

A GLOSSARY OF INTELLECTUAL PROPERTY TERMS

COPYRIGHT TERMS

Attribution: Some people mistakenly believe that they have satisfied the requirements of copyright law when they use copyrighted material but provide credit to the author. Courts have ruled that attribution does not excuse a violation of copyright, but that juries can take it into account when determining penalties for infringement. Courts have also ruled that people are not in violation of the law when they use public domain material without attribution.

Berne Convention: This is an international treaty dating from 1886 that standardizes basic copyright protection across international borders for the 100 member countries. The agreement says that a member country will give the same copyright treatment to an author from other countries as it does its own authors. The General Agreement on Tariffs and Trade (GATT) would later require that all member countries adhere to the Berne Convention if they do not already do so.

Cease-and-Desist Letter: This is a letter, usually written by an attorney, warning a potential wrongdoer that they are believed to be infringing on the intellectual property rights of another. The letter typically describes the legal actions that will be taken unless the misconduct is stopped. While these letters lack formal legal effect, they can later be used in court as evidence that the offender knew about the illegal conduct and yet persisted in that conduct. The receipt of a cease-and-desist letter is usually the opening salvo in any copyright dispute.

Communications Decency Act (CDA): This 1996 law was designed to restrict access to sexually explicit materials for minors. Almost all of the law was struck down by the Supreme Court in its 1997 decision in *Reno v. American Civil Liberties Union*. The only portion of the CDA left intact was Section 230 – a provision which stated that “no provider or user of an interactive computer service shall be treated as the publisher or speaker of any information provided by another information content provider.” In simple terms, Section 230 means that internet providers are generally not legally liable for unlawful materials appearing on their platforms.

Copyleft: This term refers to a grassroots movement involving some librarians, legal scholars, historians, artists, website creators, and others who are protesting the abuses of copyright law. Some of the leaders of the Copyleft movement are Harvard law professors, Larry Lessig and Jonathan Zittrain, who argue that U.S. copyright law serve more to stifle creativity than to promote it.

Digital Millennium Copyright Act (DMCA): The U.S. Copyright Office offers the following explanation of the changes brought about by the DMCA: “In 1998, Congress passed the Digital Millennium Copyright Act (DMCA), which amended U.S. copyright law to address important parts of the relationship between copyright and the internet. The three main updates were (1) establishing protections for online service providers in certain situations if their users engage in copyright infringement, including by creating the notice-and-takedown system, which allows copyright owners to inform online service providers about infringing material so it can be taken down; (2) encouraging copyright owners to give greater access to their works in digital formats by providing them with legal protections against unauthorized access to their works (for example, hacking passwords or circumventing encryption); and (3) making it unlawful to provide false copyright management information (for example, names of authors and copyright owners, titles of works) or to remove or alter that type of information in certain circumstances” (<https://www.copyright.gov/dmca/>). The DMCA provides protection for copyright holders who have created a digital rights management system (DRM) such as the processes that prevent the copying of DVDs or online streaming of movies. Anyone who creates or sells software or codes designed to circumvent these protections is in violation of U.S. law, regardless of whether they actually copied the underlying movie. The DMCA does, however, include a “safe harbor” provision meaning that internet providers are not liable for copyright violations happening on their platforms so long as they take down offending websites once the violation has been brought to their attention.

Duration of Copyrights: Works created after 1978 have copyright protection lasting for the life of the author plus 70 years. If the author is a company or an anonymous author, the copyright lasts from 95 years

from the date of publication. For works created or published before 1978, the copyright lasts for 95 years from the date of publication.

Fair Use: The Copyright Act allows any person to make “fair use” of a copyrighted work in certain contexts including “the criticism of or comment on the work; in the course of news reporting; for teaching purposes, or as part of scholarship or research activity.”

