TRIVIA

- The first lawsuit brought under ACPA was filed by actor Brad Pitt against two domain-name holders. Mr. Pitt was successful.
- J. Crew International Inc. won a decision under the UDRP after an individual registered “crew.com” and attempted to sell it to J. Crew. Other successful complainants include NASDAQ and Madonna.
- A federal court has held that an Internet domain name registrar cannot be sued for civil rights violations for refusing to register domain names that included obscene terms.
- By late 2000, Internet users had registered more than 31 million domain names.
- The makers of the movie Spider Man were allowed to superimpose digital images on real-life billboards. The makers altered Times Square billboards by superimposing ads from companies such as Cingular Wireless over the real ads for Samsung and NBC. The court ruled that the digital alterations were protected free speech.
- “Dot com” is the most popular domain suffix.

CHAPTER SUMMARY

The Internet has dramatically changed communication. Along with that change, however, has come conflict over use of domain names and trademarks. The assignment of domain names, or Internet addresses, has resulted in disputes between the owners of domain names and the owners of trademarks. Courts have protected the rights of trademark owners as against “cybersquatters,” those who register domain names for the purpose of selling them to their rightful owners rather than for some bona fide use or purpose.

If a dispute arises between parties claiming rights to domain names, the aggrieved owner has a variety of avenues in which to pursue relief. Under the new Anticybersquatting Consumer Protection Act, money damages can be obtained in court. Under the Uniform Domain Name Dispute Resolution Policy, a streamlined and inexpensive process, an arbitrator can cancel an abusive domain name or order it transferred to its rightful owner.

Use of the Internet also implicates First Amendment rights to freedom of speech. At present, courts have held that merely providing links to another party’s web site is permissible. Deep link-
ing (allowing a party to bypass a home page and proceed directly to relevant material) is subject to dispute. The practice of embedding another party’s trademarks on a web site may also constitute trademark infringement. In addition, merely having a passive presence or web site on the Internet will likely not subject a party to personal jurisdiction; however, if goods are offered for sale or contracts are entered into through a web site, a court may subject the web site owner to personal jurisdiction. Finally, use of another’s mark on a noncommercial web site for the purposes of satire, parody, or consumer commentary is likely permissible as long as there is no likelihood of confusion.

### INTERNET RESOURCES

<table>
<thead>
<tr>
<th>Resource</th>
<th>Description</th>
</tr>
</thead>
<tbody>
<tr>
<td>WIPO:</td>
<td><a href="http://www.wipo.org">http://www.wipo.org</a> (site of World Intellectual Property Organization, offering information and statistics about proceedings under the UDRP)</td>
</tr>
<tr>
<td>ICANN:</td>
<td><a href="http://www.icann.org">http://www.icann.org</a> (site of Internet Corporation for Assigned Names and Numbers, offering information about domain name registration and the full text of the UDRP)</td>
</tr>
<tr>
<td>Information on First Amendment related issues:</td>
<td><a href="http://www.chillingeffects.com">http://www.chillingeffects.com</a> (site devoted to examining issues relating to trademark use and the First Amendment and offering sample cease and desist letters and general information about issues such as deep linking and the use of metatags)</td>
</tr>
</tbody>
</table>
A CTM application may be filed in any one of the languages of the EU nations.
Approximately 70 percent of all CTM registrations from 1997–2001 issued to non-EU nations were issued to the United States.
The WTO has estimated that the impact of the 1994 Uruguay Round trade deal was between $109 billion and $510 billion added to world income.
INTA was established more than 100 years ago by seventeen merchants and manufacturers to protect and promote the rights of trademark owners.
WIPO administers twenty-three treaties related to intellectual property.

CHAPTER SUMMARY

A foreign national may file an application for trademark registration with the PTO on the basis of actual use of the mark in commerce in the United States, a bona fide intent to use the mark in commerce in the United States, or on the bases of a pending application or existing registration in a foreign country. If the application is filed with the PTO within six months of its filing in the foreign country, it will retain its earlier foreign filing date for purposes of determining priority rights in the mark. Once filed, the application will proceed similarly to other applications, although to secure a U.S. registration, the applicant must submit to the PTO a certified copy of the registration issued by the foreign country. One significant difference is that while U.S. applicants can receive a registration only upon a showing of actual use, foreign nationals can obtain registrations without ever using the mark (inasmuch as their U.S. registration is based upon their foreign registration, which may not have required use).

Just as foreign nationals may seek protection for their marks in the United States, U.S. trademark owners may seek protection for their marks in various foreign countries. The assistance of a foreign associate who is expert in trademark law in the relevant country is nearly always required. As with applications filed by foreign nationals in the United States, applications filed in countries that are members of the Paris Convention filed within six months of the date of a U.S. application retain the earlier U.S. filing date for priority purposes. U.S. trademark owners should file applications in countries in which they intend to do business and in any countries that have a history or tradition of trademark piracy, namely, countries in which third parties attempt to register marks
for goods or services they will not be offering in anticipation of the entrance of a foreign trademark owner to whom they can then sell the mark.

