# **Table of Contents**

# CHAPTER 1 COPYRIGHT

by Shane Delsman

# I. Scope of Chapter [§ 1.1]

# II. Introduction to Copyright Law [§ 1.2]

- A. What Copyright Protects [§ 1.3]
  - 1. In General [§ 1.4]
  - 2. Categories of Works [§ 1.5]
  - 3. Original Manner of Expression [§ 1.6]
- B. What Copyright Does Not Protect [§ 1.7]
  - 1. Essential Requirements [§ 1.8]
  - 2. How Copyright Differs from Trademarks, Patents, and Trade Secrets [§ 1.9]
    - a. Trademarks [§ 1.10]
    - b. Patents [§ 1.11]
    - c. Trade Secrets [§ 1.12]
  - 3. No Protection of Underlying Idea [§ 1.13]
  - 4. No Protection of Mere Words or Phrases [§ 1.14]
  - 5. No Protection of Blank Forms [§ 1.15]
  - 6. No Protection of Facts [§ 1.16]
  - 7. Designs of Useful Articles [§ 1.17]

#### III. Creation of a Copyright [§ 1.18]

- A. In General [§ 1.19]
- B. U.S. Copyright Act [§ 1.20]
  - 1. In General [§ 1.21]
  - 2. Duration of Copyright [§ 1.22]
    - a. Works Created on or After January 1, 1978 [§ 1.23]
    - b. Works Created but Not Published or Copyrighted Before January 1, 1978 [§ 1.24]
    - c. Copyrights Existing on January 1, 1978 [§ 1.25]
    - d. Terminal Date [§ 1.26]
- C. Fixation in a Tangible Medium of Expression [§ 1.27]

## IV. Exclusive Rights of Copyright Owner [§ 1.28]

- A. Description of Rights [§ 1.29]
- B. Exceptions to Owner's Rights [§ 1.30]
  - 1. Fair Use [§ 1.31]
  - 2. Co-ownership [§ 1.32]
  - 3. Reproduction by Libraries and Archives [§ 1.33]
  - 4. Certain Performances or Displays [§ 1.34]
  - 5. First-Sale Doctrine [§ 1.35]
- C. Rights in Derivative Works [§ 1.36]

# V. Copyright Registration [§ 1.37]

- A. In General [§ 1.38]
- B. Procedure [§ 1.39]
- C. Failure to Comply with Mailing Requirement [§ 1.40]
- D. Who May Apply for a Copyright Registration [§ 1.41]
- E. Software Copyright Registration—An Example [§ 1.42]
- F. Preregistration [§ 1.43]

#### VI. Transfer of Rights [§ 1.44]

- A. Assignments [§ 1.45]
- B. Agreements Involving Work Made for Hire (Presumption of Ownership) [§ 1.46]
  - 1. Work Made for Hire [§ 1.47]
  - 2. Independent Contractor [§ 1.48]
- C. Termination of Assignment of License [§ 1.49]

#### VII. Infringement [§ 1.50]

- A. In General [§ 1.51]
- B. Act of Copying Without Authorization [§ 1.52]
- C. Infringement of Open Source Software [§ 1.53]
- D. Computation of Actual Damages [§ 1.54]
- E. Statutory Damages and Attorney Fees [§ 1.55]
- F. Right to Jury Trial in Context of Statutory Damages [§ 1.56]
- G. Copyright Alternative in Small-Claims Enforcement Act [§ 1.57]
- H. Defenses [§ 1.58]
  - 1. In General [§ 1.59]
  - 2. Fair Use [§ 1.60]
  - 3. Joint Ownership [§ 1.61]
  - 4. Statute of Limitation [§ 1.62]
  - 5. Claim Preclusion (Res Judicata) [§ 1.63]
  - 6. Estoppel [§ 1.64]

- 7. Assignment or License [§ 1.65]
- 8. Unclean Hands [§ 1.66]
- 9. Abandonment [§ 1.67]

#### VIII. Notice of Copyright [§ 1.68]

- A. Requirements [§ 1.69]
- B. Effect of Proper Notice [§ 1.70]
- C. How to Give Notice [§ 1.71]
- D. Exclusions [§ 1.72]
- E. Omission of, and Errors in, Copyright Notice [§ 1.73]

