular point of law. Nor does it predict the law's future course. United States law has always been in flux; it is a process not a structure. Like a river crossing a plain, it will meander, but when and to where no one can say with certainty; environmental changes may affect the way the river changes. In no area is this more true than with intellectual property.

Mr. Chisum acknowledges West Publishing Company's assistance in providing him access to "WESTLAW" to prepare this book. Having written a multi-volume treatise on patent law the old-fashioned way with dusty books, 3" x 5" cards, and an IBM Selectric typewriter, he appreciates the speed, thoroughness and accuracy of data searching, quotation fetching, and word processing.

Barbara Nielsen, Mr. Chisum's editorial assistant, edited the entire text and verified its citations and quotations. She encouraged us to write directly, clearly, and without excessive verbiage. To the extent our style falls short of that goal, it is not for want of effort by Ms. Nielsen.

Donald S. Chisum
Michael A. Jacobs
Morrison & Foerster

San Francisco
October 4, 1991

