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FRANKLIN PIERCE LAW CENTER

# Germeshausen Center Newsletter

*Winter 1998*

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and the Student Intellectual Property Law Association

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# Bruce E. Friedman In Memoriam

The students of Franklin Pierce Law Center would like to express their profound sadness at the passing of Franklin Pierce Law Center Professor Bruce Friedman. Professor Friedman taught Civil Procedure and was therefore an integral part of the education of every FPLC student. He was a dedicated teacher who endeavored to make this complex area of law accessible and even fun. Professor Friedman impacted the lives of every Franklin Pierce student, no matter what area of law they studied.

In addition to his work at the Law Center, Professor Friedman was dedicated to improving the lives of underprivileged children. He founded FPLC's Civil Practice Clinic, a program designed to give law students practice in various aspects of law by allowing them to represent low-income clients, and co-founded the Children's Alliance of New Hampshire as an independent voice for children in the state legislature. For his efforts, Professor Friedman was awarded the New Hampshire Voice for Children's Award and the Jonathan Ross Award for Outstanding Commitment to Legal Services for the Poor. His accomplishments made every FPLC student proud and served as a reminder that above all we should attempt to maintain our humanity.

We will deeply miss Professor Friedman but are thankful that we had the brief opportunity to experience his unique vitality and humor.

Bruce E. Friedman  
1947-97

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## *Editorial Staff*

Produced by The Kenneth J. Germeshausen Center for the Law of Innovation and Entrepreneurship and Student Intellectual Property Law Association

- Karl Jorda, Editor and Faculty Advisor
- Diane Hernandez, '98, and Dan Salehi, '98, Student Editors
- Additional assistance and articles contributed by:  
Skip Singleton, '98; Joanna Dukovcic, '99.
- Carol Ruh, Editorial Assistant

The Germeshausen Center, created in 1985 through the generosity of Kenneth J. and Pauline Germeshausen, is the umbrella organization for Franklin Pierce Law Center's specialization and policy studies in the legal protection, management and transfer of intellectual property, especially as they relate to the commercialization of technology.

The Germeshausen Center Newsletter is published semi-annually for the alumni/ae, students and friends of Franklin Pierce Law Center. Our readers are encouraged to send news, photos, comments or letters to :

Carol Ruh, FPLC, 2 White Street, Concord, NH 03301 USA

Phone: 603/228-1541; fax: 603/224-3342; E-mail: cruh@fplc.edu

## – PROFILE –

# JEREMY WILLIAMS

Franklin Pierce Law Center welcomes Jeremy Williams from Warner Brothers in Los Angeles, California. Jeremy has served as the Senior Vice President and General Counsel at Warner since 1984. In addition to directing the legal department for the future film division, he was responsible for contracts, defamation and privacy issues and other intellectual property related matters.

Prior to joining Warner, Jeremy worked for Sidley & Austin, and Kaplan, Livingston, Goodwin, Berkowitz & Selvin, two prominent entertainment law firms in the Los Angeles areas. Jeremy is a graduate of Amherst College, Yale University, and Harvard Law School.

Jeremy taught Copyrights this past fall. He emphasized the practical aspects of the course, the realistic applications, as well as the academic concepts. He feels that the current state of copyright law is greatly affected



*Professor Jeremy Williams*

by the rapidly advancing Internet technology, and this growth has created a merger between the intellectual and the practical sides of copyright law. Was he pleased with the result? "It was a pleasure teaching Copyright Law at a school where it is considered by so many people as a core subject. I was impressed by the level of participation, even in a very large class."

Currently, Jeremy is co-teaching Property to the first year class with Marcus Hurn. He is also teaching an Entertainment Law class, taking students through the legal process of putting together a motion picture. He will also be teaching courses during Franklin Pierce's summer institute program.

While Jeremy will be returning to Los Angeles and Warner Brothers next fall, he will remain in contact with the faculty and students at FPLC, advising students interested in entertainment law.

He has this to say about his past year at FPLC: "I have found that the most notable thing about the faculty here to be its devotion to teaching and improvement of teaching – this is something that should not be taken for granted in today's higher education environment."

We are certainly glad to have had the opportunity to have Jeremy this past year, and look forward to a continuing relationship.

## FPLC-INTA REUNION WEEKEND

The Faculty and Administration of FPLC  
invite you to attend the  
**FPLC-INTA Reunion Weekend**  
to be held Saturday, May 9  
from 3:00 - 9:00 p.m.

The reunion, which includes dinner,  
will be held at the Law Center.

Transportation from the  
International Trademark Association meeting  
in Boston will be provided.

If you would like to attend,  
please contact Linda Ashford  
at 603-224-3342  
or at [LAshford@fplc.edu](mailto:LAshford@fplc.edu).

### FRANKLIN PIERCE Number One IP Law Program



According to the 1998 *U.S. News and World Report* survey of America's accredited law schools, Franklin Pierce Law Center ranked number one in the specialty of "Intellectual Property" in the whole nation. This is the second year in a row that FPLC has ranked in the top spot.

# The 1998 MIP/LLM Class

This year 60 students from 22 countries are enrolled in FPLC's MIP/DIP program. The largest delegation is from the U.S. with 15 students, followed by Korea with 12 students, China with 9 students, Japan with 4 students, and Thailand with 3 students. Other countries represented include Brazil, Costa Rica, Peru, Spain, Swaziland, The Netherlands, Vietnam and Yugoslavia. The following offers a closer look at the 1998 MIP/DIP class.

*Mr. Yasushi Asami* is in-house counsel at Fuji Xerox in Tokyo, Japan. He received his B.A. in law from Meiji University, Japan.

*Ms. Gisella Barreda* is an attorney at Barreda Moller Abogados in Lima, Peru. She has a B.E. in industrial engineering from the Universidad de Lima, Peru.

*Ms. Kathryn Beesley* is an entrepreneur in Chester, NH. She received her B.A. in philosophy and political science from the University of New Hampshire in Durham and a J.D. from the Massachusetts School of Law in Andover.

*Mr. Razzarq Bello* has a B.S. in management from New Hampshire College, an A.L.M. from Harvard University Extension School and a J.D. from the University of Florida College of Law.

*Mr. Philip Boxell* is an attorney in private practice in Boston, MA. He has a B.A. in economics from Wabash College and a J.D. from Indiana University Law School.

*Mr. Julian Burke* has a B.A. in philosophy from the University of London, England and a J.D. from Boston University School of Law.

*Mrs. Bih-Lih Chen* is an attorney at Trace Storage Technology Corporation in Taipei, Taiwan, ROC. She received her LL.B from National Taiwan University.

*Mr. Dae Ho Choi* is an economist for the legal department of Hyundai Motor Company in Seoul, Korea. He has a B.A. in Japanese and economics from Hankuk University of Foreign Studies in Seoul.

*Mr. Wonsuck Choi* is an electrical engineer at LG Semicon in Seoul, Korea. He received his B.S. in electronics from Dong-A University.

*Mr. Jedsada Chomcherngpatt* is an attorney at Malinee Food Products Co., Ltd. in Bangkok, Thailand. He has a LL.B from Thammasat University in Bangkok.



