

# **An Outline of US Copyright, Patent and Trademark Law**

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# US Copyright Law

**Copyrights** are rights to copy, distribute, display and perform creative works. They are one of the basic forms of **intellectual property**.

This text discusses copyright law as it applies in the United States. This concise presentation necessarily omits a number of important provisions of a very complex area of law.

## Introduction

### History of US copyright law

American copyright law traces its lineage to the English **Statute of Anne**, passed in 1710. The Statute provided that authors of books had an exclusive right to their works for fourteen years, which could be renewed by the author for an additional fourteen years.

After the American Revolution, many states passed statutes modeled on the Statute of Anne. Because the laws were different from state to state, the Constitutional Convention decided that the new Congress should have the power to pass a national copyright statute, and added a clause in Article I to that effect. The statute was enacted as the **Copyright Act of 1790**, one of Congress's first laws. Like the Statute of Anne, it provided a 14-year initial term, renewable for an additional 14 years, and it only applied to books. Over the next century, the 1790 Act was expanded to cover other types of works.

The next major revision of the Act was passed as the **Copyright Act of 1909**. The 1909 Act doubled the term of copyrights to 28 years, renewable for an additional 28, and expanded protection to cover all written works in the US as well as many foreign works. Both the 1790 Act and the 1909 act required a number of formalities before copyright would attach: these formalities are described later.

The **Copyright Act of 1976** formed the basic copyright law regime which the US follows today. It provided a single copyright term: the life of the author, plus fifty years (seventy-five years from fixation in the case of corporate authors). It eliminated many of the required formalities and applied copyright at the moment the work was "fixed" in a tangible medium of expression.

Since then, the main revisions to the 1976 Act have been the **Audio Home Recording Act** of 1992, adding new laws pertaining to digital audio recordings; the **Sonny Bono Copyright Term Extension Act** of 1998, extending the term of copyright for an additional twenty years (see [Duration](#)); and the **Digital Millennium Copyright Act** of 1998, imposing new rules on high-tech works.

## Copyrightable works

To be copyrightable, a work must be an **original work of authorship** that is **fixed in a tangible medium of expression**. These requirements are often shortened to **creativity** and **fixation**.

### Original works of authorship

An original work of authorship can be just about anything. 17 U.S.C. § 102(a) lists eight basic kinds, by way of example:

1. **Literary works** - Any work expressed in letters, numbers, or symbols, regardless of medium. This Wikibook is a literary work under the Copyright Act. Computer source code is also considered to be a literary work. If a literary work is fictional, its characters, plot, structure and other devices can be copyrighted along with the actual text, but only to the extent that they are original and expressive.
2. **Musical works** - Original musical compositions. Actual performances of music are covered as a different type of work, a "sound recording." 17 U.S.C. § 115 provides that anyone may create a sound recording of any composition, so long as they pay that composer a set licensing fee.
3. **Dramatic works** - Distinguished from literary works in that they direct a performance through written instructions.

4. **Choreographic works** - Added in the 1976 Act. They must be "fixed," either through notation or video recording.
5. **Pictorial, graphic and sculptural works** - Any two-dimensional or three-dimensional art work may be copyrighted as a PGS work. These works are constrained by the "useful article doctrine" described below, which serves to keep copyright and patent law divided.
6. **Audiovisual works** - Includes films, television programs and any other work that combines audio and visual components.
7. **Sound recordings** - Any magnetically or digitally recorded audio work (except the accompanying audio to a visual work, which is treated as part of the audiovisual work). Unlike musical works, there is no statutory licensing of sound recordings. While anyone may produce a rendition of an artist's *composition* by paying him the statutory fee, they may not reproduce his *recordings* without his express permission.
8. **Architectural works** - Added in the 1976 Act. Copyright in architectural works only extends to aesthetics. If a design element is "functionally required," it is not protected by copyright. See H.R. Rep. No. 101-735 (1990) and "Useful article doctrine," below.

## Idea vs. expression

Copyright does not protect ideas, whether they are fact, opinion or fantasy. It only protects the *expression* of those ideas.

Compilations of facts, such as encyclopedias, dictionaries and even telephone directories, can receive copyright protection. But the facts *themselves* cannot be copyrighted—only the expression of those facts can be copyrighted. This means that many database providers cannot rely on copyright to protect their data from being republished: they must rely on licenses and other elements of contract law. In other cases, the law of unfair competition can prevent one business from using another's compilations of information in an unfair way. See *Intl. News Serv. v. Associated Press*, 248 U.S. 215 (1918) (holding that INS could not re-report AP news stories on the West Coast for commercial advantage).

In the realm of software, source code and object code are copyrightable, but other elements of a program may not be. User interfaces, for instance, are generally not copyrightable: see *Apple Computer v. Microsoft*, 35 F.3d 1435 (9th Cir. 1994) (icons and desktop appearance of Windows not copyrightable); *Lotus Development v. Borland Intl.*, 49 F.3d 807 (1st Cir. 1995) (menu structure of Lotus 1-2-3 not copyrightable).

## Useful article doctrine

Many pictorial, graphic and sculptural works are also patentable as useful inventions. If the creative component of a work cannot be separated from its functional component, it is considered an **industrial design** and it cannot be copyrighted. This is known as **conceptual separability**. One well-known example is the Brandir Ribbon bicycle rack, which adopted an artistic design quite different from previous bicycle racks. Because the creativity of the design was inseparable from its functionality, the rack was deemed protectable only through patent law. *Brandir Intl. v. Cascade Pacific Lumber*, 834 F.2d 1142 (2d Cir. 1987). For more on patents, see the Wikibook on [US Patent Law](#).

## Government works

Works of the U.S. federal government are not copyrighted. 17 U.S.C. § 105; see also *Wheaton v. Peters*, 33 U.S. 591 (1834) (official reporter of the Supreme Court unable to protect annotations of Supreme Court opinions).

State statutes and court opinions are generally considered to be public domain as well, because of a public policy interest in allowing citizens unrestricted access to the law. See *Nash v. Lathrop*, 6 N.E. 559 (Mass. 1886) (state statutes held to be public domain); *Veeck v. Southern Bldg. Code Cong. Intl.*, 293 F.3d 791 (5th Cir. 2002) (model statutes enter public domain when enacted).

However, other state government works can be copyrighted when the creator of the work needs an economic incentive; see *Co. of Suffolk v. First Am. Real Estate Solutions*, 261 F.3d 179 (2d Cir. 2001) (county allowed to hold copyright in tax maps).

## Fixation

*Fixation* requires that the work be recorded in a form that can be perceived directly or by means of a device "now known or later developed." Writing, drawing, sculpting, recording and making notations all count as fixation. Improvisational and/or unrecorded performances of music, dance or drama are likely to be creative but not fixed. Something that is typed on a computer but never saved to a permanent storage medium might also be unfixed (but once the work is saved, it is fixed).

