CHAPTER 1. INTRODUCTION

- § 1:1 Origins of U.S. intellectual property law—Origins of U.S. patent and copyright law
- § 1:2 —Origins of U.S. trademark law
- § 1:3 The practice of intellectual property law—Patent attorneys
- § 1:4 —Professional associations

CHAPTER 2. PRINCIPLES OF PATENT LAW

- § 2:1 The concept of patents
- § 2:2 Patent attorneys and patent agents
- § 2:3 Patentability opinions
- § 2:4 Patent-eligible subject matter
- § 2:5 USPTO publications
- § 2:6 Example of a utility patent
- § 2:7 —Cover sheet
- § 2:8 —Figures
- § 2:9 —Specification
- § 2:10 Example of a utility patent application publication
- § 2:11 —Cover sheet
- § 2:12 —Figures
- § 2:13 —Specification
- § 2:14 Example of a design patent
- § 2:15 Example of a plant patent
- § 2:16 Ownership of U.S. patents—Original ownership
- § 2:17 —Inventorship
- § 2:18 —Transfer of ownership
- § 2:19 —Joint ownership
- § 2:20 Priority of inventions—Claiming priority
- § 2:21 —Provisional applications
- § 2:22 —Nonprovisional applications
- § 2:23 —Divisional applications
- § 2:24 —Continuation applications
- § 2:25 —Continuation-in-part applications
- § 2:26 Nature of U.S. patent rights—Patent term
- § 2:27 —Exclusionary rights
- § 2:28 —Patented inventions can infringe other patents
- § 2:29 —Patent marking
- § 2:30 —Inventions enter the public domain after a patent expires

§ 2:31	Patentability of inventions—The "first to file" patent	
§ 2:32	system —Inventions must be useful	
-		
§ 2:33	—Inventions must be novel	
§ 2:34	—Defining novelty	
§ 2:35	—Inventions must be nonobvious	
§ 2:36	—Inventions must not be previously patented	
§ 2:37	Validity and infringement opinions	
CHA	PTER 3. OBTAINING A PATENT	
§ 3:1	Overview	
§ 3:2	Who may file a patent application—Inventors, guardians, assignees, or any party with sufficient proprietary interest	
§ 3:3	—Patent attorney or patent agent	
§ 3:4	—Establishing small entity status	
§ 3:5	Avoiding time bars—Post-AIA	
§ 3:6	—Pre-AIA	
§ 3:7	Filing the patent application—Filing a provisional patent application	
§ 3:8	—Filing a PCT application	
§ 3:9	—Filing a nonprovisional application	
§ 3:10	Claiming priority from an earlier application— Claiming priority from a provisional application	
§ 3:11	—Claiming priority from a nonprovisional U.S. application	
§ 3:12	—Claiming priority from a foreign application	
§ 3:13	Other requirements of the patent application process Information disclosure statements	
§ 3:14	—Assignment	
§ 3:15	—Power of attorney	
§ 3:16	—Establishing a noninventor's right to prosecute an application	
§ 3:17	—Incomplete applications and missing parts	
§ 3:18	—Filing receipt	
§ 3:19	Examination at the USPTO—Patent examiners	
§ 3:20	—Rejection for patent-ineligible subject matter	
§ 3:21	—Rejection for vague or indefinite specification	
§ 3:22	—Anticipation rejections	
§ 3:23	—Obviousness rejections	
§ 3:24	—Rejection for duplicate claims or double patenting	
§ 3:25	—Restriction and election requirements	
§ 3:26	—Examiner interviews	
§ 3:27	—Response to an office action	
§ 3:28	—Final office action	

- § 3:29 —Appeal
 § 3:30 Interferences and derivation proceedings
 § 3:31 Preissuance third party submissions
- § 3:32 Allowance and issuance of the patent
- § 3:33 Maintenance fees

CHAPTER 4. CORRECTION AND REVIEW OF ISSUED PATENTS

- § 4:1 Overview
- § 4:2 Certificates of Correction
- § 4:3 Disclaimers
- § 4:4 Reissue applications
- § 4:5 Supplemental examination
- § 4:6 Ex parte reexamination
- § 4:7 PTAB trials
- § 4:8 —Post grant review
- § 4:9 —Inter partes review
- § 4:10 —Transitional program for covered business method patents