From left to right: *Stephen Magagula, Adel Oweida and Kinley Wangchuk* experience a snowy New Hampshire day.

*Mr. Carlos Corrales* is an attorney at Bufete, Corrales & Jimenez in San Jose, Costa Rica. He received his B.A. in law from the University of Costa Rica.

*Ms. Ana Crnilovic* is from Belgrade, Yugoslavia. She has a B.S. in financial management from Franklin Pierce College in Rindge, N.H.

*Ms. Caroline duPont-Kiracofe* is an entrepreneur in Epping, NH. She received her B.S. in broadcast journalism and international relations.

*Ms. Annemarie Dooijes* is an attorney at Arthur Anderson in The Netherlands. She received her J.D. from Utrecht University.

*Mr. Thibault Fayette* was the technical attache for the French Embassy in Tokyo, Japan. He has a B.E. from I.U.S.T.I. of Marseille, France, and University Degrees in fluid mechanics-aeronautic and intellectual property from the University of Marseille and C.E.I.P.I. of Strasbourg.

*Ms. Michelle Gallon* is an attorney from the United Kingdom. She received her LL.B from Buckland University College in Oxford, England.

*Mr. Song Gao* is a patent and trademark attorney who teaches at the Chinese Training Center for Senior Judges in Beijing, PRC. He has a B.S. in medicine and biochemistry from Changchun Traditional Medicine College.

*Ms. Marta Garcia* is an attorney and film director from Madrid, Spain. She has a Law Degree from Universidad Complutense de Madrid.

*Ms. Dahlia George* is Assistant Attorney General for the Department of Justice in Concord, NH. She has a B.A. in

## THE 1998 MIP/DIP CLASS (CON'T.)

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political science and international relations from Boston University and a J.D. from the University of Dayton School of Law.

*Mr. Llewellyn Gibbons* has a B.A. in psychology from SUNY at New Paltz, a J.D. from Northeastern University School of Law in Boston and an LL.M. from Temple University School of Law in Philadelphia.

*Mr. Mahmoud Hmoud* is a diplomat at the Ministry of Foreign Affairs and legal advisor at the Office of the Crown Prince in Amman, Jordan. He received a B.A. in law from the University of Jordan and an LL.M. from The George Washington University, National Law Center in Washington, DC.

*Mr. Young Gi Hong* is a patent attorney at Y.P. Lee & Associates in Seoul, Korea. He has a B.A. in business administration from Yonsei University in Seoul.

*Mr. Tsu-Sung Hsieh* is an officer in the Chinese Navy. He has a B.S. in naval science from the Chinese Naval Academy in Taiwan, ROC and an M.S. in Management from the U.S. Naval Postgraduate School.

*Ms. Yvonne Imbert-Garraton* is an attorney in private practice in San Juan, Puerto Rico. She has a B.A. in communications from Loyola University in New Orleans and a J.D. from the University of Puerto Rico.

*Mr. Tadashige Itoh* is a patent attorney at Itoh International Patent Office in Tokyo, Japan. He received his B.E. in mechanical engineering from Waseda University in Tokyo.

*Mr. Shih-Chieh Jang* is a patent engineer at Mitac International Corporation in Taiwan, PROC. He has a B.E. in mechanical engineering from National Sun Yat-Sen University in Taiwan.

*Mr. John Kheit* is an attorney at Time Warner in New York City. He has a B.A. in computer science from Rutgers University in New Brunswick, NJ, a M.A. in business administration from Rutgers University Graduate School of Management and a J.D. from New York Law School.

*Ms. Saisawan Khobthong* is an attorney at Anek & Brischon Co., Ltd. in Bangkok, Thailand. She received

her LL.B. from Chulalongkorn University in Bangkok. *Ms. Hye Jin Kim* is a patent agent at C.H. Chun, Son & Kim in Seoul, Korea. She has a B.S. in chemistry from Seoul Women's University.

*Mr. Sung Pil Kim* is a patent agent at Samsung Electronics in Seoul, Korea. He received both a B.S. and an M.S. in electronic engineering from Hanyang University in Seoul.

*Mr. Sang Chul Kwon* is a patent manager at Samsung Electronics in Seoul, Korea. He has a B.S. in electrical engineering from Kyungpook National University in Taegu, Korea.

*Mr. Duong Hoai Le* is the deputy director of the Patent and Trademark Bureau in Hanoi, Vietnam. He received diplomas in IP from the Institute of Industrial Property in Moscow and the Center for International Industrial Property in France.

*Mr. In-Seok Lee* is a trademark examiner for the Korean Industrial Property Office. He has a B.A. in English from Hankuk University of Foreign Studies in Seoul.

*Mr. Jun-Seo Lee* is a patent attorney at Y.S. Chang & Associates in Seoul, Korea. He has a B.E. in engineering from Seoul National University.

*Mr. Won-Sun Lim* is the deputy director of the copyright division for the Ministry of Culture & Sports in Seoul, Korea. He received his B.A. in public administration from Soong Sil University in Seoul and his M.A. in public administration from Seoul National University.

*Ms. Jacqueline Lindsay* is an attorney in private practice in Haverhill, MA. She has a B.A. in humanities from Merrimack College and a J.D. from Massachusetts School of Law at Andover.

*Mr. Hui Ma* is an attorney for China National Scientific Instruments and Materials Import & Export Corporation in Beijing, PRC. He has a B.E. in engineering from Gansu Agricultural University and a LL.B. from Beijing University.

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*Kinley Wangchuk brought his wife, Karma, to New Hampshire.*

## THE 1998 MIP/DIP CLASS (CON'T.)

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*Mr. Stephen Magagula* is the deputy registrar of companies at the Registrar General's Office in Mbabane, Swaziland. He received a diploma in public service law from the University of Botswana & Swaziland and a certificate in communication for national development from San Diego State University.

*Mr. Anthony Meola* is an attorney from New York City. He has a B.E. in mechanical engineering from SUNY at Stony Brook and a J.D. from Touro Law Center.

*Ms. Sun-Young Mock* is a patent agent at D.S. Mock Patent Office in Seoul, Korea. She has a B.S. in chemistry from Ewha Womans University in Seoul.

*Mr. David Morfesi* received his B.S. in marketing from Boston College and a J.D. from the Catholic University of America, Columbus School of Law in Washington, DC.

*Ms. Rose Ndegwa* is a patent examiner at the Kenya Industrial Property Office. She received a B.S. in botany and zoology from the University of Nairobi.

*Mr. Satar Omolola* is an attorney in private practice in Lagos, Nigeria. He has an LL.B. from Lagos State University and a B.L. from the Nigeria Law School.

*Mr. Adel Oweida* is director of automation at the Egyptian Patent Office. He has a B.S. in geology from Cairo University.

*Mr. Jun Sung Park* is a patent manager at Samsung Electronics in Seoul, Korea. He has a B.S. in electrical engineering from Kyungpook National University in Taegu, Korea.

*Mr. Man Soon Park* is a patent agent at Park & Shin in Seoul, Korea. He has a B.A. in economics from Seoul National University.

*Ms. Knoelle Power* is a chemist at Pharm-Eco Labs in Lexington, MA. She received her B.S. in chemistry from the University of Massachusetts at Lowell.