## Formalities

Under the 1790 and 1909 Acts, formalities were a necessary prerequisite to copyright protection. The 1976 Act made many of these formalities unnecessary to receive protection, and since US accession to the Berne Convention, formalities are generally not required for copyright protection, although they give the copyright holder some distinct advantages if followed. There are three sets of rules for formalities:

- Works created before January 1, 1978 follow the rules of the 1909 Act.
- Works created between January 1, 1978 and March 1, 1989 follow the rules of the 1976 Act.
- Works created after March 1, 1989 follow the rules of the Berne Convention Implementation Act.

## Notice

The 1909 Act required that all published works carry the "©" symbol or the word "Copyright," the year of first publication, and the name of the author in order to receive copyright. The 1976 Act eased the particularities of the notice requirement, but kept it as a prerequisite to copyright protection.

Today, notice is not a requirement. The Berne Convention Implementation Act of 1989 made notice unnecessary on all works first published after March 1, 1989. Notice is still encouraged by the law, however. If a work carries copyright notice, the notice bars other parties from claiming "innocent infringement" as a defense. 17 U.S.C. § 401.

## Publication

Under the 1909 Act, publication had two important legal purposes: it applied federal copyright protection to the work, and it removed common law copyright protection. Courts eventually determined that there were two types of publication. **Investive publication**, the type that would apply federal protection, did not have to be widespread: it could be among a small group of people. Federal protection would not attach unless notice and other formalities were followed, but in the absence of such formalities, common law protection would still apply. **Divestive publication**, the type that would remove common law protection, had to be on a larger, more general scale. The 1976 Act changed the law so that federal copyright protection attaches upon fixation, not publication. This eliminated the entire concept of investive publication. Divestive publication remained in a different form: if a work was offered to the public without copyright notice and other formalities, it would lose its copyright protection under federal law.

Since 1989, publication has had no effect upon the validity of copyright. It still has relevance to post-1989 works: it determines when deposit is required, and it determines the term length for works by corporate authors, among other purposes.

## Registration

Copyright registration has never been a requirement for protection, but it has always been helpful to authors. The most important aspect of registration, which applies under all three copyright regimes, is that registration is a prerequisite to suing for infringement. Note that registration can occur after the infringement itself, but it must be made before any suit is filed.

Under the 1909 Act, registration was also necessary before renewing a copyright. This meant that not registering a copyright effectively halved its term.

## Deposit

When a person registers a copyright, they must supply two copies of the work to the Library of Congress. 17 U.S.C. § 408. The deposit requirement also applies to any work published in the United States for which copyright is claimed within three months of publication. 17 U.S.C. § 407.

## Rights

### Rights conferred by copyright

The actual rights contained within a copyright are:

- **Right to copy.** This right includes all exact or substantially similar reproduction of the work.
- **Right to make derivative works.** Derivative works include translations, adaptations to other media (for instance, movies based on books, books based on movies, toys based on movies, movies based on other movies, books based on other books, art works based on photographs, etc.), annotations and editorial revisions. Unauthorized derivative works receive no copyright protection, even for their original elements.
- **Right to distribute.** The author has the right to control the sale and importation of their work, subject to the "first sale doctrine" described under Infringement.
- **Right to publicly perform.** Performance applies to dynamic works such as drama, music and choreography. Any act that makes such works perceivable to viewers or listeners is a performance; "public" generally means in an environment "open to the public." Note that authors have no performance right in a sound recording, although there is a performance right in musical compositions.
- **Right to publicly display.** Display applies to static works such as photography and sculpture. Generally, the owner of a copy has the right to display their copy to anyone present at the place where it is located: this means that authors cannot keep art works out of galleries. The display right is generally invoked to stop broader displays of a work, such as on a television broadcast or web site. Note that authors have no display right in architectural works.

### Ownership of copyright

When an individual single-handedly creates a work, they receive the copyright in that work.

When an individual creates a work within the scope of their employment, their work is considered a **work for hire** and, in the absence of a contrary provision in the contract, the copyright goes to their employer. The doctrine is governed by the common law of agency, so independent contractors are not considered to be working for hire; see *Community for Creative Non-Violence v. Reid*, 490 U.S. 730 (1989) [1]. Some works of non-employees may be considered to be works for hire, but only "if the parties expressly agree in a written instrument signed by them": such works include translations, contributions to collective works, atlases and parts of motion pictures. 17 U.S.C. § 101. Courts generally except university professors from this rule: they usually have copyright in their work regardless of whether it was made in the scope of their employment. See *Hays v. Sony Corp of Am.*, 847 F.2d 412 (7th Cir. 1988).

When a work has more than one author, the authors can have **joint ownership**. To receive joint copyright, the authors must each contribute an independently copyrightable contribution, and must intend their contributions be merged into a unitary whole. This is often governed by contracts between authors, but can also be inferred from the parties' roles in the creation of the work; see *Aalmuhammed v. Lee*, 202 F.3d 1227 (9th Cir. 2000).

**Collective works** such as periodicals, anthologies and encyclopedias can be copyrighted independently of their contributions. The authors retain copyright in their individual contributions, but the compiler has copyright in the entire collective work. 17 U.S.C. § 201(c).

### Duration

The duration of copyright has been continuously extended by legislation throughout the 20th century. The most recent legislation, the Sonny Bono Act of 1998, extended copyright terms for an additional 20 years after intense

lobbying by the entertainment industry. This was challenged on constitutional grounds (that Congress could not keep extending copyrights indefinitely), but the Supreme Court's decision in *Eldred v. Ashcroft*, 537 U.S. 186 (2003) [2], held the act to be constitutional. The current duration rules are as follows:

<b>Date of creation</b>	<b>Date copyright attaches</b>	<b>Duration of copyright</b>
Created before 1978 but unpublished	January 1, 1978	Life of the author plus 70 years
Published between 1923 and 1963	Date of publication	28 years, with an option to renew for 67 years. If not renewed, public domain.
Published between 1964 and 1977	Date of publication	95 years
Created 1978 or later	Date of fixation	For individual authors, life of the author plus 70 years. For corporate or anonymous authors, 95 years from publication OR 120 years from creation, whichever is less.

## Division and transfer

Like real property, a copyright can be subdivided and its parts can be transferred to others. This was not always the case: under the 1909 Act, a copyright was only transferrable in its entirety: transferring part of a copyright was interpreted as a **license**, akin to a lease of property. Under the 1976 Act, a transfer of a copyright or part of a copyright is valid if executed in writing and signed by the copyright owner. 17 U.S.C. § 204.

