



**Intellectual Property: The Law of Trademarks, Copyrights, Patents, and Trade Secrets, Fourth Edition**  
**Deborah E. Bouchoux**

Vice President, Careers & Computing:  
Dave Garza

Director of Learning Solutions: Sandy Clark

Senior Acquisitions Editor: Shelley Esposito

Managing Editor: Larry Main

Editorial Assistant: Diane Chrysler

Vice President, Marketing: Jennifer Baker

Marketing Director: Deborah Yarnell

Senior Marketing Manager: Mark Linton

Marketing Coordinator: Erin DeAngelo

Senior Production Director: Wendy Troeger

Production Manager: Mark Bernard

Content Project Manager: Betty L. Dickson

Art Director: Riezebos Holzbaur Group

Senior Technology Project Manager:  
Joe Pliss

Media Editor: Deborah Bordeaux

© 2013, 2009, 2005, 2000 Delmar, Cengage Learning

ALL RIGHTS RESERVED. No part of this work covered by the copyright herein may be reproduced, transmitted, stored, or used in any form or by any means graphic, electronic, or mechanical, including but not limited to photocopying, recording, scanning, digitizing, taping, Web distribution, information networks, or information storage and retrieval systems, except as permitted under Section 107 or 108 of the 1976 United States Copyright Act, without the prior written permission of the publisher.

For product information and technology assistance, contact us at  
**Cengage Learning Customer & Sales Support, 1-800-354-9706**

For permission to use material from this text or product,  
submit all requests online at **www.cengage.com/permissions**.

Further permissions questions can be e-mailed to  
**permissionrequest@cengage.com**.

Library of Congress Control Number: 2012931915

ISBN-13: 978-1-111-64857-2

ISBN-10: 1-111-64857-3

**Delmar**

5 Maxwell Drive  
Clifton Park, NY 12065-2919  
USA

Cengage Learning is a leading provider of customized learning solutions with office locations around the globe, including Singapore, the United Kingdom, Australia, Mexico, Brazil, and Japan. Locate your local office at:  
**international.cengage.com/region**

Cengage Learning products are represented in Canada  
by Nelson Education, Ltd.

To learn more about Delmar, visit **www.cengage.com/delmar**

Purchase any of our products at your local college store or at our  
preferred online store **www.cengagebrain.com**

**Notice to the Reader**

Publisher does not warrant or guarantee any of the products described herein or perform any independent analysis in connection with any of the product information contained herein. Publisher does not assume, and expressly disclaims, any obligation to obtain and include information other than that provided to it by the manufacturer. The reader is expressly warned to consider and adopt all safety precautions that might be indicated by the activities described herein and to avoid all potential hazards. By following the instructions contained herein, the reader willingly assumes all risks in connection with such instructions. The publisher makes no representations or warranties of any kind, including but not limited to, the warranties of fitness for particular purpose or merchantability, nor are any such representations implied with respect to the material set forth herein, and the publisher takes no responsibility with respect to such material. The publisher shall not be liable for any special, consequential, or exemplary damages resulting, in whole or part, from the readers' use of, or reliance upon, this material. Certain trademarks are used throughout this text as illustrative of the content. Such trademarks are the property of their respective owners and their use herein shall not be deemed to imply the endorsement or sponsorship of this product by any such owner.

Printed in the United States of America  
1 2 3 4 5 6 7 16 15 14 13 12



---

# TABLE OF CONTENTS

---

xviii	Preface
xxii	Acknowledgments
xxiii	List of Exhibits

---

## **PART ONE**

---

### INTRODUCTION TO INTELLECTUAL PROPERTY

---

02	CHAPTER 1 Introduction to Intellectual Property Law
	Chapter Overview • 2
	Intellectual Property Law Basics • 3
	Types of Intellectual Property • 3
	Agencies Responsible for Intellectual Property Registration • 7
	International Organizations, Agencies, and Treaties • 9
	The Increasing Importance of Intellectual Property Rights • 10
	Trivia • 11
	Chapter Summary • 12
	Case Illustration—Policies Underlying Intellectual Property Law • 12
	Case Study and Activities • 13
	Role of Paralegal • 13
	Internet Resources • 14
	Discussion Questions • 14
	Using Internet Resources • 15

