



# IP Mississippi



Intellectual Property News for the  
Higher Education Community of Mississippi

Volume 2, Issue 3    A Publication of the Mississippi Law Research Institute    October 2009

## Retired Professor Convicted of Passing US Secrets

A former University of Tennessee physics professor, J. Reece Roth, was sentenced to four year in prison for passing restricted research data to two graduate students, one from Iran and one from China.

The research, conducted under two United States Air Force contracts, related to the development of plasma guidance systems in aircraft. Roth was found guilty of eighteen criminal counts, including fraud, conspiracy, and violating the Arms Control Export Act.

## NCAA Being Sued by Players

A group of former college basketball and football players headed by Ed O'Bannon recently filed an antitrust lawsuit against the National Collegiate Athletic Association (NCAA) and the Collegiate Licensing Company (CLC). The former players allege that the NCAA and CLC improperly infringe on the players' rights to their own likenesses and images.

The lawsuit alleges that while the NCAA requires that college athletes follow strict rules and regulations to maintain their amateur status, the NCAA itself is allowed to profit from licensing the images and likenesses of college players to promote NCAA events. The O'Bannon lawsuit is just the most recent in a spate of new cases against the NCAA.

"IP Mississippi" is a publication of the Mississippi Law Research Institute designed to keep educators and administrators at Mississippi universities aware of current happenings in the world of intellectual property.

The Mississippi Law Research Institute is a division of the University of Mississippi School of Law. The IP Group is composed of two attorneys, William T. Wilkins and A. Meaghin Burke. For more information, please visit the website at <http://www.mlri.olemiss.edu>, or feel free to contact the IP Group at (662) 915-7775.

## Nokia Sues Apple over iPhone

Nokia has sued Apple, alleging that the iPhone violates ten Nokia-owned patents related to two wireless transmission standards: G.S.M. and U.M.T.S. The patents at issue were created through a large-scale consortium.

Typically, handset manufacturers that were not part of the consortium pay royalties for the use of G.S.M.-related technologies. Nokia asserts that it spent approximately \$60 billion to develop the technology.

### INSIDE THIS ISSUE

- 1 Retired Professor Convicted of Passing US Secrets
- 1 NCAA Being Sued by Players
- 1 Nokia Sues Apple over iPhone
- 2 IP News of Note
- 2 Status of Google Book Settlement
- 3 Article: An Introduction to Trademarks

## IP News of Note

- Over forty amicus briefs have been filed on behalf of Bilski in the case Bilski v. Kappos, the follow-up to In Re Bilski, in which the Federal Circuit Court of Appeals held that the “machine or transformation” test is the exclusive test to determine subject matter patentability. Bilski appealed the Federal Circuit decision to the United States Supreme Court, arguing that the new test artificially limits the amount of protection available to business methods.
- In Blackwell Publishing Group, Inc. v. Excel Research Group, LLC, a copy shop was found liable for direct infringement of copyrights after accepting coursepacks from university professors, lending the coursepacks to students upon request, and providing copy machines for the students to copy the coursepacks. This case, out of the Eastern District of Michigan, establishes a novel and potentially problematic theory of direct liability.
- The Pennsylvania Trademark Counterfeiting Act was recently overturned by the Pennsylvania Supreme Court for being unconstitutionally overbroad. The Counterfeiting Act prohibited the knowing use, display, or sale of any items with a counterfeit trademark. The Pennsylvania Supreme Court held that the statute effectively prohibited any use of a trademark, including constitutionally protected uses.
- In August, David Kappos was confirmed as Under Secretary for Intellectual Property and Director of the United States Patent and Trademark Office.

## Status of Google Book Settlement

A new hearing date has been set in the Google Book Settlement. The hearing was originally set for October 7, but has been moved back to November 9 in order to allow more time to process the objections that have been raised against the proposed settlement. The settlement flows out of litigation between Google, who intends to create a digital library of thousands of out-of-print books, and a class of authors and publishers who initially decried Google’s actions as impermissible infringements of copyright. Google maintains that the digital archives will create an invaluable repository of hard-to-find books and allow millions of authors to earn royalties from digital versions of their books. Critics, such as the American Society of Journalists and Authors and Microsoft, argue that Google will be establishing an impermissible monopoly of information.

The case took an interesting turn on September 18, when the United States Department of Justice filed a Statement of Interest asserting that the proposed agreement might, as written, violate antitrust law. The federal judge overseeing the case, Judge Denny Chin, will consider the \$125 million proposed settlement in light of the opposition filings and the public policy implicated by such a large settlement. Judge Chin can either approve the settlement or strike it down. If he strikes it down, he will have the option to provide guidance to the parties on how to create an acceptable settlement.

## AN INTRODUCTION TO TRADEMARK LAW

### **What is a trademark?**

A trademark is a distinctive symbol that an organization attaches to its products to differentiate those products from other organizations' products. A trademark can be composed of words or images or both. Nike's "swoosh" is a famous trademark that allows Nike to set its products apart from its competitors.

Not all marks are designed to differentiate products, however. A service mark is a word or image that differentiates one service provider from another. Service marks are treated identically to trademarks under the law and the same rights and responsibilities attach to the owner of a service mark as to the owner of a trademark.

Ultimately, a trademark or service mark allows an organization to "brand" an item or service. Consumers are therefore protected from confusion by allowing them to clearly identify the source of a product.

### **What rights do you have when you have a trademark?**

At the very least, having a trademark gives you the right to prevent others from using your mark if their use is likely to cause confusion. This right to prevent confusion arises simply through the use of a mark in commerce or the registration of the mark with the appropriate state agencies. Many people choose to expand their trademark rights, however, by registering their mark with the United States Patent and Trademark Office. By registering a mark with the USPTO, the owner of a mark can expand the geographical region of his mark and can file federal lawsuits to keep others from infringing on his mark. Federal registration also gives the owner an edge in court proceedings by changing the burden of proof and burden of production in some instances.

Owners of famous marks have another right. They can prevent others from using marks that would dilute the impact of the original mark, even if there is no likelihood of confusion between the two similar marks.

### **How do you acquire trademark rights?**

Trademark rights arise in the owner of a mark as soon as the mark is used in commerce. No special registration is necessary to gain basic rights in the mark. But as mentioned above, many mark owners choose to register their marks with the USPTO in order to increase their rights and protection.

In order to secure federal registration, a trademark application must be filed with the USPTO. The application can be filed online at the USPTO website, <http://uspto.gov>, or can be done with a paper form. Once submitted, the application is either rejected or granted. If rejected, an appeals process is available. If granted, the mark is published for public opposition. Once all the necessary steps are completed, the mark will be registered on the appropriate federal register.

Some words or symbols are not candidates for trademark registration. For example, a mark will be rejected if it is scandalous, is primarily merely a surname, or is simply a generic term.

### **What responsibilities do you have when you have a trademark?**

Trademarks can last forever. In order to keep a trademark, though, the owner must protect his mark in several ways. For example, a mark owner must continue to use his mark in commerce in order to keep it. An owner must also keep an eye out for other marks being used in commerce that are likely to cause consumer confusion. A trademark owner should also pay attention to new trademark applications when they are published online at the USPTO website.

A notice is a small notation that a mark owner can include with his trademarks to broadcast the fact that rights to the mark are being claimed. Any mark can be protected with the <sup>TM</sup> symbol. Only marks registered on the federal register can be protected with a ® symbol. Mark owners are not required by law to include a notice when they use their marks. Including the notice symbols, however, is probably a good idea because it lets others know that the mark is being claimed and it may help maintain the mark's distinctiveness.