Infringement: According to the U.S. Copyright office, “copyright infringement occurs when a copyrighted work is reproduced, distributed, performed, publicly displayed, or made into a derivative work without the permission of the copyright owner” (<https://www.copyright.gov/help/faq/faq-definitions.html>)

Mechanical Rights: This refers to the right to reproduce a song on physical or digital media such as MP3s, CDs, vinyl recordings, or DVDs. Mechanical rights are contrasted with “broadcasting rights,” dealing with the playing of a song on the radio, TV, Internet, or in a video game.

Music Modernization Act (MMA) of 2018: The U.S. Copyright Office explains that the MMA actually included three separate Titles: I. Musical Works Modernization Act; II. Classics Protection and Access Act; and III. Allocation for Music Producers Act. The Musical Works Modernization Act replaces the existing song-by-song compulsory licensing structure for making and distributing musical works with a blanket licensing system for digital music providers to make and distribute digital deliveries (e.g., permanent downloads, limited downloads, or interactive streams). The legislation establishes a process for collecting and distributing royalties, and identify musical works and their owners for payment. The Classics Protection and Access Act brings pre-1972 sound recordings into the federal copyright system, extending remedies for copyright infringement to owners of sound recordings made before 1972. The Allocations for Music Producers Act allows music producers, mixers, or sound engineers to receive royalties collected for uses of sound recordings by codifying a process for the distribution of royalties.

Parody and Fair Use: Parody refers to a situation where one work is ridiculing another. Courts have generally, though not always, viewed parody as a permissible exception to normal copyright protection under the rubric of “fair use.”

Performing a Work: The exclusive right to perform a work is one of the rights protected by copyright. The Copyright Act states that “to perform a work means to recite, render, play, dance, or act it, either directly or by means of any device or process or, in the case of a motion picture or other audiovisual work, to show its images in any sequence or to make the sounds accompanying it audible.” The Copyright Act considers a public performance to be: “(1) when a work is performed or displayed at a place open to the public or at any place where a substantial number of persons outside of a normal circle of a family and its social acquaintances is gathered; or (2) when a performance or display of the work is transmitted or otherwise communicated to the public, by means of any device or process.”

Registration: Registration occurs when the Copyright Office receives all of the required application materials associated with an author’s claim and approves the application. However, under U.S. law registration is not required to obtain copyright protection; that occurs automatically when a work of authorship is “fixed in a tangible medium of expression.” While unregistered works are protected, only those works properly registered are authorized to display the circle-R copyright symbol. It is also true that copyright owners must register their work prior to suing for infringement.

Substantial Similarity: This is the main test used by courts to determine whether a copyright has been infringed. Unfortunately, there is no clear standard for determining what constitutes substantial similarity. Courts have differed on whether substantial similarity should best be determined by “the perception of ordinary observers” or whether the testimony of subject matter experts is required.

U.S. Copyright Office: While patents and trademarks are administered through the U.S. Patent and Trademark Office, copyrights are administered through a branch of the Library of Congress. The U.S. Copyright Office processes applications for copyrights and stores submissions that are made in the registration process.

PATENT TERMS

Alice Test: This test, sometimes also called the Alice/Mayo Test, made it more difficult to claim patents for inventions that include laws of nature, abstract ideas, or natural phenomena. The test got its name from

two Supreme Court cases: *Alice Corporation v. CLS Bank International* and *Mayo v. Prometheus*. Prior to the Court's *Alice* ruling in 2014, numerous patents had been issued for isolated genes, biological products, and associated diagnostic tests. These court rulings sought to prevent the monopolization of the basic scientific and technological tools required for future innovation by creating a "judicial exception" excluding patentability for natural phenomena or abstract ideas. After the Court rulings, any patents in this area would have to pass a two part test: Step 1: Do the patent claims fall within the statutory subject matter (a process, machine, manufacture, or composition of matter)? If yes, proceed to the second step, which is divided into two parts. Step 2A: Are the patent claims directed to a law of nature, a natural phenomenon, or an abstract idea (judicial exceptions)? If no, the invention is eligible, and examination should continue for patentability. If yes, proceed to Step 2B. Step 2B: Do the claims as a whole amount to significantly more than the judicial exception? The *Alice* test remains controversial primarily because of its vagueness; lower courts have had difficulty making sense of the test.

