Intellectual Property in Georgia

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I. INTRODUCTION

This Article surveys case law developments in Georgia in the area of intellectual property including patents, copyrights, and trademarks from June 1, 1999 to May 31, 2000. The authors have not attempted to include all cases that touch upon intellectual property but instead have selected decisions that are more significant or interesting.

Intellectual property law comprises several discrete yet overlapping areas of law. The three primary areas are patent, trademark, and copyright law. Secondary areas include trade secret, trade dress, and know-how. Patent and copyright law are provided for in the United States Constitution. Thus, the cases regarding these two areas are based on federal law and are gleaned from the federal courts. Trademark law has both federal and state aspects; thus, the cases regarding this area are based on federal or state law, or both, and are gleaned from the federal courts and Georgia state courts.

1. The Constitution provides that Congress shall have power "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8, cl. 8. Authors/Writings refers to copyright, and Inventors/Discoveries refers to patent.

2. The Commerce Clause, which forms the constitutional basis for federal trademark and unfair competition legislation, provides that Congress shall have power "[t]o regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes." U.S. CONST. art. I, § 8, cl. 3.
II. PATENT CASES

The Georgia Court of Appeals opinion in *Bell v. Sasser*\(^3\) arose following the sale of stock of a closely held corporation by the president of the competing corporation. The closely held corporation brought action against the seller and the competing corporation, alleging, inter alia, that the seller and the competing corporation conspired to drive the closely held corporation out of business. The seller of stock in the closely held corporation was the president of the competing corporation. The superior court denied the seller's and the competing corporation's motion for summary judgment on the conspiracy claim, and all parties appealed.\(^4\) The Georgia Court of Appeals held a competing corporation's threats to file a patent infringement suit against a closely held corporation did not establish a prima facie case of conspiracy to drive the closely held corporation out of business, absent a showing that the president of the competing corporation participated in sending the letters or that the threats were made in bad faith.\(^5\)

In *Nelson v. Adams*,\(^6\) the Supreme Court held judicial speculation that the sole shareholder was liable for plaintiff's attorney fees did not justify adding the sole shareholder as a party after the judgment was entered.\(^7\) The Court reasoned this action violated the shareholder's due process rights as reflected in Rule 15 and Rule 12(a)(1) of the Federal Rules of Civil Procedure.\(^8\)

After dismissal of plaintiff licensee's patent infringement suit and the grant of attorney fees and costs for defendants, defendants moved to amend their third-party complaint to add plaintiff licensee's sole shareholder as a third-party defendant and also amend the judgment. This amendment subjected the sole shareholder to individual liability for these fees.\(^9\) The Supreme Court held an amended judgment that imposes liability simultaneously with an amendment of the pleadings violates Rule 15 and due process.\(^10\) Furthermore, the Court held plaintiff did not waive his due process rights.\(^11\) The Court stressed that Congress had specifically promulgated the Federal Rules of Civil

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4. *Id.* at 843-44, 852-53, 520 S.E.2d at 290, 296.
5. *Id.* at 852-53, 520 S.E.2d at 296.
7. *Id.* at 1587.
8. *Id.* at 1581-82.
9. *Id.* at 1582.
10. *Id.* at 1584-85.
11. *Id.* at 1586.
Procedure to ensure due process, and because Rule 15 specifically gave a ten day period for a party to respond to being joined, the imposition of a final judgment before this time violated the Due Process Clause.\textsuperscript{12}

In \textit{Mackay v. Commissioner of Patents & Trademarks},\textsuperscript{13} the Supreme Court denied a petition for writ of certiorari after the Federal Circuit affirmed the district court's holding that it lacked jurisdiction for hearing either a Federal Torts Claims Act ("FTCA")\textsuperscript{14} or an Administrative Procedures Act ("APA")\textsuperscript{15} claim.\textsuperscript{16} On October 30, 1996, Mackay filed a patent application with the United States Patent and Trademark Office ("PTO"). On January 17, 1997, the PTO notified Mackay his patent application was incomplete and could not be accorded a filing date. Mackay did not submit the required materials in the time allowed by the PTO; therefore, the PTO terminated his patent application.\textsuperscript{17}

On January 18, 1998, Mackay filed a complaint in the district court seeking relief of $2 billion because the PTO "willfully negated the patent."\textsuperscript{18} The district court assumed Mackay was seeking relief under either the FTCA or the APA, and concluded it had no jurisdiction to hear the claims. Mackay appealed the district court's dismissal of his case to the United States Court of Appeals for the District of Columbia ("the D.C. Circuit"). The D.C. Circuit transferred the case to the Federal Circuit because the Federal Circuit has exclusive jurisdiction to hear claims relating to practice before the PTO.\textsuperscript{19}

The district court stated that jurisdiction could not be found for an FTCA claim because Mackay did not allege that he exhausted his administrative remedies before filing his action in the district court.\textsuperscript{20} Mackay indicated in his complaint that he discussed his patent application with an examiner at the PTO. He made no allegation that he exhausted the appropriate administrative remedies available to him, such as filing a petition with the Commissioner of Patents and Trademarks to contest the PTO's failure to assign a priority date pursuant to 37 C.F.R. § 1.53(e)(2).\textsuperscript{21} Thus, because Mackay did not pursue administrative remedies before filing his complaint in the district court, the

\textsuperscript{12} Id.
\textsuperscript{13} 120 S. Ct. 1438, ___ U.S. ___ (2000).
\textsuperscript{17} Id. at *1.
\textsuperscript{18} Id. at *2.
\textsuperscript{19} Id. at *1.
\textsuperscript{20} Id.
\textsuperscript{21} Id.
The district court had no jurisdiction under the FTCA. Similarly, the district court did not have jurisdiction to hear Mackay's claim for monetary damages under the APA. The APA waives the sovereign immunity of the United States only for "[a]n action in a court of the United States seeking relief other than monetary damages." Therefore, Mackay's request for monetary damages in the amount of $2 billion precluded the district court from granting the relief he sought under the APA.

In College Savings Bank v. Florida Prepaid Postsecondary Education Expense Board, the Supreme Court held state infringement of a patent, though interfering with a patent owner's right to exclude others, may neither be remedied pursuant to authority under the Patent Clause nor preventively remedied under the Due Process Clause. In College Savings Bank, the patent owner brought an action against a Florida agency, alleging infringement of a patented apparatus and method for administering a college investment program. The United States intervened to defend the constitutionality of the statute. The trial court denied the state agency's motion to dismiss for lack of subject matter jurisdiction, and the agency appealed. The Federal Circuit affirmed, and the Supreme Court granted certiorari. Chief Justice Rehnquist wrote the opinion for the Court.

