Introduction

Intellectual property consists of *private rights to prevent other people from using information*. This textbook provides a broad introduction to the bodies of law that create these rights, and a systematic way of thinking about the legal problems involving the control of information.

If you are used to American casebooks, the present volume may strike you as eccentric. So a few words are in order on what this book does, and why.

Coverage

Patent, copyright, and trademark dominate most IP courses and most casebooks, sometimes with cameos from trade secret and right of publicity. I don't mean to denigrate these fields. They are important, and an IP course that omitted one of them would be seriously deficient. But they are not so much *more* important than other IP fields that they should have the course to themselves.

For one thing, these other fields are important in regular "IP" practice. Just ask an observer of the smartphone design-patent wars or a business lawyer reviewing ad copy for substantiation. For another, these other fields help illuminate the traditional ones. Trademark law's treatment of descriptive and misdescriptive marks looks very different after a trip through false-advertising law.

Thus, this book casts an extremely broad net when including IP regimes. It includes contracts for the use of information, trade secrets, copyrights, trademarks, unfair competition, parts of false advertising law, geographic indications, rights of publicity, moral rights, design patents, and a miscellany of federal and state regimes like boat-hull protections and common-law misappropriation.

The book then casts its net widely again within each IP regime. My working motto when debating what to include was *no unpleasant surprises*. It is fine to gesture briefly at something big and messy whose details are not filled in in the slightest – like the compulsory copyright license for satellite broadcasting, whose rules fill dozens of pages in sections 119 and 122 of title 17. But it is not fine to pass by something that comes up regularly, is important when it does, and whose existence is not easily predictable – like the exemption in section 110 for most in-person noncommercial public performances.

And finally, the book casts its net widely a third time to sweep in bodies of law that are not traditionally regarded as "intellectual property" at all, but have something to teach about how intellectual property law works. Sometimes, this is because they provide useful points of comparison: FOIA and classification effectively create a body of secrecy law for the government, and seeing how they work clarifies what is distinctive about *trade* secret law. Sometimes, it is because they provide the backdrop against which "intellectual property" law plays out: pharmaceutical patent law is unintelligible without a grounding in the drug-approval process. And sometimes, it is because they really *are* intellectual property law: Actors Equity gives out stage names on a first-come first-served basis, and while the resulting rights are narrow and privately created, they are binding within the relevant domain.
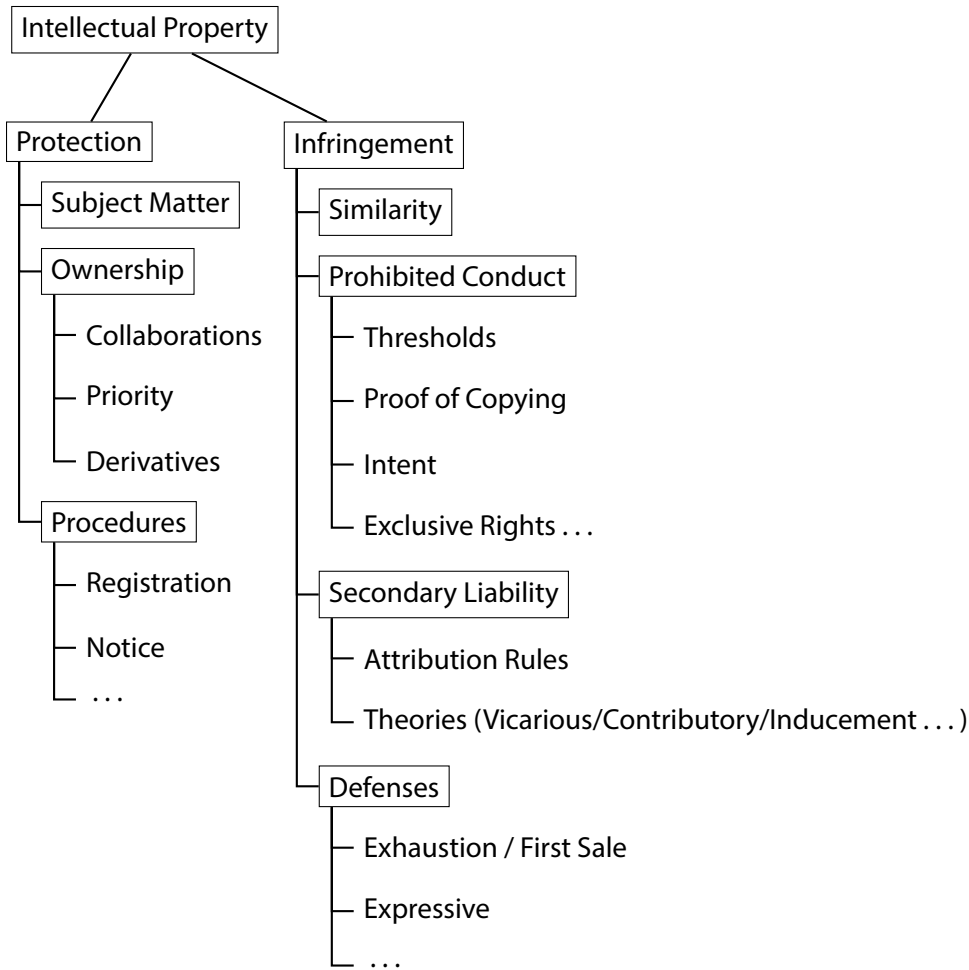
Given this wide range of subjects, the book does not cover each of them in equal depth. Instead, I have tried to do two things. On the one hand, I try to give a good conceptual sense for how each body of IP law thinks about the world. Copyright is built around originality and similarity; trademark is built around distinctiveness, priority, and confusion; advertising law is built around truth; and so on. Each chapter is arranged to build this intuition, even at the expense of detail.