The Copyright Act also contains provisions for **termination of transfer** in 17 U.S.C. §§ 203 and 304(c). These provisions allow the original author of many types of work to "take back" their copyright at a certain date after transferring it.

- Authors of works created after 1977 may terminate transfers between the 35th and 40th year following the execution of the transfer.
- Authors of works created before 1978 may terminate transfers between the 56th and 61st year of copyright protection.
- The transfer to an employer of a work made for hire may not be terminated. This includes all motion pictures, sound recordings and contributions to collective works (e.g. magazines and anthologies).

## Infringement and other offenses

### Infringement of right to copy

To find infringement of the right to copy, a court must find **copying** and **improper appropriation** of the copyrighted work by the accused infringer.

### Copying

Independent creation of a copyrighted work is not considered to be copying. This means that copying cannot be proven from similarity alone. There are two ways to prove copying.

The first is through *direct evidence*. Some authors (especially authors of factual compilations such as phone books) plant minor errors in their works so there will be obvious evidence of any copying. In other cases, there may be evidence of the infringer's admission to copying.

The other way to prove copying is through *circumstantial evidence*. The factors in this analysis are **access** and **similarity**. If the author of the accused work had access to the original, and the accused work has sufficient similarities to the original, a court can conclude that copying took place.

## Improper appropriation

While copying is a fairly straightforward analysis, improper appropriation is often more difficult. When a work is copied word for word (or bit for bit), the copying can generally be considered to be improper appropriation. The more difficult case is when only part of a work is copied—for example, when characters or plot devices from a literary work, or a chord progression or melody from a musical composition, are copied to create a derivative work. The key to improper appropriation is **substantiality** of the copying. Copying an insubstantial part of a work is not likely to constitute infringement. Whether copying is substantial is still a difficult question. In *Nichols v. Universal Pictures*, 45 F.2d 119 (2d Cir. 1930), Judge Learned Hand concluded that "the proper approach" in answering the question must be "more like that of a spectator, who would rely upon the complex of his impressions of each character." This is known as the *subjective test* for improper appropriation. Some other courts, particularly in the Ninth Circuit, apply an *objective test* that compares each copyrightable element of the two works to determine to what extent the accused work copies the original.

Note also that in some circumstances, certain works or certain parts of works can legally be copied under the **fair use** doctrine, discussed later.

## Infringement of right to distribute

Copyright owners also have the sole right to distribute copies of their work, whether through sales or otherwise. This includes the right to import: 17 U.S.C. § 602 bans unauthorized importation of copyrighted works, except for certain personal or educational uses.

The key exception to this right is the **first sale doctrine**. Once a legal copy is sold, the copyright holder has no further control over its distribution. The only exceptions to this doctrine are sound recordings and computer programs, which cannot be rented out even after their first sale. 17 U.S.C. § 109.

## Contributory and vicarious infringement

**Contributory infringement** is a common law doctrine famously stated in *Gershwin Publishing v. Columbia Artists Mgmt.*, 443 F.2d 1159 (2d Cir. 1971): "One who, with knowledge of the infringing activity, induces, causes or materially contributes to the infringing conduct of another, may be held liable as a 'contributory' infringer."

**Vicarious infringement** is a separate but related doctrine applied to those who have the power to halt infringing conduct, and derive a financial benefit from the infringing conduct.

The two doctrines can be found together, but can also be found separately. Contributory infringement is a tort doctrine; it requires knowledge and participation. Vicarious infringement is more closely related to agency. A person can be liable for vicarious infringement simply because of their relation with the infringer (e.g. an employer can be liable for employees' infringement on the job). Both types of infringement are equivalents of direct infringement. The most famous contributory and vicarious infringement case is *Sony v. Universal City Studios*, 464 U.S. 417 (1984) [3]. The Supreme Court was deeply split on the issue, but a 5-4 majority decided that Sony was not liable for contributory infringement from the sale of its Betamax VCRs. "The sale of copying equipment," wrote Justice John Paul Stevens, "like the sale of other articles of commerce, does not constitute contributory infringement if the product is widely used for legitimate, unobjectionable purposes. Indeed, it need merely be capable of **substantial noninfringing uses**." The Court went on to find that "time shifting," the act of videotaping a broadcast to watch it later, was a form of fair use even if unauthorized, and therefore not infringing. Similar logic was applied to MP3 players in *RIAA v. Diamond Multimedia Systems*, 180 F.3d 1072 (9th Cir. 1999) (holding "space shifting" to be a substantial noninfringing use).

The rapid growth of the internet has led to a number of developments in contributory and vicarious infringement law. One early fear was that the doctrines would lead to potentially limitless liability for any person operating a system that processed infringing data. The Digital Millennium Copyright Act of 1998 created a "safe harbor" for ISPs and server operators, protecting them from contributory infringement as long as they (1) have a policy of terminating users who are repeat copyright infringers, (2) adopt standard copyright protection measures, and (3) register an agent with the Copyright Office to receive infringement claims from copyright owners. The safe harbor applies to systems involved in the routing, storing, caching, and linking of copyrighted data.

Despite the safe harbor, some online services have been found liable for contributory and vicarious infringement. The best-known examples are the Napster and Grokster file sharing services, both of which were forced to shut

down after they were unable to effectively police their content to stop infringement. *A&M Records v. Napster*, 239 F.3d 1004 (9th Cir. 2001); *MGM Studios v. Grokster*, 545 U.S. \_\_\_\_ (2005) [4].

## Criminal offenses

### Criminal infringement

17 U.S.C. § 506(a) provides that an infringer faces criminal liability in two situations:

1. When their infringement is "for purposes of commercial advantage or private financial gain."
2. When they distribute "1 or more copies or phonorecords of 1 or more copyrighted works" with a total value of greater than \$1,000 within any 180-day period.

Criminal infringement is punishable by up to ten years in prison (for repeat offenders). See 18 U.S.C. § 2319.

### Circumvention

The DMCA contains provisions to criminalize the **circumvention** of copy protection technology. See 17 U.S.C. § 1201 et seq. These provisions have been used to stop a variety of activities. The publishing of DVD decryption code was deemed illegal in *Universal City Studios v. Corley*, 273 F.3d 429 (2d Cir. 2001). Later, in *U.S. v. Elcom*, 203 F.Supp.2d 1111 (N.D. Cal. 2002), anticircumvention law was used to enjoin the publication of software that could convert copy-protected Adobe eBooks to unprotected PDF files.