The Court emphasized that the sovereign immunity guaranteed under the Eleventh Amendment to the Constitution barred suits against defendant states and that this immunity could be abrogated pursuant to the Due Process Clause. However, the Court recognized that appropriate legislation pursuant to authority from the Fourteenth Amendment to the Constitution may be used to abrogate the Eleventh Amendment only where the State provides no remedy, or only inadequate remedies, to injured patent owners for the State's infringement of a patent and hence may be a deprivation of property without due process.

22. Id. at *3.
23. Id.
26. Id. at 643.
27. Id. at 631.
29. 527 U.S. at 630.
30. Id. at 637 (citing Seminole Tribe v. Florida, 517 U.S. 44, 59 (1964)).
31. Id. at 643.
A determination of whether a Congressional act validly abrogates states' sovereign immunity generally requires consideration of two questions: "whether Congress has 'unequivocally expressed its intent to abrogate the immunity,' . . . and second, whether Congress has acted 'pursuant to a valid exercise of power.'"\(^{32}\) The Patent and Plant Variety Protection Remedy Clarification Act ("Patent Remedy Act")\(^{33}\) clearly expresses Congress' intention to abrogate states' immunity from patent infringement claims.\(^{34}\) However, the Supreme Court reiterated that neither the Commerce Clause nor the Patent Clause provided Congress with the authority to abrogate state sovereign immunity from patent infringement claims.\(^{35}\)

Congress may pass legislation pursuant to the Fourteenth Amendment to the Constitution to abrogate sovereign immunity.\(^{36}\) However, in order for Congress to do so, "it must identify [states' conduct that transgresses] the Fourteenth Amendment's substantive provisions, and must tailor its legislative scheme to remedying or preventing such conduct."\(^{37}\) In analyzing whether the Patent Remedy Act was appropriate, the Court in *College Savings Bank* found the conduct Congress intended to remedy was "state infringement of patents and the use of sovereign immunity to deny patent owners compensation for the invasion of the patent rights."\(^{38}\)

Although appropriate legislation pursuant to the Enforcement Clause of the Fourteenth Amendment can abrogate state sovereignty, the propriety of any such legislation "'must be judged with reference to the historical experience . . . it reflects.'"\(^{39}\) Patents are considered "property" of which no person may be deprived by a state without due process of law.\(^{40}\) Hence, Congress can stop state patent infringement if there is a pattern or a history of state infringement. The Supreme Court in *College Savings Bank* found Congress enacted the Patent Remedy Act absent a showing of any patterns of state patent infringement.\(^{41}\) The Court added that "only where the State provides no remedy, or only inadequate remedies, to injured patent owners for [the State's] infringe-
ment... [can] a deprivation of property without due process result."\textsuperscript{42} It also noted that with regard to the Patent Remedy Act, Congress had "barely considered" available remedies for patent infringement claims against a state.\textsuperscript{43}

In *Dickinson v. Zurko*,\textsuperscript{44} the Supreme Court held the APA's standards govern the judicial review of findings of fact made by federal administrative agencies and apply when the Federal Circuit reviews findings of fact made by the PTO.\textsuperscript{46} The Court stressed that Congress intended uniform review of administrative agencies and did not exempt the PTO.\textsuperscript{46} The Federal Circuit's use of a "clearly erroneous" standard when reviewing findings of fact made by the PTO was not considered an "additional requirement" under an APA provision creating an exception for "additional requirements... recognized by law," as required for an application of the "clearly erroneous" standard rather than the APA's "substantial evidence" standard.\textsuperscript{47} The Supreme Court held that to show such "additional requirements," more than a possibility of a heightened standard and more than a preponderance of evidence must be shown.\textsuperscript{48} The "[e]xistence of the additional requirement must be clear."\textsuperscript{49}

In *Zurko* the patent applicant appealed a decision of the Patent Office Board of Patent Appeals and Interferences ("BPAI") rejecting the patent application. The Federal Circuit reversed the BPAI's decision on the original submission and also during an en banc rehearing. The court analyzed the PTO's factual findings using a "clearly erroneous" standard of review rather than the APA's less stringent standards, which permit a court to set aside an agency's findings of fact found to be arbitrary, capricious, (i.e., abuse of discretion), or unsupported by substantial evidence.\textsuperscript{50} However, the Supreme Court granted certiorari and applied the APA's standards to judicial review of the PTO's factfindings.

The APA requires a "meaningful review."\textsuperscript{51} This review of agency fact-finding is stricter than what Congress believed some courts

\textsuperscript{42} Id. at 643 (citing Parratt v. Taylor, 451 U.S. 527, 539-41 (1981)).
\textsuperscript{43} Id.
\textsuperscript{44} 527 U.S. 150 (1999).
\textsuperscript{45} Id. at 152.
\textsuperscript{46} Id. at 154.
\textsuperscript{47} Id.
\textsuperscript{48} Id. at 154-55.
\textsuperscript{49} Id. at 155.
\textsuperscript{50} Id. at 153. The "clearly erroneous" standard is considered a "court/agency review," requiring a court to ask whether a reasonable mind might accept a particular evidentiary record as adequate to support a conclusion. Id. at 161-62.
\textsuperscript{51} Id. at 162.
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previously conducted. Therefore, a court must review an agency’s reasoning “to determine whether it is ‘arbitrary’ or ‘capricious,’ or, if bound up with a record-based factual conclusion, to determine whether it is supported by ‘substantial evidence.’” The Supreme Court did not accept the argument that the standard of review will differ depending on which of the two paths the applicant chose for review: “clearly erroneous” from a district court or the APA standard from the PTO. However, the Court stated that nothing in the opinion prevents the Federal Circuit from adjusting review standards when necessary. After Zurko, it is clear that there is less review of the PTO’s factual findings.

In Brasseler U.S.A. v. Stryker Sales Corp., the United States District Court for the Southern District of Georgia held that a patent applicant’s failure to disclose information relating to a sale to the PTO that would have barred the patent issuance was inequitable conduct warranting an award of attorney fees to the prevailing defendant. The district court found inequitable conduct although the undisclosed material information may have been legitimately overlooked during a rush filing by the applicant’s counsel. Once counsel filed the rush application, the counsel’s failure to investigate and disclose the sale information was considered to be inequitable conduct. The district court considered counsel’s argument that reasonable counsel might differ on what constitutes a sale irrelevant because counsel did not know of the sale; therefore, no subjective good faith judgment was found.