A new system called the Community Trademark System allows trademark owners in the United States to file one single trademark application and receive a single registration covering all twenty-five member nations of the European Union, resulting in significant savings of time and money.

INTERNET RESOURCES

Information on section 44 applications: See TMEP at http://www.uspto.gov/web/offices/tac/tmep/index.html (see Chapter 12).


Information about CTM applications: See web site of Office for Harmonization in the Internal Market at http://www.oami.eu.int.

World Trade Organization: http://www.wto.org (web site offers information about the WTO and full text of TRIPs and Uruguay Round agreements)

International Trademark Association: http://www.inta.org

CHAPTER 9

Foundations of Copyright Law

TRIVIA

- According to the Department of Commerce, combined copyright and trademark indus-
tries represent the second fastest-growing segment of the U.S. economy (behind
Internet-related electronic commerce).
- In 2001, the Business Software Alliance estimated that there were 840,000 Internet sites
engaged in copyright infringement by selling illegal or pirated software as the real thing.
- The total number of copyrights registered in the United States, through 2001, was more
than 29 million.

CHAPTER SUMMARY

In the United States, copyright law arises under the Patent and Copyright Clause of the
Constitution. The U.S. copyright laws have been amended several times, and the current governing
statute is the Copyright Act of 1976. Copyright ensures that an author or creator of a work will
derive benefits from his or her creation and will be protected from unauthorized use or copying of a
work. Under the Copyright Act of 1909, a work had to be published to be protected under the act.
The 1976 act eliminated the requirement of publication and provides that copyright is secured
automatically when the work is created. No publication or registration is necessary to secure copy-
right protection, although there are certain advantages to registration of a copyright with the U.S.
Copyright Office.

INTERNET RESOURCES

Federal laws relating to copyright:  http://www.ll.georgetown.edu;
http://www.findlaw.com; and
http://www.copyright.gov/title17/circ92.pdf

Copyright Office:  http://www.loc.gov/copyright or
http://www.copyright.gov
General information: http://www.law.cornell.edu/topics/copyright.html; (site of Cornell Law School); http://www.findlaw.com; http://www.megalaw.com; and http://www.csusa.org (site of Copyright Society of the United States, a nonprofit corporation organized in 1953 to foster interest in and study of copyright law)
CHAPTER 10

The Subject Matter of Copyright

TRIVIA

- Nearly 6 percent of all employment in the United States is in copyright-related industries.
- Between 1977 and 2001, U.S. copyright-related industries’ share of the gross domestic product grew more than twice as fast as the remainder of the U.S. economy.
- In Arden v. Columbia Pictures Industries, Inc., 908 F. Supp. 1248 (E.D.N.Y. 1995), the court considered whether plaintiff’s novel of a man trapped in a repeating day, forced to live the same day over and over, infringed the famous movie Groundhog Day, produced twelve years later. The court held that there was no infringement because the works were not substantially similar. While the ideas expressed were the same, the expression of those ideas was quite different because the novel was dark and introspective and featured witchcraft while the movie was a romantic comedy. Any similarity between the two related only to unprotectable ideas, concepts, or abstractions.
- Even silence may be copyrightable. Artist John Cage, now deceased, recorded “4’33”’ (an entirely silent piece lasting four minutes and thirty-three seconds). Whenever “4’33”’ has been recorded by other artists, as it was by Frank Zappa in 1993 (for a tribute album to Cage), royalties have been paid to use the silent work.

CHAPTER SUMMARY

Copyright protects original works of authorship that are fixed in a tangible form of expression such that they can be perceived, communicated, or reproduced either directly or with the aid of a machine or device. The requirement of originality means that the work must be independently created by the author; it need not be the only work of its kind. Copyrightable works include the following categories: literary works; musical works (including any accompanying words); dramatic works (including any accompanying words); pantomimes and choreographic works; pictorial, graphic, and sculptural works; motion pictures and other audiovisual works; sound recordings; and architectural works.

Some matter is uncopyrightable, such as ideas, useful articles, blank forms, titles, short phrases, common property (such as height and weight charts), lists of ingredients, facts, and matters in the public domain, including works whose copyrights have expired and works of the U.S. government.
A compilation of otherwise uncopyrightable material may be protectable (such as a book of lists). Similarly, a collection of other copyrightable material (such as the collection of film clips that made up the movie *That's Entertainment*) may itself be copyrightable as a new work. Finally, a work that is recast (such as a movie made from a book) is copyrightable, in regard to the new material, as a derivative work.