CHAPTER 5. PATENT LITIGATION

- § 5:1 Pre-filing matters—Subject matter jurisdiction
- § 5:2 —Personal jurisdiction
- § 5:3 —Venue
- § 5:4 —Statute of limitations
- § 5:5 —Drafting the complaint
- § 5:6 Drafting the answer
- § 5:7 Rule 11 considerations
- § 5:8 Patent office procedures involving issued patents
- § 5:9 Declaratory judgment actions
- § 5:10 Infringing acts—Direct infringement
- § 5:11 —Active inducement of infringement
- § 5:12 —Contributory infringement
- § 5:13 Establishing patent infringement—Claim construction
- § 5:14 —Literal infringement
- § 5:15 —Infringement of a means plus function claim
- § 5:16 —Infringement of a design patent
- § 5:17 —Infringement of a plant patent
- § 5:18 —Infringement under the doctrine of equivalents
- § 5:19 Common discovery and evidentiary issues in patent litigation—Attorney-client privilege
- § 5:20 —Attorney work product
- § 5:21 —Confidential information
- § 5:22 —E-discovery

§ 5:23	—Bifurcation
§ 5:24	—Role of expert witnesses
§ 5:25	Remedies—Injunctions
§ 5:26	—Consent judgments
§ 5:27	—Lost profits
§ 5:28	—Reasonable royalty
§ 5:29	—Marking/actual notice
§ 5:30	—Increased damages
§ 5:31	—Attorney's fees
§ 5:32	—Total Profits
§ 5:33	Invalidity and unenforceability defenses—General
	principles
§ 5:34	Invalidity defenses—Section 101 defenses
§ 5:35	—Anticipation
§ 5:36	—On-sale bar
§ 5:37	—Experimental use
§ 5:38	—Invention by another
§ 5:39	—Obviousness
$\S 5:40$	—Lack of enablement
$\S 5:41$	—Inadequate description of the invention
$\S 5:42$	—Indistinct claims
§ 5:43	Unenforceability defenses—Inequitable conduct
§ 5:44	—Laches
§ 5:45	—Equitable estoppel
§ 5:46	—Patent misuse
$\S 5:47$	—Patent exhaustion
§ 5:48	—Prior commercial use
§ 5:49	Unenforceability—Experimental use defense and § 271(e)(1)
§ 5:50	Non-Infringement defenses—Repair doctrine
§ 5:51	—Product made by patented process

CHAPTER 6. PRINCIPLES OF COPYRIGHT LAW

§ 6:1	The concept of copyright
§ 6:2	Copyrightable subject matter—Originality
§ 6:3	—Works of authorship
§ 6:4	—Fixation
§ 6:5	Noncopyrightable subject matter
§ 6:6	Ownership of a copyright—Initial ownership
§ 6:7	—Works made for hire
§ 6:8	—Joint ownership
§ 6:9	—Contribution to a collective work
§ 6:10	—Ownership of copyright distinct from ownership of

TABLE OF CONTENTS

	material object
§ 6:11	—Assignment of copyrights
§ 6:12	—Mandatory licenses
§ 6:13	Exclusive rights—Right to reproduce copies of the work
§ 6:14	—Right to prepare derivative works
§ 6:15	—Right to distribute copies of the work
§ 6:16	—Right to perform the work publicly
§ 6:17	—Right to display the work publicly
§ 6:18	Limitations on copyrightable subject matter—Idea- expression dichotomy
§ 6:19	—Utilitarian works
§ 6:20	—Transfer of material objects
§ 6:21	—Computer programs
§ 6:22	Fair use—General rule
§ 6:23	—Examples of fair use
§ 6:24	Digital Millennium Copyright Act of 1998—Overview
§ 6:25	—Implementation of WIPO provisions
§ 6:26	—Limitations on online infringement liability
§ 6:27	—The making available right
§ 6:28	Moral rights
CHA	PTER 7. REGISTERING A COPYRIGHT
§ 7:1	Registration is not mandatory
§ 7:2	Publication—Definition of publication
§ 7:3	—Copyright Office policy on publication
§ 7:4	—Copyright Office policy on date of first publication
§ 7:5	—Copyright Office policy on nation of first publication
§ 7:6	Who may register a copyright
§ 7:7	Preparing the registration—Requirements of registration
§ 7:8	—Application fee for registration
§ 7:9	—Application forms for registration
§ 7:10	—Deposit copies required for registration
§ 7:11	—Other deposit considerations
§ 7:12	Duration of copyright registrations—Works created on
	or after January 1, 1978
§ 7:13	—Works created before January 1, 1978
§ 7:14	Copyright notice—Form of notice
§ 7:15	—Method of affixing notice
§ 7:16	Omission of copyright notice—Works published before January 1, 1978
§ 7:17	—Works first published between January 1, 1978 and March 1, 1989