*Mr. Eugene Quinn* is an attorney at Hall, Hess, Kenison, Stewart, Murphy & Keefe in Manchester, N.H. He has a J.D. from Franklin Pierce Law Center in Concord.

*Mr. Stephen Scuderi* is an attorney from Springfield, MA. He has a B.S. in mechanical engineering from the University of Massachusetts at Amherst and both a J.D.

and a B.S. in electrical engineering from Western New England College School of Law in Springfield.

*Mr. Akira Sekiguchi* is a patent attorney at Eisai Co., Ltd. in Tokyo, Japan. He received his B.S. and M.S. in genetic engineering from Hokkaido University in Sapporo.

*Ms. Jane Shershenovich* has a B.S. in biochemistry from the University of Scranton, PA and a J.D. from Widener University School of Law in Wilmington, DE.

*Mr. Eduardo Silva* is an attorney at Clarke Modet do Brasil in Rio de Janeiro, Brazil. He has an LL.B. from VERJ in Rio de Janeiro.

*Mr. Lars Smith* is an attorney at Kassler & Feuer in Boston, MA. He has a B.A. in economics from Colby College in Waterville, ME and a J.D. from New England School of Law in Boston.

*Mr. Ekburus Srisanit* is an attorney at Anek & Brischon in Bangkok, Thailand. He received his law degree from Assumption University Law School in Bangkok.

*Ms. Bin Su*, a patent examiner from Beijing, PRC, is currently a foreign intern at Pennie & Edmonds in New York City. She has a B.S. in chemistry from Beijing University.

*Ms. Ray Wang* is a patent engineer at Lee & Li Attorneys-at-Law in Taipei, Taiwan, ROC. She has a B.S. in chemistry from Chung Yuan Christian University and an M.S. in chemistry from the National Tsing Hua University.

*Mr. Kinley Wangchuk* is the IP director at the Ministry of Trade and Industry in Thimphu, Bhutan. He has a B.A. in English literature from Delhi University, a certificate in intellectual property from the Sri Lanka Foundation and a certificate in industrial property from C.E.I.P.I. in France.

*Ms. Ting Ting Wu* is an attorney in Taiwan, ROC. She received her LL.B. from the National Taiwan University and her LL.M. from University of the Pacific, McGeorge School of Law in Sacramento, CA.

*Mrs. Dan Yang* is the overseas representative at Lung Tin International Patent & Trademark Agent in Canada. She has a B.A. in English language and a M.A. in communications from Shanghai International Studies University.

*Mr. Tianan Zhang* is a patent attorney at China Patent Agent (H.K.) in Hong Kong, PRC. He received a diploma in machinery manufacture from the Staff & Workers College of Beijing Machine Building Industry Bureau.

# A Right of Publicity Standard for a Privileged Appropriation of Identity

by Sang Eun Lee

**Did the *White v. Samsung* Court make a proper decision?**

The right of publicity is the right of each individual to control and profit from the value of his or her name, image, likeness, and other indicia of identity. Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203 (1954). Courts have protected the worth of a person's identity under numerous legal theories. After a long history of judicial development, the right of publicity today affords the celebrity a cause of action against the unauthorized commercial exploitation of his persona. However, after the decision in *Vanna White v. Samsung Electronics America, Inc.*, 971 F.2d 1395 (9th Cir. 1992), 989 F.2d 1512 (9th Cir. 1993), cert. denied, 133 S. Ct. 2443 (1993), the scope and extent of the right of publicity law do not seem to have any limitations. The *White* court found an appropriation of identity even where the advertiser's depiction of the celebrity did not constitute a "likeness" for the purpose of California's name-and-likeness statute. *Id.* at 1399. The court reasoned that a mere evocation of White's identity to viewers, regardless of whether they believed that White was endorsing the advertised product, was enough to decide whether Samsung had infringed her right of publicity. *Id.* The court's decision "erects a property right of remarkable and dangerous breadth." *White*, 989 F.2d 1512, 1514 (Kozinski, J., dissenting). It also threatens free speech right otherwise accommodated by intellectual property law by granting a too broad monopoly right to a celebrity. The *White* decision teaches that an unauthorized use of virtually anything that is associated with a celebrity may expose an advertiser to liability.

This article will argue whether or not the *White v. Samsung* court granted the celebrity a broader right than necessary to safeguard the economic value of a celebrity's identity, and the danger of the court's application of the evocation-of-identity standard.

## The VannaBot Case

In 1992, Vanna White, the hostess of the television game show "Wheel of Fortune," brought a right publicity action against Samsung Electronics. *White*, at 1395. White claimed that the defendant violated Ca. Civ. Code §3344 and §43(a) of the Lanham Act and infringed her common law right of publicity. *Id.* The subject of the suit was a humorous advertisement depicting a robot dressed to resemble White and posed alongside the "Wheel of Fortune" game board. *Id.* at 1396.

The district court granted summary judgment for the defendants, dismissing all claims. *Id.* On appeal, the Ninth Circuit (with Kozinski dissenting) affirmed the dismissal of the §3344 claim, but reversed the dismissal of the right of publicity and Lanham Act claims and remanded for trial. *Id.* at 1402.

Vanna White is the hostess of the "Wheel of Fortune," a game show reaching forty million people daily. Due to her celebrity status, Vanna endorses a variety of products. Samsung developed an advertising campaign featuring the use of Samsung products in the 21st century, which included humorous futuristic advertisements. The advertisement at issue featured a robot with a blonde wig, gown, and jewelry selected to resemble Vanna's hair and dress. The robot was placed next to a game board instantly recognizable as the Wheel of Fortune game show set with the caption: "Longest-running game show. 2012 A.D."

In *White's* case, the Ninth Circuit confirmed its position to strictly construe the California right of privacy statute. See *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) (Midler could not assert a cause of action under the statute because Ford used someone to imitate her voice in the advertisement and did not use her voice.) Closely following *Midler*, the Ninth Circuit affirmed dismissal of *White's* §3344 claim because the advertisement used a robot, and not a photo or model of Vanna. Therefore, according to this holding, the defendant did not use *White's* "likeness within the meaning of §3344." *White*, 989 F.2d 1512, 1514 (Kozinski, J., dissenting).

Nevertheless, the Ninth Circuit majority concluded that the right of publicity was not limited to "likeness," but included misappropriation of someone's identity, a broader concept. Jeffrey W. Tayon, *Recent Developments in the Right of Publicity*, 1 TEX. INTELL. PROP. L.J. 109 (1993). The court held that a simple evocation of the celebrity's image in the public's mind is a tort. *White*, at 1512. The court concluded that a reasonable jury could find that viewers of the ad would believe that White endorsed Samsung product and that Samsung's appropriation of *White's* identity was actionable under California common law. *White*, at 1513. Samsung had argued that the advertisement parodied *White* and thus was speech protected under the First Amendment. *Id.* However, the court rejected the First Amendment defense concluding that this was not a parody for fun, but for profit. *Id.* The court stated:

The ad's spoof of Vanna White and Wheel of Fortune is subservient and only tangentially related to the ad's

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primary message: "buy Samsung VCRs." Defendants' parody arguments are better addressed to noncommercial parodies. The difference between a "parody" and a "knock-off" is the difference between fun and profit. *Id.*

Subsequently, a jury found for White, awarding her \$403,000 in damages. *White v. Samsung Electronics America, Inc.*, No. CV-886499 (C.D. Cal. filed January 20, 1994).