## IX. Musical Works [§ 1.74]

- A. Licensing Music [§ 1.75]
- B. Division of Rights [§ 1.76]
  - 1. In General [§ 1.77]
  - 2. Performance Rights [§ 1.78]
  - 3. Music Modernization Act [§ 1.79]

#### X. Moral Rights [§ 1.80]

# XI. Digital Millennium Copyright Act of 1998 [§ 1.81]

- A. In General [§ 1.82]
- B. Additional Protections Granted [§ 1.83]
- C. Prohibited Activities [§ 1.84]
  - 1. Circumvention [§ 1.85]
    - a. Technological Measures to Prevent Access [§ 1.86]
    - b. Technological Measures to Protect Rights of Copyright Owner [§ 1.87]
  - 2. Tampering with Copyright Management Information [§ 1.88]
    - a. Definition [§ 1.89]
    - b. Prohibitions [§ 1.90]
    - c. Exceptions [§ 1.91]
  - 3. Additional Exceptions [§ 1.92]
  - 4. Remedies and Penalties [§ 1.93]
- D. Safe Harbor [§ 1.94]
  - Limitation of Liability for Copyright Infringement by Online Service Providers, 17 U.S.C. § 512 [§ 1.95]
  - 2. Copying for Maintenance or Repair, 17 U.S.C. § 117 [§ 1.96]
- E. Miscellaneous DMCA Provisions [§ 1.97]

#### XII. Federal Preemption of Wisconsin Law [§ 1.98]

- A. Basis of Preemption [§ 1.99]
- B. Impact on State-Granted Rights [§ 1.100]

#### **CHAPTER 2**

#### **TRADEMARKS**

by Joseph S. Heino

# I. Scope of Chapter [§ 2.1]

# II. Types of Marks [§ 2.2]

- A. In General [§ 2.3]
- B. Trademarks [§ 2.4]
- C. Service Marks [§ 2.5]
- D. Collective Marks [§ 2.6]
- E. Certification Marks [§ 2.7]

# III. Selecting a Strong Mark [§ 2.8]

- A. In General [§ 2.9]
- B. Unprotectable Terms [§ 2.10]
- C. Generic Terms [§ 2.11]
- D. Descriptive Marks [§ 2.12]
- E. Suggestive Marks [§ 2.13]
- F. Arbitrary Marks [§ 2.14]
- G. Fanciful Marks [§ 2.15]

#### IV. Proper Usage of Trademarks [§ 2.16]

- A. In General [§ 2.17]
- B. Notice Considerations [§ 2.18]
- C. Acquired Distinctiveness or Secondary Meaning [§ 2.19]

#### V. Common-Law Marks [§ 2.20]

#### VI. Registration of Marks in Wisconsin [§ 2.21]

- A. Applicable Wisconsin Statutes [§ 2.22]
- B. Eligibility for State Registration [§ 2.23]
- C. Procedure for State Registration [§ 2.24]
- D. Effect of State Registration [§ 2.25]

#### VII. Federal Registration of Marks [§ 2.26]

- A. The Lanham Act [§ 2.27]
- B. Eligibility for Federal Registration [§ 2.28]
- C. Federal Registration Categories [§ 2.29]
- D. Registration Application [§ 2.30]
- E. Examination of the Application [§ 2.31]
- F. Publication and Opposition [§ 2.32]
- G. Intent-to-Use Applications [§ 2.33]
- H. Duration and Maintenance of Federal Registrations [§ 2.34]
  - 1. In General [§ 2.35]
  - 2. Six-Year Affidavits or Declarations [§ 2.36]
  - 3. Renewal [§ 2.37]
  - 4. Cancellation Proceedings [§ 2.38]

#### VIII. Enforcing Trademark Rights [§ 2.39]

- A. Common-Law Infringement [§ 2.40]
  - 1. Elements [§ 2.41]
  - 2. Remedies [§ 2.42]
- B. Violation of Wisconsin Statutes [§ 2.43]
  - 1. Wis. Stat. Ch. 132 [§ 2.44]
  - 2. Unfair Trade Practice Liability [§ 2.45]
- C. Infringement Under the Lanham Act [§ 2.46]
  - 1. Elements [§ 2.47]
  - 2. Remedies [§ 2.48]
- D. Related Federal Causes of Action [§ 2.49]
  - 1. False Advertising [§ 2.50]
  - 2. Trade-Dress Infringement [§ 2.51]
  - 3. Dilution [§ 2.52]
- E. Defenses [§ 2.53]