The district court has discretion to award attorney fees to a prevailing party in exceptional patent cases and may consider its familiarity with the matter in litigation as well as the interests of justice. For example, a patentee may be considered to have engaged in inequitable conduct for purpose of awarding attorney fees by failing to disclose material facts to the PTO that might otherwise preclude issuance of the patent. In Brasseler, the prevailing defendant, having established by clear and convincing evidence that the patentee’s failure to disclose material information to the PTO was inequitable conduct, was entitled to recover fees spent litigating both the defense on which it prevailed and the

52. Id.
53. Id. at 164.
54. Id.
55. Id.
57. Id. at 1257-58.
58. Id. at 1262.
59. Id. at 1257-58.
alternative defenses if they were not legally frivolous.\textsuperscript{60} The district court did not challenge the amount of attorney fees requested by the prevailing party because it was not challenged on appeal.\textsuperscript{61}

In \textit{Maxwell Chase Technologies, L.L.C. v. KMB Produce, Inc.},\textsuperscript{62} the United States District Court for the Northern District of Georgia held that under a “stream of commerce” theory, an Alabama manufacturer's sale of absorbent pads to a third party, who it knew would use the pads to package tomatoes sold in Georgia, subjected the manufacturer to the personal jurisdiction of the federal court sitting in Georgia.\textsuperscript{63}

In cases like this the plaintiff bears the burden of establishing personal jurisdiction over a defendant and may establish a prima facie case of personal jurisdiction by presenting sufficient evidence to withstand a motion for directed verdict.\textsuperscript{64} The Federal Circuit has been granted original jurisdiction over any appeals arising under the United States patent laws; therefore, “[i]n analyzing the issue of personal jurisdiction over a defendant accused of patent infringement, a district court must apply the law of the Federal Circuit rather than that of the regional circuit in which the case arises.”\textsuperscript{65} The court stated, “[D]espite this requirement, the same basic test utilized in the Eleventh Circuit for determining the existence of personal jurisdiction applies in the Federal Circuit.”\textsuperscript{66}

The Georgia long arm statute\textsuperscript{67} confers personal jurisdiction to the full extent permitted by the Due Process Clause.\textsuperscript{68} As in this case, “[w]here a state’s long arm statute confers personal jurisdiction to the limits of due process, the Court may pass over an analysis of the statute and exercise personal jurisdiction where the constitutional requirements are satisfied.”\textsuperscript{69} Generally, a party is subject to general jurisdiction in a forum when it has continuous and systematic contacts, and the party may be haled into court in that forum on any claim.\textsuperscript{70} If it cannot be established that the defendant has continuous and systematic contacts with the forum, a defendant may be subject to specific jurisdiction in that forum when: (1) it has purposefully established minimum contacts

\begin{itemize}
\item[60.] \textit{Id.} at 1264-65.
\item[61.] \textit{Id.} at 1265.
\item[63.] \textit{Id.} at 1371.
\item[64.] \textit{Id.} at 1366-67.
\item[65.] \textit{Id.} at 1367.
\item[66.] \textit{Id.}
\item[68.] 79 F. Supp. 2d at 1367.
\item[69.] \textit{Id.}
\item[70.] \textit{Id.} at 1368.
\end{itemize}
with the forum state; and (2) an exercise of jurisdiction will not offend traditional notions of fair play and substantial justice.\footnote{Id.} In other words, a plaintiff’s cause of action must arise out of or relate to a defendant’s contacts with the forum state; the contacts must show the defendant purposefully conducted activities within the forum state and invoked the benefits and protections of the forum state’s laws; and the defendant’s contacts with the forum state must demonstrate the defendant should have reasonably anticipated being haled into court in the forum state.\footnote{Id.}

In Maxwell the district court held that for purposes of this patent infringement action, the Alabama manufacturer’s single sale of absorbent pads to a Georgia buyer was sufficient to subject the manufacturer to specific personal jurisdiction of the federal court within Georgia.\footnote{Id. at 1373.} Further, subjecting the manufacturer to the specific personal jurisdiction of the federal court was held to be consistent with notions of fair play and substantial justice.\footnote{Id.} The burden on defendant in being required to defend the claim in a neighboring state was held to be slight, and plaintiff was found to have a clear interest in obtaining convenient and effective relief in its home forum.\footnote{Id. at 1334-35.}

III. TRADEMARK CASES

In Frehling Enterprises v. International Select Group, Inc.,\footnote{192 F.3d 1330 (11th Cir. 1999).} the Eleventh Circuit held that for purpose of a service mark infringement action, the seller of decorative accessories and furniture under the “OGGETTI” service mark created a likelihood of confusion resulting from use of the “BELL’ OGGETTI” trademark by the seller of ready-to-assemble furniture for housing electronic equipment.\footnote{Id. at 1342.} Plaintiff brought an action alleging its “OGGETTI” service mark was infringed and diluted by defendant’s use of “BELL’ OGGETTI.”\footnote{Id. at 1334.} Following a bench trial, the district court ruled in favor of defendant, and plaintiff appealed to the Eleventh Circuit.\footnote{Id. at 1334-35.}

The Eleventh Circuit set out the well-known test for a plaintiff to prevail in an infringement action under the Lanham Act: (1) that its
mark has priority; and (2) that the defendant's mark is likely to cause consumer confusion. The Eleventh Circuit then set out the factors used in assessing whether a likelihood of consumer confusion exists in an infringement action under the Lanham Act: (1) type of mark; (2) similarity of mark; (3) similarity of the products; (4) similarity of the parties’ retail outlets, trade channels, and customers; (5) similarity of advertising media; (6) defendant's intent; and (7) actual confusion. Of these factors, the Eleventh Circuit held the type of mark and the evidence of actual confusion were most important in this case, and the findings as to each factor, and as to the ultimate conclusion regarding whether a likelihood of confusion existed, are subject to the clearly erroneous standard of review. The mere fact that plaintiff's mark was a service mark relating to selling furniture and defendant's mark was a trademark relating to actual furniture goods did not affect the analysis of the likelihood of confusion in an infringement action.

First, the Eleventh Circuit considered the strength of plaintiff's mark. The stronger a mark, the greater the scope of protection accorded it. The court noted four categories of trademarks: (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary. "Generic" marks refer to a class of goods or services. They are weakest and not entitled to protection. "Descriptive" marks describe a characteristic or quality of the goods or services. "Suggestive" marks suggest characteristics of the goods or services and require an effort of the imagination by the consumer to be understood as descriptive. "Arbitrary" marks are words or phrases that bear no relationship to the goods or services and are the strongest of the four categories.