One unintended consequence of the anticircumvention law was a flurry of litigation involving producers of after market accessories for electronic devices. Two cases decided in 2004 made it clear that the DMCA would not cover such anticircumvention claims. In *Lexmark Intl. v. Static Control Components*, 381 F.3d 1178 (6th Cir. 2004), anticircumvention protection was denied to a printer manufacturer after another company reverse engineered codes for its proprietary ink cartridges. In *Chamberlain v. Skylink Technologies*, 381 F.3d 1178 (Fed. Cir. 2004), the court ruled that buyers of garage doors were free to reverse engineer the code on their garage door opener, since otherwise they couldn't open their own garage.

### Other offenses

- Publishing of a fraudulent copyright notice, or fraudulent removal of a copyright notice, is punishable by a fine of up to \$2,500. 17 U.S.C. §§ 506(c)-(d).
- False representations in a copyright application are punishable by a fine of up to \$2,500. 17 U.S.C. § 506(e).

## Defenses

### Fair use

The most common defense to copyright infringement is **fair use**. It is a highly vague (and therefore highly versatile) doctrine. The Copyright Act provides (17 U.S.C. § 107) that a finding of fair use depends on:

1. The "purpose and character of the use"—e.g., whether it is for profit or for educational purposes.
2. The "nature of the copyrighted work."
3. The "amount and substantiality of the portion used in relation to the copyrighted work as a whole."
4. The "effect of the use upon the potential market for or value of the copyrighted work."

While all four factors must be considered, they are not exclusive: courts can (and do) consider other factors in ruling on whether use of a copyrighted work counts as fair use. Examples of fair use include:

- **Parody**, most likely to be found when the work is criticizing the original upon which it is based.
- **Copying for personal use**, such as the "time shifting" permitted by *Sony*, the "space shifting" permitted by *Diamond* and photocopying of books for research purposes. But if such copying is used to escape licensing provisions (as may be the case with software or technical journals), it may not be considered fair use.

## License

A person may copy a copyrighted work if the original author has given them a **license** to do so. Licenses are often in writing, but they need not be: if the copyright owner gives verbal consent to another person, that person is legally entitled to copy the work to the extent allowed by the owner. Note, however, that transferring the entire copyright requires a written contract or deed.

More precisely, an **exclusive license** gives the "licensee" (the recipient of the license) the right to prevent others from using the work. An exclusive license must be in writing. A non-exclusive license allows the licensee to use the work, but does not give the licensee the power to grant or deny a license to anyone else. A **non-exclusive license** does not have to be in writing.

## Copyright misuse

**Copyright misuse** is a fairly recent (and not universally accepted) doctrine that seeks to prohibit the use of copyrights for anti-competitive purposes. It is connected to antitrust law and derived in part from the [patent misuse](#) doctrine.

## Statute of limitations

Under 17 U.S.C. § 507, a civil suit for copyright infringement can only be brought within three years "after the claim accrued." A claim accrues every time a work is illegally copied and every time an infringing work is illegally sold or transferred, so statute of limitations defenses are usually very difficult to successfully assert. Also under § 507, the statute of limitations in criminal cases is five years.

# US Patent Law

**Patents** are temporary monopolies granted to inventors by the government, in exchange for public disclosure of how the invention works. They are one of the basic forms of **intellectual property**. This text outlines patent law as it is applied in the United States.

## Introduction

### History of patent law

The idea of patents dates back to Aristotle, but the earliest patent system was implemented in Venice in 1474. England issued its first patents under Elizabeth I and established a patent system in the **Statute of Monopolies of 1624**, the country's first antitrust law as well as its first patent law (barring all monopolies except over disclosed inventions).

Colonial governments in British North America issued patents as early as 1641, but the separate patent systems in each state led to problems as the colonies became better interconnected. The best-known of these problems was a conflict over the steamship patent in the late 1700s. These issues led the Constitutional Convention to add a clause to the Constitution permitting Congress to enact a national patent regime.

The **Patent Act of 1790** created a very simple structure for granting patents, consisting of a three-member panel led by the Secretary of State (at that time, Thomas Jefferson). In 1836, the law was revised to provide for a system of **patent examiners**, similar to that which is used today. Today's patent law mostly dates to the **Patent Act of 1952**. In 1982, Congress created the **Court of Appeals for the Federal Circuit (CAFC)** to hear patent appeals from across the country. One of the purposes for the Federal Circuit was to bring patent doctrine under the watch of a specialist court. Under the Federal Circuit, patents have strengthened, and more inventors have filed to take advantage of this stronger patent protection.

### Parts of a patent

The key components of a patent are the **claims**, which set its legal scope, and the **description**, which shows others how to reproduce the invention.

#### Claim

From a lawyer's perspective, the **claims** are the most important component of a patent. The claims are what define the scope of the patent—which devices its monopoly will cover, and which devices will be unprotected.

Infringement cases always revolve around the claims, not the description, although the description can help to clarify the meaning of the claims.

Many claims follow a **means plus function** structure, which allows the claim to be adapted to future technological progress. A "motive means for turning a turntable" could include various types of electric motors, hand cranks, or even hamster wheels.

Note that while the claim can be broad and rather non-descriptive, the patentee still has to have a physical invention to show for their efforts, and the other parts of the patent have to illustrate how that invention is built. Moreover, the terms of the claim have to be construed strictly.

#### Written description

From a researcher's perspective, the **written description** following the claims is the most important component of a patent. It shows how the invention works and how it is made and used.

The main purpose for the written description is **enablement**. Based on the description, a person having ordinary skill in the art should be able to build and use the invention.

The written description also has a more legal purpose: it shows exactly what the inventor has discovered. This can limit the breadth of the claims. A famous example is Sawyer and Man's patent on the light bulb, in which the description discussed various filaments made of paper and wood, none of which were particularly superior for use in light bulbs. When Sawyer and Man tried to use their patent against Thomas Edison, his lawyers had it invalidated because its claims, covering all fibrous materials, were much broader than the materials Sawyer and Man had actually outlined in the description. *The Incandescent Lamp Patent*, 159 U.S. 465 (1895).

The description must disclose the **best mode** of carrying out the invention. The idea is that a person cannot gain the monopoly of a patent without letting the public know how their invention works. If they were allowed to keep the best mode secret, they would be getting something for nothing. In *Bayer AG v. Schein Pharmaceuticals*, 301 F.3d 1306 (2002), the Federal Circuit established a two-prong test for finding best mode violations:

9. Did the inventor have a best mode of practicing the invention at the time they filed for the patent? If they didn't know of, or believe in, a best mode at that time, then there is no best mode violation.
10. Is the disclosure in the patent specification adequate to enable a person having ordinary skill in the art to practice the best mode of the invention?

## Types of patent

### Utility patents

Most patents are **utility patents**, so called because they cover "useful" processes and products. This text focuses on utility patents.