§ 7:18 —Works first published after March 1, 1989

- § 7:19 —Notice removed without authorization
- § 7:20 —Notice on unpublished works
- § 7:21 Certificate of registration

CHAPTER 8. COPYRIGHT LITIGATION

- § 8:1 Pre-filing matters—Subject matter jurisdiction
- § 8:2 —Personal jurisdiction
- § 8:3 —Venue
- § 8:4 —Drafting the complaint
- § 8:5 —Pre-emption of state law claims
- § 8:6 —Right to a jury
- § 8:7 Liability for copyright infringement—Direct infringement
- § 8:8 —Contributory infringement
- § 8:9 —Inducement of infringement
- § 8:10 —Vicarious liability
- § 8:11 —Liability of states
- § 8:12 Establishing copyright infringement—Exclusive rights of the copyright owner
- § 8:13 —Ownership of the copyright
- § 8:14 —Access
- § 8:15 —Substantial similarity
- § 8:16 —Computer software
- § 8:17 —Role of expert witnesses
- § 8:18 Defenses—Fair use
- § 8:19 —Fair use of computer programs
- § 8:20 —Lack of notice
- § 8:21 —Fraud
- § 8:22 —Misuse
- § 8:23 —Statute of limitations
- § 8:24 —Laches
- § 8:25 —First sale doctrine
- § 8:26 —License defense
- § 8:27 Remedies—Injunctions
- § 8:28 —Impoundment
- § 8:29 —Actual damages and infringer's profits
- § 8:30 —Statutory damages
- § 8:31 —Willful infringement
- § 8:32 —Attorney's fees

CHAPTER 9. PRINCIPLES OF TRADEMARK LAW

- § 9:1 The concept of trademarks—Definitions
- § 9:2 —Duration of rights

§ 9:3	—Purpose of trademarks
§ 9:4	—Policy behind trademark law
§ 9:5	Distinctiveness of marks—The distinctiveness
	continuum
§ 9:6	—Fanciful marks
§ 9:7	—Arbitrary marks
§ 9:8	—Suggestive marks
§ 9:9	—Descriptive marks
§ 9:10	—Generic terms
§ 9:11	Secondary meaning
§ 9:12	Things that function as marks—Common kinds of
0.010	trademarks
§ 9:13	—Combination marks
§ 9:14	—House marks
§ 9:15	—Family of marks
§ 9:16	—Trade dress
§ 9:17	Special kinds of marks—Surnames
§ 9:18	—Geographic terms
§ 9:19	—Abbreviations, misspellings and foreign words
§ 9:20	Acquiring trademark rights—Common law rights
§ 9:21	—Federal registration
§ 9:22	—State registration
§ 9:23	—Protection of unregistered marks under § 43(a)
§ 9:24	Loss of trademark rights—Abandonment through nonuse
§ 9:25	—Abandonment through affirmative acts of owner
§ 9:26	—Genericide
§ 9:27	Preserving trademark rights—Trademark owner's duty to preserve mark
§ 9:28	—Proper designation of mark
§ 9:29	—Distinguishing the mark
§ 9:30	—Using the mark as an adjective
§ 9:31	—Policing third-party use
§ 9:32	Selecting a trademark—Conduct a trademark clearance search
§ 9:33	—Consider strength of mark
§ 9:34	—Avoid unregistrable subject matter
	-

