

- I. Types of Intellectual Property
 - a. Patents
 - b. Copyrights
 - c. Trademarks
 - d. Trade Secrets
 - i. Protected by state law only
 - e. Contracts
 - i. Software licenses
 - ii. Non-disclosure agreements
 - iii. Protected by state law only

- II. Guide to Analyzing Copyright Problems
 - a. What type of work (§§ 102 – 105)?
 - b. What right is being violated (§ 106)?
 - c. What exceptions or affirmative defences might apply (§§ 107 – 122)?

- III. Boundaries of Copyright
 - a. *Sony v. Universal Studios*: Purpose of copyright is to promote creativity; it is a trade-off between the benefits of encouraging creation and the costs of restricting access and use
 - i. Extending copyright to short phrases can hurt expression
 - b. Ownership of a copy is distinct from ownership of a copyright
 - c. Common-Law Copyright: The Right of First Publication
 - i. *Pushman v. New York Graphic Society*: If an object (e.g. a painting) is sold unconditionally, all common-law copyrights pass with it unless specifically reserved
 - ii. *Chamberlain v. Feldman*: If the seller shows an intent to retain the right of first publication, then the right will not be transferred with the sale
 - iii. Common-law copyright terminates upon publication
 - iv. *Hemingway v. Random House*: Oral communication can be subject to common-law copyright if notification of such is made
 - v. General Publication (that terminates right of first publication)
 - 1. When tangible copies of the work are distributed to the general public so as to allow the public dominion and control over the work
 - 2. Where the work is displayed in such a manner as to allow unrestricted copying of the work by the general public
 - d. Public performance is not a publication
 - e. § 1101: Anti-bootlegging provision
 - i. Only affects musical works; does not apply to speeches, etc.
 - ii. Does not pre-empt state law
 - f. Statutory Formalities
 - i. Notice
 - 1. 1909 Act: Notice was required or work was not copyrighted
 - 2. 1976 Act: Notice was still required, but could be cured (§ 405)
 - 3. 1988 Berne Implementation Act: Requirement of notice eliminated as of March 1, 1989
 - 4. Advantages of notice: Eliminates defense of innocent infringement
 - 5. Notice statutes: §§ 401 – 412
 - 6. *Hasbro Bradley v. Sparkle Toys*: Owners may cure a lack of notice even if the failure to notice was intentional
 - ii. Registration
 - 1. 1909 Act: Registration required
 - 2. 1976 Act: Registration optional
 - 3. Registration required in order to sue for infringement

- IV. Subject Matter of Copyright
 - a. Work of Authorship
 - i. *Burrow-Giles v. Sarony*: A photograph is a work of authorship
 - b. Original
 - i. Elements of originality
 - 1. Independent creation (original to author)
 - 2. Minimal degree of creativity
 - ii. *Burrow-Giles v. Sarony*: The originality of a photograph derives from the selection and arrangement of the objects in the photograph as well as lighting, etc.
 - iii. *Bleistein v. Donaldson Lithographing*: The commercial nature of a work does not render it un-copyrightable; nor must the work be of the “fine arts” or “useful”
 - iv. *Alfred Bell v. Catalda Fine Arts*: Anything more than a trivial variation is original
 - v. Creating a derivative work from a public domain work does not create a copyright in the public domain work; the copyright in the derivative extends to those portions original to the derivative
 - vi. *L. Batlin & Son v. Snyder*: Reproduction of a work in a different medium is not sufficiently original
 - vii. *Bridgeman Art Library v. Corel*: A slavish copy is insufficiently original
 - viii. You cannot create a new copyright (via a derivative work) with a trivial change
 - ix. *Feist Publications v. Rural Telephone Service*: Factual compilations are original insofar as the compiler selects and arranges the facts
 - 1. Originality is required by the Constitution; there must be a modicum of originality
 - 2. What is copyrighted is the selection and arrangement, not the facts
 - 3. “Sweat of the brow” doctrine is repudiated
 - x. Maps
 - 1. *U.S. v. Hamilton*: Maps have the same standard of originality as other works
 - 2. Legends and symbols are not copyrightable
 - 3. “Sweat of the brow” doctrine in maps repudiated
 - c. Fixed
 - i. Definition: § 101
 - ii. Images from video games are sufficiently fixed for the copyright statute
 - iii. The fixation must be authorized by the author
 - d. The Idea/Expression Dichotomy
 - i. *Baker v. Seldon*: Only an expression is copyrightable; ideas are not
 - ii. Forms and charts to be used with a system are not copyrightable (*Taylor Instruments*)
 - iii. *Harcourt Brace*: Machine-readable forms can be copyrightable because there are different ways to express the ideas
 - iv. *Continental Casualty v. Beardsley*: If a concept has only a limited number of ways to be expressed, the scope of protection will be lower
 - v. *Morrissey v. Proctor & Gamble*: If the number of ways to express an idea is extremely limited, the expression merges with the idea and becomes unprotectable (the merger doctrine)
 - vi. *Apple v. Franklin*: Computer programs
 - 1. Source code and object code is copyrightable as a literary work
 - 2. Computer code does not fall under the merger doctrine as there are multiple ways to write code to do the same thing
 - e. Useful Articles
 - i. *Mazer v. Stein*
 - 1. The design of a commercial article can be copyrighted
 - 2. You can have a design patent and a copyright in the same item
 - ii. Negatives and developed photographs are treated as the same work
 - iii. Software source code and object code are treated as the same work
 - iv. Conceptual Severability
 - 1. Only artistic features that are conceptually separate from the utilitarian aspect of the design of a useful article are copyrightable