As part of this analysis, the Eleventh Circuit considered the degree to which third parties make use of a mark. The less that third parties use the mark, other than as a trademark or service mark, the stronger it is and the more protection it deserves. Further, if the mark has been registered for five years with the PTO, its holder has filed the required affidavit with the PTO, and the PTO accordingly has declared the mark "incontestable," then the mark's incontestability serves to

80. Id. at 1335.
82. 192 F.3d at 1335.
83. Id.
84. Id. at 1334 n.3.
85. Id. at 1335-37.
86. Id. at 1335.
87. Id. at 1335-36.
88. Id. at 1336.
89. Id.
enhance its strength.\textsuperscript{90} The Eleventh Circuit also considered the
“doctrine of foreign equivalents,” under which a foreign word that is
commonly used in that language as the generic name of a product cannot
be imported into the United States and transformed into a valid
trademark.\textsuperscript{91} However, the Eleventh Circuit found the doctrine of
foreign equivalents was inapplicable in this case because it agreed with
the district court that the mark was at least suggestive.\textsuperscript{92}

Second, the Eleventh Circuit compared the marks and considered the
impressions that the marks create, including the sound, appearance, and
manner in which they are used.\textsuperscript{93} For the purpose of assessing the
similarity of plaintiff’s “OGGETTI” mark to defendant’s “BELL’
OGGETTI” mark in order to determine a likelihood of confusion,
plaintiff’s use of the words “Tavola Collection” in connection with its
“OGGETTI” mark was found not to have undermined the attribution of
the source of defendant’s products to “OGGETTI.”\textsuperscript{94} To the contrary,
the Eleventh Circuit decided the words merely suggested they represent-
ed a single product line or signature collection of “OGGETTI.”\textsuperscript{95} As
part of this analysis, the Eleventh Circuit stated that a service mark
“may be surrounded by additional words of lesser importance and not
have its strength diluted.”\textsuperscript{96}

Third, the Eleventh Circuit looked at similarity between the goods and
services, which required a “determination as to whether the products
and services are the kind that the public attributes to a single source,
not whether the purchasing public can readily distinguish between the
products of the respective parties.”\textsuperscript{97} The Eleventh Circuit could not
conclude this factor favored a particular party; therefore, the court
concluded the district court erred in this respect.\textsuperscript{98}

Fourth, the Eleventh Circuit looked at the similarity of the parties’
retail outlets or trade channels and the parties’ customers, taking into
consideration where, how, and to whom the parties’ products are
sold.\textsuperscript{99} Although direct competition between the parties is not required for this
factor to support a likelihood of confusion, evidence that the products
and services are provided in the same stores is certainly strong evidence

\textsuperscript{90} Id.
\textsuperscript{91} Id. at 1336 n.3.
\textsuperscript{92} Id.
\textsuperscript{93} Id. at 1337.
\textsuperscript{94} Id.
\textsuperscript{95} Id.
\textsuperscript{96} Id.
\textsuperscript{97} Id. at 1338.
\textsuperscript{98} Id.
\textsuperscript{99} Id. at 1339.
favoring a likelihood of confusion. The court stated that differences
"between the retail outlets for and the predominant customers of
plaintiff's and defendant's goods lessen the possibility of confusion . . .
[however,] [t]he parties' outlets and customer bases need not be
identical" to support finding a likelihood of confusion. It is enough
that some degree of overlap be present. Although the Eleventh
Circuit could not determine which side this factor favored, the court
noted it was "troubled by the district court's methodology of dividing
the world up into distinct segments of 'affluent' and 'less affluent' for
the purpose of determining the balance of the instant factor."

Fifth, the Eleventh Circuit reviewed the advertising media used by the
parties. The Eleventh Circuit held that "the standard is whether
there is likely to be significant enough overlap in the readership of
the publications in which the parties advertise that a possibility of confusion
could result" and that the identity of periodicals is not required to show
parties use similar methods of advertising.

Sixth, the Eleventh Circuit addressed defendant's intent and held that
"if it can be shown that a defendant adopted a plaintiff's mark with the
intention of deriving a benefit from the plaintiff's business reputation,
this fact alone may be enough to justify the inference that there is
confusing similarity." The Eleventh Circuit concluded defendant
attempted to derive a benefit from "willful blindness" by not conducting
a registration search and the continued use of the mark was contrary to
their own counsel's advice.

Finally, the Eleventh Circuit looked for instances of actual confusion
by the consuming public between plaintiff's and defendant's goods. Although evidence of actual confusion is the best evidence of a likelihood
of confusion, the court noted such evidence is not a prerequisite. As
part of its analysis, the court held lack of survey evidence is not
dispositive as to whether a plaintiff has shown actual confusion.

When the court assessed all of these factors, consumers could possibly
attribute the parties' products to the same source despite their somewhat

100. Id.
101. Id.
102. Id.
103. Id.
104. Id. at 1339-40.
105. Id. at 1340.
106. Id.
107. Id.
108. Id. at 1340-41.
109. Id. at 1340.
110. Id. at 1341 n.5.
different composition, function, and design; therefore, the court reversed the district court's decision and found infringement by defendant.\textsuperscript{111}

In \textit{Wilhelm Pudenz, GmbH v. Littlefuse, Inc.},\textsuperscript{112} the Eleventh Circuit held that "registered trademarks that have become incontestable \ldots may still be declared invalid if they are found to protect the functional features of a product."\textsuperscript{113} The subsequent statutory amendment to the Lanham Act,\textsuperscript{114} which implemented the Trademark Law Treaty and explicitly added functionality as a defense, did not demonstrate prior Congressional intent to preclude this defense.\textsuperscript{115} Plaintiff, a foreign manufacturer of plug-in blade fuses for automobiles, brought an action against defendant competitor seeking a declaration that plaintiff's fuses did not infringe upon the registered trade dress of defendant's fuses. Defendant counterclaimed for trade dress infringement, unfair competition, and unlawful importation. The district court invalidated defendant's federally registered trademarks and denied defendant's counterclaims. Defendant appealed.\textsuperscript{116} The court of appeals held incontestable trademarks are subject to cancellation based on functionality.\textsuperscript{117}

