1. **Trade Secrets:** 
   1. **Information** of value that P takes
   2. **reasonable efforts to protect** and is
   3. **misappropriated.**

**-----------------------------------------------------------**

1. Generally:
   * 1. Uniform Trade Secrets Act (UTSA) adopted in all states *except* 4: MA, NY, NJ, TX.
     2. **Restatement of Torts §757 –** *trade secret is any secret information used in one’s business that gives its owner an opportunity to obtain an advantage over competitors who do not know or use it, and it was a secret.*
     3. **No novelty requirement.**
     4. **Patented software has TS protection** as long as state TS law allows reverse engineering.
     5. **Parties** – can sue anyone who used information they knew or should have known was misappropriated.
2. **Information** that derives economic value
   * 1. **UTSA - Cannot be readily ascertainable.** The more work the stronger the protection
     2. **Restatement factors:**
        1. extent to which the information is known outside claimant’s business
        2. extent to which it is known by employees and others involved in the business
        3. extent of measures taken by the claimant to guard the secrecy of information
        4. value of the information to the business and its competitors
        5. amount of effort or money expended by the business in developing the info
        6. ease or difficulty with which the information could be properly acquired
     3. **NY requires the information be in current use by P**, as this proves the value.
3. **Reasonable Efforts** to Keep Secret
   * 1. **TS is killed by disclosure:**
        1. a trade secret owner may publish the secret
        2. a trade secret owner may disclose the secret by selling a commercial product that embodies the secret
        3. trade secrets may be publicly disclosed by someone other than the trade secret owner
        4. trade secrets may be disclosed inadvertently
        5. government agencies sometimes require the disclosure of trade secrets in order o serve some other social purpose (e.g. the FDA requires ingredients)
4. **Misappropriation**
   * 1. **Use** (Dravo – shipping containers)
     2. **Disclosure –** e.g. departing employee. Consider independent creation and inevitable disclosure
     3. **Acquisition** (Dupont)
5. **Patents**
   1. **Patentable Subject Matter**
      1. **Products – Must be sufficiently isolated and purified**
      2. **Processes – Abstract ideas NOT patentable**
         1. **Medical Process Patents unenforceable against medical practitioners**
         2. **Software / Business methods patentable if result is useful, tangible, & concrete**
      3. **Improvements on Products/Processes**
   2. **Utility – Section 101 –** Invention must do something useful.
      1. **Types of Utility:** (Must have all)
         1. **General Utility** - Requirement for real-world utility, not just utility research interest.
         2. **Specific Utility** – Showing that *this thing* is useful
         3. **Credible Utility** – PHOSITA believes it has commercial potential.
      2. **Balance between scope and showing of utility**
   3. **Novelty & Statutory Bars – Section 102 (use All Elements Test)**
      1. **Novelty – 102(a) –** Cannot be known to others in US or published or patented elsewhere.
      2. **Statutory Bars – 102(b) – Grace Period –**application filed within one year of public disclosure.
   4. **Priority** **– Section 102(g)**
      1. **Suppression -** No priority if inventor abandoned, suppressed, or concealed his invention
      2. **Events used to Evaluate Priority**
         1. **Actual reduction to practice -** Constructing a working model of the invention
         2. **Constructive reduction to practice -** Filing an application at PTO
         3. **Conception of invention** **+** **diligence** – requires showing of continuous, reasonable efforts to reduce to practice.
   5. **Claim Interpretation**
      1. **Vocabulary**
         1. **“Comprising”** – A transition that denotes limitations will follow (“open claim”)
         2. **“Consisting of”** – A transition that denotes “nothing more, nothing less” can be used in technology (“closed claim”).
      2. **Elements**
         1. **Primacy of claim language –** ordinary meaning to PHOSITA at time of application
         2. **Specification and prosecution history**
         3. **Extrinsic evidence**
            1. Can never be used to contradict claim meaning that is unambiguous in light of the intrinsic evidence.
            2. Dictionaries are a good example.
            3. Experts don’t play much of a role, nor does industry jargon.
      3. **Terms not restricted solely to corresponding documentation** (Phillips; Baffles case)
         1. **Means Plus Function Language –** “plus a **means** for X, **which may** include Y, Z, etc.”
            1. Claims every possible way to X.
            2. **Triggers rule s.t. you then turn to the specification. Under DoE you are not looking only to the claims in interpreting the claim.**