#### IX. Transferring and Licensing Rights in Marks [§ 2.54]

- A. In General [§ 2.55]
- B. Assignments [§ 2.56]
- C. Licenses [§ 2.57]

#### X. Marks and Cyberspace [§ 2.58]

#### XI. Marks and Biotechnology [§ 2.59]

#### CHAPTER 3

#### **PATENTS**

by Timothy E. Newholm & Michael T. Griggs

# I. Scope of Chapter [§ 3.1]

### II. What is a Patent? [§ 3.2]

- A. In General [§ 3.3]
- B. Types of Patents [§ 3.4]
  - 1. In General [§ 3.5]
  - 2. Utility Patents [§ 3.6]
    - a. In General [§ 3.7]
    - b. Process, Including Computer-Implemented Processes and Methods of Doing Business [§ 3.8]
    - c. Machines and Programmed Computers [§ 3.9]
    - d. Article of Manufacture, Including Program Stored on Disk [§ 3.10]
    - e. Composition [§ 3.11]
    - f. Examples of Eligible Subject Matter [§ 3.12]
    - g. Examples of Ineligible Subject Matter [§ 3.13]
  - 3. Plant Patents [§ 3.14]
  - 4. Design Patents [§ 3.15]
- C. The Provisional Patent Application [§ 3.16]

# III. General Requirements; Useful, Novel, and Nonobvious [§ 3.17]

- A. In General [§ 3.18]
- B. Utility [§ 3.19]
- C. Novelty [§ 3.20]
- D. Nonobviousness [§ 3.21]
- E. Prior Art Disclosures Generally [§ 3.22]
  - 1. In General [§ 3.23]
  - 2. Prior Publications as Prior Art Disclosures [§ 3.24]
  - 3. Other Disclosures as Prior Art [§ 3.25]
- F. Time Limits for Filing [§ 3.26]
  - 1. In General [§ 3.27]
  - 2. Exceptions for Inventor-Based Disclosures [§ 3.28]

#### IV. Rights Afforded [§ 3.29]

- A. In General [§ 3.30]
- B. Right to Exclude Others from Making [§ 3.31]

- C. Using [§ 3.32]
- D. Selling or Offering for Sale [§ 3.33]
- E. Importing [§ 3.34]
- F. Territory Covered by a Patent [§ 3.35]
- G. Foreign Patents [§ 3.36]
- H. Patent Cooperation Treaty Application [§ 3.37]

# V. Obtaining Patent Protection [§ 3.38]

- A. In General [§ 3.39]
- B. Protecting an Invention Before a Patent is Obtained [§ 3.40]
  - 1. In General [§ 3.41]
  - 2. Dealing with Vendors [§ 3.42]
  - 3. Dealing with People Involved in Testing [§ 3.43]
- C. Reasons for Filing a Patent Application [§ 3.44]
  - 1. In General [§ 3.45]
  - 2. Defensive Purposes [§ 3.46]
  - 3. Provide Negotiation Leverage and Minimize Royalty Exposure [§ 3.47]
  - 4. Protect Product Line [§ 3.48]
  - 5. Enhance Competitiveness [§ 3.49]
  - 6. Generate Income [§ 3.50]
  - 7. Foster and Recognize Creative Efforts by Employees [§ 3.51]
  - 8. Cross-License to Obtain New Technology and Freedom in Marketplace [§ 3.52]
  - 9. Enable Entry into New Market [§ 3.53]

#### VI. Inventorship [§ 3.54]

- A. In General [§ 3.55]
- B. Conception [§ 3.56]
  - 1. In General [§ 3.57]
  - 2. Conception—The Mental Part of Invention [§ 3.58]
  - 3. Must Be Complete and Define an Operative Invention [§ 3.59]
- C. Reduction to Practice [§ 3.60]
  - 1. In General [§ 3.61]
  - 2. Physical Part of Invention [§ 3.62]
  - 3. Actual Reduction [§ 3.63]
  - 4. Constructive Reduction—Patent Application [§ 3.64]