CHAPTER 10. REGISTERING TRADEMARKS

§ 10:1 Advantages of federal trademark registration
 § 10:2 Trademark examination within the USPTO—Sources of law
 § 10:3 —Basic registration scheme

§	10:4	—Principal and supplemental registers
§	10:5	—Classification system
§	10:6	—Priority between multiple users
§	10:7	Types of applications for trademark registration— Use-based applications
Ş	10:8	—Intent-to-use applications
	10:9	—Applications based on foreign applications
-	10:10	—Applications based on foreign registrations
-	10:11	—The Madrid Protocol and international registration of marks
§	10:12	—Applications based on an international registration under the Madrid Protocol
§	10:13	Requirements of the application
§	10:14	—Information about the mark and its owner
§	10:15	—Description of goods and services
§	10:16	—Filing basis
§	10:17	—Drawings
§	10:18	—Specimens of use
§	10:19	—Declaration or oath
§	10:20	—Fee
§	10:21	—Foreign registration certificate
§	10:22	—Designation of domestic representative by foreign applicant
§	10:23	—Allegations of use in ITU applications
§	10:24	Grounds for refusal to register—Proposed mark does not function as a trademark
Ş	10:25	—Confusing similarity to registered mark
-	10:26	—Scandalous or immoral subject matter
	10:27	—Deceptive matter
	10:28	—Disparaging matter
	10:29	—Other kinds of unregistrable subject matter
_	10:30	—Merely descriptive or deceptively misdescriptive mark
Ş	10:31	—Geographically descriptive or misdescriptive marks
	10:32	—Primarily merely a surname
-	10:33	Proving secondary meaning
_	10:34	Examination of applications—Initial examination and office actions
Ş	10:35	—Responses to an office action
	10:36	—Appeal to Trademark Trial and Appeal Board
_	10:37	—Publication
	10:38	Inter partes proceedings before the TTAB—
		Oppositions
	10:39	—Cancellations
Š	10:40	—Procedures in inter partes proceedings

§ 10:41 Duration and renewal of registrations

CHAPTER 11. TRADEMARK AND UNFAIR COMPETITION LITIGATION

§ 11:1	Pre-filing matters—Subject matter jurisdiction
§ 11:2	—Personal jurisdiction
§ 11:3	—Venue
§ 11:4	—Statute of limitations
§ 11:5	—Drafting the complaint
§ 11:6	—Rule 11 considerations
§ 11:7	Liability for trademark infringement
§ 11:8	Establishing trademark infringement—Ownership of the mark
§ 11:9	—Likelihood of confusion
§ 11:10	Common discovery and evidentiary issues in trademark litigation—Proving secondary meaning
§ 11:11	—Proving likelihood of confusion
§ 11:12	2 —Third party uses
§ 11:13	3 —Surveys
§ 11:14	· · · · · · · · · · · · · · · · · · ·
§ 11:1	
§ 11:16	
§ 11:1'	
§ 11:18	B —Parody
§ 11:19	9 —Limited geographic use
§ 11:20	—Labeling and use of disclaimers
§ 11:2	1 —Laches and acquiescence
§ 11:22	2 Defining trademark dilution
§ 11:23	B History of dilution—Trademark law in the nineteenth century
§ 11:24	4 —A rational basis for trademark protection
§ 11:2	5 Dilution statutes—State dilution statutes
§ 11:26	3 —Federal dilution statute
§ 11:2'	7 Analyzing a dilution case
§ 11:28	B Dilution—Famous marks
§ 11:29	Theories of dilution
§ 11:30	Proving dilution
§ 11:3	1 —Remedies
§ 11:32	2 Dilution by competing goods
§ 11:33	
§ 11:34	
§ 11:3	
8 11.26	