**Does not apply if claim fully explains the means** (means for X **by**…)

* 1. **Non-Obviousness – Section 103**
     1. **Known components leading to a predictable result (e.g. modernization) is obvious**
     2. **Graham v. John Deere Test**: Is the invention a meaningful advance over prior art?
        1. **What is the scope and content of the prior art?**
        2. **What are the differences between the prior art and the claims at issue?**
        3. **What is the level of ordinary skill in the art? (PHOSITA has creativity)**
     3. **Hindsight Bias** can be reduced by **secondary considerations**
        1. Commercial success
        2. Long-felt unmet need
        3. Failure of others
        4. Copying
        5. Licensing
        6. Unexpected results.
  2. **Enablement – Section 112**
     1. **Written Description Requirement - This is essentially a disclosure requirement**
     2. **Must not require PHOSITA to do undue experimentation** (Sawyer)
     3. **Best mode requirement**
     4. **Written Description requirement** – Almost always satisfied.
        1. **Inventors must have envisioned the allegedly violating thing time of invention.**
  3. **Infringement**
     1. **Literal Infringement** uses **All Elements Rule**
     2. **Non-Literal Infringement**
        1. **Doctrine of Equivalents** – *Question of Fact – Use either test*
           1. **Triple Identity Test –** Equivalent (1) function, (2) means and (3) result
           2. **Insubstantial Difference Test –** only “insubstantial change” btw. P & D
           3. **Prosecution History Estoppel**
           4. **Dedication to the Public -** does not cover material disclosed but not claimed.
        2. **Contributory Infringement –** Section 271(c)
           1. Sale
           2. Component or material for an apparatus
           3. Constituting a material part of an invention
           4. **Knowing** that it is made of adapted for infringing use
           5. Not a staple or capable of non-infringing use.
  4. **Defenses**
     1. **Prosecution History Estoppel –** See above
     2. **Dedication to the Public** **–** See above
     3. **Inequitable Conduct:** (a) material failure to disclose or (b) false submission w/ intent to deceive
     4. **Misuse - Patent holder misuses patent after it is issued –** RecallMotion Picture Patents Co.
     5. **Experimental Use** *– LARGELY DEAD*
     6. **Prior use** in case of business method patents

1. **Copyright**
   1. **Subject Matter**
      1. **Originality -** Requires a **modicum of creativity**
         1. Selection and arrangement qualify (Roth Greeting Cards)
      2. **Fixation – Must be in a “fixed medium” s.a. writing, phonorecord, etc.**
      3. **Abstract Ideas or Facts Not Copyrightable**
         1. **Telephone book uncopyrightable** (Feist)
            1. *Was made in response to state regulation*
            2. *Names are facts, and no creativity in sorting alphabetically .*
         2. **Copyright on book explaining a process only protects that author’s explanation, and not the process itself.** (Baker)
            1. **Process may be patentable.**
         3. **Forms are not generally copyrightable a not enough expressive choice.**
         4. **Merger – When few expressive options, idea merges w/ expression and thus uncopyrightable.**
         5. **Scenes a Faire Doctrine** – Certain kinds of stock characters, settings just define a genre.
      4. **Characters are copyrightable only in 2 circuits (including the 9th)**
      5. **Copyright of Useful Articles**
         1. **If an object contains both functional and expressive elements, only the latter are subject to copyright.** (Mazer)
         2. **Seperability –** Only protect elements that can be separated from the item’s functionality
            1. **Physical Seperability –** *E.g. hood ornament is expressive as the car still works*
            2. **Conceptual Seperability**

**Denicola** **Test**–reflects artistic judgment unconstrained by function

**Newman** – “Conjures Up” a separate, non-functional aesthetic quality **Brandir Bike Test** – Was design focus on aesthetic or function?

***Other Tests****:*

Primary use – Whether utilitarian object or artistic work?

Marketable – Is the object marketable as art alone?

Primarily aesthetic

* 1. **Ownership**
     1. **Rights belong to author unless it is a work made for hire**
     2. **Works for Hire - Made within the scope of employment**

|  |  |  |
| --- | --- | --- |
| **a. Skill Required** | b. Whose Tools? | **c. Location of work** |
| **d. Duration** | **e. Level of employer control** | **f. Flexibility of scheduling** |
| **g. Method of payment** | **h. Assistants / Subcontractors?** | **i. Regular business of hirer?** |
|  | **j. Emp. Benefits / tax treatment?** |  |