- D. Determining Inventorship [§ 3.65]
  - 1. In General [§ 3.66]
  - 2. Applicant for Patent [§ 3.67]
  - 3. Conception Determines Inventorship [§ 3.68]
    - a. In General [§ 3.69]
    - b. Listed Inventors Must Have Each Participated in the Conception [§ 3.70]
  - 4. Joint Inventors [§ 3.71]
    - a. In General [§ 3.72]
    - b. Inventors Need Not Physically Work Together or at the Same Time [§ 3.73]
    - c. Each Need Not Make the Same Type or Amount of Contribution [§ 3.74]
    - d. Each Need Not Make a Contribution to the Subject Matter of Every Claim [§ 3.75]
  - 5. No Penalty for Good-Faith Error in Naming Inventors [§ 3.76]
- E. Documenting the Invention [§ 3.77]
  - 1. In General [§ 3.78]
  - 2. Written Record Is Important [§ 3.79]
    - a. Need for Written Record [§ 3.80]
    - b. Acts to Record [§ 3.81]
  - 3. Types of Corroborating Documentation [§ 3.82]
    - a. In General [§ 3.83]
    - b. Inventor's Logbook [§ 3.84]
    - c. Invention Disclosure Form [§ 3.85]
    - d. Other Mechanisms for Documenting Invention [§ 3.86]

# VII. The Patent Application Document and Patent Procurement Process [§ 3.87]

- A. In General [§ 3.88]
- B. Filing [§ 3.89]
- C. Parts of a Utility Patent Application [§ 3.90]
  - 1. In General [§ 3.91]
  - 2. Specification [§ 3.92]
    - a. In General [§ 3.93]
    - b. Written Description [§ 3.94]
    - c. Enablement [§ 3.95]
    - d. Best Mode [§ 3.96]
  - 3. Drawings (If Necessary) [§ 3.97]

- 4. Claims [§ 3.98]
  - a. In General [§ 3.99]
  - b. Types of Claims [§ 3.100]
  - c. Parts of an Independent Claim [§ 3.101]
    - (1) In General [§ 3.102]
    - (2) The Preamble [§ 3.103]
    - (3) The Transition [§ 3.104]
    - (4) The Body [§ 3.105]
- D. Examination—Formal Examination by Patent

Examiner [§ 3.106]

- 1. In General [§ 3.107]
- 2. The Patent Examiner [§ 3.108]
- 3. Search [§ 3.109]
- 4. Official Action [§ 3.110]
- 5. Response [§ 3.111]
- 6. Appeal [§ 3.112]
- 7. Allowance and Issue [§ 3.113]
- 8. Pre-grant Publication [§ 3.114]
- E. Duty of Candor [§ 3.115]

#### VIII. Patent Term and Expiration [§ 3.116]

- A. Duration [§ 3.117]
- B. Periodic Maintenance Fees [§ 3.118]
- C. Expiration [§ 3.119]

#### IX. Enforcement for Infringement and Remedies [§ 3.120]

- A. Literal Infringement [§ 3.121]
- B. Infringement Under the Doctrine of Equivalents [§ 3.122]
- C. Direct Infringement [§ 3.123]
- D. Contributory Infringement [§ 3.124]
- E. Inducing Infringement [§ 3.125]
- F. Proof of Infringement [§ 3.126]
- G. Territorial Limitations on Infringement [§ 3.127]
- H. Remedies [§ 3.128]
  - 1. Injunction [§ 3.129]
  - 2. Monetary Damages for Infringement of a Utility Patent or Plant Patent [§ 3.130]
    - a. In General [§ 3.131]
    - b. Reasonable Royalty [§ 3.132]
  - 3. Lost Profits [§ 3.133]

#### TABLE OF CONTENTS

- 4. Monetary Damages for Infringement of a Design Patent [§ 3.134]
- 5. Willful Infringement [§ 3.135]
- 6. Attorney Fees for Exceptional Circumstances [§ 3.136]
- I. Defenses to Infringement [§ 3.137]
  - 1. In General [§ 3.138]
  - 2. Invalidity [§ 3.139]
  - 3. Inequitable Conduct [§ 3.140]
  - 4. Laches and Equitable Estoppel [§ 3.141]
    - a. In General [§ 3.142]
    - b. Laches [§ 3.143]
    - c. Equitable Estoppel [§ 3.144]