### A critique of the *White* decision

In the *White* court's view, the critical issue is not how the celebrity plaintiff's identity has been appropriated, but whether it has been appropriated. The evocation-of-identity test suggested by the *White* court is paraphrased as follows: if an advertiser uses any method that indirectly evokes a celebrity's identity, then the advertiser has infringed the celebrity's right of publicity. *White*, 971 F.2d 1395, 1398-99. This evocation-of-identity test is dangerous in many respects. First, it effectively grants the celebrity's property right in attributes that merely remind the public of him, as opposed to a property right in his persona *per se*. Weiler, *supra*, at 258. Second, the test ignores the possibility that the celebrity's identity, as evoked within a particular advertisement, may serve an entertainment function or form a part of a parody, such that the appropriative portion of the advertisement merits First Amendment protection. *Id.* In addition, it also conflicts with the Copyright Act and the copyright clause. *Id.* at 1513.

#### A. Property Rights in Identity Attributes

Under California law, White has the exclusive right to use her name, likeness, signature and voice for commercial purposes. Cal. Civ. Code § 3344 (a). But here, Samsung didn't use White's name, voice or her likeness. It is clear to anyone viewing the advertisement that White was not being depicted. No reasonable juror could confuse a metal robot with White. *White*, 971 F.2d at 1404.

Then what is the most determinative factor in the Samsung's Vannabot ad to remind the viewer of Vanna White? Traits such as blonde hair, an evening gown, and jewelry are shared by thousands of women. *White*, 989 F.2d 1512, 1515. Even if a chimpanzee was standing beside the "Wheel of Fortune" board, people would have been reminded of White's role. *Id.* Hence, in this case, it was the "Wheel of Fortune" game board that evoked the identity of White to viewers. *Id.* The "Wheel of Fortune" set, however, was not an attribute of White's identity, but rather "an identifying characteristic of a television game show." *White*, 971 F.2d at 1405.

Distinguishing between the performer and the part she plays is essential to analyze the facts of *White*. Dissenting from the majority's opinion about White's publicity claim, Judge Alarcon cited *Nurmi v. Peterson*, 10 U.S.P.Q.2d (BNA) 1175 (C.D. Cal. 1989), a case that conflicts with *White*. (The court held that the use of props, clothes or mannerisms that non-deceptively imitate a character is not actionable under California's common law right of publicity.) *White*, 971 F.2d at 1404. Conceding that "anyone seeing [Samsung's] commercial would be reminded of Vanna White," Judge Alarcon observed that a performance by another female as a game-show hostess would remind viewers of White because "Vanna White's celebrity is so closely associated with the role." *Id.* at 1405.

It is suspicious whether the *White* court's decision that recognized White's role as an attribute of her identity could be justified. Judge Kozinski criticized the majority's absurd decision stating that "The panel is giving White an exclusive right not in what she looks like or who she is, but in what she does for a living." *White*, 989 F.2d at 1515.

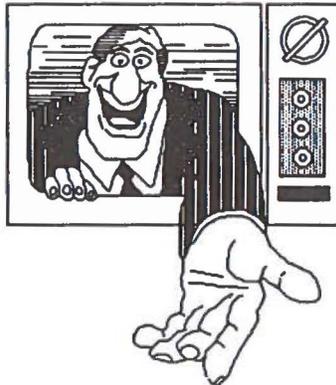
Yet in finding misappropriation in this case, a court is empowering White to enjoin an advertiser from depicting anything next to the "Wheel of Fortune" game board. Granting White such a monopoly right is markedly different from recognizing a celebrity's right of publicity in controlling unauthorized uses of her persona. Weiler, *supra*, at 258.

Therefore, the majority in the *White* court did not prevent the "evisceration" of White's existing rights. *White*, 989 F.2d at 1514. The decision created a new and much broader property right which does not exist under law. *Id.*

#### B. Conflicts between Copyright and Publicity Interests

The majority's decision in *White* also conflicts with the federal copyright law. What would have happened if the Ninth Circuit had to decide the Midler case after it presented the evocation-of-identity test in *White*? See *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) (a professional singer, Midler recovered against an advertiser that used a "sound alike" in commercial to imitate her voice). Rather than hiring a singer and instructing her to "sound as much as possible like. . . Bette Midler," *id.* at 462, what if the advertising agency in *Midler* has a male singer who sounds nothing like Midler's singing "Do You Want To Dance" in the background of a television commercial. Weiler, *supra*, at 259. Midler could argue that the mere singing of her hit song would evoke her identity to listeners. The the Ninth Circuit, relying on *White*, would have to find infringement of Midler's right of publicity. Midler's publicity claim would preclude advertisers from using any rendition of the song in a commercial

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without first securing Midler's permission. Consequently, licensing a cover version of the song would become an expensive proposition because Midler could demand a royalty from each potential licensee — all for a song that she had no part in creating. Steven J. Hoffman, *Limitations on the Right of Publicity*, 28 BULL. COPYRIGHT SOC'Y 111, 112 (1980-81). The income stream that flows to the copyright proprietor of the song, as well as the songwriter who licenses cover versions of the composition, would be thus impaired. Ironically, this was the exact result that the Ninth Circuit consciously sought to avoid in *Sinatra v. Goodyear Tire & Rubber*, 435 F.2d 711 (9th Cir. 1970), cert. denied, 402 U.S. 906 (1971) (the court dismissed Sinatra's claim of publicity in his hit song because holding otherwise would "grant state copyright benefits without the federal limitations of time to permit definite public domain use"). Weiler, *supra* at 250. Thus, the *White* court's evocation-of-identity test will cause chaos and contradict the copyright system.

In addition, the *White* decision raises a parody issue in the copyright system. Samsung claimed that its advertisement was a parody and the appropriation of White's identity should be privileged. The majority refused to recognize the parody exception to the right of publicity, which also contradicts the Copyright Act. *White*, at 1517. Copyright law specifically gives the world at large the right to make "fair use" parodies. *Id.* (Citing *Fisher v. Dees*, 794 F.2d 432, 435 (9th Cir. 1986)).

In the present case, Samsung did not merely parody Vanna White, but also her appearance in "Wheel of Fortune," a copyrighted television show governed by federal copyright law. *White*, at 1517. It is impossible to parody a movie or TV show without at the same time "evoking the identities" of the actors. *Id.* The image of the celebrity in her show is free to be parodied. If a court prohibits the unavoidable evocation of the celebrity's identity in parody, it is denying the essence of the federal copyright law. Thus, the evocation-of-identity test itself negates the right to make parodies.

In sum, the *White* court decision incurs some serious conflicts between copyright and publicity interests.

### C. Conflicts with the First Amendment Right

Samsung's parody defense is closely related to First Amendment issues. The court did not recognize the First Amendment right because Samsung's ad was for profit. *Id.* at 1513. It is unclear, however, why a parody within the context of an advertisement should be treated any differently than a parody in news or entertainment mediums.

