



**Patterns of
Information Law**
Intellectual Property Done Right
Version 1.2

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Introduction

Why This Book?

This book takes its subtitle from Sheldon Axler's *Linear Algebra Done Right* and its inspiration from a line by the great mathematician Emil Artin: "It is my experience that proofs involving matrices can be shortened by 50% if one throws the matrices out." Matrices are numerical representations of mathematical operations; proofs involving them tend to look something like:

$$c \begin{bmatrix} a_{1,1} & \cdots & a_{1,i} & \cdots & a_{1,n} \\ \vdots & & \vdots & & \vdots \\ a_{j,1} & \cdots & a_{j,i} & \cdots & a_{j,n} \\ \vdots & & \vdots & & \vdots \\ a_{m,1} & \cdots & a_{m,i} & \cdots & a_{m,n} \end{bmatrix} = \begin{bmatrix} ca_{1,1} & \cdots & ca_{1,i} & \cdots & ca_{1,n} \\ \vdots & & \vdots & & \vdots \\ ca_{j,1} & \cdots & ca_{j,i} & \cdots & ca_{j,n} \\ \vdots & & \vdots & & \vdots \\ ca_{m,1} & \cdots & ca_{m,i} & \cdots & ca_{m,n} \end{bmatrix}$$

Axler's book throws most of the matrices out, and as a result, is one of the clearest college mathematics textbooks ever written. There are matrices and proofs using them, but they are secondary to the algebraic explanations and proofs, which tend to look more like:

$$cT(v) = T(cv)$$

This book is my attempt to take intellectual property law and throw the matrices out. The matrices aren't literal matrices, of course, or IP would be much less fun and interesting to study, to teach, and to practice. Instead, the matrices consist of built-up expectations about how the subject is structured, and how it should be taught. But many of these traditions have nothing but tradition to support them. Cast them aside, and what emerges is simpler, richer, and more elegant.

Coverage

The first tradition to discard is the assumption that "intellectual property" primarily means patent, copyright, and trademark. These three fields dominate most IP courses and most casebooks. Trade secret

law usually makes a walk-on appearance, as does the right of publicity, but that is typically it. Design patents, false advertising, and idea protection may be mentioned as afterthoughts. I don't mean to denigrate patent, copyright, and trademark. 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 fields of IP that they should push those other fields out of the picture.

For one thing, these other fields are important in regular "IP" practice: just ask any observer of the smartphone design-patent wars, any employment lawyer negotiating an NDA, or any business lawyer reviewing ad copy for substantiation. A professor who lets students leave the IP survey unaware these bodies of law even exist commits academic malpractice.

If that weren't enough, 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: the difference between an arbitrary mark and a misdescriptive one is whether consumers are in on the joke. Recognizing that the reverse engineering privilege in trade secret law is a form of exhaustion helps clarify exhaustion in patent law.

Thus, this book casts an extremely broad net when including IP regimes. In my view, intellectual property consists of any private right to prevent other people from using information. This encompasses 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. They are all given serious attention.

Having cast a wide net to gather in IP regimes, the book then casts its net widely again within each system. My working motto when debating what to include was *no unpleasant surprises*. It is fine to gesture 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 many in-person noncommercial public performances. Thus, the book is unusually detailed in covering theories of liability and major defenses: examples include the DMCA's prohibition on removing copyright management information, the unfair-competition cause of action for deliberate passing off even in the absence of trademark rights, and the limitation of patent remedies against medical practitioners.

And finally, the book casts its net widely a third time to sweep

It probably does not help that the Big Three are all federal regimes, leading students to neglect the importance of state law.

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 absolute within the relevant domain. Thus, the book includes such unusual topics as FOIA, privacy torts, drug approval and labeling, state business name registries, country-of-origin labeling statutes, the law of personal name changes, and the BBB’s advertising self-regulatory programs.

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. Students should know that copyright is built around originality and similarity; that trademark is built around distinctiveness, priority, and confusion; that advertising is built around truth; and so on. The cases and materials are selected and arranged to build this intuition, even at the expense of detail. The point is to leave readers in a position where they can make plausible interpolations in the parts of the subjects they have not seen. A good first guess and good research skills will take you surprisingly far.