* + 1. **Joint Works –** Both parties must intend work to be inseperable
       1. **Intent** - Objective manifestations of intent by both authors needed
       2. Did D superintend the work by exercising control, showing lack of intent to be joint?
       3. Does **audience appeal** turn on both’s inseparable contributions?
  1. **Term of Rights**
     1. **Individual – Life of author + 70 years**
     2. **Works made for hire – 95 years from publication (or 120 years from creation)**
  2. **Rights Granted**
     1. **Copying - exclusive right to make copies** of the work (or a substantial amount thereof)
     2. **Derivative works**
     3. **Distribution** – Recall **First Sale Doctrine**
     4. **Performance and display** – control public (but not private) performance and display
     5. **Anticircumvention** – See DMCA
     6. **Moral rights**
        1. **Owner has right to assert authorship** of work.
        2. **Owner can prevent intentional distortion, mutilation, or other modification**
  3. **Infringement – Must show both:**
     1. **Copying**
        1. **Test: Similarity and Access** (sliding scale; Arnstein; copyrighted song case)
        2. **Test: Total Concept and Feel** (Roth Greeting Cards)
     2. **Unlawful Appropriation –** Must show both:
        1. **Was the copied material copyrighted?**
        2. **Would an ordinary observer find them to be *substantially similar*?**
        3. **Test: Abstraction** (for copyrighted plot; Nichols)
           1. Begin abstracting out the plot, and see how far you have to go before you have substantial similarity.
        4. **Test: Abstraction, Filtration, Comparison** – Use for software
     3. **Derivative Work?**
     4. **Indirect Infringement**
        1. Consider **Contributory / Vicarious** Infringement dichotomy
        2. **One who, with knowledge of the infringing activity, induces, causes, or materially contributes to infringing conduct of another**
        3. **No infringement if product is capable of substantial non-infringing use** (Sony)
        4. **Online Service Provider exception** protects ISPs that don’t monitor the content
  4. **DMCA** - cannot circumvent technological measure that effectively controls access to copyrighted work
  5. **Software - Use Abstraction Filtration Comparison test**
  6. **Defenses**
     1. **Independent Creation**
     2. **Functionality/Seperability (see IV (a)(iv)(2) above)**
     3. **Fair Use** –
        1. **Balance four nonexclusive factors** (Campbell) -
           1. **Purpose and character of use**

**Commercial v. Noncommercial**

**Transformative v. Superseding.** Should I be buying another copy?

* + - * 1. **Nature of copyrighted work**

**Thick or thin protection?**

* + - * 1. **Amount taken**
        2. **Market effect on peers (proper derivative use/licensing)**
      1. **Parody is protected. Satire is not.** Did D use more than necessary to **conjure up** parody?
      2. **Cover license - Compulsory license for people who cover another’s song.**

1. **Trademark**
   1. **Source means the producer of the chattel, not the content *unless* the content is inherently distinctive.**
   2. **Purposes:** (i) prevent consumer confusion (ii) encourage investment (iii) protect mark’s good will.
   3. **Distinctiveness**:
      1. **Abercrombie test:**
         1. **Generic** (e.g. Aspirin) – **Never acquires trademark protection**
         2. **Descriptive** – Characteristic or quality of the product. **Requires Secondary Meaning**
         3. **Suggestive** (e.g. CopperTone) **Inherently Distinctive.**
         4. **Fanciful** (e.g. Xerox) **or** **Arbitrary** (e.g. Apple Computer) **Inherently Distinctive.**
      2. **Trade Dress** (overall appearance thereof)can be protected
         1. **Must be distinctive** by (1) inherently distinctive or (2) acquired secondary meaning
         2. **D must have alternate designs available** (Merger)
         3. **Argument lessened if D took steps to warn public.**
   4. **Priority**
      1. **Acquire first rights either by (1) registration or (2) first commercial use**
      2. **What kind of use counts** to establish a mark?
         1. Quantity: Commercial use of type common in industry
         2. Intention to use
         3. Use is continuous
         4. Bona Fide
         5. Distributors (if arms length)
         6. Good Faith (Zazu)
         7. Potential of presale activity (e.g. advertising)
   5. **Immoral, Scandalous, disparaging marks**
   6. **Incontestability**
      1. **Requirements:** 
         1. Five years of continuous use
         2. no ownership clouds
      2. **Benefit**: Presumed to have secondary meaning after 6 years (defensive use of incontestability).
      3. **Uses:**
         1. **Mark cannot be attacked as Descriptive**
         2. *Can be attacked as functional*
   7. **Confusion –** Throughout, \* means may require use of mark
      1. **Source Confusion\* -** Standard passing off. B sells something as being made by A.
         1. **Factors:** (Sleekcraft)
            1. **Strength of the mark –** How well known is the marlk?
            2. **Proximity of the goods –** Are the goods similar?
            3. **Similarity of the marks**
            4. **Evidence of actual confusion**
            5. **Marketing channels used**
            6. **Type of goods and degree of care consumers exercise in purchase**
            7. **Defendant’s Intent -** Bad faith?
            8. **Likelihood of expansion of product lines**
      2. **Reverse Source Confusion** (Big O v. Goodyear)
      3. **Sponsorship**
      4. **Initial Interest Confusion\***
   8. **Dilution** (through (a) blurring or (b) tarnishment)
      1. **Elements**:
         1. **Commercial use by D**
         2. **of P’s famous mark after the mark because famous**, and
         3. **causes or is likely to case blurring or tarnishment.**
      2. **Remedy**: Injunction only.
      3. **Anticybersquatting Consumer Protection Act (ACPA)**
         1. **Elements:**
            1. **P’s mark is distinctive or famous**
            2. **D acted in bad faith to profit from registration**