A particular advertising use of a celebrity might not generate any deleterious effects on a celebrity's interest. For example, in *White*, the defendant evoked White's identity to humorously convey the message that its VCRs would last well into the future. Samsung did not repre-

sent that White endorsed the product. Nor did Samsung exploit White's appearance to enhance the attractiveness of its product, as is obvious from its use of a robot rather than the real White.

Privileged appropriation of identity presumes that evoking a celebrity persona within an advertisement is not wrongful *per se*. Rather, advertisers should be able to remind the public of a celebrity, so long as the advertiser does not link the celebrity to the product in order to make the product more desirable. One could argue that since the evocation of a celebrity's identity for humor draws the attention of viewers, therefore making the product more attractive, there should be no "joke defense" to publicity infringement. The response to this is that entertainment and social commentary are protected under the First Amendment, such that celebrity parodies in an advertisement should at least be treated as commercial speech.

The First Amendment is not only about religion or politics, but also about protecting the free development of our national culture. *White*, 989 F.2d 1512, 1518. Parody, humor and irreverence are all vital components of the marketplace of ideas. *Id.* The last thing the First Amendment will tolerate is a law that lets public figures keep others from mocking them, or from "evoking" their images in the mind of the public. *Id.* The fact that the advertising is less protected because it is commercial speech does not mean that it should not be protected at all.

If the First Amendment protects a speech right to enhance a free communication of the public, as matter of policy, advertising should be protected in the same sense. Advertising has a profound effect on our culture and our attitudes. Seemingly-neutral ads influence people's social and political attitudes and raise political controversy. *Id.* Is the Samsung parody any different from a parody on Saturday Night Live? *Id.* Both are profit motivated and using a celebrity's identity to sell things — one to sell VCRs, the other to sell advertising. Commercial speech is a significant and valuable part of national discourse.

It is worthwhile to review whether the right of publicity is justified enough to give a celebrity power to limit the expressive and communicative opportunities of the public. In modern society, advertising is not merely a method to sell products. Advertising helps us identify products that fill our needs, and often shapes our desires together, associating them with the name of the brand advertised. Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 972 (Oct., 1993). The public has communicative interests in advertising because it provides people with information and fill the gaps of communication between manufacturers and consumers.

Usually advertisers convey a strong concept of products to consumers. The ad could provide detailed information about a product or merely an image. To communicate with people more easily, advertisers often use verbal slogans, trademarks or celebrity images. These

# Leveling the Litigation Playing Field Through Efficiency and Technology

by Skip Singleton

Intellectual property litigation is a high stakes proposition, one that can bankrupt either party.<sup>1</sup> The average cost of a patent infringement suit is over \$1 million, and in complex cases, the cost can easily reach into several millions.<sup>2</sup> The epic patent case, *Polaroid Corp. v. Eastman Kodak Co.*,<sup>3</sup> spanned over fourteen years and cost the parties \$200 million combined.<sup>4</sup> The enormous potential burdens of intellectual property litigation can cause long lasting business repercussions due to significant attorneys' fees, survey and travel costs, abundant use of expert witnesses, onerous discovery and preliminary motions, potential appeals and retrials, not to mention the high cost of executive and management time.<sup>5</sup> In the end, not only is the losing party often left financially and emotionally drained by litigation, the winner is as well.<sup>6</sup>

Many successful ongoing businesses consider litigation simply a cost of doing business.<sup>7</sup> They budget substantially to fight to protect what is theirs, and without hesitation will challenge the rights of others when it is to their advantage. Many independent inventors, authors and creators on the other hand, do not have such allocated funds to fully assert their acquired rights; nor do many start-up or developing companies have the necessary capital to sustain lengthy litigation. Larger, wealthier businesses can take advantage of the meek by unjustly asserting their power. A little guy with fewer financial resources can be knocked out of the picture before a trial is even scheduled, or forced to settle on unfavorable terms.<sup>8</sup>

## Developing an Efficient Strategy

Surgical Systems and Instruments, Inc. (S.S.I.), a small New England-based company and owner of several medical-related patents, has found a way compete successfully against larger corporations in costly patent litigation. S.S.I. builds its cases through efficient use of a combination of litigation talent, law professors and law students' help, and has coordinated their efforts through the aid of computer technology.<sup>9</sup> This creative strategy has not only allowed S.S.I. to be a player in the litigation game, it has helped to make them a formidable opponent.

As a member of the law student team for S.S.I., I have experienced the inner workings of a litigation team in their effort to help a small company seek justice. In

this "survival of the fittest" arena, efficiency is the key when facing opponents with aggressive litigation strategies and unlimited budgets. Employing the right people at the right prices has proven to be a winning element for a small patent holder in pursuit of its legal right.

Intellectual property students, under the guidance of a law professor,<sup>10</sup> perform research, analyze issues and draft preliminary matter compiling the data in a single software utility for the "primary" attorney to review, revise and rework. Multiple issues and ideas are pursued to help to build a stronger case at an affordable cost without jeopardizing the attorney-client relationship. Occasional conference calls are necessary, but the majority of the preliminary "grunt work" is performed in a fully integrated litigation software package. Were it not for such technology and its efficient application, the client would be in dire straits, unable to seek judicial protection and/or redress for its patent infringement dilemma.

Morgan Chu, attorney for Stac Electronics, used a completely different approach when it sued the giant Microsoft Corporation<sup>11</sup> for patent infringement of data compression technology.<sup>12</sup> Chu took a "rifle shot" on the patent issues by purposely streamlining the complaint with the intent to drastically cut the document load to get to trial in a reasonable amount of time.<sup>13</sup> Since Microsoft's strategy was to make the litigation time-consuming and expensive for Stac, a small company with limited resources, Chu's strategy was one of efficiency.<sup>14</sup> As a result, Stac was able to muster enough effort to speed the case to trial only one year after filing and win a significant \$120 million judgment against Microsoft in the process.<sup>15</sup>

## Use of Technology as a Weapon

The future of the United States court system lies in the hands of state-of-the-art "paper-less" technology.<sup>16</sup> In a paper-less trial, documents are electronically stored in computers and presented in court through computer images.<sup>17</sup> Document management is easier and less time consuming through instantaneous searches and chronological indexing, making computers a powerful, efficient and persuasive technological tool in the courtroom.<sup>18</sup>

Many may think that only the federal government and large firms can afford to utilize such technology but that is simply not true.<sup>19</sup> Smaller firms have the opportunity

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to gain equal footing and compete with larger firms in complex litigation through affordable automation software. For instance, the basic price of the CASE-Links<sup>20</sup> litigation software, which the U.S. Attorney's office recently used in Massachusetts' first paper-less trial, is available for a single user at \$295 and \$395 for a network (IBM PC or compatible only).

A few other litigation support software packages are available, such as "TrialMaker,"<sup>21</sup> which has been developed and refined by an attorney with twenty years of experience in civil litigation. It is available in both Macintosh and Windows versions at a cost of \$379 for a single user or \$479 for a multi-user license for up to 3 people. Like CASE-Links, TrialMaker also has the advantage of full text capabilities. Scanned documents can be imported to TrialMaker and linked to other documents and files, allowing for ease of organization, effective information retrieval and efficient case preparation. TrialMaker appears to be equally as advantageous to use as CASE-Links.