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 infringe-

ment, 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. The two basic issues for any form of IP are protection and infringement; as far as possible, I try to keep them distinct. I insist on the division even for areas, like rights of publicity, where it is not conventionally made. 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.

I further divide protection into subject matter, ownership, and procedures, or, roughly "what?", "who?" and "how?" 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. Yes, fixation. It isn't a question of what information is copyrightable so much as what one must do to obtain a copyright in that information (answer: not much). This arrangement is a bit unconventional, but I think it's clearer. I tend to break up subject matter doctrines into thresholds, which ask whether something is [creative, secret, distinctive, etc.] enough for an IP field to care about, and boundary conditions like functionality, which declare something the wrong kind of thing for an IP field. Ownership rules subdivide into rules to allocate ownership with 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, and defenses. The distinction between the first two is all-important. Similarity is a test of the relationship between the plaintiff's information and the defendant's; prohibited conduct deals with what the defendant did with that information. Similarity is the domain of claim construction and the every-element rule, of substantial similarity, and of the likelihood of confusion. Prohibited conduct is the domain of "makes, uses, offers to sell, or sells" and of the exclusive rights. It further breaks down into threshold conditions like Lanham Act § 43(a)(1)(B)'s "in commercial advertising or promotion," into intent requirements (or their absence), (sometimes) into proof of copying from the plaintiff, into the specific enumerated or unenumerated theories of direct infringement, and into various secondary liability doc-

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

None of these divisions are as fully implemented as I would like in the current version.

trines. Here is where I have found the comparative method most useful; it has forced me to find and present cases on topics like secondary liability for right of publicity violations and on proving copying in trade secret misappropriation. They exist, and they display interesting and revealing variations from their more familiar cousins.

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 essentially universal – and especially revealing, because while every IP field embraces the exhaustion principle, each IP field 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 – 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 sex-partite 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 six topics – subject matter, ownership, procedures, similarity, prohibited conduct, and defenses – suffice to give a reasonably clear account of how an IP field looks at the world.

I would have liked to include a chapter on federal preemption that also covers the miscellaneous fragments of state IP law that survive preemption and are not already covered elsewhere. I did not complete that chapter in time for my fall 2016 course.

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 intrusion on seclusion, FOIA, and classification show up in the trade secret chapter; phone numbers, radio call signs, and business name registries 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. I pull similar stunts by putting moral rights in the "personality rights" chapter rather than the copyright chapter; geographically descriptive and misdescriptive marks in the geographic indications chapter; useful articles, architectural works, and functional marks in the design chapter alongside design patents.

The extreme examples of this approach are the chapters devoted to software and to biotechnology, both of which are immensely important and can only properly be understood by considering how different IP fields interact. Software requires consideration of trade secret, copyright, and patent; biotechnology law involves patent and trademark, but also discussion of the FDA drug approval process and regulation of drug marketing and labeling. (Again, my broad understanding of what is relevant to IP means that I have no compunction against treating these regulatory regimes as establishing *de facto* IP regimes.)

This "rest" of the book remains hypothetical for now.

The rest of the book consists of chapters devoted to cross-cutting topics where there is more insight to be gained from setting out general principles and then seeing how different IP fields play out variations on the theme: litigation, remedies, transactions, and international IP. One could include these issues within each substantive chapter, but for the most part, I find it clearer just to save these issues for dedicated chapters.

What This Book Is Not

This is, as I said, a book about the structure of IP law. Traditional casebooks try to do many other things, and I want to be clear on the sacrifices I have made.

This is not a book on learning to think like a lawyer. I have made no concessions to making cases "teachable" in a standard Socratic

sense. I have cut out procedural postures. I have cut out reasoning from precedent. I have cut out dissents, even brilliant and well-argued ones. I have cut judges' names, and sometimes cut parties' names. In extreme cases, I have cut out all the facts, or all of the reasoning supporting a holding.