2. *Kieselstein-Cord v. Accessories by Pearl*: Belt buckles had separate artistic features because they were not being used solely for their intended purpose
 3. *Carol Barnhart v. Economy Cover*: Aesthetic features required by the utilitarian design are not conceptually severable
 4. Conceptual severability exists where design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences
- v. An image of a useful object does not confer copyright in the useful object (§ 113)
- f. Architectural Works
- i. Protected by copyright after 1990 under § 102(a)(8)
 - ii. *Robert R. Jones v. Nono Homes* (prior to 1990 amendment)
 1. Buildings constructed using copyrighted blueprints do not infringe the copyright in the blueprints
 2. Construction using illegally copied blueprints is an infringement
 3. Measure of damages is lost profits on sale of the homes
 - iii. Only architectural works constructed after 1990 are protected by § 102(a)(8)
 - iv. Exceptions to copyrights in architectural works (§ 120)
 1. Does not prohibit pictures of the building if it is visible in a public place
 2. Owners of a building may alter the building or destroy it without consent of the copyright holder
- g. Choreography
- i. Protected by copyright under § 102(a)(4)
 - ii. Images of a dance could infringe the copyright in the choreography
 - iii. Football plays are not copyrighted under § 102(a)(4)
- h. U.S. Government Works
- i. Works made by the U.S. government are not copyrightable under § 105
 - ii. *Schnapper v. Foley*: Does not apply to works made pursuant to a contract with the U.S. government
 - iii. U.S. Government can own copyrights by assignment/transfer
 - iv. Does not apply to state/local governments
 - v. Judicial opinions are not subject to copyright, even if written by a state court judge
- i. False or Obscene Material
- i. Materials that are false or obscene are not precluded from copyright protection

