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 legal problems involving the control of information.

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

A Textbook, not a Casebook

Most obviously, this book contains very few extended case excerpts. I don't think that reading cases to extract their facts and holdings is the best way to learn IP law. Instead of spending three pages to bring out a one-sentence rule it stands for, I would rather just to say what the rule is. The book discusses plenty of cases, but they are mostly there as vivid illustrations of the rules in action. There are a few exceptions, but they fall into one of three categories:

- First, some important doctrines are fact-intensive inquiries, such as trademark's multi-factor likelihood of confusion tests. Applying these tests is a craft that must be learned by doing, so I have included extended passages from cases in which courts do that job conscientiously.

- Second, some cases are so quotable that trying to summarize them would be gilding the lily. I cannot improve on Justice Holmes's statement of the aesthetic nondiscrimination principle in *Bleistein*, so I have not tried to.

- And third, some cases are such perfect discussion fodder that it makes sense to read them in the original. An example is *E.I. DuPont deNemours & Co. v. Christopher*, the famous aerial-espionage trade secret case. Almost everything you need to know about improper means is in there.

The skills this book emphasizes have 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.
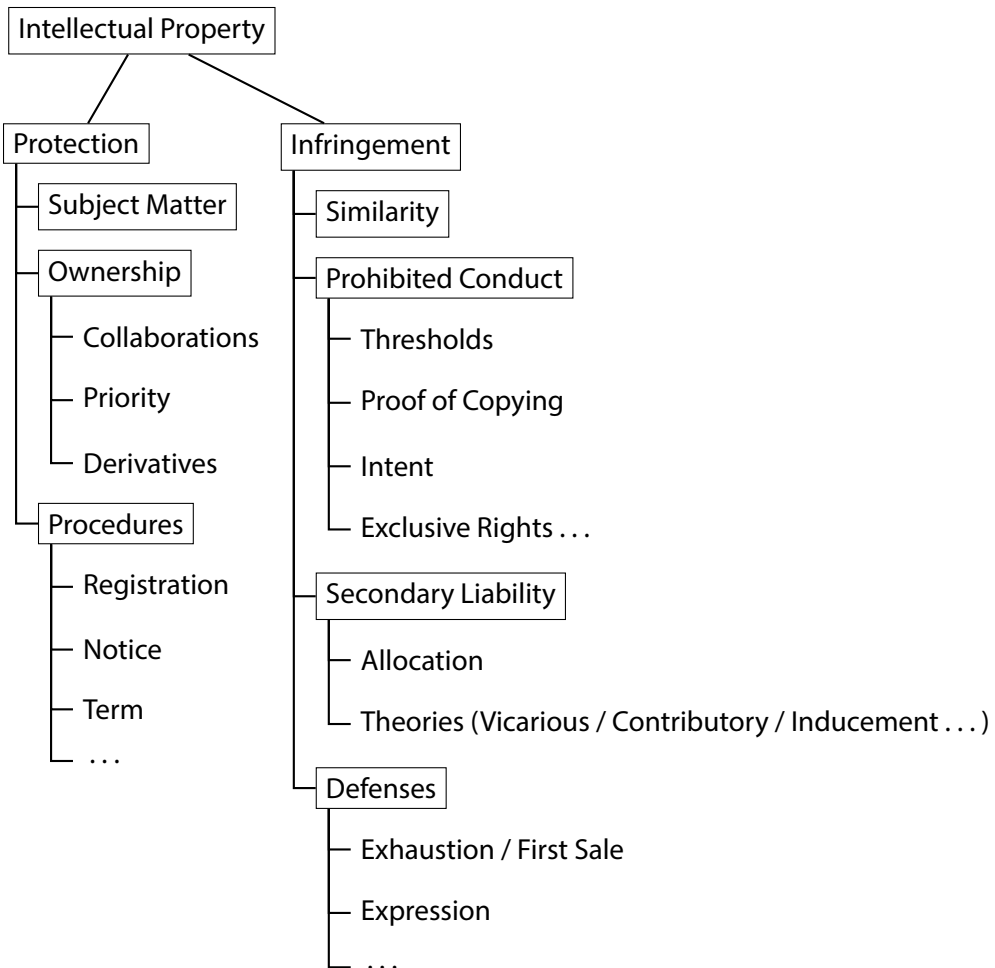
A Taxonomy of IP

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*. Both are required to find a defendant liable, which means that both are in play in every case.[2]

I subdivide 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. Subject-matter doctrines tend to consist of a mixture rule-like categorical exclusions and standard-like thresholds of protection, although the details vary immensely among IP areas. 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. The most common procedural issues involve registration, notice, and the term of protection.

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

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1. The only exceptions are those fields, like geographic indications, discussed too briefly to bother with the full structure.
2. For more on the relationship between protection and infringement, see Mark A. Lemley & Mark P. McKenna, *Scope*, 57 WILLIAM & MARY L. REV. 2197 (2016).

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Intellectual Property
├── Protection
│   ├── Subject Matter
│   ├── Ownership
│   │   ├── Collaborations
│   │   ├── Priority
│   │   └── Derivatives
│   └── Procedures
│       ├── Registration
│       ├── Notice
│       ├── Term
│       └── . . .
└── Infringement
    ├── Similarity
    ├── Prohibited Conduct
    │   ├── Thresholds
    │   ├── Proof of Copying
    │   ├── Intent
    │   └── Exclusive Rights . . .
    ├── Secondary Liability
    │   ├── Allocation
    │   └── Theories (Vicarious / Contributory / Inducement . . . )
    └── Defenses
        ├── Exhaustion / First Sale
        ├── Expression
        └── . . .
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Generic Outline of Every IP Field

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.

For the most part, this book covers each of these topics for each IP field. 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 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.

I have also pulled out some subject-matter-specific parts of traditional IP fields to chapters dedicated to IP fields that more squarely address those subject matters. The most obvious example is that I defer useful articles in copyright and functionality in trademark until a separate design chapter, so that I can discuss them alongside design patent.

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Acknowledgments

Many people have contributed, knowingly or not, to the existence of this textbook. 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. Connor Flannery (Cornell Law School JD class of 2023) and Angelina He (Cornell Law School JD class of 2023) provided diligent research assistance. They helped set up the bibliographic database of citations, checked the manuscript for typos and other mistakes, and hunted down illustrations. Others who have given corrections, provided materials, or made suggestions include Bryan Choi, Ralph Clifford, Elizabete Ludborza, and Brian Pyne. The Sawzie concept and photograph are by James Major.

Many scholars, teachers, judges, and lawyers have blazed trails through the overgrowth that is IP law; I have benefited from their work and I hope they will find in here the occasional useful shortcut or scenic detour. Although in places I respectfully disagree with the editorial

choices of other IP casebooks, I have learned a great deal from them, especially when it comes to finding vivid cases.

I owe an immense debt to the Georgetown IP Teaching Resources database created and maintained by Rebecca Tushnet. Many of the images that adorn the pages of this book came from the Database, and I have also been significantly influenced by Tushnet's argument that IP teaching benefits from a multimedia approach.[3]

This book was typeset using the XeLaTeX document preparation system. The citations are formatted using Charles Duan's Hereinafter package. Excerpts from cases and other primary materials are set in a contrasting sans-serif typeface. The accent color, RGB #B31B1B, is Carnelian, a/k/a Cornell red.

This book in its present form was compiled for my Fall 2024 Intellectual Property survey course at Cornell Tech. I am sure that many errors and omissions remain. I welcome any comments, suggestions, or 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 your time dining here as much as I have enjoyed mine in the kitchen.

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