

INTELLECTUAL PROPERTY – Fall 2013
(180 min.)

I. (60 min.)

- 1A. Removal/destruction of *bas-relief* without demolition of building.
- VARA - creates moral right of integrity. Owner of limited edition visual art work cannot destroy work w/o artist's consent.
 - includes alteration/mutilation of work. § 106A(a)(3)(A).
 - involves destruction of work of recognized stature. § 106A(a)(3)(B).
 - here, the facts do not indicate whether the *bas relief* is a work of recognized stature.
 - thus, VARA right of integrity may not be actionable.
 - Architectural Works Act. Artistic works which are part of fabric of building can be demolished with building. Owner of building can demolish it for any reason. § 120(b).
 - that exemption from VARA does not apply if only the art work, not the building, is destroyed. § 113(d)(2), 106A(a)(3).
 - artist must consent to destruction to immunize owner from liability for destruction of the art work.
 - here, the artist did not consent.
 - thus, sculptor has a cause of action.
 - art work is not a "work for hire". While commissioned, it does not fall within one of the seven categories of "work for hire" commissioned works. Also, sculptor is not an employee. § 101.
 - thus, sculptor, not the city, owns the copyright in the *bas-relief*.
 - but, VARA moral right of integrity exists even if copyright is owned by owner of physical copy of work.
 - thus, "work for hire" rules do not impact on liability of city for destruction of art work.
- 1B. Destruction of *bas-relief* as part of demolition and replacement of building.
- Architectural Works Act exception to VARA applies. § 120(b).
 - the exception allows owner of building to destroy work of art that is an integral part of the building with demolition of the building.
 - here, sculptor has no cause of action.
- 1C. Removal and relocation of *bas-relief* without damage.
- neither VARA nor Architectural Works Act bars moving art work to another location if it will be undamaged.
 - VARA allows modifications of work of art for purposes of conservation ... and placement. § 113(d)(2), 106A(a)(3), 106A(c)(3).
 - thus, sculptor has no cause of action.
- 1D. Photographing of *bas-relief* from a public place.
- Architectural Works Act expressly allows photographing of copyrighted buildings from a public place. § 120(a).

- does that exemption apply to copyrighted art works attached to buildings? Yes.
- thus, although a derivative work, the photographer, as member of the public, has a right to take the photograph. [And has a copyright in the photograph.]
- thus, sculptor has no cause of action.

1E. Publishing photograph without sculptor's consent.

- sculptor has copyright in the *bas-relief*. § 106(1).
- thus, he has the exclusive right to make derivative works (such as, the photograph). § 106(2).
- the Architectural Works Act "photographing from a public place" exception does extend to publishing the photographs of architectural works; it allows "making ... distributing" photographs of copyrighted buildings taken from public places. § 120(a).
- *note*: probably, there is no fair use defense.
 - four factor test is used. § 107.
 - here, publishing photograph is a commercial use, and potentially could adversely affect sculptor's derivative market for photographs of his sculpture.
- thus, sculptor has no cause of action.

1F. Mentioning the sculptor's name when publishing the photograph.

- VARA gives visual artists (here, the sculptor) the right of paternity/attribution. § 106A(a)(1)(A).
- failure to indicate the name of the sculptor with the *bas-relief* or works derived from it violates VARA.
- sculptor has a cause of action.

1G. City consent to publication of photograph.

- since *bas relief* is not a "work for hire" (*per* # 1A), sculptor retains copyright in it; city does not have the copyright.
- therefore, the city's consent to publication is irrelevant.
- the answer to # 1E is not altered by the city's consent.

1H. Copyright in photo?

- creator of a derivative work has a copyright in the derivative work. [*Burrow-Giles*]
- photographer's copyright covers the elements introduced by the creator of the derivative work.
- it does not cover the elements carried over from the original work.
- [to publish or reproduce the derivative work, consent of both the creators of the original work and of the derivative work must be obtained.]

II. (30 min.)

bonus: AIA applies, because both Adam and Bailey filed after March 1, 2013.

novelty:

- § 102(a)(1) requires that an invention be novel.
- that means there must be no single prior art reference which contains all of the same elements claimed in the inventor's patent application.
 - here, the remote-controlled drone is novel.
- *public sale bar*: § 102(a)(1) bars a patent if it had been in public use or on sale by anyone before application.
 - here, Adams advertised the invention for sale less than one year before Bailey's application.
 - here, Adams's testing was a public use in a public park if it was not experimental.
 - see below.

disclosure:

- disclosure by or through applicant more than one year before application bars patent. § 102(b).
 - disclosure can be by publication or public use.
 - here, Adams use in the public park is a disclosure if it was not an experimental use; if so, it would bar his patent.
 - see below.
 - here, Bailey didn't make a use in public or otherwise disclose his invention, so he patent is not barred by a disclosure by him.

obviousness:

- § 103 requires that an invention not be obvious to a person with ordinary skill in the relevant art.
- here, both Adams and Bailey combined the elements of prior art drones remotely-controlled with analog radio signals with remote-control by encrypted digital radio signals.
- Bailey expected that combination of elements to be operative, so he did not test the combination, but went straight to application.
- does his expectation rise to the level of obviousness?
 - if so, Bailey's patent should be barred for obviousness.
- DECIDE.

utility:

operability: an invention must be operable to be patented.

- reduction to practice confirms operability.
- *bonus*: filing a patent application is deemed constructive reduction to practice, subject to PTO's requiring proof of operability.

experimental use:

- moderately-complex and complex inventions must be tested to establish reduction to practice.
- experimental use for testing does not constitute a public use for prior art purposes (either novelty or disclosure).

- a drone is a complex device, which ought to be tested for operability.
 - Adams did so; Bailey did not (he assumed operability, based on operability of prior art devices).
- arguably, while miniature aircraft principles already had been proven operable in prior art miniature aircraft, remote control by digital radio signals had not yet be proven operable.
 - however, other remote control devices remotely controlled by digital radio signals had been proven operable (such as, garage door openers and car locks).
- DECIDE whether testing was required for this invention.

consequences of experimental use decision:

- if reduction to practice is required:
 - Adams's use in public between August 2012 and October 2012 is an experimental use to prove operability, and is not treated as a "use in public" for purposes of § 102(a)(1). Thus, his offer of sale in February 2013 is his first public use which occurred less than one year before Bailey filed.
 - this does not bar Adams's patent under § 102(a)(1) because the § 102(b) disclosure bar does not apply..
 - it does bar Bailey's patent under § 102(a)(1) because Adams's public use occurred before Bailey's application.
- if reduction to practice is not required:
 - Adams's use in public in August 2012 was not an experimental use, but was a "use in public" which occurred more than one year before Bailey's application.
 - this does bar Adams's patent under § 102(a)(1).
 - it also bars Bailey's patent under § 102(a)(1).

bonus: the duration and order of a application preparation by Adams's patent attorney is normal. Thus, it is a mere explanation of why Adams didn't file sooner; it does not affect the legal result, since it does not give Adams any priority.

III. (40 min.)

suits by Dr. Wilson against the other doctors;

- copyright is automatic; affixation of a copyright notice has not been required since 1989.

copyright infringement:

- infringement is copying/reproducing the copyrighted work without consent of the copyright owner. § 106(1), 501(a).
- here, the other doctors copied the photographs without consent.

unfair competition:

- definition: appropriation of business good will of a competitor with consequent deception among customers about the origin of goods/services and/or about comparative qualities of competing goods/services.
- unfair competition law prohibits "palming off": engaging in practices causing consumers to think defendant is origin of plaintiff's goods/services. [*Wm. Warner*]

- here, defendant doctors posted Dr. Proboscis's photos to induce consumers to think that defendant doctors are the origin of those "nose jobs" and that their work has the quality depicted in the photos.

- those doctors "palmed off" Dr. Proboscis's work as their own. [*note*: more than one of them copied the same photographs.]

- the same unfair competition principles apply both under state common law and Lanham Act § 43a.

§ 43(a) unfair competition:

- false or misrepresentation of fact in commercial advertising which misrepresents the character or quality of goods/services. § 43(a)(1)(b).

- here, photos cause consumers to believe other doctors' surgical abilities resulted in the appearance of those patients. (Of course, their abilities might be equivalent to those of Dr. Wilson.)

- this is a violation of § 43(a).

remedies:

- injunction to remove the photographs. § 502.

- actual damages for diverted surgical business. § 504(b)

- measured by Dr. Wilson's lost profit or the other doctors added business created by the use of the copyrighted photos on their web pages.

- probably, this would be very hard to document.

- statutory damages. § 504(c)

- if actual damages are inadequate.

- treble damages. § 504(d)

- if defendant(s) did not have reasonable grounds to believe the copying was exempt.

- *note*: since 1989, existence of a copyright is presumed; there are no presumption about fair use.

suits by patients against the other doctors:

right of publicity

- *definition*: appropriation of person's name or likeness without consent for commercial advantage.

- but, it is available only to celebrities.

- which requires public recognition.