A utility patent can cover a physical **product** (e.g. a chemical compound), or it can cover a **process** for using a product (e.g. a method for creating a chemical compound). The scope of these concepts has changed over time. For example:

- **Artificially-created organisms** were not patentable as products until the Supreme Court's decision in *Diamond v. Chakrabarty*, 447 U.S. 303 (1980), which held that a genetically-engineered bacterium was a "nonnaturally occurring manufacture or composition of matter" entitled to product protection.
- **Business methods** were not patentable until the Federal Circuit's decision in *State Street Bank v. Signature Financial Group*, 149 F.3d 1368 (1998), holding that a patentable process need not act on anything tangible.

A utility patent is in effect from the date the patent issues until twenty years from the date the application for patent was filed, so long as periodic maintenance fees are paid.

### Design patents

**Design patents** are awarded to original designs for articles of manufacture. Like utility patents, design patents require novelty and nonobviousness. There is no utility requirement, but there are two other criteria for design patents. First, they must have **ornamentality**—they must be "the product of aesthetic skill and artistic conception." Design patents must also be **not primarily functional**. If the design is primarily functional, it should be the subject of a utility patent, not a design patent.

Design patents last for fourteen years.

### Plant patents

**Plant patents** can be granted for any distinct and new variety of asexually-reproducing plant. Overall, plant patents are not as strong as utility patents in terms of protection.

Plant patents last for seventeen years.

## Patent procedure

The process of obtaining a patent is called **prosecution**. It varies greatly in duration. The average prosecution takes about three years from start to finish, but a prosecution can be completed within one year in some cases, or drag on

for decades. Most of this time is due to backlogs in the Patent Office: the total time spent examining an application is 18 hours on average.

## Filing

The process starts when an **application** is filed with the Patent Office. The application contains the components which will form the final patent—the **specification** (summary and description) and the **claims** (the "new" portions of the invention, which will be protected by the patent). The application must be signed under oath and accompanied by a filing fee.

If an inventor is not ready to file an application, they can file a **provisional application**. The provisional application mainly serves to ensure the inventor has priority, a concept discussed later. After filing a provisional application, the inventor has twelve months to file their actual application.

An inventor can file for a patent on their own, but most inventors enlist the help of a person who has passed the **Patent Bar Examination**. If this person has a law degree, they are known as a **patent attorney**. Trained scientists and engineers can also take the examination: they have the title of **patent agent**. The only practical difference, besides educational background, is that patent attorneys are also qualified lawyers and (if admitted to a state bar) can take patent infringement cases to court.

## Inside the Patent Office

The Patent Office is divided into eight **Technology Centers**, each of which deals with a specific area of technology:

- Technology Center 1600: biotechnology and organic chemistry
- Technology Center 1700: chemical and materials engineering
- Technology Center 2100: computer architecture software and information security
- Technology Center 2600: communications
- Technology Center 2800: semiconductors, electrical and optical systems and components
- Technology Center 2900: designs
- Technology Center 3600: transportation, e-commerce, construction, agriculture
- Technology Center 3700: mechanical engineering, manufacturing and products
- Technology Center 3900: reexaminations

Each center is divided into several **examining groups**, and each examining group is divided into several **art units**. Some groups are highly specialized to deal with fields that deal with many patent applications (Electronic Commerce). Other groups are more diverse (e.g. Aeronautics, Agriculture, Fishing, Trapping, Vermin Destroying, Plant and Animal Husbandry, Weaponry, Nuclear Systems, and Licensing and Review—a single examining group). The art units are staffed by **patent examiners** who perform the actual examination of the application, usually after a waiting period of about a year. The examiner reviews each claim separately.

If a claim is unpatentable, because of prior art or for other substantive reasons, the examiner issues a **rejection** of the claim. The applicant can either **acquiesce** (agree) to the rejection, or **traverse** (contest) it. One way to traverse a rejection is to file for a **continuation**, which sends new claims to the examiner without the long wait associated with the first application.

If the claim is unpatentable for formalistic reasons, the examiner issues an **objection**. This most often happens when more than one invention is claimed in a single application: in such cases, the inventor can divide their claims into separate applications, which are then processed on their own.

Should the applicant and the examiner reach an impasse, the applicant can file an appeal to the **Board of Patent Appeals and Inferences**, an administrative tribunal within the Patent Office.

## Contesting a patent

Once a patent is granted, it can be contested in a number of ways. One way is to produce the patented device, and then argue the patent's validity when a suit for infringement is brought.

A person may also request a **reexamination** of a patent by the Patent Office. Historically, the patent office only considered prior art (e.g., documents) that were not considered in the initial examination, that is, on the face of the patent. However, recent revisions to PTO regulations enable the PTO to consider previously considered art so long as a substantial new question of patentability is raised.

Note that two types of reexamination exist- ex parte reexamination and inter partes reexamination. In ex parte reexamination, a 3rd party requestor's involvement is curtailed after filing the request for reexamination. In the case of inter partes reexamination, the requester is allowed a degree of participation- but note that estopped provisions may apply.

Finally, a person can bring suit against the patentee in federal court for a **declaratory judgment** of the patent's invalidity. As federal courts can only consider "cases and controversies" under article III of the constitution, a defendant seeking a DJ must demonstrate reasonable apprehension...typically in the form of threatening communications from the patentee.

## Patentability

As described above, utility patents can be granted for **products** or **processes**. They cannot be granted for ideas; they must pertain to the application of an idea. That application must meet the basic requirements of **utility**, **novelty**, and **nonobviousness**.

### Utility

To be patentable, an invention must be "useful." This requirement is known in patent law as **utility**. There are three "types" of utility that appear in precedent: together, they form the notion of "utility" as it is applied by the Patent Office.

**General utility** is the notion that a patentable invention must "do something." It must have a useful function of some kind. In practice, it is not difficult to find a function for an invention: an invention can be purely entertaining and still be useful.

**Specific utility** refers to the ability of the invention to perform its function. It is the most commonly invoked form of utility. The specific utility doctrine is used to invalidate inventions such as perpetual motion machines, which may have a formal function but which are highly unlikely to fulfill that function.

**Moral utility** is a theory that an invention designed for an immoral purpose should not be patentable. It has not been invoked to invalidate patents in recent years, leading many to conclude that it is a dead doctrine. Some examples of moral utility:

- **Gambling devices.** The doctrine was used to invalidate many gambling machine patents in the 19th and early 20th centuries. A number of other patents were invalidated simply because they *could* be used for gambling—inventions like coin return devices and horse racing games. However, by the 1970s, gambling machines were routinely receiving patents despite the moral utility arguments.
- **Misleading devices.** One well-known early example was a patent for seamless stockings with fake seams: at the time (the 1920s), stockings with seams were widely viewed to be higher-quality than seamless stockings, so the fake seams were seen as an attempt to defraud consumers, and the patent was rejected. This line of jurisprudence ended in 1999, when the Federal Circuit upheld a patent for the Juicy Whip machine. The Juicy Whip is a lemonade dispenser which circulates an inert yellow liquid inside a visible tank while dispensing actual lemonade from a hidden tank below the counter: the Federal Circuit said that deceptiveness should not affect the utility of an invention.
- **Medicines of questionable safety.** Today, the Patent Office leaves such issues to the judgment of the FDA, and does not deny drug patents on the basis that the drug is unsafe.