## X. Post-Grant Review of Patents at the USPTO [§ 3.145]

- A. In General [§ 3.146]
- B. Post-Grant Review [§ 3.147]
- C. Inter Partes Review [§ 3.148]
- D. Covered Business Method Patent Review [§ 3.149]

#### **XI.** Appendices [§ 3.150]

- A. In General [§ 3.151]
- B. Appendix 3A: Utility Patent [§ 3.152]
- C. Appendix 3B: Design Patent [§ 3.153]

#### CHAPTER 4

# TRADE SECRETS

by Kyle M. Costello

#### I. Scope of Chapter [§ 4.1]

#### II. Background [§ 4.2]

- A. In General [§ 4.3]
- B. History [§ 4.4]
- C. General Subject Matter [§ 4.5]
- D. Trade Secret Protection Versus Patent or Copyright Protection [§ 4.6]

#### III. State Uniform Trade Secrets Act [§ 4.7]

- A. In General [§ 4.8]
- B. Wisconsin's Statute [§ 4.9]

- C. Subject-Matter Requirements for Trade Secret Protection [§ 4.10]
  - 1. In General [§ 4.11]
  - 2. Formulations [§ 4.12]
  - 3. Manufacturing Methods, Product Designs, and Software [§ 4.13]
  - 4. Methods of Doing Business, Business Plans, and Marketing Plans [§ 4.14]
  - 5. Customer Lists, Customer Files, Tables of Data, and Credit Ratings [§ 4.15]
  - 6. Patterns, Blueprints, and Architectural Plans [§ 4.16]
- D. Independent Economic Value as Another Requirement for Trade Secret Protection [§ 4.17]
  - 1. In General [§ 4.18]
  - 2. Independent Economic Value: Factors [§ 4.19]
    - a. In General [§ 4.20]
    - b. Not Generally Known [§ 4.21]
    - c. Not Readily Ascertainable or Easily Discoverable by Proper Means [§ 4.22]
    - d. Subject of Reasonable Efforts to Maintain Secrecy [§ 4.23]
  - 3. Nondisclosure Clauses in Employment Agreements [§ 4.24]
  - 4. Preemployment and Exit Interviews with Employees [§ 4.25]
  - 5. Need-to-Know Basis [§ 4.26]
  - 6. Third-Party Written Agreements of Confidentiality [§ 4.27]
  - 7. Physical Security Measures [§ 4.28]
  - 8. Computer Security Procedures [§ 4.29]

#### IV. Conflict with Employment Law [§ 4.30]

# V. Disadvantages of Attempting Protection by Trade Secret [§ 4.31]

- A. In General [§ 4.32]
- B. Independent Discovery [§ 4.33]
- C. Reverse Engineering [§ 4.34]
- D. Lawful Disclosure by One with the Right to Disclose It [§ 4.35]

#### VI. Other Means of Protecting Trade Secrets [§ 4.36]

- A. In General [§ 4.37]
- B. Federal Protection for Trade Secrets [§ 4.38]
- C. Other Statutory Options [§ 4.39]
- D. International Protection [§ 4.40]

## VII. Enforcement [§ 4.41]

- A. In General [§ 4.42]
- B. Burden of Proof [§ 4.43]
- C. Wisconsin Uniform Trade Secrets Act Requires Plaintiff to Disclose the Secret [§ 4.44]
- D. Misappropriation Under Wisconsin Uniform Trade Secrets Act [§ 4.45]
  - 1. Threshold Issue [§ 4.46]
  - 2. Definition of Misappropriation [§ 4.47]
  - 3. Definition of Improper Means [§ 4.48]

# VIII. Remedies Under the UTSA in General and the Wisconsin Act in Particular [§ 4.49]

- A. In General [§ 4.50]
- B. Injunctive Relief [§ 4.51]
- C. Monetary Damages [§ 4.52]
  - 1. In General [§ 4.53]
  - 2. Plaintiff's Actual Loss [§ 4.54]
  - 3. Defendant's Unjust Enrichment [§ 4.55]
  - 4. A Reasonable Royalty [§ 4.56]
  - 5. Punitive Damages [§ 4.57]
  - 6. Attorney Fees [§ 4.58]