The Lanham Act provides that incontestability of trademark narrows, but does not eliminate, the grounds upon which a defendant may call the trademark's validity into question.\textsuperscript{118} The court stated that the Lanham Act's "incontestability provisions allow a 'registrant to quiet title in the ownership of his mark. The opportunity to obtain incontestable status by satisfying the requirements \ldots thus encourages producers to cultivate the goodwill associated with a particular mark.'"\textsuperscript{119} The Eleventh Circuit chose not to apply the Fourth Circuit's rationale\textsuperscript{120} that functionality is not one of the grounds for invalidating an incontestable trademark and instead held that functionality is a basis for the cancellation of incontestable trademarks.\textsuperscript{121}

The court held that "[t]he applicability of the functionality doctrine to a trademark that is the subject of an incontestable registration is a question of law," which the court of appeals can review de novo.\textsuperscript{122}

\begin{footnotes}
\item[111] \textit{Id.} at 1342.
\item[112] 177 F.3d 1204 (11th Cir. 1999).
\item[113] \textit{Id.} at 1206.
\item[115] \textit{Id.} at 1210.
\item[116] \textit{Id.} at 1206.
\item[117] \textit{Id.} at 1206-07.
\item[118] \textit{Id.} at 1208.
\item[119] \textit{Id.} (quoting Park 'N Fly, Inc. v. Dollar Park & Fly, Inc., 469 U.S. 189, 198 (1985)).
\item[120] See Shakespeare Co. v. Silstar Corp., 9 F.3d 1091 (4th Cir. 1993).
\item[121] 177 F.3d at 1209.
\item[122] \textit{Id.} at 1207 (citing McBride v. Sharpe, 25 F.3d 962, 968 (11th Cir. 1994)).
\end{footnotes}
Under the functionality doctrine, no trademark rights may be claimed in a product’s functional shapes or features, such as the shape of the automobile fuses. The proscription against granting trademark rights to a product’s functional shapes or features serves two purposes. First, it ensures “that competitors remain free to copy useful product features,” thereby preventing “the trademark law from undermining its own pro-competitive objectives. Second, the functionality doctrine prevents the trademark law from conflicting with the patent law by eliminating trademark monopolies of potentially unlimited duration on a product’s utilitarian features.”

In Pine Tree Publishing, Inc. v. Community Holdings, Inc., the Georgia Court of Appeals held the trial court could not open a default without first determining whether the final judgment could be set aside under the statute governing relief from judgment. After a finding of default, final judgment was entered in a trademark infringement case. The trial court granted defendant’s motion to open the default judgment. Plaintiff appealed. The court of appeals held the trial court could not open the default without first determining whether the final judgment could be set aside under the state statute governing relief from judgment.

In Macon-Bibb County Board of Tax Assessors v. J.C. Penney Co., the Georgia Court of Appeals upheld a jury’s determination of the fair market value of property that was significantly lower than the tax assessor’s determination. The board appealed. The court of appeals held that for the purposes of ad valorem taxation, the fair market value of personal property may be determined by the following: cost to the taxpayer, wholesale pricing in relation to the retail field, and intangibles such as trademark rights. The court further held that “the jury’s verdict [was] supported in part by the [expert’s] methodology that

123. Id.

124. Id. (citing Qualitex Co. v. Jacobson Products Co., 514 U.S. 159, 164 (1995)). By explicitly requiring that the inventor’s exclusive right as embodied in a granted patent must be of a limited duration, the Constitution’s Patent Clause “strikes a balance between the encouragement of innovation and the establishment of a public domain of freely available inventions to foster competition.” Id. (citing Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 146 (1989)).


126. Id. at 689-90.

127. Id. at 689.

128. Id. at 689-90.


130. Id. at 324-25, 521 S.E.2d at 236.

131. Id. at 324, 521 S.E.2d at 236.
reduced the end-of-calendar-year costs by such factors as obsolescence and intangible, nontransferable trademark rights.\footnote{132}

In *College Savings Bank v. Florida Prepaid Postsecondary Education Expense Board*,\footnote{133} the Supreme Court held Florida Prepaid did not implicitly nor constructively waive its Eleventh Amendment immunity from suit under the Lanham Act by selling and advertising a for-profit educational investment vehicle in interstate commerce after being put on notice by the Trademark Remedy Clarification Act ("TRCA") that it would be subject to Lanham Act liability for doing so.\footnote{134} The Supreme Court held federal courts have no jurisdiction to entertain this type of suit because Florida Prepaid's sovereign immunity was neither validly abrogated by the TRCA nor voluntarily waived.\footnote{135} In *College Savings Bank*, petitioner (College Savings Bank) markets and sells certificates of deposit designed to finance college costs. When respondent (Florida Prepaid), a Florida state entity, began its own tuition prepayment program, petitioner filed suit, alleging respondent violated section 43 of the Lanham Act by misrepresenting its own program.\footnote{136} In granting respondent's motion to dismiss based on sovereign immunity, the district court rejected arguments that

under the constructive waiver doctrine of *Parden v. Terminal Railway of Alabama Docks Department*,\footnote{137} respondent waived its immunity by engaging in interstate marketing and administration of its program after the TRCA made clear that such activity would subject it to suit; and that Congress's abrogation of sovereign immunity in the TRCA was effective, since it was enacted to enforce the Fourteenth Amendment's Due Process Clause.\footnote{138}

The Third Circuit affirmed.\footnote{139} The Supreme Court granted certiorari. Overruling *Parden*, the Supreme Court held state sovereign immunity was neither validly abrogated by the TRCA nor voluntarily waived by the State's activities in interstate commerce.\footnote{140}

\footnote{132} Id.
\footnote{133} 527 U.S. 666 (1999).
\footnote{134} Id. at 680.
\footnote{135} Id. at 691.
\footnote{136} Id. at 670-71.
\footnote{137} 377 U.S. 184 (1964).
\footnote{138} 527 U.S. at 666.
\footnote{139} Id. at 672.
\footnote{140} Id.
\footnote{141} Id. at 680, 691.
The Court declared a state's immunity from suit can only be abrogated in two instances.\textsuperscript{142} First, Congress may authorize these suits while enforcing the Fourteenth Amendment.\textsuperscript{143} Second, the court noted that "a state may waive its sovereign immunity by consenting to a suit."\textsuperscript{144} However, the Supreme Court made it clear that Congress may not abrogate sovereign immunity through the Commerce Clause.\textsuperscript{145} The Supreme Court held neither the right to be free from a competitor's false advertising nor the right to be secure in one's business interests qualified as a "property right" protected by the Due Process Clause of the Fourteenth Amendment so as to authorize abrogation of immunity against claims under the Lanham Act section that affords a private right of action against any person who uses false descriptions or makes false representations in commerce.\textsuperscript{146}