**INTERNET RESOURCES**

Federal laws relating to copyright: http://www.ll.georgetown.edu  
http://www.findlaw.com; and  
http://www.copyright.gov/title17/circ92.pdf

Copyright Office: http://www.loc.gov/copyright or  
http://www.copyright.gov

General information: http://www.law.cornell.edu/topics/copyright.html (site of Cornell Law School);  
http://www.findlaw.com; http://www.megalaw.com; and  
http://www.csusa.org (site of Copyright Society of the U.S.A., a nonprofit corporation organized in 1953 to foster interest in and study of copyright law)
CHAPTER 11

The Rights Afforded by Copyright Law

TRIVIA

- The year 2002 saw a 7 percent drop in global music sales and a 10 percent drop in units sold in the United States, probably due to high-tech piracy and CD burning.
- In fiscal year 2001, the Copyright Office collected and deposited approximately $186 million in royalty fees for various copyright owners.
- In April 2003, the Recording Industry Association of America filed lawsuits against students at Princeton, Michigan Tech, and Rensselaer Polytechnic Institute for copyright infringement for operating song-sharing sites on their university servers.
- John Philip Sousa, Jerome Kern, Irving Berlin, and Victor Herbert were among the first members of ASCAP.

CHAPTER SUMMARY

Owners of copyright are granted a bundle of exclusive rights:

- rights to reproduce the work;
- rights to prepare adaptations or derivative works based on the original work;
- rights to distribute the work;
- rights to perform the work; and
- rights to display the work.

Exercise of any of these rights without permission of the copyright owner will constitute infringement of copyright, even if there is no intent to infringe and the use is innocent. There are, however, certain exceptions to the exclusive rights granted to copyright owners, such as rights to use certain copyrighted works in certain instructional and educational activities, during religious worship services, for noncommercial fund-raising, for the handicapped, and for transmission of works in small commercial establishments. Moreover, according to the first sale doctrine, once a copyrighted work has been lawfully distributed by the owner, the new purchaser is free to further distribute the work by sale or lending.

A copyright owner’s rights in sound recordings are significantly more limited than rights granted for other works, especially nondramatic literary and musical works.
Finally, authors of fine arts such as paintings and sculptures are granted “moral rights” in those works, allowing them to be identified as the author of the work and prohibiting destruction or alteration of the work, even after the creator has sold it.

**INTERNET RESOURCES**

Federal laws relating to copyright: http://www.ll.georgetown.edu or http://www.findlaw.com

Copyright Office: http://www.loc.gov/copyright or http://www.copyright.gov
(for information on compulsory licenses and CARP)


Copyright Clearance Center: http://www.copyright.com

CHAPTER 12

Copyright Ownership, Transfers, and Duration

TRIVIA

• In 2001, the Copyright Office registered 601,659 claims of copyright and recorded more than 15,000 documents.
• *To Kill a Mockingbird*, the movie, a derivative work based on Harper Lee’s earlier novel, was copyrighted in March 1963.
• The Copyright Office employs approximately 500 staff. Its fiscal year 2001 budget was more than $38 million, approximately $21 million of which was funded by fees charged by the Copyright Office.

CHAPTER SUMMARY

Determining ownership of a copyright is critical because a wide variety of rights flow from copyright ownership, including rights to reproduce, adapt, distribute, perform, and display the work. Moreover, the duration of copyright depends upon its ownership. When two or more people create a work with the intent that their separate contributions be merged into the completed work, the work is a joint work and the authors each have rights to distribute, perform, reproduce, or display the work. A derivative work is one based upon an underlying work. The author of the underlying work has exclusive rights in his or her work, and the author of the derivative work has rights in his or her newly created work that exist independently from any rights in the original work.

Although the general rule is that the person who creates a work is the author of that work, there is an exception to that rule: the copyright law defines a category of works called “works made for hire.” If a work is one “made for hire,” either the employer or commissioner of the work is the author for copyright purposes and possesses the exclusive rights of a copyright owner. A work made for hire is one prepared by an employee in the scope of employment or one of nine specially enumerated types of commissioned works that the parties have agreed in writing will be a work made for hire.

Because copyrights are property, they may be transferred. Moreover, the rights of a copyright owner (including rights to reproduce, adapt, distribute, perform, and display the work) are divisible, meaning that the author may transfer some rights and retain others. Transfers of exclusive rights must be in writing. Transfers of copyright can be terminated either by the author or certain of his or her heirs during a statutorily defined period beginning the thirty-sixth year after the transfer.
This unusual provision in copyright law is intended to protect authors who transfer rights before they fully understand the value of their works.

Copyrights created after the 1976 act last for the author’s life plus seventy years or seventy years from the last survivor’s death in the case of joint works. For works made for hire and anonymous and pseudonymous works, the duration of copyright is ninety-five years from first publication of the work or one hundred and twenty years from its creation, whichever first occurs.

**INTERNET RESOURCES**

- Federal laws relating to copyright: [http://www.ll.georgetown.edu](http://www.ll.georgetown.edu) or [http://www.findlaw.com](http://www.findlaw.com)
- Copyright Office: [http://www.loc.gov/copyright](http://www.loc.gov/copyright) or [http://www.copyright.gov](http://www.copyright.gov) (for forms, circulars, and information on copyright ownership, works made for hire, transfers, termination of transfers, and duration)
- General information: [http://www.findlaw.com](http://www.findlaw.com) and [http://www.megalaw.com](http://www.megalaw.com)