On the other hand, the book is relentlessly comparative. I don't mean that it's internationally comparative, although some sections do sketch the major distinctions between the U.S. approach and other countries' (e.g. on geographic indications and moral rights). Instead, it draws every possible comparison within American IP law. It does this at a macro level, emphasizing the similarities and the differences between the basic principles undergirding each body of IP law. For example, patent and copyright think similarly about incentives, while trademark and false advertising think similarly about consumers. And it does this at a micro level, setting up similar doctrines across IP fields to compare and contrast. For example, trade secret law shares with copyright law the requirement that the defendant must have copied *from the plaintiff* to infringe, which plays out in their similarly permissive attitude in allowing multiple independent parties to lay claim to the same information simultaneously. They stand in sharp contrast to patent and trademark, where subsequent independent creation can only mitigate the consequences of infringement, rather than negating it entirely.

A Taxonomy of IP

To make the internal logic of each IP field clearer, and to facilitate comparisons between them, I have imposed a rigorous structure on them. [1] The two basic issues for any form of IP are **protection** and **infringement**; as far as possible, I try to keep them distinct. In some areas, like rights of publicity, this distinction is unconventional. But whether the defendants are trading on the plaintiff's identity is a different question than which aspects of that identity are protectable at all, and separating them clarifies what is at stake in each.

1. The only exceptions are those fields, like geographic indications, discussed too briefly to bother with the full structure.