A state's decision to waive Eleventh Amendment immunity is a voluntary sovereign act.\textsuperscript{147} Accordingly, the Supreme Court's test for determining whether a state has waived its immunity from federal jurisdiction is stringent.\textsuperscript{148} The Supreme Court will find a waiver of Eleventh Amendment immunity if a state either voluntarily invokes the Court's jurisdiction or makes a "clear declaration" that it intends to submit itself to the Court's jurisdiction.\textsuperscript{149} A state does not consent to a suit in federal court merely by consenting to a suit in its own courts or by stating its intention to "sue and be sued," or by authorizing suits against it "in any court of competent jurisdiction."\textsuperscript{150} In overruling \textit{Parden}, the Supreme Court held courts should make every reasonable presumption against a waiver of Eleventh Amendment immunity and that waivers are not implied.\textsuperscript{151} The constitutional principle of state sovereign immunity "is any less robust where the asserted basis for constructive waiver is conduct that the state realistically could choose to

\begin{itemize}
  \item \textsuperscript{142} \textit{Id.} at 670. The court stated that the Fourteenth Amendment was enacted after the Eleventh Amendment and was "specifically designed to alter the federal-state balance."
  \item \textit{Id.}
  \item \textit{Id.}
  \item \textit{Id.} at 672.
  \item \textit{Id.} (referring to 15 U.S.C. §§ 1051 to 1127 (1994 & Supp. 1998)).
  \item \textit{Id.} at 675 (quoting \textit{Beers v. Arkansas}, 61 U.S. 527, 529 (1858)).
  \item \textit{Id.} (quoting \textit{Atascadero State Hosp. v. Scanlon}, 473 U.S. 234, 241 (1985)).
  \item \textit{Id.} at 675-76 (citing \textit{Gunter v. Atlantic Coast Line R. Co.}, 200 U.S. 273, 284 (1906); \textit{Great Northern Life Ins. Co. v. Read}, 322 U.S. 47, 54 (1944)).
  \item \textit{Id.} at 676 (citing \textit{Smith v. Reeves}, 178 U.S. 436, 441-45 (1900); \textit{Florida Dept of Health & Rehabilitation Servs. v. Florida Nursing Home Ass'n}, 450 U.S. 147, 149-50 (1981); \textit{Kenecott Copper Corp. v. State Tax Comm'n}, 327 U.S. 573, 577-79 (1946)).
  \item \textit{Id.} at 682 (quoting \textit{Aetna Ins. Co. v. Kennedy ex rel. Bogash}, 301 U.S. 389, 393 (1937)).
\end{itemize}
abandon, that is undertaken for profit, that is traditionally performed by private citizens and corporations, and that otherwise resembles the behavior of market participants."\textsuperscript{162}

It is well established that an individual may sue a state when Congress has authorized this type of suit through its power to enforce the Fourteenth Amendment\textsuperscript{153} or when a state has waived its sovereign immunity by consenting to suit.\textsuperscript{154} The TRCA subjects states to suits brought under Section 43(a) of the Lanham Act for false and misleading advertising. However, the Supreme Court held the TRCA did not abrogate Florida's sovereign immunity, notwithstanding the clear language in the Lanham Act notifying states of the possibility of suits.\textsuperscript{155} Although Congress may legislate under Section 5 of the Fourteenth Amendment to enforce the Amendment's other provisions, the object of the legislation must be to remedy or prevent constitutional violations.\textsuperscript{156} Therefore, the Supreme Court rejected petitioner's argument that Congress enacted the TRCA to remedy and prevent state deprivations of two property interests without due process.\textsuperscript{157}

In \textit{Leigh v. Warner Bros.},\textsuperscript{158} the Eleventh Circuit held a photographer was not entitled to trademark protection when there was no sufficient evidence showing that the photographer had trademark rights in a photograph prior to the release of a movie.\textsuperscript{159} The photograph at issue was the now-famous photograph appearing on the cover of the novel \textit{Midnight in the Garden of Good and Evil}.\textsuperscript{160} The court held the photograph was used in various art gallery and museum advertisements as an example of the photographer's available work rather than as a trademark.\textsuperscript{161}

Plaintiff photographer, who had been hired to take a photograph that would appear on the cover of the novel, brought suit against defendant motion picture company for its alleged copyright and trademark infringement.\textsuperscript{162} The district court granted summary judgment for defendant, and plaintiff appealed.\textsuperscript{163}

\begin{enumerate}
\item[152.] \textit{Id.} at 684.
\item[155.] 527 U.S. at 671-74.
\item[156.] \textit{Id.} at 672.
\item[157.] \textit{Id.}
\item[158.] 212 F.3d 1210 (11th Cir. 2000).
\item[159.] \textit{Id.} at 1217.
\item[160.] \textit{Id.} at 1212.
\item[161.] \textit{Id.} at 1218.
\item[162.] \textit{Id.} at 1213.
\item[163.] \textit{Id.} at 1214.
\end{enumerate}
The court in *Leigh* reiterated that the plaintiff, under the general rule for prevailing on claims of trademark infringement, has the burden of showing: (1) that the plaintiff had a valid trademark and (2) that the defendant had adopted an identical or similar mark so that consumers were likely to confuse the two. The court stated that for a trademark to exist, it must not only be descriptive, but it must also answer the question "Who made it?" rather than "What is it?" Further, to be infringed, the plaintiff's use of the mark must predate the defendant's use of its potentially confusing mark.

However, in *Leigh* the court held that even if plaintiff had trademark rights in the picture of the cemetery statue, defendant did not infringe upon plaintiff's rights by building its own replica of the statue to photograph and film. Specifically, the court noted plaintiff's picture was not altered or distorted and defendant never attributed its images of the copy of the statue to plaintiff.

In *Tooltrend, Inc. v. CMT Utensili*, the Eleventh Circuit held that under Florida law, defendant manufacturer was not unjustly enriched by plaintiff distributor's advertising and promotion of defendant's tools because plaintiff engaged in those activities with the objective of making a profit for itself, and not for defendant. Plaintiff brought an action against defendant alleging Lanham Act violations and unjust enrichment arising from defendant's use of certain trademarks after the parties' business relationship ended. After the jury entered a verdict in favor of the plaintiff for $1,741,993 on the unjust enrichment claim, the district court granted the manufacturer's motion for a judgment as a matter of law. Plaintiff appealed, and the Eleventh Circuit affirmed the district court's judgment that the manufacturer was not unjustly enriched by the distributor's advertising and promotion of defendant's tools.