- V. Infringement
 - a. *Arnstein v. Porter*: Elements of Infringement
 - i. Ownership of copyright
 - ii. Misappropriation
 - iii. Protected Expression
 - b. Misappropriation
 - i. Copying
 - 1. Admission (smoking gun)
 - 2. Access and similarity
 - 3. Striking similarity
 - ii. Misappropriation of protected expression
 - 1. Ordinary observer test
 - a. intrinsic – let the finder of fact decide whether the two works are substantially similar
 - b. For literary works, compare characters, plot structure, etc.
 - c. For visual works, substantial similarity consist of stylistic relationship
 - d. *Warner Bros. v. ABC*: For characters, use totality of character, total perception, and visual resemblance
 - e. *Computer Associates v. Altai*: Expert testimony is appropriate only in the case of computer programs, where the ordinary observer is a person with programming skill
 - f. *Shaw v. Lindheim*: Question of fact for the jury
 - 2. Abstractions test
 - a. *Nichols*: Abstract the elements of a work from expression to idea; protectable expression lies somewhere along the continuum
 - iii. You are free to copy the original, but you cannot copy the copy
 - iv. *Sheldon*: Defendants cannot defend infringement by demonstrating what was not copied
 - v. *Fred Fisher v. Dillingham*: Unconscious copying is still infringement
 - vi. *Selle v. Gibb*: Independent creation is a defence to copyright infringement
 - vii. Determining substantial similarity in visual works: compare stylistic elements, arrangement of objects, etc.
 - viii. *King Features v. Fleischer*
 - 1. Copying into a different medium is still infringement
 - 2. Characters can be copyrighted
 - ix. The public domain can be used only to point out non-protectable elements
 - c. Copyrights in Characters
 - i. *DC v. Bruns Publications*
 - ii. *Warner Bros. v. ABC*
 - 1. Visual resemblance
 - 2. Totality of character; total perception
 - d. Summary Judgement
 - i. *Arnstein v. Porter*: Infringement is generally a question of fact left for the jury
 - ii. For defendant when copying is only of non-protectable elements
 - iii. For defendant when no reasonable jury could find substantial similarity
 - e. Non-Fiction
 - i. Facts are not copyrightable
 - ii. *Hoehling v. Universal*: Interpretations of historical events are not copyrightable
 - iii. *Toksvig v. Bruce Pub.*: Copying the expression of facts is infringement
 - iv. *Landsberg v. Scrabble*: Literary works of facts may be subject to the merger doctrine
 - f. Infringement of Computer Programs
 - i. *Altai* three-step test
 - 1. Abstraction: Use abstraction principle to create series of abstractions
 - 2. Filtration: Filter out non-protectable material
 - a. Efficiency: Structure that is necessary to efficiently implement the program is filtered out
 - b. External factors: Structure dictated by external factors is filtered out

- c. Public domain: Public domain material is filtered out
 - 3. Comparison: Compare what remains and see if they are substantially similar
 - ii. *Lotus v. Borland*: Menu command structure is unprotectable method of operation
 - iii. *Apple v. Microsoft*: Graphical user interfaces have thin protection
 - iv. Computer displays are part of the software (a literary work) rather than a separate pictorial work
- g. The World Wide Web
 - i. Linking does not constitute copyright infringement
 - ii. Framing is a better case for copyright infringement
- h. Infringement of Sound Recordings
 - i. No right of public performance in sound recordings (§ 114(a))
 - ii. Originality in a sound recording is the manner in which the orchestra created the sound, choices of the conductor, etc.
- i. Right of Public Performance
 - i. *Hayes v. The Shanley Co.*: For 1909 Act works, infringement does not turn on whether the performance was for direct profit, e.g. charging a fee to listen, as long as the defendant profited in some manner from the performance
 - ii. § 110: Exceptions to right of public performance and display
 - iii. *Fortnightly*: CATV systems did not violate right of public performance
 - iv. The radio broadcaster is doing the performance; the listeners are passively benefiting
 - v. *Twentieth Century Music v. Aiken*: Chicken shop exception
 - 1. Using a private radio in a small shop is not a violation of the right of public performance
 - 2. Where there is a chain of stores, each store is counted separately
 - vi. Private performance in a public store is public performance (video store cases)
 - vii. ASCAP/BMI: Song licensing companies; license song rights to broadcasters and other individuals/organizations
- j. Right of Distribution, Display, and Derivative Rights
 - i. First Sale
 - 1. § 109: Once a copyright owner sells a copy of a work, he cannot prevent others from selling or disposing of that copy
 - 2. *Independent News v. Williams*: In the absence of an agreement to the contrary, owner of a copy is free to dispose of the copy
 - 3. First sale doctrine applies once title is acquired free and clear
 - 4. Doctrine does not impair any other exclusive rights (copying, public performance/display, etc.)
 - 5. Exception: Cannot rent sound recordings or computer programs
 - 6. In some circuits, a lease/license can be considered a sale for the purposes of first sale doctrine if it is sufficiently broad
 - ii. Importation
 - 1. §§ 601, 602: Copyright owners can control the importation of copyrighted works
 - 2. *Quality King v. L'Anza Research*: First sale doctrine applies to importation, and thus re-importation is legal (§ 601(a))
 - 3. Exceptions to importation right
 - a. Importation for government use
 - b. Importation by individuals for private use
 - iii. Derivative Works
 - 1. *Litchfield v. Spielberg*: Substantial similarity is still required for infringement of derivative work
 - 2. *Lee v. ART Co.*: Mounting a picture does not create a derivative work but there is no bright-line rule for determining what constitutes a derivative work
 - 3. *Lewis Galoob v. Nintendo*: Significant modification or originality is required to create derivative work
 - 4. Courts are split as to whether originality is required to create a derivative work