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Intellectual Property
├── Protection
│   ├── Subject Matter
│   ├── Ownership
│   │   ├── Collaborations
│   │   ├── Priority
│   │   └── Derivatives
│   └── Procedures
│       ├── Registration
│       ├── Notice
│       └── . . .
└── Infringement
    ├── Similarity
    ├── Prohibited Conduct
    │   ├── Thresholds
    │   ├── Proof of Copying
    │   ├── Intent
    │   └── Exclusive Rights . . .
    ├── Secondary Liability
    │   ├── Attribution Rules
    │   └── Theories (Vicarious/Contributory/Inducement . . . )
    └── Defenses
        ├── Exhaustion / First Sale
        ├── Expressive
        └── . . .
```

Generic Outline of Every IP Field

I further divide protection into *subject matter*, *ownership*, and *procedures* – roughly "what?", "who?" and "how?" Subject matter doctrines determine what kinds of information are protectable, ownership doctrines determine who (if anyone) actually has rights in protectable information, and procedural doctrines determine what they must do to obtain, maintain, and enforce those rights. In copyright, for example, subject matter includes *Feist*'s famous "modicum of creativity" and the idea/expression dichotomy; ownership includes joint works, works made for hire, and derivative works; and procedures include term, registration, deposit, notice, and fixation. Recurring issues within ownership include rules to allocate ownership within *collaborations*, rules to assign *priority* among competitors, and rules for *derivative* creation that builds on others' information. Procedures are too diverse to taxonomize systematically, although registration and notice are common that I have tried to flag them wherever they appear, and their absence wherever they don't.

I subdivide infringement into *similarity*, *prohibited conduct*, *secondary liability*, and *defenses*. Similarity doctrines compare the plain-

tiff's information and the defendant's; prohibited conduct doctrines ask what the defendant did with that information. Important subtopics of prohibited conduct include **threshold** conditions like Lanham Act § 43(a)(1)(B)'s "in commercial advertising or promotion," **intent** requirements (or their absence), and **proof of copying** from the plaintiff. Secondary liability doctrines include the various theories by which one party can be held liable for another's infringement, as well as the **allocation** rules that decide which defendants' conduct should be analyzed as direct infringement and which as secondary.

Some IP defenses are idiosyncratic, like the compulsory mechanical license in copyright or the vestigial experimental use defense in patent. But others display systematic consistency across almost all of IP. The **exhaustion** defenses, which define the interface between intellectual property rights in information and personal property rights in tangible things, are especially revealing. While every IP field embraces the exhaustion principle, each puts characteristically different limits on it. Another cluster of common defenses protect **expressive** uses. Sometimes these limits are internal to the doctrinal logic of an IP field; sometimes they appear as separate defenses; sometimes they are explicitly stated as First Amendment requirements. Again, both the similarities and the differences are instructive.

Organization

There are three natural ways to organize material on intellectual property. One could – like most casebooks and hornbooks – present it *by field*: trade secret, patent, copyright, trademark, etc., in each case starting with protectability and moving through infringement. One could present it *by subject matter*: literature, music, characters, industrial design, software, etc., in each case discussing all of the relevant IP fields. Or one could present it *by doctrine*: subject matter, ownership, procedure, similarity, etc., in each case moving through relevant IP fields. I have used all three.

Large parts of the book are organized by IP field: there are chapters (or major sections) devoted to trade secret, patent, copyright, trademark, false advertising, right of publicity, and design patents. Each of them takes a single IP field and marches through the septempartite taxonomy of topics. The order varies a bit (the complexity and centrality of patent prosecution means it makes sense to address patent procedures before patent ownership), sometimes the divisions aren't worth insisting on (in trademark, similarity tests are just one factor in multiple likelihood of confusion tests), and some areas omit one or more entirely (there are no meaningful procedural prerequisites to protection against false advertising). But these sections all more or less stick to this structure. These seven topics – subject matter, ownership, procedures, similarity, prohibited conduct, secondary liability, and defenses – suffice to give a reasonably clear account of how an IP field looks at the world.

Mixed in with these in-depth treatments are quicker hits on related

fields of IP and IP-adjacent law. The general rule is that they are presented in connection with the major IP fields they shed light on. Thus, phone numbers, radio callsigns, and business name registries show up in the trademark chapter; FTC and consumer false advertising suits in the advertising chapter; and so on.

Conversely, I have also distributed out subject-matter-specific parts of traditional IP fields to chapters dedicated to IP fields that more squarely address those subject matters. This first happens in the advertising chapter; I deliberately hold over the material on certification marks and deceptive marks from the trademark chapter so that I can juxtapose it with the false advertising materials. Materiality in the context of Lanham Act § 2(a) makes more sense once readers have seen it at work in § 43(a)(1)(B) cases.

Learning by Doing