**Factors**

Any IP of **D** in the name

Domain involves D’s name or

Use in offering of goods/services

Fair use

Intent to divert P’s customers.

Offer to sell

False personal info in domain registration

Registration/acquisition of multiple similar domains

Extent of mark’s distinctiveness.

**D cannot reasonably think they have a right to register the domain.**

* + - * 1. **Domain name and mark are identical or confusingly similar**
      1. **Remedy**: **Injunction**; or **Statutory damages** of $1,000 to $100,000 per domain.
    1. **False/Misleading Advertising**
       1. Significant part of audience holds false belief
       2. Injury is suffered by P
  1. **Defenses**
     1. **Genericness –** a valid TM must identify source, not product category (Murphy Bed)
     2. **Functionality**
        1. **Inwood** - functional feature is essential to the use or purpose/cost/quality of product
        2. **Qualitex***-* TM owner cannot gain a significant non-reputation-related advantage.
     3. **Abandonment**
        1. **Lack of use –** Constituting (i) stopped use and (ii) no intent to resume use
     4. **Lack of appropriate use** – Dawn Donut
     5. **Fair Use**
        1. Use is descriptive (Describes a product; see Zatarains)
        2. Use is in good faith (not done to poach good will)
     6. **Nominative Use**
        1. Product cannot be identified without using the mark.
        2. D can use the mark to the extent required to identify the product
        3. Cannot imply sponsorship or endorsement.
     7. **1st Amendment**
        1. May not propose commercial transaction

1. **State Protection**
   1. **Publicity Rights** – *Often CA based. Many states have no publicity rights.*
      1. **Tested based on Originality and Market Effect from Copyright Fair Use test.**
      2. **Defenses**
         1. **Fair Use –** Imitative or Expressive?
         2. **1st Amendment** – Cannot propose a transaction
   2. **Idea Submission**
      1. **Premised on either:**
         1. **Property** (requires (a) absolute novelty to D and (b) implied promise to pay)
         2. **Contract**
            1. **Disclosure conditioned on payment**
            2. **Condition accepted before disclosure**
            3. **Novelty to buyer.**
   3. **Federal Preemption**
      1. **Patent - States may not prohibit reverse-engineering or duplication allowed under Federal IP.** 
         1. May avoid harming chances to imitate by requiring labeling (Stiffel)
         2. Must respect balance between access and disclosure set forth in patent law
      2. **Copyright** 
         1. **State law invalid if:**
            1. ***Scope* – state law equivalent to a federal copyright right (Extra Element Test)**
            2. ***Subject Matter* – something that is either copyrighted, or otherwise belongs in public domain** (e.g. white pages)
            3. **Pro-CD – Extra element is that no rights against strangers.**
            4. **Bowers – Shrink wrap prohibition on reverse engineering valid due to extra element of negotiated contract.**

**5th cir. Holds prohibition on reverse engineering to be unenforceable.**

* + - * 1. **2d Cir has a “hot news” element**

1. **International Intellectual Property Law**
   1. **Cyberlaw 1.0** – The Old Worldview - **Borderless Internet, bordered law**
   2. **Cyberlaw 2.0** – The New Worldview - **IP has extraterritorial reach**
      1. **ACPA -** In rem jurisdiction over domain names – Can sue foreign domain owners.
      2. **DMCA applies to persons who committed the actions legally elsewhere**
      3. **For Direct Infringement in the case of** (RIM)
         1. **processes, all elements must be infringed in the US**
         2. **systems, all elements must be infringed (location irrelevant)**
            1. **D must have beneficial use and control situated in the US**
   3. **Grey Markets – First Sale Doctrine may trump importation or other rights.**