America Invents Act (AIA): Also known as the Leahy-Smith America Invents Act, the 2011 passage of the AIA made a number of changes in U.S. patent law. Most significantly, it changed the U.S. patent system from "first-to-invent" to "first-to-file." Under the "first-to-invent" standard, courts were called upon to determine which inventor had first come up with an idea or process; the AIA made this process simpler by looking at who filed the patent. The AIA also sought to limit the activities of "patent trolls" by creating the Patent Trial and Appeals Board (PTAB) and three new procedures to invalidate issued patents – Inter Partes Review (IPR), Post Grant Review (PGR) and Covered Business Method Review (CBM). But critics argue that the AIA erred by over-reacting to the fear of patent trolls. Paul Morinville, former president of U.S. Inventor, Inc. had the following reaction: "For inventors, those who create most of America's new jobs, the America Invents Act (AIA) was the single worst disaster in the 226 year history of the U.S. patent system. The AIA did very real damage – enough to put many inventors out of business and discourage many others." (<https://ipwatchdog.com/people/paul-morinville/>)

Bayh-Dole Act: This 1980 legislation enables universities, nonprofit research institutions, and small businesses to own, patent and commercialize inventions developed under federally funded research programs within their organizations. Bayh-Dole allows recipients of government-funded research to patent their inventions and then to license those rights to private sector companies who can then commercialize them.

Board of Patent Appeals and Interferences (BPAI): This was a tribunal of administrative judges of the U.S. Patent and Trademark Office that handled patent appeals. This Board was abolished in 2012 and replaced by the Patent Trial and Appeal Board (PTAB).

Compulsory licensing: This refers to a provision in the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS Agreement) which allows governments in low-income countries, if certain conditions are met, to produce generic versions of patented pharmaceuticals while paying a fee to the holder of the patent.

Design patents: This is one of the three types of patents recognized by the U.S. Patent and Trademark Office. Design patents include surface ornamentation – that is, a design applied to or embodied in an article of manufacture; a product shape or configuration, and a combination of the first two categories. Court rulings have limited design patents to the visual appearance of a product, not its sound, smell, or taste. Famous examples of design patents include the original curvy Coca-Cola bottle (1915) and the shape of the Statue of Liberty (1879). The USPTO provides the following explanation of a "design patent:" "A design consists of the visual ornamental characteristics embodied in, or applied to, an article of manufacture. Since a design is manifested in appearance, the subject matter of a design patent application may relate to the configuration or shape of an article, to the surface ornamentation applied to an article, or to the combination of configuration and surface ornamentation. A design for surface ornamentation is inseparable from the article to which it is applied and cannot exist alone. It must be a definite pattern of surface ornamentation, applied to an article of manufacture." (<https://www.uspto.gov/patents/basics/apply/design-patent>)

Fintiv doctrine: This term refers to six factors that arose from a decision of the 2020 ruling of the Patent Trial and Appeal Board (PTAB) in *Apple Inc. v. Fintiv, Inc.* The *Fintiv* ruling provided a number of considerations that would block the Board from conducting a post-grant patent proceeding whenever regular federal litigation is underway or is likely. *Fintiv*, a company that holds patents for mobile wallet

applications, claims that Apple infringed on its patents with its Apple Pay and Apple Wallet systems. The PTAB rejected Apple's effort to secure Inter Partes Review (IPR) of Fintiv's patent claim, and established a number of considerations that could block IPR review in other cases. The creation of the rule has reduced the number of Inter Partes Reviews (IPRs) by almost 40%. While Fintiv and Apple have privately settled their dispute, the future form of the Fintiv doctrine is currently under review.

Graham v. John Deere: This 1966 Supreme Court case established guidelines for determining when an invention is "nonobvious" and therefore eligible for patent protection. The Court provided standards for determining whether "a person reasonably skilled in the art involved in the invention would find the invention to be a surprising or unexpected development at the time it was made."