- not available to patients here (except those who are celebrities; no such facts).

suit by Dr. Wilson against web service providers:

direct infringement:

- web service providers are not a direct infringers, because they did not post the infringing photographs.

secondary liability:

- *contributory infringement*:

- *definition*: actions where accused has knowledge of another's infringement and materially contributes to, induces, or causes it. [*Sony; Fonovisa; Perfect 10*]

- *vicarious infringement*:

- *definition*: defendant has the legal right and physical ability to supervise the infringing activity and profits from or has a direct financial interest in those activities. [*Fonovisa; Perfect 10*]
- here, service providers enabled defendant doctors to post Dr. Proboscis's copyrighted photographs. They financially benefitted from the unlawful postings because they were paid for hosting their web pages.
- this is vicarious infringement.

DMCA issues:

- service provider not liable. § 512(a).
 - DMCA presumes that service provider does not have or exercise pre-posting editorial control over content of hosted web pages.
- when notified, service provider must remove infringing material. § 512(b).
- service provider must comply with "take down" order from copyright owner. § 512(c).

IV. (20 min.)

IVA. Injunction against Casey's for use of "Footlong" on its sub sandwiches.

- Subway has used "Footlong" on its 12" sandwiches for years.
- trademarks cannot be generic or merely descriptive terms; they must be distinctive terms referring to the origin of goods or services.
 - generic terms are nouns referring to something.
 - descriptive terms are adjectives referring to qualities or characteristics of something.
- on its face, "Footlong" is merely descriptive of the length of the sandwiches (which is factually accurate).
- distinctive terms are arbitrary or suggestive terms, or descriptive terms that have acquired secondary meaning.
 - terms with secondary meaning are those which the public has come to associate with the origin of goods or services and not with the ordinary meanings of those terms.
- Subway can protect "Footlong" as a trademark (common law or statutory) only if it has acquired secondary meaning. The public must think that "Footlong" sandwiches come only from Subway.
- in light of fact that many restaurants/sandwich shops sell sandwiches as "12" long" or "foot long", it seems unlikely that public believes all "foot long" sandwiches come from Subway. (*Consider* "foot long" hot dogs, Sub Shop in Columbia MO, sub sandwiches at any number of other shops for many decades.)
- but if public has come to use "Footlong" only to refer to sub sandwiches from Subway, then it has acquired secondary meaning and has become protectable as a mark.
- DECIDE.

IVB. Registration by Subway of "Footlong".

- trademark or service mark can be registered only if it is distinctive.
- to be distinctive, the term must be arbitrary, suggestive, or descriptive with secondary

meaning.

- *see above.*

- in light of IVA, it is not distinctive.

- [*note:* in the unlikely event that the examiner granted a registration, Caseys could file an opposition based on lack of distinctiveness.]

- *supplemental registration:* available for terms which are capable of acquiring distinctiveness (secondary meaning) in the future, but have not yet acquired it.

V. (30 min.)

Briefly define the following terms:

- (1) *incontestability* – after 5 years use, a trademark is deemed to have acquired secondary meaning and cannot be declared invalid for lack of distinctiveness or is a prohibited mark. [Lanham Act § 15]
- (2) *prior art reference* – a public use, public sale or offer of sale, patent, or printed publication which occurs or exists before the effective date of applicant's patent application. [Not before applicant's date of invention.] [Patent Act § 102(a)]
- (3) *likelihood of confusion* – identical or similar terms which could cause consumer to be deceived or confused about the origin of goods or services. [Lanham Act § 2(d); *Mead*]
- (4) *concurrent use* – use of same or similar marks on the same or similar goods or services in separate geographic areas. [*Dawn Donut*]
- (5) *right of paternity* – moral right to have the artist's name and authorship recognized. [*Smith*; Copyright Act § 106A(a) [VARA]]
- (6) *dilution* – sufficiently similar terms on noncompeting goods or services which evoke an instinctive mental association by consumers that could cause blurring or tarnishment of the senior term and lessens the capacity of the mark to identify the origin of those goods or services. [*Starbucks*; Lanham Act § 43(c)]
- (7) *obviousness* – subject matter as a whole would have been obvious at the time of invention was made to a person having ordinary skill in the art to which said subject matter pertains [Patent Act § 103]; combines elements of two or more prior art references.
- (8) *distinctiveness* – term which public associates with the origin of a product or service; it must have a meaning which is not generic or merely descriptive. [Lanham Act § 2]
- (9) *doctrine of equivalents* – elements of patented and accused devices do the same work, in substantially the same way, and accomplish substantially the same result even though they differ in name, form or shape. [*Graver Tank*]
- (10) *parody* – is a form of indirect criticism which involves a humorous comparison with the original work; is allowed by the fair use doctrine. [*Campbell*]