### Novelty

"A person shall be entitled to a patent unless the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent." 35 U.S.C. § 102(a).

**Novelty** is the requirement that an invention be different from everything that has been published, known or marketed before.

The following definitions apply when discussing novelty and its related issues of statutory bar and priority:

- Knowledge or use by others must be in public. Personal or experimental use does not count, but giving or selling the invention to any third party usually counts as public knowledge or use, unless the third party is expressly bound to secrecy.
- Description in a printed publication occurs when the publication is made available to at least one member of the general public. So when a magazine is sent to subscribers or a dissertation is shelved in a library, the one-year clock begins for any inventions described therein.

## Statutory bar

"A person shall be entitled to a patent unless the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States." 35 U.S.C. § 102(b).

**Statutory bar** is similar to novelty, but not the same. Novelty can only be destroyed by others because it is based on the date of invention. Statutory bar is based on the date of filing. The doctrine essentially prevents inventors from waiting too long to request a patent. Once an inventor patents, publishes, publicizes or sells their invention, they have only one year to file for a U.S. patent, or else they lose their right to it.

Another way to conceptualize statutory bar is as priority of application, while novelty is priority of invention.

## Experimental use

**Experimental use** is an exception to both novelty and statutory bar. An inventor can use their invention in public for experimental purposes without that use counting as "public use," so long as the use is a *bona fide* effort to bring the invention to perfection or ensure that it will answer its designated purpose. The best known example of this exception is found in *City of Elizabeth v. Pavement Company*, 97 U.S. 126 (1877), where an inventor tested an experimental pavement on a public street for several years. This use was held to be "experimental use" and novelty was not affected.

## Priority

In the United States, a patentee must be the **first to invent**. This is different from many other countries where the patent is given to the **first to file**. To be the first to invent, the inventor must generally be:

3. the first person to reduce the invention to practice
4. without abandoning the invention.

There is one exception. If someone *conceives* the invention first but is not the first to reduce it to practice, they receive priority *if* they were diligent in reducing the invention to practice.

"Reduction to practice" is the earliest date where the inventor can prove that they produced or applied the product or process successfully. Filing for a patent is considered to be the legal equivalent of reducing to practice if no earlier date can be proven.

## Nonobviousness

"A patent may not be obtained... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made." 35 U.S.C. § 103.

**Nonobviousness** adds an additional inquiry to novelty: is the invention new *enough*? The standard inquiry to determine nonobviousness is:

5. Would the prior art suggest to those of ordinary skill in the art that they should make the claimed device or carry out the claimed process?
6. Would the prior art have revealed that those of ordinary skill would have a reasonable expectation of success in doing so?

To reach this conclusion, the factfinder must examine:

1. The scope and content of prior art
2. The differences between the claimed invention and the prior art

3. The level of ordinary skill in the art
4. "Objective evidence of non-obviousness"—commercial success, long-felt unsolved need, failure of others, copying, and unexpected results.

The "objective evidence" in point 4 is controversial among scholars. The Federal Circuit requires such evidence to be taken into account, but the Supreme Court does not.

## Infringement

### Literal infringement

Literal infringement is found when a person makes, uses, sells, offers for sale or imports an invention described in the claims of someone else's patent. The invention must contain every element of at least one claim in order to infringe the patent: if it fails to meet any part of the claim, it does not infringe that claim.

### Infringement by equivalents

Even if the invention does not meet the literal criteria of a claim, it can infringe that claim by **equivalents**. To do so, it must have the "substantial equivalent" of every limitation or element of the claim.

The doctrine of equivalents has limitations. It cannot be used to expand a claim to an extent that would have made it invalid. It cannot, for instance, broaden the claim to include prior art.

One difficult area for equivalents doctrine is improvements in technology. Claims are sometimes interpreted to include new technological advances that do not literally fall within their scope. For example, the patent for a light beam-assisted pipe-laying tool was held to cover laser-assisted tools as well in *Laser Alignment v. Woodruff & Sons*, 491 F.2d 866 (7th Cir. 1974). But other patents have not received protection under equivalents doctrine based on an **entirety of the technology** argument. A Texas Instruments patent on handheld calculators was not extended to cover models with MOS transistors and LCD readouts, on the grounds that "all of the claimed functions are performed in the accused devices by subsequently developed or improved means." *Tex. Instruments v. U.S. Intl. Trade Commn.*, 805 F.2d 1558 (Fed. Cir. 1986).

### Contributory infringement

"Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer." 35 U.S.C. § 271(c).

Unlike direct infringement, contributory infringement requires knowledge of the patent's existence.

A related concept is **inducement**. "Whoever actively induces infringement of a patent shall be liable as an infringer." 35 U.S.C. § 271(b). Inducement can be found in a variety of activities: telling someone to violate a patent, selling parts to builders of infringing devices, and so on.

## Defenses

### Inequitable conduct

If a patent is obtained through **inequitable conduct**, it may be rendered unenforceable (but not invalid). Patent applications that contain blatant falsehoods or omissions (e.g. concealing prior art known to the inventor) can lead to the entire patent being rendered unenforceable.

## Patent misuse

**Patent misuse** refers to the use of a patent to illegally stifle competition: it is closely tied to antitrust law. The doctrine was first applied in *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502 (1917), where manufacturers licensed a film projector patent under the condition that the projectors must be licensed to end users so that they could only be used with films covered by the manufacturers' patent. A finding of patent misuse invalidates the entire patent.

## Remedies for infringement

### Injunctions

Following a complaint for infringement, a court can issue a **preliminary injunction** to stop the accused infringing action. The Federal Circuit's test for awarding a preliminary injunction is:

1. Reasonable probability of eventual success in the litigation
2. Complainant will be irreparably injured if relief is not granted
3. Possibility of harm to others from the grant or denial of the injunction (optional)
4. Public interest militating in favor of or against injunction (optional)

If the complainant prevails at trial, a **permanent injunction** against the infringement is almost always issued

### Damages

Damages for patent infringement are generally based on **lost profits**, which are based upon demand for the product, presence or absence of substitutes, the patent holder's capacity to exploit demand, and the amount of profit the patent holder would have made.