Under Florida law, "a claim for unjust enrichment is an equitable claim, based on a legal fiction created by courts to imply a 'contract' as

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164. *Id.* at 1216.
165. *Id.* at 1216-17 (citing J. THOMAS McCARTHY, McCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3-6 (4th ed. 2000)).
166. *Id.* at 1217 (citing Tally-Ho, Inc. v. Coast Community College Dist., 889 F.2d 1018, 1022 (11th Cir. 1990)).
167. *Id.* at 1218-19.
168. *Id.*
169. 198 F.3d 802 (11th Cir. 1999).
170. *Id.* at 807.
171. *Id.* at 804-05.
172. *Id.* at 808.
a matter of law."\textsuperscript{173} Thus, although the parties may have never indicated in any way there was any agreement between them, the law creates a quasi-contract in situations in which it is deemed unjust for one party to have received a benefit without having to pay compensation for it.\textsuperscript{174} The court stated:

To succeed in a suit for unjust enrichment a plaintiff must prove that: (1) the plaintiff has conferred a benefit on the defendant, who has knowledge thereof; (2) the defendant has voluntarily accepted and retained the benefit conferred; and (3) the circumstances are such that it would be inequitable for the defendant to retain the benefit without paying the value thereof to the plaintiff.\textsuperscript{175}

In the present case, because the court determined plaintiff acted for its own benefit, defendant's use of certain trademarks did not create unjust enrichment and the district court's consideration of the distributor's expectation of compensation, in determining whether it would be unjust for the manufacturer to retain a benefit from use of the trademarks without having to pay for it, was proper.\textsuperscript{176}

In \textit{Carnival Brand Seafood Co. v. Carnival Brands, Inc.},\textsuperscript{177} the Eleventh Circuit held that

"a trademark owner cannot by the normal expansion of its business extend the use or registration of its mark to distinctly different goods or services not comprehended by its previous use . . . where the result could be a conflict with valuable intervening rights established by another through extensive use . . . of the same or similar mark for like or similar goods and services."\textsuperscript{178}

The court also observed that "[t]o prevail on a trademark infringement claim, a plaintiff must show that: (1) its mark has priority; and (2) the defendant's mark is likely to cause consumer confusion."\textsuperscript{179} In this case, plaintiff, owner of the "CARNIVAL" trademark for shrimp and other seafood products, brought an infringement action against a seller of Creole and Cajun food products that also bore the "CARNIVAL" mark. The district court granted summary judgment for defendant, and

\begin{itemize}
  \item \textsuperscript{173} \textit{Id.} at 805.
  \item \textsuperscript{174} \textit{Id.}
  \item \textsuperscript{175} \textit{Id.}
  \item \textsuperscript{176} \textit{Id.} at 807-08.
  \item \textsuperscript{177} 187 F.3d 1307 (11th Cir. 1999).
  \item \textsuperscript{178} \textit{Id.} at 1310-11 (quoting \textit{American Stock Exchange, Inc. v. American Express Co.}, 207 U.S.P.Q. 356, 364 (T.T.A.B. 1980)).
  \item \textsuperscript{179} \textit{Id.} at 1309.
\end{itemize}
plaintiff appealed. The Eleventh Circuit held the proper disposition of the case depended necessarily on the resolution of genuine issues of material fact regarding (1) "the likelihood of confusion of source, sponsorship, or affiliation with respect to the products and (2) whether defendant was the senior and priority user of the mark. The lower court's judgment, therefore, was vacated.

First, the court determined plaintiff had priority in the use of the mark in connection with the selling of raw shrimp products. "The senior user's rights may extend into uses in "related" product or service markets (termed the "related goods" doctrine)." However, the court held that genuine issues of material fact existed as to whether it would have been natural for plaintiff to expand its business into seafood and chicken gumbo and then into shrimp cakes, crawfish cakes, lobster cakes, and crab cakes. It could not be decided whether defendant's subsequent use of the "CARNIVAL" mark to sell those products created a likelihood of confusion until that determination was made.

Additionally, when using a likelihood of confusion test to analyze a trademark priority question by looking at whether a senior user's rights would naturally expand to a junior user's use of the mark, the court must consider the state of events that existed at the time the intervening use commenced. Because the district court had not made that determination, summary judgment in favor of plaintiff was reversed.

Second, the court found the trademark "CARNIVAL" would be an arbitrary mark as applied to raw shrimp because, although it is a word in common usage, it is being applied to goods unrelated to its meaning. Thus, if the district court determines plaintiff's natural zone of expansion includes defendant's products, plaintiff has a stronger case.

IV. COPYRIGHT CASES

In Leigh v. Warner Bros., the Eleventh Circuit declared copyright protection covers the "concrete elements of a photographer's craft" such as lighting, shading, timing, angle, and film; however, the court declined

180. Id.
181. Id. at 1315-16.
182. Id. at 1316.
183. Id. at 1309.
184. Id. at 1310 (quoting Talley-Ho, Inc., 889 F.2d at 1023).
185. Id. at 1316.
186. Id. at 1311.
187. Id. at 1316.
188. Id.
189. Id. at 1312.
190. 212 F.3d 1210 (11th Cir. 2000).
to "unwittingly extend[]" copyright protection to the photographer's choice of subject matter or to the "eerie," "spiritual" mood that was commonly associated with the subject matter.191 Plaintiff brought suit against defendant for its alleged copyright infringement. The district court granted summary judgment for defendant, and plaintiff appealed.192 The Eleventh Circuit held that: (1) the film did not infringe the photographer's copyright; and (2) a fact issue existed as to whether defendant's publicity photographs infringed the photographer's copyright.193

The Eleventh Circuit reiterated "that [t]o establish a claim of copyright infringement, a plaintiff must prove, first that he owns a valid copyright in a work and, second, that the defendant copied original elements of that work."194 A copyright infringement plaintiff "can prove copying either directly or indirectly, by establishing that the defendant had access, and produced something 'substantially similar' to the copyrighted work."195 The court stated that "n[o] matter how the copying is proved, the plaintiff must also establish specifically that the allegedly infringing work is substantially similar to the plaintiff's work with regard to its protected elements."196 Thus, even if a defendant attempts to appropriate a copyright owner's original expression, the defendant does not infringe unless the defendant's work is substantially similar to protected elements of the owner's work.