Inter Partes Review (IPR): This refers to a procedure created by the 2011 America Invents Act for challenging the validity of a United States patent before the United States Patent and Trademark Office (USPTO). This review process allows the USPTO to reexamine and possibly cancel a patent that the agency had previously allowed. In order for an IPR review to commence, the petitioner must show a "reasonable likelihood" that the patent challenge would prevail. If there is a reasonable likelihood of success, the USPTO's Patent Trial and Appeal Board (PTAB) presides over a trial-like proceeding including the use of witnesses, the opportunity for limited discovery, and an oral hearing prior to a decision on the merits. Defenders of Inter Partes Review believe this provides an expedient and cost-effective means for challenging patents that were erroneously issued. Critics believe this process is biased against patent owners and believe that they have significantly eroded the confidence of innovative industry in the U.S. patent system. They note that patents could always be reviewed in federal courts, but that PTAB review creates an unnecessary review process that is biased against small patent-holders.

Mayo v. Prometheus: This 2012 Supreme Court decision struck down two DNA gene patents, finding that they covered only natural phenomena. The Mayo decision is often linked to the 2013 case in *Association for Molecular Pathology v. Myriad Genetics, Inc.*, where the Supreme Court found that simply isolating a naturally occurring DNA segment does not make it patentable.

Patent Trial and Appeal Board (PTAB): This is the administrative arm of the U.S. Patent and Trademark Office, established in 2012 to replace the Board of Patent Appeals and Interferences. The PTAB has both an appeals division that reviews rejections by patent examiners, and a trial division that settles disputes over patents that have already been issued.

Patent Troll: This is a pejorative term without any official definition in U.S. law. Nevertheless it is commonly used to describe someone who sues for patent infringement but does not actually make products based on the patent; another term associated with a patent troll is a non-practicing entity (NPE). Patent trolls often benefit from the willingness of companies to pay a settlement fee rather than to face the considerable expense of going to court. While it is perfectly legal for non-practicing entities to hold patents, the American Invents Act (AIA) of 2011 sought to limit the activities of patent trolls by creating various review processes.

Patent: This refers to a right provided by the federal government that allows an inventor to prevent others from manufacturing, selling, or using the patent owner's invention. Once a patent application has been filed, an inventor can describe the device as "patent pending," but ownership is not established until after the patent is approved.

Plant patents: This is one of the three types of patents allowed by the U.S. Patent and Trademark Office. The USPTO provides the following explanation of this type of patent: "A plant patent is granted by the United States government to an inventor (or the inventor's heirs or assigns) who has invented or discovered and asexually reproduced a distinct and new variety of plant, other than a tuber propagated plant or a plant found in an uncultivated state. The grant, which lasts for 20 years from the date of filing the application, protects the patent owner's right to exclude others from asexually reproducing the plant, and from using, offering for sale, or selling the plant so reproduced, or any of its parts, throughout the United States, or from importing the plant so reproduced, or any part thereof, into the United States. This protection is limited to a plant in its ordinary meaning: A living plant organism which expresses a set of characteristics determined by its single, genetic makeup or genotype, which can be duplicated through asexual reproduction, but cannot otherwise be 'made' or 'manufactured.' Cultivated sports, mutants,

hybrids, or transformed plants, where sports or mutants may be spontaneous or induced, and hybrids may be natural, from a planned breeding program, or somatic in source. While natural plant mutants might have naturally occurred, they must have been discovered in a cultivated area. Algae and macro-fungi are regarded as plants, but bacteria are not.” (<https://www.uspto.gov/patents/basics/apply/plant-patent>)

Public Domain: If a machine, process, or expression does not belong to anyone under patent, copyright, or trademark law, it exists in the public domain. This means it can be used without obtaining permission from anyone. Under U.S. law, an invention or expression that is published, put in public use, or sold more than one year before filing a patent application is considered to be in the public domain.