If lost profits cannot be proven, a **reasonable royalty** analysis can be substituted, in which damages are based on the amount a manufacturer would pay on the market for a license to produce the patented article.

# US Trademark Law

**Trademarks** are distinguishing devices used by businesses to distinguish their goods and services from those produced by others. They are a basic form of **intellectual property**. This text outlines trademark law as it applies in the United States.

## Introduction

### History of trademark law

Although trademarks are the oldest form of intellectual property and have been protected at common law for decades, they were the last to be protected by a federal statute in the US, and infringement cases were very rare until the late 19th century.

The first trademark statute, enacted in 1870, was struck down by the Supreme Court in *The Trade-Mark Cases*, 100 U.S. 82 (1879), for exceeding the powers granted by the patent and copyright clause of the Constitution. Congress responded with the **Trademark Act of 1881**, which was based on its Commerce Clause powers.

The current federal trademark statute is the **Lanham Act of 1946**, codified in Title 15 of the United States Code.

### ® or ™?

The Lanham Act establishes a procedure for **registration** of trademarks. If a trademark meets certain qualifications, it can be listed on the **Principal Register**, which affords it many benefits. Other trademarks can be listed on the **Supplemental Register**, which exists to allow trademarks not otherwise registrable in the United States to be registered in foreign countries that require home-country registration first. Registration is not mandatory to receive trademark protection, but trademarks on the Principal Register receive significantly stronger protection than unregistered trademarks.

Among other criteria, registered trademarks may not be "immoral, deceptive or scandalous," or "disparage or falsely suggest a connection with persons, institutions, beliefs or national symbols." They may not be "merely descriptive," "deceptively misdescriptive," "primarily geographically misdescriptive," "primarily merely a surname," or "functional." See 15 U.S.C. § 1052.

Trademarks on the Principal Register can be marked with the ® symbol to denote their higher level of protection. Unregistered trademarks or trademarks on the Supplemental Register can be marked with the ™ symbol. Both symbols exist to place third parties on notice that they may infringe the trademark by using it without authorization.

## Types of protected mark

Trademark law protects **marks**. Marks can be words, names, symbols or devices. They come in several classes:

### Trademark

Strictly speaking, a **trademark** is a mark that distinguishes one person's goods from others'. In practice, the word "trademark" is often used to refer to any class of mark that is protected under trademark law.

### Service mark

A **service mark** is similar to a trademark, except that it is used to distinguish one person's services from others'. Service marks are registrable in the same manner as trademarks and are denoted by the ® symbol once they are registered. If they are not registered, they often carry an "sm" symbol.

## Trade name

A **trade name** is a mark used to identify a business, as opposed to a good or service. The Lanham Act does not allow trade names to be registered unless they also function as trademarks or service marks by identifying the source of a good or service. However, many states allow trade names to be registered and protected under state law.

## Certification mark

A **certification mark** is a mark used to certify a good in some way, regardless of its specific source. Seals of approval (e.g. the Good Housekeeping Seal of Approval) and marks of origin (e.g. Roquefort cheese) are examples of certification marks. A certification mark is held by an organization and is protected under trademark law so long as the holder establishes a standard for awarding the mark and polices that standard effectively.

## Collective mark

A **collective mark** is a mark held by a group for the use of its members. Examples include union stamps and franchise marks. Collective marks are treated like regular trademarks and service marks under the Lanham Act.

## Trade dress and product configuration

**Trade dress** refers to the distinctive packaging of a product. One example of trade dress is the decor of a restaurant chain. Trade dress is protected if it is inherently distinctive.

**Product configuration** refers to the distinctive design and shape of a product. The best-known example is the glass Coca-Cola bottle. A product configuration must have **secondary meaning** to be protected, regardless of whether it is inherently distinctive or not. Secondary meaning means that the appearance of the product should indicate its source to a consumer.

Both trade dress and product configuration can be registered as trademarks, but they are more often protected without registration as a "false designation of origin" under 15 U.S.C. § 1125(a). They pose special problems in trademark law because of their non-verbal nature. Words are easy to protect; more abstract designs are not.

# Trademarkability

## Distinctiveness

Marks in the form of words can be classified as either **arbitrary**, **fanciful**, **suggestive**, **descriptive** or **generic**. The nature of the mark determines the extent to which it is protected by law.

### Arbitrary, fanciful and suggestive marks

A "fanciful" mark has no meaning other than its meaning as a trademark. Examples include Xerox copiers, Lego bricks and Verizon phones. "Arbitrary" marks have a separate meaning, but that meaning has nothing to do with their use as a trademark. Examples include Apple computers, Diesel jeans and Ivory soap. "Suggestive" marks suggest a characteristic of a good or service without actually describing that characteristic. Examples include Coppertone sunblock, Earthlink internet service and jetBlue airline service.

Arbitrary, fanciful and suggestive marks receive highly similar treatment under the law. They are the strongest types of mark in that their holders do not need to prove a secondary meaning in order to protect the mark. Because there is no reason to associate Apple with computers, outside of the popularity of computers made by Apple Computer, third parties have few legitimate reasons to use the name "Apple" on their computers.

## Descriptive marks

A "descriptive" mark is one that identifies a characteristic of the article or service it marks. Examples include American Airlines (a **geographic mark**) and Dell Computer (a **surname mark**). Descriptive marks cannot be registered without proof that the mark has a secondary meaning in the eye of the consumer public. Even if a descriptive mark has a secondary meaning, its descriptive nature makes it possible to avoid trademark infringement liability through a **fair use** defense. A person could, for instance, use "American Airlines" in a commercial context to refer to airlines from America, so long as they were not using the term in its trademark sense.

## Generic marks

Generic marks, like "laptop computer," *cannot* receive trademark protection even if they have a secondary meaning. The rule against generic trademarks is particularly important for holders of famous marks, because their marks may lose protection if they become common nouns or adjectives in the public eye. Formerly-trademarked words like "aspirin" and "cellophane" have lost their protection due to **genericide**. Genericide is discussed in detail in the Defenses section.

## Non-verbal marks

A mark need not be a word or phrase. Besides trade dress and product configuration, discussed above, trademarks can also be found in sounds (e.g. the NBC chimes), colors, fragrances, and other distinctive features of a product. The most important criteria in determining their trademarkability is secondary meaning (whether the feature denotes origin to consumers) and whether the feature is **functional**. Functional features are not trademarkable: they must be protected under patent law if they are to be protected at all.

## Priority

Generally speaking, the owner of a mark is the person who is first to use that mark in commerce. This is known as the **race to the marketplace** test. For unregistered marks, protection only extends to the areas where marked products are sold or advertised, where their reputation is established, or where the owner is reasonably expected to reach in the normal expansion of their business. Registered marks automatically receive nationwide protection regardless of where they are used.