- VI. The Limits of Liability
 - a. Moral Rights
 - i. Limited to certain types of visual works
 - ii. Prevents alteration or destruction without consent of author
 - b. Fair Use: § 107
 - i. The Fair Use Factors
 - 1. Purpose and nature of the use (commercial vs. non-profit)
 - a. *Sony v. Universal*: If use is non-commercial, plaintiff must show
 - i. the particular use is harmful
 - ii. widespread use would adversely affect the market (fourth factor)
 - b. *American Geophysical Union v. Texaco*: Photocopying for commercial research weighs against fair use
 - c. Do not look solely to whether or not the use is commercial
 - d. *Princeton University Press v. Michigan Document Service*: Look at what the defendant is using the work for, not what the defendant's customers are using the work for
 - 2. Nature of the work
 - a. *Iowa State v. ABC*: Material of public importance is not necessarily susceptible to fair use, especially if the material can be obtained from other sources
 - b. *Harper & Row v. The Nation*: Unpublished material weighs against fair use
 - 3. Amount and substantiality of the portion used in relation to the work as a whole
 - a. *Harper & Row v. The Nation*: Compare the amount used to the copyrighted work as a whole, *not* to the defendant's work
 - b. *Harper & Row v. The Nation*: A small amount taken may still be enough to defeat fair use if it goes to the heart of the work
 - 4. Effect of the use on the potential market for or the value of the copyrighted work
 - a. For derivative works, look at the potential market for that derivative work
 - b. *Harper & Row v. The Nation*: Direct evidence of market harm weighs against fair use
 - c. *American Geophysical Union v. Texaco*: Look to the market for the copyrighted works, not the market for any collective work which the copyrighted work may be a part
 - ii. Parody
 - 1. *Campbell v. Acuff-Rose*: Parody is fair use (overturning *Benny v. Loew's*)
 - 2. *Benny v. Loew's*: A significant taking of the copyrighted work will not be fair use
 - 3. The more transformative a use, the more likely that the use is fair
 - iii. *Atari v. Nintendo*: Where disassembly/reverse engineering is necessary to gain access to the unprotectable ideas, then the disassembly/reverse engineering weighs in favour of fair use
 - c. Innocent Infringement
 - i. *D'Acosta v. Brown*: Intent is not an element of copyright infringement
 - d. Contributory Infringement
 - i. Elements
 - 1. Knowledge of infringement
 - a. *Sony v. Universal Studios*: Mere operation of infringing service or sale of infringing devices does not create knowledge
 - i. Followed in *Napster v. A&M Records*, *Grokster*
 - b. Substantial non-infringing uses weigh against knowledge element

- c. Cease-and-desist letters may provide evidence of knowledge of infringement
 - 2. Act or participation in the infringement
 - ii. *Sony v. Universal Studios*: As long as there is some non-infringing use that is more than insubstantial, there is no contributory infringement
 - iii. *Religious Technology Center v. Netcom*: An ISP does not have contributory liability for the postings of its subscribers
 - e. Vicarious Liability
 - i. Elements
 - 1. Right or ability to control activity
 - 2. Direct benefit from infringing activities
 - a. *Religious Technology Center v. Netcom*: A service provided for a flat fee weighs against this factor
 - ii. Landlords are not generally vicariously liable
 - f. Audio Home Recording Act: restrictions on digital audio tapes; digital audio recorders
 - g. DMCA
 - i. § 512: Safe harbour for ISPs (subject to limitations and restrictions)
 - ii. § 1201: Anti-circumvention provision