**PART  
TWO****THE LAW OF TRADEMARKS**

---

**18 CHAPTER 2 Foundations of Trademark Law**

---

Chapter Overview • 18

Introduction • 19

Purpose and Function of Trademarks • 19

Types of Marks: Trademarks, Service Marks, Certification Marks,  
and Collective Marks • 20

Acquisition of Trademark Rights • 22

Common Law Rights, Federal Registration under the Lanham Act, Laws  
and Treaties Governing Trademarks, and State Trademark Rights • 23

Categories of Marks • 26

Trade Names and Business Names • 28

Protectable Matter • 29

Exclusions from Trademark Protection • 33

U.S. Patent and Trademark Office • 36

Trivia • 37

Chapter Summary • 37

Case Illustration—Refusal to Register Disparaging Mark • 38

Case Study and Activities • 38

Role of Paralegal • 38

Internet Resources • 39

Discussion Questions • 39

Using Internet Resources • 40

**41 CHAPTER 3 Trademark Selection and Searching**

---

Chapter Overview • 41

Selecting and Evaluating a Mark • 42

The Trademark Search • 42

Trivia • 52

Chapter Summary • 53

Case Illustration—Effect of Failure to Perform Trademark Search • 53

Case Study and Activities • 54

Role of Paralegal • 54

Internet Resources • 54

Discussion Questions • 55

Using Internet Resources • 55

---

**56      CHAPTER 4 The Trademark Registration Process**

---

- Chapter Overview • 56
- Preparing the Application • 57
- Drawing of Mark • 64
- Filing the Application, Docketing Critical Dates, and Initial Role of the U.S. Patent and Trademark Office • 68
- The Examination Process • 70
- Postexamination Procedure • 75
- Registration • 80
- The U.S. Patent and Trademark Office's TARR Monitoring System • 84
- Trivia • 84
- Chapter Summary • 84
- Case Illustration—Bona Fide Intent to Use • 85
- Case Study and Activities • 86
- Role of Paralegal • 86
- Internet Resources • 87
- Discussion Questions • 87
- Using Internet Resources • 87

---

**89      CHAPTER 5 Postregistration Procedures, Trademark Maintenance, and Transfer of Rights to Marks**

---

- Chapter Overview • 89
- The Affidavit of Use • 90
- The Affidavit of Incontestability • 91
- Renewal of Registrations • 92
- Docketing Requirements • 93
- Loss of Trademark Rights • 94
- Trademark Use and Compliance Policies • 96
- Trademark Policing and Maintenance • 98
- Use of Marks Owned by Third Parties • 99
- Transfer of Ownership or Rights in Trademarks • 99
- Trivia • 109
- Chapter Summary • 110
- Case Illustration—Standard for Cancellation of Registrations for Fraud • 111
- Case Study and Activities • 111
- Role of Paralegal • 111
- Internet Resources • 112
- Discussion Questions • 112
- Using Internet Resources • 113

**114**    **CHAPTER 6** Inter Partes Proceedings, Infringement,  
and Dilution

---

- Chapter Overview • 114
- Inter Partes Proceedings • 115
- Infringement of Trademarks • 121
- Dilution of Trademarks • 133
- Related Trademark Claims • 135
- Trivia • 139
- Chapter Summary • 139
- Case Illustration—Contributory Trademark Infringement • 140
- Case Study and Activities • 141
- Role of Paralegal • 141
- Internet Resources • 142
- Discussion Questions • 142
- Using Internet Resources • 143