§ 11:37	——False attribution of credit
§ 11:38	——False advertising
§ 11:39	—State advertising law—Uniform Deceptive Trade Practices Acts
§ 11:40	——Defamation and commercial torts
§ 11:41	— —Warranties and product liability
	•
CHAI	PTER 12. TRADE SECRETS
§ 12:1	Importance of trade secrets
§ 12:2	Defining trade secrets—Restatement (First) of Torts
§ 12:3	—Uniform Trade Secrets Act
§ 12:4	—Economic Espionage Act/Defend Trade Secrets Act
§ 12:5	—Other definitions of trade secrets
§ 12:6	Elements of a trade secret—Novelty
§ 12:7	—Economic value
§ 12:8	—Not generally known or readily ascertainable
§ 12:9	—Reasonable efforts to maintain secrecy
§ 12:10	Confidentiality agreements—Employee agreements
§ 12:11	—Implied duty of confidentiality
§ 12:12	Ownership of a trade secret—Employee work and submissions
§ 12:13	—Non-employee submissions
§ 12:14	—Termination of employment
§ 12:15	Losing trade secret rights through public disclosure- Sale of products incorporating secret information
§ 12:16	—Disclosure in patent or copyrights
§ 12:17	—Other forms of disclosure
§ 12:18	Misappropriation of trade secrets—Elements of a
	misappropriation claim
§ 12:19	—Acquisition by improper means
§ 12:20	—Reverse engineering
§ 12:21	—Disclosure or use without consent
§ 12:22	Preparing to bring a trade secret misappropriation suit—Statute of limitations
§ 12:23	—Pleadings
§ 12:24	—Pre-emption
§ 12:25	—Protection of trade secret during litigation
§ 12:26	Proving trade secret misappropriation—Burden of
	proof
§ 12:27	—Proving economic value
§ 12:28	—Proving novelty
§ 12:29	—Proving secrecy
§ 12:30	—Proving improper use
§ 12:31	—Proving inevitable disclosure
8 12:32	—Proving improper acquisition

§ 12:33 Remedies—Injunctive relief
§ 12:34 —Damages
§ 12:35 —Attorneys' fees
§ 12:36 Federal trade secrets actions
§ 12:37 Criminalization of trade secret law

CHAPTER 13. THE RIGHT OF PUBLICITY

- § 13:1 Evolution of the right of publicity—The right of privacy
 § 13:2 —The right of publicity
 § 13:3 Policy behind the right of publicity
 § 13:4 Enforcing the right of publicity—Common law claims
- § 13:5 —State statutory claims § 13:6 Proving infringement of the right of publicity— Elements of a claim
- § 13:7 —Appropriation of plaintiff's identity, name or likeness
- § 13:8 —For defendant's commercial advantage
- § 13:9 —Without plaintiff's consent
- § 13:10 —Resulting in injury
- § 13:11 Right of publicity surviving the death of a celebrity
- § 13:12 Statute of limitations—Duration for bringing action
- § 13:13 —Tolling of statute
- § 13:14 Remedies—Injunctions
- § 13:15 —Damages
- § 13:16 —Attorney's fees
- § 13:17 Defenses—First Amendment

CHAPTER 14. TRANSFERRING, LICENSING AND SECURING INTELLECTUAL PROPERTY RIGHTS

- § 14:1 Assignments—Distinguishing between assignments and licenses
- § 14:2 —Structure of assignments
- § 14:3 —Recording requirements
- § 14:4 —Prohibited assignment practices
- § 14:5 —Termination of assignment
- § 14:6 —Arbitration
- § 14:7 —Right to remedy a breach
- § 14:8 —Non-default
- § 14:9 —No implied continuing waiver
- § 14:10 —Choice of law
- § 14:11 —Choice of forum
- § 14:12 Licenses—Types of licenses

§ 14:13 —Structure of license —Prohibited licensing practices § 14:14 § 14:15 —Termination of agreement § 14:16 —Arbitration § 14:17 -Right to remedy a breach § 14:18 —Non-default § 14:19 -No implied continuing waiver § 14:20 —Choice of law —Choice of forum § 14:21 § 14:22 Security interests—Creation of a security interest § 14:23 -Perfecting the security interest-Perfecting under the UCC --- Preemption of UCC filing § 14:24 § 14:25 — —Copyrights and mask works § 14:26 ——Patents and plant variety certificates — Federally registered trademarks and goodwill § 14:27 § 14:28 - Trade secrets, know-how, rights of publicity, and other intellectual property created by state law § 14:29 — —Dual filing § 14:30 —Description of intellectual property in security agreements § 14:31 -Priority -Right of debtor to use the secured property § 14:32 § 14:33 —Effects of bankruptcy § 14:34 Mergers and acquisitions—Letter of intent and confidentiality agreement § 14:35 —Identifying the assets § 14:36 —Stock purchase agreement § 14:37 -Asset purchase agreement § 14:38 —Hostile takeovers § 14:39 —After the transaction