Part of this is a sense that traditional case reading and analysis – valuable skills that they are – are overvalued in most law schools. Part of it also is the freedom that comes from teaching IP to LLM students, for whom “thinking like a lawyer” is not something to be learned but one of the prerequisites for admission. And part of it is the critical distance that I have gained on the enterprise of legal education since moving to an institution where most of my colleagues are not law professors. Things that once seemed natural to me are strange now.

This is also not a book on IP policy. My discussions of the policy rationales for IP fields are exceedingly brief. I have cut substantial chunks of the policy discussions from the cases I excerpt. In some cases, the policy arguments are essential to understanding the holdings and the concepts they rely on. But if this book is at all useful for teeing up discussions of IP policy, it is entirely by accident.

Cases and Materials

The overriding principle for my selection of cases and other materials was *clarity*. Accordingly, I have tried hard to find cases that are either broadly representative of the doctrinal point they stand for or that state it succinctly. In my years of teaching the IP survey I came to loathe the memorable but unusual cases, because students invariably remembered them for the wrong points. I have tried to avoid including cases that go off on tangents that haven't been picked up on; they give an incorrect impression of where the action is.

Where there is a genuine doctrinal split in contemporary caselaw, I have tried to make this clear in the materials I have chosen: either by pairing cases on either side of an issue, by picking a case with a strong and well-taken dissent, or by picking a case that respectfully presents the other side of the debate before disagreeing with it. Where there is *not* a major split in the caselaw, I have tried hard to present the false impression of one.

I have also tried to strike a balance between teachability and authority. My sense is that most casebooks tend too much towards respectful but excessive quotation from Supreme Court opinions. But for various institutional reasons – including the Supreme Court's rarified docket, its emphasis on following its own precedents to the exclusion of “inferior” courts' wisdom, its frequent unwillingness to resolve the actual case before it, and some Justices' regrettable writerly habits – Supreme Court opinions are often terrible teaching cases. I

have responded by excerpting these cases with extreme brevity, or by presenting them in reflection – as other courts apply the Supreme Court’s holdings to crisper fact patterns.

Editing

My editorial technique is borrowed from Sweeney Todd: extensive and shocking cuts. These are pedagogical materials, not a legal brief. I have not put words in anyone else’s mouth, but I have been unconcerned with the usual editorial apparatus of ellipses and brackets. I drop words from sentences, sentences from paragraphs, paragraphs from opinions – all with no explicit indication that anything is gone. I also reorder paragraphs and sometimes sentences as needed to improve the readability of a passage. My goal is to make it easy for the reader. If it matters to you what the original said, consult the original.

Similarly, I have been ruthless in pruning citations. Editorial conventions that make sense in briefs and opinions are not appropriate for teaching materials. Generally, I have kept citations only when the case being cited is important in its own right or when the citation is impossible to remove without great awkwardness. I have had no qualms about attributing to courts things they quoted other courts as saying.

I also discarded the tradition that a case should be presented as a case. There are cases with wonderful discursive passages – like Judge Posner’s musings on the protectability of names as trademarks in ?? – embedded in larger messes. My edit of *peaceableplanet* keeps this discussion of name marks and discards everything else, including the facts and holding. There are also cases that are important for their holdings, like ?? and ??, but which take their damn time getting there. I kept the holdings and cut everything else.

Sometimes, the best way to make a point isn’t with a case at all. The federal government has published outstanding guides to patent, copyright, and trademark law: the MPEP, Compendium, and TMPEP, respectively. I have freely drawn from them, along with Restatement sections, regulations, and law-review articles whenever I thought that they covered the ground better than the cases I had to work with. For rarely-litigated matters like the deposit requirement, these secondary materials are far and away the best option. I have written notes and introductory materials where necessary, but I tried to keep them focused on bringing out structural issues, rather than saying again what others have already said better.

Formatting

Another crucial early decision was to format the text with a two-and-three-quarter-inch outer margin, placing notes and illustrations in the margin alongside the text they pertain to. The design is not original; I had seen it used very effectively in Donald Knuth et al'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, the narrower text column is typographically attractive. With such a larger outer margin, the resulting column is five inches wide, which makes for lines that have a comfortable font size and a comfortable length. Extended reading is easier and the page looks nice.