**144**    **CHAPTER 7** New Developments in Trademark Law

---

- Chapter Overview • 144
- The Internet • 145
- Protecting a Domain Name • 147
- Hyperlinking and the First Amendment • 153
- Other Cyberspace Trademark Issues • 154
- Trivia • 158
- Chapter Summary • 159
- Case Illustration—Key Word Advertising as Infringement • 160
- Case Study and Activities • 160
- Role of Paralegal • 160
- Internet Resources • 161
- Discussion Questions • 161
- Using Internet Resources • 162

**163**    **CHAPTER 8** International Trademark Law

---

- Chapter Overview • 163
- Applications in the United States Based on Foreign Applications and Registrations • 164
- Securing Trademark Protection in Foreign Countries • 167
- Effects of New International Agreements (NAFTA, TRIPS, and the Trademark Law Treaty) • 175
- International Associations • 176
- Trivia • 177
- Chapter Summary • 178

- Case Illustration—Effect of Foreign Registration in United States • 179
- Case Study and Activities • 179
- Role of Paralegal • 179
- Internet Resources • 180
- Discussion Questions • 180
- Using Internet Resources • 181

**PART  
THREE****THE LAW OF COPYRIGHTS****184 CHAPTER 9 Foundations of Copyright Law**

- Chapter Overview • 184
- Introduction • 185
- Common Law Rights and Rights under the 1976 Copyright Act • 186
- The U.S. Copyright Office • 188
- Trivia • 188
- Chapter Summary • 189
- Case Illustration—Purpose of Copyright Law • 189
- Case Study and Activities • 189
- Role of Paralegal • 190
- Internet Resources • 190
- Discussion Questions • 190
- Using Internet Resources • 191

**192 CHAPTER 10 The Subject Matter of Copyright**

- Chapter Overview • 192
- Introduction • 193
- Originality of Material • 193
- Fixation of Material • 193
- Works of Authorship • 194
- Exclusions from Copyright Protection • 198
- Compilations, Collections, and Derivative Works • 202
- Trivia • 205
- Chapter Summary • 205
- Case Illustration—Merger Doctrine • 206
- Case Study and Activities • 206
- Role of Paralegal • 206
- Internet Resources • 207
- Discussion Questions • 207
- Using Internet Resources • 208

**209**    **CHAPTER 11** The Rights Afforded by Copyright Law

---

- Chapter Overview • 209
- Introduction • 210
- Rights of Reproduction • 210
- Rights to Prepare Derivative Works • 211
- Rights of Distribution and the First Sale Doctrine • 212
- Rights to Perform the Work Publicly • 214
- Rights to Display the Work Publicly • 219
- Other Limitations on Exclusive Rights • 220
- Moral Rights and the Visual Artists Rights Act • 220
- Compulsory Licenses • 222
- Trivia • 224
- Chapter Summary • 224
- Case Illustration—Rights under the Visual Artists Rights Act • 225
- Case Study and Activities • 225
- Role of Paralegal • 226
- Internet Resources • 226
- Discussion Questions • 226
- Using Internet Resources • 227

**228**    **CHAPTER 12** Copyright Ownership, Transfers, and Duration

---

- Chapter Overview • 228
- Copyright Ownership Issues • 229
- Joint Works • 229
- Ownership in Derivative or Collective Works • 231
- Works Made for Hire • 231
- Transfers of Copyright • 234
- Termination of Transfers of Copyright Rights • 236
- Duration of Copyright • 239
- Trivia • 241
- Chapter Summary • 241
- Case Illustration—Independent Contractors • 242
- Case Study and Activities • 243
- Role of Paralegal • 243
- Internet Resources • 244
- Discussion Questions • 244
- Using Internet Resources • 245

**246**    **CHAPTER 13** Copyright Registration, Searching Copyright Office Records, and Notice of Copyright

---

- Chapter Overview • 246
- Introduction • 247



---

	The Application for Copyright Registration • 247
	Deposit Materials • 251
	The Application Process and Registration of Copyright • 253
	Preregistration • 256
	Searching Copyright Office Records • 256
	Obtaining Copyright Office Records and Deposit Materials • 257
	Copyright Notice • 258
	Trivia • 262
	Chapter Summary • 262
	Case Illustration—Deference Given to Decisions by Copyright Office • 263
	Case Study and Activities • 264
	Role of Paralegal • 264
	Internet Resources • 265
	Discussion Questions • 265
	Using Internet Resources • 266