CHAPTER 15. INTELLECTUAL PROPERTY RIGHTS IN FOREIGN COUNTRIES

§ 15:1 International treaties—Reciprocity § 15:2 —Bilateral agreements § 15:3 -Multilateral agreements § 15:4 Patents—Foreign protection § 15:5 -Foreign filing under the Paris Convention § 15:6 —Foreign filing under the WTO Agreement —PCT filing as entry into foreign nations § 15:7 § 15:8 -Filing under the European Patent Convention § 15:9 Trademarks—Foreign trademark registrations § 15:10 —Foreign filing under the Paris Convention

- § 15:11 —Foreign trademark filing under TRIPS
- § 15:12 —Foreign filing under the Madrid System
- § 15:13 —The European Community Trademark
- § 15:14 Copyright—Foreign copyright protection
- § 15:15 —Foreign copyright under the Berne Convention
- § 15:16 —Copyright protection under the WTO Agreement
- § 15:17 —Copyright under the Universal Copyright Convention
- § 15:18 Trade secrets

CHAPTER 16. EXTRA-TERRITORIAL APPLICATION OF U.S. INTELLECTUAL PROPERTY LAW

- § 16:1 Using American law against foreign infringers—U.S. Customs Service
- § 16:2 —U.S. International Trade Commission
- § 16:3 —Extra-territorial application of U.S. trademark and copyright law
- § 16:4 —Extraterritorial application of U.S. patent law
- § 16:5 Gray market goods

CHAPTER 17. ADVISING A BUSINESS ABOUT INTELLECTUAL PROPERTY

- § 17:1 Introduction
- § 17:2 Attorneys must learn about their client's intellectual property—Identify an intellectual property contact person
- § 17:3 —Identify how intellectual property is created
- § 17:4 —Identify how products are marketed
- § 17:5 —Identify the industry and competitors
- § 17:6 —Identify ways to systematically protect intellectual property
- § 17:7 —Identify the role of intellectual property
- § 17:8 Educating the client about intellectual property— Creating awareness of the benefits of intellectual property
- § 17:9 —Creating awareness of the dangers of ignoring intellectual property
- § 17:10 Creating a system for protecting intellectual property—Identifying existing intellectual property
- § 17:11 —Protecting new intellectual property
- § 17:12 —Enforcing intellectual property rights
- § 17:13 Avoiding infringement of intellectual property rights of others

$\S~17:14~$ Intellectual property due diligence considerations

APPENDICES

Appendix A.	United States Utility Patent and Published Application
Appendix B.	United States Design Patent
Appendix C.	United States Plant Patent
Appendix D.	Comparison of Post-Grant Patent Proceedings
Appendix E.	Patent Infringement Complaint
Appendix F.	Patent Infringement Answer and Counterclaim
Appendix G.	Protective Order
Appendix H.	Consent Judgment
Appendix I.	Copyright Application Form TX
Appendix J.	Copyright Registration
Appendix K.	Copyright Infringement Complaint
Appendix L.	Trademark Registration
Appendix M.	Trademark Notice of Opposition
Appendix N.	Trademark Petition for Cancellation
Appendix O.	Trademark Infringement Complaint
Appendix P.	Confidentiality and Non-Disclosure Agreement
Appendix Q.	Employment Agreement
Appendix R.	Citations to State Deceptive Trade Practices Acts
Appendix S.	Citations to State Unfair Business Practices Acts
Appendix T.	Citations to State False Advertising Acts
Appendix U.	Citations to State Right of Publicity Acts
Appendix V.	Patent Assignment
Appendix W.	Trademark Assignment
Appendix X.	Copyright Assignment
Appendix Y.	Patent License
Appendix Z.	Trademark License
Appendix AA.	Copyright License
Appendix BB.	Invention Disclosure

Table of Laws and Rules

Table of Cases

Index