Second, margins are for marginalia. A note in the margin is less intrusive than a box cut out of the text and easier to glance back and forth to than a footnote. The result is that I have been free to annotate the text liberally and a little Talmudically. I have extensively decorated the margin with illustrations from the cases being excerpted. I have also included quotations and case summaries that might have gone in the notes after a case in a traditional casebook, or been presented as squib cases. Having the margin available lets me include them precisely where they are relevant. Sometimes I include see also citations to interesting articles. And occasionally I pop in with a leading question or just a straight-up joke.

And third, the margin enables me to remove citations and other unnecessary apparatus from the body of cases themselves. For the most part, cases are presented with only the name of the case in the main text: the citation is evacuated to the margin. This is another way of clarifying of the cases themselves; citations are a remarkable hindrance to readability. By putting citations alongside the text (as in some law reviews' online supplements), I believe I have resolved the Garner-Posner debate over whether citations belong in text or in footnotes. The best answer is neither: they belong in the margin.

There is a reason that law reviews print on pages that are narrower than 8.5 inches.

Document Production

I used the XeLaTeX document preparation system to prepare the manuscript of this book. XeLaTeX is a computer typesetting system derived from Leslie Lamport's L^AT_EX and built on Donald Knuth's T_EX. I type out the text of the book in a set of individual text files, marked up with tags like

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\textit{this is in italics}
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. XeLaTeX then assembles the hundreds of individual files into a single PDF output.

This approach has several advantages compared with a more traditional word processor. First, where Word or Pages.app might have choked or slowed down on a document this size, XeLaTeX has no trouble at all. True, I needed to take a minute to recompile the PDF each time I make changes. But the editing itself is fast and responsive.

Second, this method gave me fine-grained control over every aspect of how the book appears. My choice of a wide margin, for example, with sidenotes that float with the main text, would have been extremely difficult to implement in a word processor. With XeLaTeX, it was a matter of specifying the width of the margins and then writing a few commands to place materials in them in particular ways. I have been able to customize the fonts, the colors, the formatting of trademarks and the captioning of images. I have also been able to hyperlink the short forms of cases back to the full citation introducing them – all while automatically pulling them into the indices at the back of the book.

Some of my more specific formatting choices are also worth commenting on. At the moment, the book is set primarily in Palatino, which I chose because it is an attractive typeface that is widely available and happens to be Cornell's principal typeface. (Similarly, the accent color is Cornell red.) The header typeface, used for the running heads, the marginal notes and captions, and case names, is Myriad, which is also widely available.

I think the choice to use splashes of color is a no-brainer. It doesn't print out on black-and-white printers, but given that so many people read so much on screens already, it livens up the experience for the majority. I also think the use of a contrasting sans-serif font is easily defensible; it makes entirely clear what is part of the excerpted material and what is editorial apparatus.

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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 Tech whom I have subjected to draft versions of these materials 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.

This book also owes an immense debt to the Georgetown IP Teaching Resources database maintained by Rebecca Tushnet, now of Harvard Law School. In her words,

The Georgetown IP Teaching Resources Database contains images, sound clips, video clips, and related material for use in teaching copyright, trademark, right of publicity, and other IP courses. Contents include works that were subjects of litigation, such as clips from the songs involved in *Campbell v. Acuff-Rose*, as well as materials that provide useful hypotheticals for class discussion.

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.

Others who have given corrections, provided materials, or made suggestions include Bryan Choi and Ralph Clifford.

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

In Closing

Although I respectfully disagree with the organizational choices and emphases of all existing casebooks, I have learned a great deal from them. Many cases in these materials came to my attention as good teaching prospects because I found them in other books and admired how the authors used 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.

These materials were assembled for my Fall 2016 Intellectual Property survey course at Cornell Tech. I may revise and update them the next time I teach the course. I am sure that many errors remain (indeed, I have marked many on my printouts of the chapters) – but I have not had the to go back and fix even the ones I know of, let alone to look for the rest. I welcome any comments, suggestions, and corrections and will try to incorporate them if I am able to make revisions. If you would like to customize these materials for your own use or others', please get in touch so we can discuss the mechanics.

I hope that you enjoy working with these materials as much as I have enjoyed assembling them.

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