- VII. Calculus of Rights
- a. Renewal, Duration, Termination
 - i. Renewal
 1. Under the 1909 Act, renewal creates a new term of copyright which reverts to the author
 2. *Fred Fisher Music v. M. Witmark*: Renewal rights are assignable
 - ii. Duration: See handout
 - iii. Termination
 1. For grants made after the 1976 Act came into effect, author may terminate the grant in a five-year window starting 35 years after the grant
 2. Authors also have a termination window after each time the copyright enters an extension period
 - a. for works made before 1978, one period 40 years before end of term and another 20 years before end of term
 - b. For works made between 1978 and 1998, one period 20 years before end of term
 3. Termination rights permit owners of derivative works made under the grant to continue to use the work after termination (but cannot make another derivative work)
 - b. Contracts and Copyrights
 - i. *Harper Bros. v. Klaw*
 1. Rights in a future (unknown) technology always exist
 2. Where a contract does not contemplate a new technology, a court may use a double injunction to press the parties to the negotiating table where one party would otherwise be severely harmed
 - ii. Where the contract does contemplate a new technology or the new technology existed at the time the contract was made, the courts will construe the contract broadly
 - iii. § 204: Transfers of copyright ownership must be in writing
 - iv. § 201(c): Collective Works
 1. Absent express contractual agreement, owner of collective work only has the right to reproduce and distribute the individual work as part of
 - a. the collective work
 - b. any revisions of the collective work
 - c. any later collective work in the same series
 2. *New York Times v. Tasini*: Electronic collections (such as LexisNexis) do not fall under any of the § 201(c) categories
 3. *Greenberg v. National Geographic*: Alteration and separation of works (pictures) from the collective work as part of CD-ROM collection does not fall under § 201(c) exceptions
 - c. Rights in Derivative Works
 - i. *Ricordi v. Paramount*: Renewal creates a new estate; renewal terms exist free and clear of any contractual arrangements with respect to the first term (Ricordi doctrine)
 - ii. *Stewart v. Abend*: The owner of the copyright in a derivative work may use that work only if the owner of the copyright in the underlying work permits it or if the underlying work is in the public domain
 - d. Works Made for Hire
 - i. Under the 1909 Act: where the employer had the right to direct and supervise the work
 - ii. Under the 1976 Act
 1. when the work is prepared by an employee within the scope of his employment
 2. when the work is commissioned as part of
 - a. a collective work;
 - b. part of a motion picture or audiovisual work;
 - c. a translation;
 - d. a supplementary work (work prepared for publication as a secondary adjunct for the purpose of introducing, concluding, etc. another work);

- e. a compilation;
 - f. as an instructional text;
 - g. as a test or answer material for a test; or
 - h. as an atlas; and
 - i. both parties expressly agree in writing that the work is one made for hire
 - 3. Effects of works made for hire
 - a. Employer owns the copyright (is considered the author)
 - b. No termination rights in works made for hire
 - c. Affects the length of copyright
 - 4. *CCNV*: The definition of employee is that used by the common law of agency
- e. Joint Authorship
 - i. Intent to be joint authors
 - ii. Separate, original contribution
 - iii. Co-owners (similar to tenancy in common)
 - iv. § 302(b): Term is 70 years from the death of the last author to die
- f. Jurisdiction
 - i. Actions arising under copyright have subject matter jurisdiction
 - ii. Counterclaims arising under copyright laws do not have subject matter jurisdiction
- g. State Sovereign Immunity
 - i. States have sovereign immunity from copyrights claims
 - ii. *Ex parte Young*: Copyright owners can sue for an injunction against a state official
 - iii. Federal government has waived sovereign immunity under 28 USC 1498, but different rules apply when suing the federal government
- h. Indivisibility
 - i. 1909 Act: Copyright indivisible
 - ii. 1976 Act: Copyright divisible
- i. Compulsory Licenses
 - i. § 114: Digital sound recordings
 - ii. §§ 111, 119, 122: Satellite and cable transmissions of television programs
 - iii. § 115: Phonorecords
 - 1. Non-dramatic musical works only
 - 2. Must be intended for sale for private use
 - 3. Available if copyright owner sells records in the U.S.
 - 4. License fees regulated by 37 CFR 255.3
 - 5. Arrangements are permitted so long as they do not change the melody or the fundamental character of the work; the arrangement is not considered a derivative work
 - 6. Does not extend to lyrics (cannot include lyrics with the phonorecord absent a separate arrangement with the copyright owner)
 - iv. §116: Coin-operated phonorecord players; jukeboxes
 - v. §118: Non-commercial broadcasting
- j. *Lasercomb v. Reynolds*: Copyright misuse is a defence to infringement until the misuse ceases
- k. Statute of Limitations
 - i. 5 years for criminal infringement
 - ii. 3 years for civil infringement
 - iii. Fraudulent concealment tolls the statute
- l. Damages : § 504
 - i. Actual damages and additional profits from the infringement
 - 1. § 504(b): Cannot receive damages and additional profits unless the additional profits are not part of the damages (no double-dipping)
 - 2. *Sheldon v. MGM*: Copyright owner is entitled only to those profits attributable to the infringement
 - ii. Statutory damages
 - 1. The finder of fact determines amount of damages
 - 2. Damages from \$750 - \$30,000 per infringed work