### **IX.** Appendices [§ 4.59]

- A. Appendix 4A: Trade Secrets Checklist [§ 4.60]
- B. Appendix 4B: Model Trade Secrets Policy [§ 4.61]

#### CHAPTER 5

#### THE RIGHT TO CONTROL PUBLICITY

by John H. D'Antico

#### I. Scope of Chapter [§ 5.1]

#### II. Introduction [§ 5.2]

- A. Wisconsin's Right to Control Publicity is Subset of Right of Privacy [§ 5.3]
- B. Nature of the Right [§ 5.4]

#### III. Wisconsin's Right to Control Publicity [§ 5.5]

- A. Background [§ 5.6]
- B. Common Law [§ 5.7]
- C. Wisconsin's Statute [§ 5.8]
  - 1. Legislative History [§ 5.9]
  - 2. The Wisconsin Statute [§ 5.10]
  - 3. Federal and Other State Laws [§ 5.11]

## IV. Causes of Action, Defenses, and Relief [§ 5.12]

- A. Statutory Cause of Action [§ 5.13]
- B. Common-Law Cause of Action [§ 5.14]
- C. Dual Causes of Action [§ 5.15]
- D. Defenses [§ 5.16]
- E. Relief [§ 5.17]

#### V. Other Cases [§ 5.18]

- A. Joel v. Various John Does [§ 5.19]
- B. Heinz v. Frank Lloyd Wright Foundation [§ 5.20]
- C. *Hagen v. Dahmer* [§ 5.21]

#### VI. Other Considerations [§ 5.22]

# CHAPTER 6 OVERVIEW OF INTELLECTUAL PROPERTY (TECHNOLOGY) LICENSING

by Brad L. Meyer

- I. Introduction [§ 6.1]
- II. Fundamentals of Licensing [§ 6.2]
- III. Intellectual Property and Technology—Overview [§ 6.3]
- IV. Nature of a License [§ 6.4]
- V. License Agreement [§ 6.5]
- VI. Exchange of Consideration; Royalties [§ 6.6]
  - A. In General [§ 6.7]
  - B. Amount Paid [§ 6.8]
  - C. When Paid [§ 6.9]
- VII. Fundamental Terms, Conditions, and Issues [§ 6.10]
  - A. In General [§ 6.11]
  - B. Representations and Warranties [§ 6.12]
  - C. Disclaimers, Limitations, and Indemnification [§ 6.13]
  - D. Changes in Party Status [§ 6.14]
  - E. Termination of License [§ 6.15]
  - F. Tax Consequences [§ 6.16]
  - G. Other Considerations [§ 6.17]

# VIII. Licensing Objectives and Allocation of Risks Between Licensor and Licensee [§ 6.18]

- A. In General [§ 6.19]
- B. Special Concerns of Licensor [§ 6.20]
- C. Special Concerns of Licensee [§ 6.21]
- D. Mutual Concerns [§ 6.22]
- E. The Ideal License [§ 6.23]
- IX. Conclusion [§ 6.24]
- **X.** Appendices [§ 6.25]
  - A. Appendix 6A: List of Selected Print References—IP Licensing [§ 6.26]

#### CHAPTER 7

#### WISCONSIN ADVERTISING LAW

by Hillary J. Wucherer & Megan Q. Peccarelli

# I. Scope of Chapter [§ 7.1]

# II. Wisconsin Law [§ 7.2]

- A. Wisconsin's False Advertising Statute [§ 7.3]
- B. Wisconsin's Unfair Competition Statute [§ 7.4]
- C. Other Wisconsin Statutes of Interest [§ 7.5]
- D. Wisconsin Administrative Regulations [§ 7.6]
- E. Wisconsin's Trademark Registration Statute [§ 7.7]
- F. Wisconsin's Common-Law Causes of Action [§ 7.8]

#### III. Federal Law [§ 7.9]

- A. Federal Trade Commission Act and Related Regulations [§ 7.10]
- B. The Lanham Act [§ 7.11]
- C. Other Federal Advertising Statutes [§ 7.12]

#### IV. Nongovernmental Regulation [§ 7.13]

**TABLE OF CASES** 

TABLE OF STATUTES, REGULATIONS, AND RULES

**INDEX**