---

**267**    **CHAPTER 14**    Copyright Infringement

---

	Chapter Overview • 267
	Introduction • 268
	Elements of Infringement • 268
	Contributory Infringement and Vicarious Infringement • 272
	Defenses to Infringement • 273
	Infringement Actions • 280
	Trivia • 283
	Chapter Summary • 284
	Case Illustration—Fair Use • 285
	Case Study and Activities • 286
	Role of Paralegal • 286
	Internet Resources • 286
	Discussion Questions • 287
	Using Internet Resources • 287

---

**289**    **CHAPTER 15**    New Developments in Copyright Law  
and the Semiconductor Chip Protection Act

---

	Chapter Overview • 289
	Introduction • 290
	Copyright Protection for Computer Programs • 290
	Copyright Protection for Automated Databases • 296
	Copyright in the Electronic Age • 297
	The Digital Millennium Copyright Act • 301
	Entertainment Notes • 305
	Recent Developments in Copyright Law • 310

Terms of the Trade • 313  
Vessel Hull Protection • 314  
Semiconductor Chip Protection • 314  
Trivia • 316  
Chapter Summary • 317  
Case Illustration—The Safe Harbor of the DMCA • 318  
Case Study and Activities • 319  
Role of Paralegal • 319  
Internet Resources • 320  
Discussion Questions • 320  
Using Internet Resources • 321

---

## 322 CHAPTER 16 International Copyright Law

---

Chapter Overview • 322  
Introduction • 323  
The Berne Convention • 323  
Treaties Supplementing the Berne Convention: The WIPO Treaties • 324  
The Uruguay Round Agreements Act • 325  
The Universal Copyright Convention • 326  
Trade Aspects of Intellectual Property Law • 327  
Gray Market Goods • 327  
Summary of U.S. Relations with Foreign Nations • 328  
Trivia • 328  
Chapter Summary • 329  
Case Illustration—The First Sale Doctrine and Foreign-Made Goods • 329  
Case Study and Activities • 330  
Role of Paralegal • 330  
Internet Resources • 331  
Discussion Questions • 331  
Using Internet Resources • 332

---

# **PART** **FOUR** THE LAW OF PATENTS

---

---

## 334 CHAPTER 17 Foundations of Patent Law

---

Chapter Overview • 334  
Introduction • 335  
Rights under Federal Law • 335  
U.S. Patent and Trademark Office • 336  
Patentability • 337

---

Design Patents • 347  
Plant Patents • 349  
Double Patenting • 351  
The Orphan Drug Act • 352  
Trivia • 352  
Chapter Summary • 352  
Case Illustration—Experimental Use • 353  
Case Study and Activities • 353  
Role of Paralegal • 354  
Internet Resources • 354  
Discussion Questions • 354  
Using Internet Resources • 355

## 356 CHAPTER 18 Patent Searches, Applications, and Post-Issuance Proceedings

---

Chapter Overview • 356  
Patent Searching • 357  
The Patent Application Process • 363  
Prosecuting the Application • 376  
Post-Issuance Actions • 392  
Term and Maintenance of Patents • 397  
Trivia • 398  
Chapter Summary • 399  
Case Illustration—False Marking • 399  
Case Study and Activities • 400  
Role of Paralegal • 400  
Internet Resources • 401  
Discussion Questions • 402  
Using Internet Resources • 403

## 404 CHAPTER 19 Patent Ownership and Transfer

---

Chapter Overview • 404  
Ownership Rights • 405  
Sole and Joint Inventors • 405  
Disputes over Inventorship • 406  
Inventions Made by Employees and Independent Contractors • 407  
Assignment of Patent Rights • 408  
Licensing of Patent Rights • 411  
Invention Developers and Promoters • 412  
Trivia • 413