This textbook is a spiritual successor to my earlier casebook *Patterns of Information Law*. The reason for the change in genre is that I no longer believe that the case method is the best way to learn IP law. Although case reading and analysis are valuable skills, they are vastly overvalued in most law schools. I have gained critical distance on legal education since moving to Cornell Tech. My classes there include LLM students, for whom case reading is not something to be learned but one of the prerequisites for admission. And they include non-law students who have never briefed a case and do not need to learn how to.

Thus, this is definitively a textbook, not a casebook. To be sure, it discusses plenty of cases, but I have mostly paraphrased and summarized them. Even where I excerpt a case or describe its facts and holding, I have made no concessions to making it "teachable" in a standard Socratic sense. If I think there is an important bottom-line to a case or a doctrine, I say what it is, rather than hiding it under my hat to be pulled out in class.

Instead, the skills this book emphasizes have more to do with *solving legal problems*. Each chapter concludes with numerous questions and exercises. While I think the text hangs together on its own, I strongly urge you to work through them all. This book is designed to provide a structured framework for using intellectual property law to solve legal problems, and plenty of practice in doing so. The questions and exercises are an essential part of building those skills.

Formatting

I have done my best to follow a few formatting conventions consistently. Important **defined terms** are in bolded and italicized type.

You may have noticed already that this book *looks* different from most law books; the "foot"-notes appear in the right-hand margin rather than at the bottom of the page. This layout is not original; I had seen it used very effectively in Ronald Grahm, Donald Knuth, and Oren

Patashnik's *Concrete Mathematics*, Robert Bringhurst's *The Elements of Typographic Style*, and Edward Tufte's books on information design. From my point of view, it solved three problems simultaneously:

First, putting citations in the margin keeps them from cluttering up the body text, while keeping them nearby for easy reference. Law reviews are widely adopting this format for the online HTML versions of their articles, and I think it makes the page substantially more readable. Second, a narrower text column is more typographically convenient. I can keep the line length to a comfortable number of characters without needing to blow up the font size and without wasting large portions of the page. And third, margins are for marginalia. I have extensively decorated the margin with illustrations, quotations, digressions, and the occasional joke.

My assumption is that most people will read this book on a screen. Although I have designed it to fill a standard $8.5'' \times 11''$ US letter portrait page as a convenience for printing, I have otherwise optimized it for digital reading. For example, marginal notes are always in the right margin, rather than alternating left and right outer margins, to facilitate continuous smooth scrolling on limited-width devices. This is a book, not a codex.

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Acknowledgments

Many people have contributed, knowingly or not, to the existence of this casebook. Please do not blame them for it.

I particularly want to thank the students at New York Law School, the University of Maryland, and Cornell University whom I have subjected to draft versions of this book over the years. They have been more patient with my pedagogical experiments than I had any right to expect, and they have gently pointed out many glitches and outright mistakes.

I am grateful to Connor Flannery (Cornell Law School JD class of 2023), who provided diligent research assistance. He helped set up the bibliographic database of citations, checked the manuscript for typos and other mistakes, and hunted down illustrations. It was not glamorous work, but any book requires a great deal of time in the trenches, and I am glad to have had him there laboring alongside me.

Although I respectfully disagree with the editorial choices of all existing IP casebooks, I have learned a great deal from them. I am grateful

to everyone else who has blazed a trail through the overgrowth that is IP law; I hope they will not begrudge me blazing one more.

This book also owes an immense debt to the Georgetown IP Teaching Resources database maintained by Rebecca Tushnet, now of Harvard Law School. Many of the images that adorn the pages of this casebook came from the Database, and I have also been significantly influenced by Tushnet's argument that IP teaching benefits from a multimedia approach.[2]

This book was typeset using the XeLaTeX document preparation system – a special-purpose programming langauge for typesetting. That may sound painful, and it is at times, but it is still unbelievably better than Microsoft Word. The body text is Herman Zapf's Palatino (the primary Cornell typeface); the headers are Robert Slimbach and Carol Twombly's Myriad. The accent color, RGB `#B31B1B`, is Carnelian, a/k/a Cornell red. The citations are formatted using Charles Duan's `bluebook.sty` package.

Others who have given corrections, provided materials, or made suggestions include Bryan Choi, Ralph Clifford, and Brian Pyne. The Sawzie concept and photograph are by James Major.

This book in its present form was compiled for my Fall 2021 Intellectual Property survey course at Cornell Tech. I am sure that many errors and omissions remain. I welcome any comments, suggestions, and corrections and will try to incorporate them in future versions.

In Closing

There is no fancy fare in this restaurant; I have set the table with the dishes I cook for myself at home. I hope that you enjoy working with this book as much as I have enjoyed writing it.

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James Grimmelmann
Cornell Tech and Cornell Law School
`james.grimmelmann@cornell.edu`

2. *See* Rebecca Tushnet, *Sight, Sound and Meaning: Teaching Intellectual Property with Audiovisual Materials*, 52 Sт. Louıs U. L.J. 891 (2008).