If two people use the same mark in the same region, the right to use the mark will be given to the first person to use the mark in that region. If one of the marks is registered, the unregistered mark will only prevail if it was in use before the application for the registered mark was filed, and the unregistered mark will only prevail in the area(s) where it was in use.

# Infringement

## Confusion

Confusion is one of the main grounds for a trademark infringement claim. It can take many forms, but the basic inquiry generally involves the same questions:

11. How strong is the mark being defended?
12. How similar are the products in question?
13. How similar are the marks in question?
14. Have consumers actually been confused?
15. Which marketing channels have been used?
16. How likely is the consumer to exercise care when purchasing the products in question?
17. What was the defendant's intent in selecting the mark?
18. How likely are the product lines to expand?

See *AMF v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979).

Infringement by confusion can involve:

- **Confusion between related products.** If one product is offered under a mark similar or identical to another, and the products would be confused by the buying public if sold under the same mark, trademark infringement can be found. Examples from actual infringement cases include Slickcraft and Sleekcraft boats, Bonamine and Dramamine medications, Pledge and Promise cleaners, and Duron and Durox paints.
- **Confusion as to source.** Confusion can also be found when the same or similar mark is applied to different types of goods. One early case, involving Borden milk and Borden ice cream, was deemed to be non-infringing in 1912; in more recent years, such cases have routinely led to findings of infringement.
- **Confusion as to sponsorship.** Even where consumers are unlikely to be confused as to source, they may be confused as to sponsorship. Team logo merchandise is a common example; consumers may expect that they are supporting the New York Yankees by purchasing a Yankees cap.
- **Initial interest confusion.** Sometimes, famous marks are used to lure consumers to different businesses. "Cybersquatting" by registering a well-known trademark as a domain name is one well-known example. Another is the use of meta tags to fool search engines: a little-known adult Web site may attempt to attract visitors by showing up in web searches for more well-known adult entertainment franchises. Both activities can be considered trademark infringement by confusion.
- **Post-sale confusion.** Post-sale confusion is often used to find infringement in counterfeit goods, such as fake watches and handbags. While the purchaser is likely to understand that they are buying a counterfeit product, the aim is to confuse others into thinking the product comes from a different source.
- **Reverse confusion.** Although confusion cases generally involve a little-known business using a well-known mark, confusion can also be found when a well-known business uses a little-known mark.

## Dilution

Trademark infringement can also be found in the absence of any confusion at all. Many trademarks are deemed to have a distinctive quality, and any third-party use that diminishes this distinctiveness is considered to be **dilution**, another form of infringement.

The textbook case of dilution is *Eastman Photographic Materials v. Kodak Cycle*, 15 R.P.C. 105 (Eng. 1898), in which the maker of Kodak cameras brought suit against a company producing Kodak bicycles. There was little chance of cameras being confused with bicycles: the risk was removing the Kodak name's association with cameras. The **Federal Trademark Dilution Act of 1995** added a dilution statute to the Lanham Act. Dilution can be found whenever a "famous mark" is used by another, "if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark." 15 U.S.C. 1125(c).

## Contributory infringement

Trademark law has a contributory infringement doctrine similar to those under [patent law](#) and [copyright law](#). Unlike its sister doctrines, however, contributory infringement of trademarks is not a very well-developed doctrine. It has come up in a few contexts, including cybersquatting liability and liability for landlords whose tenants sell counterfeit goods.

## Defenses to infringement

### Genericide

Many trademarks have been invalidated because they have lapsed from fanciful, arbitrary, suggestive or descriptive status to generic status. **Genericide** is a defense to trademark infringement: the use of a trademark that has become generic over time is not infringement. Examples include:

- aspirin; *Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921).
- cellophane; *DuPont Cellophane Co. v. Waxed Products Co.*, 85 F.2d 75 (2d Cir. 1936).
- shredded wheat; *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938).
- thermos; *King-Seeley Thermos Co. v. Aladdin Industries*, 321 F.2d 577 (2d Cir. 1973).
- Murphy bed; *Murphy Bed Door Co. v. Interior Sleep Systems*, 874 F.2d 95 (2d Cir. 1989).

Many companies, notably Xerox and Lego, have active campaigns to avoid the genericide of their trademarks: they insist that their marks be used as adjectives, not nouns, so as to avoid their trademarks becoming common terms for copying machines and interlocking blocks respectively.

## Functionality

The original *Trade-Mark Cases* invalidated Congress's first trademark statute on the grounds that trademark authority could not be based on the patent and copyright clause of the Constitution. There is still a sharp divide between patent and trademark law, illustrated by the doctrine that functional marks cannot be protected as trademarks. As stated above, **functionality** is most common when defending claims for infringement of trade dress and product configuration.

## Abandonment

Under the Lanham Act as amended in 1994, a mark is deemed "abandoned" "when its use has been discontinued with intent not to resume such use." Nonuse for three consecutive years is considered prima facie evidence of abandonment. 15 U.S.C. § 1127.

Some famous trademarks have been preserved through minor use by other companies. US Airways, for instance, preserves the trademarks of well-known but defunct Piedmont Airlines and PSA by operating some of its commuter flights under those names, and Chevron maintains the Standard Oil trademark by operating a small number of its filling stations under the Standard name.

## Non-trademark use

Use of a mark is only infringing if the mark is used *as* a mark. For instance, mentioning a mark in an article is generally not infringement. Using a mark as the basis of a song is generally not infringement ("Barbie Girl"; see *Mattel v. MCA Records*, 296 F.3d 894 (9th Cir. 2002)). Likewise, mentioning a mark in the title of a work, as in *The Lexus and the Olive Tree* or *The Devil Wears Prada*, is generally not infringement. However, using *Star Trek* in the title of an unauthorized book about Star Trek would likely infringe the mark, since the mark is used on other books authorized by its holder.

## Remedies

### Injunction

Injunctions are a standard remedy for trademark infringement. The usual injunction is to halt production and sale of infringing goods and services.

In some cases, the court might also award an injunction for **corrective advertising**, which forces the defendant to pay for an amount of advertising necessary to reverse the damage to the plaintiff's mark.

### Damages

Under 15 U.S.C. § 1117, damages for trademark infringement are based on:

5. defendant's profits
6. damages sustained by the plaintiff
7. cost of bringing the lawsuit

The plaintiff is responsible for proving the defendant's sales under point 1, as well as their own damages and costs under point 2 and point 3. The defendant is responsible for proving their costs to reach a final figure for defendant's profits

### Criminal counterfeiting

Knowingly copying another's trademark is considered **counterfeiting** and is a felony punishable by fines and imprisonment under 18 U.S.C. § 2320.

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