Spring 2004

Intellectual Property and Golden Gate University

Marc Greenberg
Golden Gate University School of Law, mgreenberg@ggu.edu

Intellectual Property and GOLDEN GATE University

By Marc Greenberg

The 21st Century will, without question, be the "Age of Information". Intellectual Property Law provides the means for the development, distribution and protection of that information. It is rapidly becoming one of the most important areas of legal specialization, and the demand for lawyers skilled in IP law is greater than the current supply.

Golden Gate University School of Law is uniquely positioned to train lawyers in this fast-paced field. Located in the heart of the hi-tech SOMA neighborhood of San Francisco and just north of Silicon Valley, the Law School is able to draw upon a rich community of legal and business expertise in Intellectual Property.

The Intellectual Property Law Program taps into the skills of our full-time faculty, aided by more than a dozen adjunct professors still in active practice, to deliver more than 23 courses per year focused on Intellectual Property Law.

The Law School offers a post-graduate LL.M. (Master in Laws) degrees to students from outside the United States, and to lawyers in the U.S. seeking to make a career transition or to enhance their understanding of IP Law. Graduates of the program have gone on to success in IP firms all over the world.

Last year's Graduate Schools Edition of *U.S. News and World Report* noted that Intellectual Property Law was going to be the hottest area of law in the new millennium. The decline in dot.com fortunes hasn't changed that assessment, with law schools all over the nation adding or expanding their intellectual property law offerings. Law placement experts confirm that the demand for IP lawyers still outpaces the supply —with no end of that demand in sight.

Is all this interest merely a fad, a momentary surge of interest by a fickle public, soon to be discarded for something new? Why is all this attention being focused on this area of law? What is intellectual property law?

To answer the first question: Though intellectual property law is experiencing a sharp rise in popularity now, it has long been an established area of law. In fact, IP Law predates the establishment of the United States. So no, the study and practice of IP law is no fad. On the contrary, it is going to continue to be a mainstay of legal education for decades to come.

As to why interest in IP law is so hot now, the recent focus is the result of the continued movement of the countries to an information-based economy. The business of information distribution, whether in the form of technological advances or the latest movie or pop song, is all part of the intellectual property field. The growth of computer related industries, such as computer hardware, software and Web-based businesses (often referred to as e-commerce) has also fueled the interest in IP Law.

So we come again to the last question—what is intellectual property law? In simple terms, it is the law regarding property created by the mind or intellect of a person. Intellectual property differs from personal or real property in that IP begins in an intangible form in the mind of its creator, and once it is put into tangible form, the other main difference is that distributing

parts of it (copies) does not take away from the original. With real property, once you divide it up and give it away, it is gone, whereas you can make hundreds of copies of an intellectual property asset, and the original remains untouched.

Intellectual property assets are, in an information age, extremely valuable. In the United States, the marketing of intellectual property assets is a business that enjoys one of the highest balances of trade of any business we engage in. U.S. IP assets are used worldwide, and in many areas, set the standard in world trade. Protecting these assets is critical to the continuation of that balance of trade. The system does this primarily through three areas of law—patent, copyright and trademark.

Patent Law

Patent law is the system for works that involve new and non-obvious ideas for functional items and/or processes, often referred to as "inventions". Patent protection is under the exclusive jurisdiction of Federal Law, which means that there can be no state law granting patents. As a result, a patent gives the creator protection throughout the U.S. for that invention or process. The protection granted is the exclusive right to protect and control all uses of the patented invention or process for 20 years.

In practical terms, a patent is a monopoly granted by the government in reward for creating a new, non-obvious and useful invention or process. Examples of patents which have generated a great deal of income for their inventors and have been useful in the society include: aspirin, the plastic rings that hold soda and other cans, and the round half-domes of plastic that appear on highways to help keep drivers in the correct lanes. These half-domes, by the way, were invented by a Mr. Botts, who called them dots, leading to their moniker of "Botts' Dots". Think about how many of those dots are on roads in the country, and then think about how much money Mr. Botts got for the monopoly on those dots. Holding the patent on a valued item can be very lucrative for the creator.

Copyright Law

Copyright law protects the expression of ideas, but not the ideas themselves. This is an important distinction. People often mistakenly believe that you can, through IP law, protect your idea for a new story, movie or song. While other systems of law (such as contracts) may offer limited protection for ideas like these, copyright law does not. If you could copyright your idea for a story, you could then prevent anyone else from writing a story about the same idea. So, for example, if your idea was for a story about how a boy meets a girl, falls in love with her, and then loses her, a copyright granted to you for this idea would mean no one else could write a love story with those elements.

So, instead of giving protection to the idea of boy meets girl, copyright law only protects how the idea is expressed—with the result being that we have movies like *Cold Mountain*, *Chicago*, *Pirates of the Caribbean* and many others all based on the same idea, but containing different ways of expressing it. And because copyright law only protects expression it is possible to change enough of the expression, and avoid violating someone's copyright. To do this, however, you must be careful only to use the idea in someone else's work, and not to copy any of the expressive elements of the work. A frequent question here is "how much change is enough"? The lawyer's answer is "it depends"—which is the correct, although frustrating answer. It depends on what the nature of the change is and how far it moves the new work away from the original work. The test for copyright infringement where the original work is available to the author is whether the new work is "substantially similar", which is decided on a case by case basis. For example, merely changing the gender of a key character may not be enough, if all other elements of the story remain the same.