In order to compete with larger firms willing to put numerous associates and/or partners on a complex case, smaller firms have to invest in automation.<sup>22</sup> Through the use of technology, time can be saved in case preparation and document management. Efficient users will embrace the new speed because fast trials may mean more cases,

whereas litigators paid by the hour may be adverse to going paper-less.<sup>23</sup> Smaller firms can use this strategy to face larger opponents, effectively using technology as their weapon to compete.

In an article entitled *David vs. Goliath*, "David" found a way to compete with "Goliath's" financial resources and intimidating litigation team.<sup>24</sup> The first round of discovery documents fired at the little guy totaled over 400,000 pages.<sup>25</sup> "David" counteracted the move by "working smarter, not harder" through the use of a few savvy people with PC's, document scanners and the use of litigation software to sift through the mountain of material.<sup>26</sup> What he found was a small fraction of documents which contained the key information needed to prove the patent infringement issue.<sup>27</sup> Discovery of the "smoking gun buried in the thousands of pages"<sup>28</sup> was made possible through full-text searches and document coding in the features of "David's slingshot,"<sup>29</sup> his use of technology. Although "Goliath" remained a formidable opponent, he was no longer as intimidating to "David's" attorney who was prepared and in command of the needed information for trial.<sup>30</sup> This allowed David, and his attorney, the opportunity to afford to go up against a giant . . . and prevail.

*Skip Singleton, '98, will be working for the law firm of Shaw Pittman Potts & Trowbridge in Washington, DC following graduation this May.*

Notes:

<sup>1</sup> Mary Ann Tucker, *Winning Strategies in Patent Litigation: Corporate Counsel's Role in Patent Litigation*, 423 PLI/PAT 279 (Mar. 1995).

<sup>2</sup> *Id.*

<sup>3</sup> *Polaroid Corp. v. Eastman Kodak Co.*, 641 F. Supp. 828, 16 U.S.P.Q. 2d (BNA)1481 (D. Mass. 1986), *aff'd*, 789 F.2d 1556 (Fed. Cir. 1986), *cert. denied*, 479 U.S. 850 (1986).

<sup>4</sup> Greg A. Paradise, *Arbitration of Patent Infringement Disputes: Encouraging the Use of Arbitration Through Evidence Rules Reform*, 64 FORDHAM L. REV. 247, 253 (1995).

<sup>5</sup> Miles J. Alexander, *Settlement of Intellectual Property Disputes: When is it Better to Switch Than Fight?*, 790 ALI-ABA at 3-4 (Nov. 20, 1992).

<sup>6</sup> *Id.* at 4.

<sup>7</sup> Ronald E. Myrick, *Corporate Counsel's Role in IP Litigation*, 349 PLI/PAT 163 (Nov.-Dec. 1992).

<sup>8</sup> Morgan Chu, *A Giant-Killer Should Limit Scope of Attack*, NAT'L L.J. C10, (col.1) (Mar. 13, 1995).

<sup>9</sup> See *infra* note #20. Surgical Systems and Instruments, Inc. uses CASE-Links software as described.

<sup>10</sup> Christopher E. Blank, Professor of Law, Franklin Pierce Law Center.

<sup>11</sup> *Stac Electronics v. Microsoft Corp.*, 38 F.3d 1222 (Fed. Cir. 1994).

<sup>12</sup> See Chu, *supra* note 8.

<sup>13</sup> *Id.*

<sup>14</sup> *Id.*

<sup>15</sup> *Id.*

<sup>16</sup> Claire Papanastasioiu Rattigan, *The 'Paper-less' Trial; A Recent Massachusetts Case Proves That Case Can Be Tried Without Paper*, THE MASSACHUSETTS LAWYER, B-1 (Feb. 19, 1996).

<sup>17</sup> *Id.*

<sup>18</sup> *Id.*

<sup>19</sup> *Id.* at B-1, B-5.

<sup>20</sup> For more information, contact: CASE-Links, The Document Manager at CAT-LINKD, Inc., 2100 N. Broadway, #200, Santa Ana, CA 92706, PH: (800)825-4657.

<sup>21</sup> For more information, contact: TrialMaker Software, 5 Keniston Rd., Lynnfield, MA 01940. PH: (617) 334-3367.

<sup>22</sup> Rattigan, *supra* note 16, at B-5.

<sup>23</sup> *Id.*

<sup>24</sup> *David v. Goliath*, 5 NEWS-LINKS (CAT-LINKS NEWSLETTER), Winter/Spring, 1993, at 1.

<sup>25</sup> *Id.*

<sup>26</sup> *Id.* at 2.

<sup>27</sup> *Id.*

<sup>28</sup> Barry D. Bayer & Benjamin H. Cohen, *User Friendly: Two Good Ways to Handle Depositions*, LEGAL TIMES, Sept. 27, 1993 at 49.

<sup>29</sup> *David vs. Goliath*, *supra* note 24.

<sup>30</sup> *Id.*

# FPLC TAKES INTELLECTUAL PROPERTY PROGRAM TO ARAB NATIONS

Franklin Pierce has recently transplanted its Intellectual Property degree program to Dubai, United Arab Emirates. Already at a WIPO conference held in Costa Rica in 1990, Professor Stanislaw Soltysinski of Mickiewicz University, Poznan, Poland recognized Franklin Pierce Law Center's IP degree program as "unique" and recommended its "transplantation" to other countries.

The Law Center initiated its unique IP degree program in 1985. Subsequently, the New Hampshire Post Secondary Education Commission cited the program, in granting its permanent approval, as "extremely impressive," and offering "a unique niche in legal education worldwide." Enrollment for half a year leads to a diploma in IP (DIP) and for one year, a Master of IP (MIP).

Last May, Mr. Khalid Al-Mehairi, Chairman of the Gulf Institute for International Law (GIIL) in Dubai and President Viles of FPLC signed an Understanding between these two institutions, establishing our IP Program as a joint venture in Dubai. The purpose of the joint venture or joint degree program is to provide intensive academic IP education and training for the Gulf countries (Bahrein, Kuwait, Oman, Qatar, Saudi Arabia and UAE) in light of the passage of IP laws in response to GATT-TRIP's requirements.

The Gulf Institute, which draws students from the neighboring Gulf countries, is the first private academic institution in the Arab World devoted to the study of law and promotion of understanding of Middle Eastern legal systems. It is located in Dubai, with a branch in Abu Dhabi, the capital of the Emirates and also has offices in Washington, DC and Frankfurt, Germany. Dubai is the center for international trade in the Gulf states and the Arab world and is a very beautiful, absolutely safe city, with a long history and rich traditions.