Chapter Summary • 413  
Case Illustration—Shop Rights • 414  
Case Study and Activities • 415  
Role of Paralegal • 415  
Internet Resources • 415  
Discussion Questions • 416  
Using Internet Resources • 416

---

**417**    **CHAPTER 20** Patent Infringement

---

Chapter Overview • 417  
Direct Infringement, Inducement to Infringe, and Contributory  
    Infringement • 418  
The First Sale Doctrine • 418  
Imports and Section 337 Investigations • 419  
Indirect Infringement • 420  
Infringement Abroad • 421  
Claims Interpretation • 421  
Defenses to Infringement • 424  
Remedies for Infringement • 426  
Resolving an Infringement Dispute • 429  
Patent Infringement Litigation • 430  
Trivia • 433  
Chapter Summary • 433  
Case Illustration—Extent of Waiver When Accused Infringer Relies  
    on Advice of Counsel • 434  
Case Study and Activities • 435  
Role of Paralegal • 435  
Internet Resources • 435  
Discussion Questions • 436  
Using Internet Resources • 436

---

**438**    **CHAPTER 21** New Developments and International  
Patent Law

---

Chapter Overview • 438  
New Developments in Patent Law • 439  
Introduction to International Patent Protection • 452  
The Paris Convention • 452  
The Patent Cooperation Treaty • 453  
The European Patent Organization • 459

---

The Patent Prosecution Highway • 460
Agreement on Trade-Related Aspects of Intellectual Property Rights • 460
The Patent Law Treaty • 461
Foreign Filing Licenses • 461
Applications for U.S. Patents by Foreign Applicants • 462
Trivia • 462
Chapter Summary • 463
Case Illustration—Patentability of Particular Methods Post- <i>Bilski</i> • 464
Case Study and Activities • 464
Role of Paralegal • 464
Internet Resources • 465
Discussion Questions • 465
Using Internet Resources • 466

---

**PART  
FIVE****THE LAW OF TRADE SECRETS AND UNFAIR  
COMPETITION**

---

**468 CHAPTER 22 Trade Secrets Law**

---

Chapter Overview • 468
Introduction • 469
Determination of Trade Secret Status • 471
Liability for Misappropriation of Trade Secrets • 473
Employer-Employee Relationships • 475
Protection for Submissions • 477
Defenses to Trade Secret Misappropriation • 479
Remedies for Misappropriation • 480
Trade Secret Litigation • 481
Trade Secret Protection Programs • 482
New and International Developments in Trade Secrets Law • 484
Trivia • 485
Chapter Summary • 486
Case Illustration—Maintaining Trade Secret Status • 486
Case Study and Activities • 487
Role of Paralegal • 487
Internet Resources • 487
Discussion Questions • 488
Using Internet Resources • 488

---

**489**    **CHAPTER 23**    **Unfair Competition**

---

- Chapter Overview • 489
- Introduction • 490
- Passing Off • 491
- Misappropriation • 493
- Right of Publicity • 493
- False Advertising • 498
- Product Disparagement • 501
- Dilution • 502
- Infringement of Trade Dress • 503
- International Protection against Unfair Competition • 504
- Trivia • 505
- Chapter Summary • 505
- Case Illustration—Right of Publicity • 506
- Case Study and Activities • 506
- Role of Paralegal • 506
- Internet Resources • 507
- Discussion Questions • 507
- Using Internet Resources • 508

---

**509**    **CHAPTER 24**    **Intellectual Property Audits and Due Diligence Reviews**

---

- Chapter Overview • 509
- Introduction • 510
- Practical Aspects of Intellectual Property Audits • 511
- Conducting the Audit • 512
- Postaudit Activity • 512
- Trivia • 517
- Chapter Summary • 517
- Case Illustration—Value of Intellectual Property • 518
- Case Study and Activities • 518
- Role of Paralegal • 518
- Internet Resources • 519
- Discussion Questions • 519
- Using Internet Resources • 519

---

**521**    **Glossary**

---

---

**535**    **Index**

---