Copyright law grants protection to creators for a much longer period than patent law. Under present U.S. law and most international treaties as well, copyright protection lasts for the life of the author, plus

continued on next page

Golden Gate University School of Law, San Francisco, California.

70 years after the author's death. In some West Indian jurisdictions it lasts for the life of the author, plus 50 while in others it is life plus 70. Copyright ownership (as opposed to a lease or license) can only be transferred by a written instrument. There must be a written agreement specifying that the entire copyright is being transferred, and clearly identifying the work transferred (the one exception to this rule is that a person may leave all of their copyright-protected works to their heirs in a will without specifically identifying the individual works).

A wide variety of different expressive works are protected by copyright, including: literary works, musical works, sound recordings, pantomimes and choreographic works, dramatic works, pictorial, graphic and sculptural works, motion pictures and architectural works. Copyright holders have the exclusive right, subject to some exceptions, to control the right to copy, distribute, display or perform their works. Importantly, owners may also control the

"U.S. News and World Report noted that Intellectual Property Law was going to be the hottest area of law in the new millennium."

extent to which new works are created based on their original works (these new works are called "derivative works").

One important and confusing exception to the derivative works rule is parody. Courts in the USA have allowed, in a number of cases, creators of parodies to publish their works, poking fun at a famous work of art or movie, without being liable for copyright infringement. *Mad Magazine*, for example, boasts that it has never been successfully sued for copyright infringement, defending all of its articles as parodies. On the other hand, many artists who attempt to parody Disney characters have been sued and lost to Disney. In short, there is no simple rule about what parody will be acceptable and what will be an infringement. Artists who are daring enough to enter into the murky waters of parody and the law are advised to have experienced counsel review their work before going public with it. The consequences of a lawsuit are real and far too expensive to forego that review. About the only thing that is certain in parody law is that if you make fun of Disney or its characters, prepare to be sued!

Trademark Law

The last major system of intellectual property protection is trademark law. This system offers protection to the brand names and symbols used to identify the owners of goods and services provided to the public. Unlike patent and copyright law, trademarks in the United States can be granted on a state level, as well as on a national level. If fact, in order to qualify for a trademark on the federal level, you must show that you are using your proposed mark in commerce in more than one state (interstate commerce).

Trademarks also differ from the other two forms of protection in that there is no time limit for the protection granted. As long as the goods or services continue to be offered in interstate commerce and the owner goes through the process of renewing the trademark registration every 10 years, the mark may be used indefinitely.

The process for obtaining a trademark is complicated. One of the first things to decide is the category of goods and/or services under which your mark will fit. There are 34 different categories of goods and eight categories of services. The same mark can be registered for different categories as long as there is no likelihood of confusion in the marketplace. For example, Lexus was allowed as a trademark for an automobile (goods category #12), over the objection of the owner of Lexis, a service mark for a legal research business tool (services category #35). If you are going to use the same mark for different goods and services, you may have to submit multiple applications.

In a world flooded with consumer goods, brand name identification is extremely important as a way of gaining purchaser's trust, particularly if the qualities of the goods cannot be discerned from simply looking at them. For example, you can tell the quality of a clothing item from looking at it and feeling it. You can't do the same with a can of soda. But if the soda is a Coca-Cola, you have a certain assurance of its quality, based on consumer experience and reputation in the marketplace. For that reason, brand name owners vigorously protect the integrity of their product names and use the trademark law to enforce those rights.

One of the more fascinating problems for trademark owners is what happens if they do their job of protection too well. Companies that initially had the trademark to words such as lingerie or cellophane found out too late that their trademarks became generic terms describing their goods, and therefore lost trademark status. Other companies, fearing such a result, have conducted campaigns to prevent the loss of their brands to generic status. So far, the owners of copier machines have kept Xerox, and soda companies have kept Coke from this fate. These companies mounted extensive publicity campaigns to educate the public not to use their brand names improperly, and in Coke's case, actually sent agents to restaurants to verify that if Coke was listed on the menu, no other cola drink was served in its place.

This short article cannot do more than give you the flavor of the endlessly fascinating field of intellectual property law. As we continue our conversion to an information-based society and economy, intellectual property law will grow in importance and complexity. The information (often referred to as content) which drives this conversion depends on copyright law to protect it, new inventions require patent protection and the companies developing and marketing this information and these inventions rely on trademark law to protect their valuable brands. The importance of IP law in so many areas of human activity is so great that it may be, in a few years, that we will not be teaching IP law as a separate discipline, because virtually all aspects of the legal process will have IP law components.

Marc Greenberg became a member of the full-time faculty of the law school and the Director of the Intellectual Property law program in June 2000. His law practice over the past 22 years has focused on transactional and litigation work in intellectual property law, from computer companies to writers and from rock stars to museums. He can be contacted at www.mgreenberg@ggu.edu.