The joint law program consists of two parts: a Winter Session and a Spring Session. Each session lasts about four to five weeks. This enables students to complete six credit hours per session for a total of twelve credit hours. Courses are taught five days a week (Saturday through



*Mr. Khalid Al-Mehairi, the Chairman signs the agreement between Gulf Institute for International Law and Franklin Pierce Law Center, with the President, Professor Robert M. Viles of the Franklin Pierce Law Center. Other persons seen in the photograph are (back row, left to right) Professor William H. Hennessey, Director, Graduate Programs and Professor of Law, Dr. Mohamed Y. Mattar, Director of Gulf Institute for International Law in the U.S. and Professor Karl F. Jorda, the David Rines Professor of Intellectual Property Law and Industrial Innovation.*

Wednesday) and classes meet for four hours each day. Upon successful completion of the Winter Session, students receive a Certificate of Completion to be awarded jointly by GIIL and FPLC. Students who attend and pass the Spring Session, after having successfully completed the Winter Session and a practical training period of about two to four weeks in a Dubai law firm specializing in IP, or having written a paper comparing an issue raised in the course to an issue in the IP laws of the Arab world, receive FPLC's Diploma degree.

A student who has successfully completed the Diploma program and would like to enroll in a FPLC masters degree program, may transfer to FPLC in Concord, with the transfer taking place in August. The transfer student must comply with all requirements for admission to the MIP degree program and can apply the credits earned for the Diploma degree towards the MIP degree and obtain the latter with a half year's residency at FPLC.

The curriculum in the Winter Session offers three two-credit courses, namely, Patents and Trade Secrets, Trademarks and Unfair Competition, and Copyrights and Neighboring Rights. The Spring Session also offers three two-credit courses, which are: International Intellectual Property Law, Intellectual Property Licensing/Technology Transfer, and IP Commercialization.

Mr. Mohammad Jomoa, the Manager of the Patent and Trademarks Department of the Gulf Institute, and Professor Karl Jorda are Co-Directors of this joint venture.

The 1997 Winter Session began at the end of last November with the course on Patents and Trade Secrets, taught by Professor Jorda. Professor Susan Richey fol-

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lowed up by teaching Trademarks and Unfair Competition and Dr. Silke von Lewinski of the Max-Planck Institute of Munich, Germany, who teaches an International Copyrights course at FPLC twice a year, concluded the Winter Session with Copyrights and Neighboring Rights after Christmas and over the New Year.

As was the case when Franklin Pierce started its MIP Program in 1985 with ten students, there were ten students enrolled in the Dubai Program, three of whom were women. Seven were from UAE, two from Saudi Arabia and one from Bahrein. Significantly, the Gulf Institute had received about 200 applications for or inquiries about this Program, which reflects a high degree of interest in the area and foretells great potential for the future.

The students were of high caliber with IP backgrounds. They were Etisalat's (the AT&T of UAE) Chief Counsel, two Patent Examiners from Saudi Arabia, the Head of the Industrial Property Office in Bahrein, a UAE Trademark Examiner, the Legal Adviser to UAE's Copyright Office, an Economic Researcher at UAE's Ministry of Economy and Commerce, two members of Dubai law firms and Mohammad Jomoa, the Co-Director. Given the excellent credentials of this class and their knowledge of IP, there was a great deal of class participation and discus-

sion. Not surprisingly, they did very well on their exams.

In this recently-concluded 1997 Winter Session, everything went very well, as was acknowledged by our President Viles in a letter to Chairman Al-Mehairi:

Both Interim Dean James E. Duggan and I are delighted with the success of the first session of the intellectual property program conducted pursuant to the understanding between the Gulf Institute for International Law and Franklin Pierce Law Center. Professors Karl Jorda, Susan Richey and Silke von Lewinski have enthusiastically told us here in Concord about the exceptional credentials of the initial students, the high quality of the classroom discussion, and the excellent hospitality enjoyed while in Dubai. We appreciate very much the efforts and care that you have taken to assure that, for the benefit of the Law Center as well as the Institute, the degree program has begun in such as outstanding way.

The 1998 Spring Session will take place in Dubai between April 18 and May 23, with courses taught by Professor Bill Murphy (IP Commercialization/Valuation) and two courses by Professor Jorda (International IP Law and IP Licensing/Technology Transfer). If everything goes according to plan, the joint program will continue with the next Winter Session starting in November 1998.

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images become famous through the ads and linger in people's minds. For example, people are motivated when they hear the words, "Just Do It" and are easily reminded of "Nike" and its message message to start working with positive attitude. Someone not been exposed to the "Nike" advertisements would not understand why the image is connected to the slogan. Advertisements create a lot of ideas in people's minds, often leading public opinion. Consequently, the communicative phenomenon by advertisements plays a great role in our culture.

For the foregoing reasons, any doctrine that gives people property rights in words, symbols, and images that have worked their way into our popular culture must carefully consider the communicative functions those images serve. Kozinski, at 974. A celebrity whose image is in the public's mind cannot simply assert, "The image is mine, I own it, and you have to pay for it any time you use it." Having disseminated her image to the world, a celebrity necessarily must give up some measure of control of her image, understand that her image is no longer entirely her own, and that in some sense it also belongs to others. This does not imply a total loss of control, however, only that the public's right to make use of the image must be considered in the balance as we decide what rights the celebrity is entitled to assert. *Id.*

## Conclusion

It is predictable that the *White* decision will cause contradictions in our legal system. The *White* court created a broad property right for a celebrity that damages public interest. The fundamental intellectual property right is threatened: the right to draw ideas from a rich and varied public domain, and the right to mock, for profit as well as fun. By the *White* decision, celebrities have been given something they never had before, and they've been given it at the public's expense. In the name of protecting a celebrity's rights in her image, the court diminished the rights of copyright holders and the public at large.

It is important to recognize, in our culture, advertisements are doing all kinds of work that affect the society. As their new functions become more important, so will the need for law to keep up. It is critical that we consider all the interests at stake and weigh those interests by reference to current reality, not according to rules made up at another time to deal with another reality. In conclusion, the law should reflect any developments and evolution of society. One of the most important responsibilities of courts is to guide the evolution of law. Advertisements have evolved to have new functions in our society. The law must evolve with them.

*Sang Eun Lee, who is interested in Copyright and Trademark law, will graduate in May with J.D. and M.I.P. degrees.*

## Patents and Monopolies

In a PLI program on IP Licensing which I attended some time ago, there was a presentation by a prominent Washington antitrust lawyer in which he all too liberally referred to patents being monopolies, as antitrust lawyers, economists and, most unfortunately, some IP lawyers and IP professors are still wont to do. When I challenged him on his wrongly equating patents with monopolies, he really let me have it! He gave the following example of what he considered a clear and manifest case of a patent monopoly: A U.S. and a Japanese company independently invent and develop the same cancer cure and both companies file for patents with the USPTO. The Japanese company prevails in the ensuing interference, ends up with the patent and refuses to license it, so as to have a monopoly on this drug.

It’s so curious that he needed to bring a Japanese company and a cancer cure into the picture to make his point. But even this fact pattern does not a monopoly make! It is simply a case of unthinking monopolophobia or worse.

For a perfect answer to our misguided antitrust lawyer, let us listen to none other than the former CAFC Chief Judge Howard Markey, who had this to say in *Carl Schenck, A.G. v. Nortron Corp.*, 218 U.S.P.Q (BNA) 698, 699 (CAFC, 1983):

Nortron’s brief characterizes Schenck as a “German monopolist.” That denigration, whether inserted in a vain hope of prejudicing the court or otherwise, has no support in the present record. Disclosure of an invention found to have revolutionized an industry is but a classic example of the ideal working of the patent system. If a patentee or licensee enjoys widespread sales, that too is but an example of the incentive-useful arts promoting element in the patent system. Patents and licenses are exemplifications of property rights. Further, and happily, participation in the U.S. patent system, as patentees and as licensees, is available to citizens and non-citizens alike.