U.S. Patent and Trademark Office (USPTO): This is an administrative branch of the U.S. Department of Commerce implements and oversees laws on patents and trademarks. Also known as the USPTO or Patent Office, this agency is responsible for examining, issuing, classifying, and maintaining records of all patents issued by the United States.

Utility patents: This is the major one of the three types of patents granted by the U.S. Patent and Trademark Office. Utility patents cover the creation of a new or improved product, process, or machine. The three requirements of a utility patent are that it be useful, novel, and non-obvious. Accordingly, a new drug or chemical for which no use has been demonstrated, would not be eligible for patent protection.

TRADEMARK TERMS

Anti-cybersquatting Consumer Protection Act: This 1999 law was designed to protect businesses against the practice of cybersquatting. Cyber-squatters register a domain name that uses or closely resembles the trademarked or registered name of an existing business. They then hope to make money by selling the domain name back to the trademark owner.

Lanham Act: This 1946 law is the main federal statute that protects trademarks. The Lanham Act determines: (1) when owners of marks may be entitled to federal judicial protection against infringement of a mark by others; (2) the types of remedies for infringement that the federal courts are authorized to provide, such as injunctive relief, money damages, and defendant’s profits; (3) procedures for registering marks with the U.S. Patent and Trademark Office (on the Principal Register or Supplemental Register); (4) guidelines for when trademarks become incontestable; and (5) remedies for activity that constitutes unfair competition.

Madrid Protocol: This is a system administered by the World Intellectual Property Organization (WIPO) for registering trademarks worldwide. The U.S. became a party of the Madrid Protocol in 2003; before that time, U.S. companies had to apply for protection of their trademark in every individual country in which they intended to do business.

Puffery: This refers to the common practice of making claims that could never be verified, such as “the world’s best hamburger.” Puffery escapes false advertising or trademark infringement claims because consumers understand the claims to be mere generalities.

Right of Publicity: This refers to the right to prevent other persons from commercially exploiting a celebrity’s name, image, or likeness. Exceptions to this right include news coverage or other public interest purposes, such as using the picture of a celebrity in a newspaper or magazine. Current controversies related to the right of publicity involve the use of deepfake copies of a celebrity’s image or voice to assist in selling a product.

TM: Any business can display the “TM” symbol as a way of showing that it views its words, design, or symbols as a protectable trademark. In the case of copyrights, only works that are

registered are legally allowed to use the “®” symbol, but there is no legal significance for the use of the “TM” marker.

Trademark Electronic Application System (TEAS): This refers to the system for paying a fee and making an electronic filing of a trademark. Before filing a trademark, the U.S. Patent and Trademark Office recommends the following: “Use our trademark search system to complete a comprehensive search to make sure that someone else hasn’t already registered or applied for a trademark that’s the same as or too similar to yours. If someone else already has done so, we may refuse your application because of a likelihood of confusion between your trademark and the other trademark. It’s your decision whether or not to file your application after conducting a search.”

Trademark Electronic Search System (TESS): This is the digital database that allows trademark applicants to determine whether someone else already holds the same or a similar mark.

Trademark Modernization Act (TMA): This 2020 law makes it easier to obtain damages by creating a presumption of irreparable harm whenever a party can demonstrate a likelihood of trademark confusion. The TMA also provides a procedure for canceling fraudulent registrations when a party can show that a trademark was never used with the claimed goods or services.

Trademark Trial and Appeal Board (TTAB): This Board is the part of the U.S. Patent and Trademark Office that settles disputes about whether an existing trademark is properly filed or should be canceled.

Zombie Trademark: This refers to trademarks that still have brand recognition, even though the product or company may have ceased to exist. Examples of Zombie trademarks are Indian Motorcycles, Pan-American Airlines, Kodak Cameras, Napster (software), or Nuprin (a medication). Although abandoned trademarks are free for anyone to use, companies sometimes file an “intent-to-use” application in order to prevent competitors from exploiting them – an example would be AT&T’s purchase of the “Cingular” trademark after it had been abandoned.