3. Not available if owner did not register copyright
 - a. Before the infringement
 - b. Within three months of publication
4. Damages can be increased to \$150,000 for wilful infringement
5. Innocent infringement
 - a. Damages can be reduced to \$200 for innocent infringement
 - b. Innocent infringement is not available if the work had a copyright notice attached
6. Damages can be reduced to nothing for non-profit entities claiming fair use
 - a. Educational institution, library, or archives infringing by reproducing copies/phonorecords
 - b. Public broadcasting entity infringing the right of public performance in non-dramatic literary work or transmitting a performance of a non-dramatic literary work
7. Damages can be increased to twice licensing fees for parties claiming the “chicken-shop” exception while knowing that they are not covered by the exception

- VIII. Trademarks and Related Rights
 - a. Unfair Competition
 - i. Elements
 - 1. Defendant passes off his goods as those of plaintiff by virtue of substantial similarity
 - 2. Leading to customer confusion
 - ii. Lanham Act § 43(a): customer confusion is the key element
 - b. Misappropriation
 - i. *International News* created misappropriation
 - ii. Elements (after 1976 pre-emption)
 - 1. Time-sensitive value of factual information
 - 2. Free-riding by defendant
 - 3. Threat to the very existence of product or service offered by the plaintiff
 - c. Pre-emption
 - i. *Sears Roebuck v. Stiffel* - A state cannot pass laws which permit damages for the copying of that which federal laws permit to be copied (also *Compco v. Day-Brite Lighting*)
 - ii. *Goldstein*: A state law that conflicts with a federal law is pre-empted
 - iii. § 301: Statutory Pre-emption
 - 1. Express pre-emption for equivalent state/common laws
 - a. Coming under the subject matter of copyright (i.e. work of authorship, fixed, original, etc.)
 - b. Rights involved equivalent to those in § 106
 - c. Fixed in a tangible medium
 - 2. No pre-emption for
 - a. Work that does not come under subject matter of copyright
 - b. Causes of action arising before 1/1/1978
 - c. Activities violating rights not equivalent to § 106
 - d. State and local landmarks, historic preservation, zoning, building codes relating to architectural works
 - 3. Generally, no pre-emption if the state law has an “extra element”
 - iv. Trade Dress Infringement
 - 1. Elements: Must show that trade dress is distinctive
 - a. Inherently distinctive: intrinsic nature serves to identify particular source
 - b. Secondary meaning: in the minds of the public, the primary significance is to identify the source of the product rather than the product itself
 - 2. *Wal-Mart v. Samara*: Product design cannot be inherently distinctive
 - 3. *Brandir v. Cascade*: Function elements may not have trade dress protection
 - v. Trademarks
 - 1. *Wallace v. Godinger Silver*: Where a feature is protected and the feature is required for competition in the market, the protection will be denied
 - 2. *Kohler v. Moen*: The federal trademark statute is not pre-empted by the patent statute
 - vi. Dilution: watering down a mark, making it worth less
 - vii. Right to privacy/publicity
 - 1. The *Midler* tort
 - a. Something not protected by the Copyright Act (voice)
 - b. Distinctive
 - c. Widely known