Another quotation from an article written by Judge Markey: (*Why not the Statute?*, 65 JPOS 331 (1983)):

One of the most water-muddying words is “monopoly.” (Elsewhere in his article called a “nasty buzz-

word.”) The word, of course, appears absolutely nowhere in the patent statute, 35 U.S.C. 154. On the contrary, 35 U.S.C. 154 specifies that a patent is a grant for seventeen years “of the right to exclude others from making, using, or selling the invention,” and 35 U.S.C. 261 says “Patents shall have the attributes of personal property.” Thus, as the statute makes plain, the owner of a patent has the same right in the patented invention that you have to your car, your clothing, or your golf clubs—i.e., the right to exclude others, which is but a pseudonym for “property.”

It is of course possible to use any property — patents or stocks or bonds or horses — in a scheme to violate the antitrust laws. Opinions in such cases will contain the word “monopoly,” but the word there applies, or should apply, to the unlawful conduct, not to the patent right itself. From such cases, and from the careless use of the non-statutory term “monopoly” as synonymous with “patent,” has come the curious canard that there is somehow a “conflict between the patent laws and the antitrust laws.”

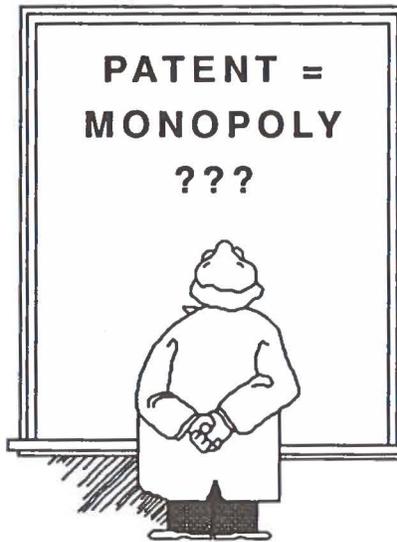
There is, or course, no such conflict,

just as there is no such conflict between the law dealing with stocks, bonds, or horses and the antitrust laws.

Hence, it should be crystal-clear from Judge Markey’s comments that a patent is not a monopoly and, in fact, is not even a “limited,” “legal” or “temporary” monopoly.

The several reasons why a patent as such is not and cannot be a monopoly can be summarized as follows:

1. A monopoly is something in the public domain that the government takes from the public and gives to a person (like in the famous British case of the playing cards). An invention is something that did not exist before and was not in the public domain. It is something novel, that upon publication via the grant of the patent, enriches the public domain with the knowledge of the invention, and upon expiration of the patent, enters into the public domain, free to be used by anyone.



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# Merck Patent Fellowship Awards

The patent division of Merck & Co., Inc., has been committed to encouraging students with scientific backgrounds and interest in pursuing patent law. The Merck fellowship consists of an award of \$5000 to a first year student, a paid summer internship with Merck, and the intention to continue the award through the student's second and third years in law school. Since the attorneys at Merck are responsible for all aspects of intellectual property law, the summer internships expose the students to trademark, patent and copyright law. In addition, the program provides an unrestricted grant to the law school in the same amount.



*Ann A. Nguyen, 1996 recipient and  
John A. Lamerdin, 1997 recipient*

Congratulations to the 1996 recipient, Ann A. Nguyen (class of 1999), and the 1997 recipient, Dr. John A. Lamerdin (class of 2000) for winning the Merck fellowship awards. Ann has a B.S. in Biochemistry from the University of California-Davis. She has worked as a sequencing associate at Incyte Pharmaceuticals, in Palo Alto, and as an intern at Genentech in San Francisco.

John has a B.S. in Chemistry and a B.A. in Philosophy from the University of Redlands, a M.S. in Biochemistry from San Francisco State University, and a Ph.D. in Biochemistry from the University of Tennessee in Knoxville. He previously served as a formulation chemist at Dow Dermatology, and has a long list of papers he has published.

## EDITOR'S FORUM (CON'T.)

2. According to our patent legislation, a patent is personal property, like any other personal property.
3. A patent does not grant the positive right to make, use and sell the patented invention but merely the negative right to prevent others from making, using and selling such an invention.
4. There are almost always alternatives available to the public — prior art alternatives, alternatives that are obvious and hence not patentable and alternatives provided by improvement inventions.
5. The patent right or property is too severely restricted in terms of duration and scope and patent misuse law, to be considered a monopoly.

And, very importantly, didn't our Justice Department and Federal Trade Commission profess up front in their joint 1995 "Antitrust Guidelines for the Licensing of Intellectual Property" that 1) "intellectual property (is) comparable to any other form of property", 2) there is no presumption that "intellectual property creates market power" and 3) "intellectual property licensing ... is gener-

ally pro-competitive"? What an 180-degree turn when contrasted to Justice's prior hostility to patents, culminating in their philosophy that a patent conferred monopoly power as a matter of conclusive presumption and at least nine common licensing restrictions ("nine no-no's") were per se illegal!

In light of Judge Markey's persuasive argumentation and the Justice Department/Federal Trade Commission's surprising about-face, isn't it high time that we stopped using the term "patent monopoly", especially because of its extremely negative connotation that inventors and innovators are reprehensible monopolists rather than public benefactors par excellence.

*Karl F. Jorda, Editor  
David Rines Professor of Intellectual Property Law and  
Industrial Innovation and Director, Kenneth J.  
Germeshausen Center for the Law of Innovation and  
Entrepreneurship*

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## Kudos!

### GILES RICH MOOT COURT COMPETITION

Congratulations to Dan Cahoy and Jim Calkins for their winning performance in the 1997 GSR Moot Court Competition. The GSR Moot Court Competition, named after the Honorable Judge Rich of the Court of Appeals for the Federal Circuit, is an intellectual property competition among all participating law schools. Even though the team lost in the primary round of competition to Suffolk University Law School, they managed to impress the final judges with both their briefs and oral arguments, bringing the victory back to FPLC. This achievement came in the same year that *U.S. News & World Report* ranked FPLC as having the best intellectual property program in the U.S.

Both Dan and Jim will be graduating this May, to begin exciting law careers. Great job Dan and Jim!



*(left to right) Dan Cahoy, Professor Chris Blank, Jim Calkins, and Judge Giles S. Rich.*

### HEALTH LAW MOOT COURT COMPETITION

Congratulations to Cinde Warmington and Parker Potter, Jr. for winning the National Health Law Moot Court Competition in Illinois this past fall. In their race for first place, Cinde and Parker defeated 32 teams from various law schools, and despite the fact that they are only second year law students, they rose to the challenge.

Parker has a Ph.D. in anthropology from Brown University, and prior to attending law school, was a lecturer in social sciences at Plymouth State College. Cinde worked as a health care consultant to Special Deliveries, Inc., and was a former C.E.O. of Trinity Health Network in Fort Worth, Texas.

Way to go Cinde and Parker!

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