In Leigh, at issue were defendant's film sequences and publicity photographs featuring the cemetery statue that was central to the photograph.197 The district court held, and the Eleventh Circuit agreed, that the film sequences were not substantially similar to the copyrighted photograph of the statue and thus did not infringe, deciding that the only commonality between the film sequences and the photograph was the statue itself.198 However, the Eleventh Circuit disagreed with the district court's holding that the publicity photographs did not infringe upon the photographer's copyright.199 The court found

191. Id. at 1214-15.
192. Id. at 1213.
193. Id. at 1215-16.
194. Id. at 1214 (citing Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 361 (1991)).
195. Id. (quoting Original Appalachian Artworks, Inc. v. Toy Loft, Inc., 684 F.2d 821, 829 (11th Cir. 1982)).
196. Id. (citing Herzog v. Castle Rock Entertainment, 193 F.3d 1241, 1248, 1257 (11th Cir. 1999)).
197. Id. at 1213-14.
198. Id. at 1213.
199. Id. at 1216.
there was an issue of material fact as to whether the promotional photographs taken for the motion picture film were substantially similar to the copyrighted photograph of the statue. Thus, the court reversed the district court's grant of defendant's motion for summary judgment.

In *Mitek Holdings, Inc. v. Arce Engineering Co.*, the Eleventh Circuit held the touchstone of awarding attorney fees under the Copyright Act is whether imposition of attorney fees will further the interests of the Act. For example, attorney fees can be awarded if by doing so, the court would be "encouraging the raising of objectively reasonable claims and defenses, which may serve not only to deter infringement but also to ensure 'that the boundaries of copyright law [are] demarcated as clearly as possible' in order to maximize the public exposure to valuable works." After affirming defendant's judgment in the copyright infringement action, the district court awarded attorney fees to defendant, and plaintiff appealed to the Eleventh Circuit.

In general, when "reviewing a district court's decision to grant or deny [attorney] fees under the Copyright Act, [the Eleventh Circuit] first determine[s] whether 'the district court weighed the relevant factors and exercised its discretion.'" Plaintiff's good faith in bringing its suit was not determinative of the issue of attorney fees. If the district court weighed the proper factors, then the court of appeals "will not question the [district] court's decision to grant or deny [attorney] fees absent an abuse of that discretion." Some of the factors courts should consider in making awards of attorney fees to any prevailing party in a Copyright Act case include: "frivolousness, motivation, objective unreasonableness (both in the factual and in the legal components of the case) and the need in particular circumstances to advance considerations of compensation and deterrence."

In the present case, the district court erred in considering solely the financial means of the parties in determining plaintiff should be liable

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200. *Id.*
201. *Id.*
202. 198 F.3d 840 (11th Cir. 1999).
204. *Id.* at 843.
205. *Id.* at 842-43 (quoting *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 527 (1994)).
206. *Id.* at 841.
207. *Id.* at 842 (quoting *Montgomery v. Noga*, 168 F.3d 1282, 1303 (11th Cir. 1999)).
208. *Id.*
209. *Id.* (quoting *Montgomery*, 168 F.3d at 1303).
210. *Id.* (quoting *Fogerty*, 510 U.S. at 534 n.19).
for the prevailing defendant's attorney fees.\textsuperscript{211} "In determining whether to award attorney fees under [the Copyright Act], the district court should consider not whether the losing party can afford to pay the [attorney] fees but whether the imposition of fees will further the goals of the Copyright Act.\textsuperscript{212} For this reason, the case was remanded to the district court.\textsuperscript{213}

In \textit{Estate of Martin Luther King, Jr., Inc. v. CBS, Inc.},\textsuperscript{214} the Eleventh Circuit held that Dr. King's "I Have A Dream" speech to the Southern Christian Leadership Conference ("SCLC"), along with the fact the speech obtained live broadcasts on radio and television, did not alone constitute a general publication for copyright purposes.\textsuperscript{215} Thus, copyright protection was not precluded on the ground the speech was public domain.\textsuperscript{216} The estate of Martin Luther King, Jr. sued defendant television network (CBS), claiming use of the famous speech in a historical documentary was a copyright violation.\textsuperscript{217} The District Court for the Northern District of Georgia granted summary judgment in favor of defendant, holding as a matter of law that Dr. King's speech was a "general publication."\textsuperscript{218}

Under the 1909 Copyright Act, an author received state common law protection automatically at the time of creation of a work, and this protection persisted until the moment of general publication.\textsuperscript{219} When a general publication of the work occurred, the author forfeited his work to the public domain unless he had complied with federal statutory requirements, in which case he converted his common law copyright into a federal statutory copyright.\textsuperscript{220} Also under the 1909 Copyright Act, a "general publication," which divested a common law copyright, occurred when a work was made available to the public without regard to identity or what the public intended to do with the work.\textsuperscript{221} A "limited publication," which did not divest a common law copyright, was "one that communicated the contents of a work to a select group and for

\begin{itemize}
  \item \textsuperscript{211} \textit{Id.}
  \item \textsuperscript{212} \textit{Id.} at 843.
  \item \textsuperscript{213} \textit{Id.}
  \item \textsuperscript{214} 194 F.3d 1211 (11th Cir. 1999).
  \item \textsuperscript{215} \textit{Id.} at 1217.
  \item \textsuperscript{216} \textit{Id.} at 1213, 1216-17.
  \item \textsuperscript{217} \textit{Id.} at 1213.
  \item \textsuperscript{218} \textit{Id.} at 1213-14.
  \item \textsuperscript{219} \textit{Id.} at 1214 (citing \textsc{Melville R. Nimmer \& David Nimmer, Nimmer on Copyright § 4.01(B) 1 (1998); Silverman v. CBS, Inc., 632 F. Supp. 1344, 1353 (S.D.N.Y. 1986)}).
  \item \textsuperscript{220} \textit{Id.} (citing King v. Mister Maestro, 224 F. Supp. 101, 105 (S.D.N.Y. 1963)).
  \item \textsuperscript{221} \textit{Id.} at 1215.
\end{itemize}
a limited purpose, and without the right of diffusion, reproduction, distribution or sale.\textsuperscript{222}

The court discussed a general publication in detail, holding a general publication occurs, for copyright purposes, "if tangible copies of the work are distributed to the general public in such a manner as allows the general public to exercise dominion and control over the work."\textsuperscript{223} A general publication also may "occur if the work is exhibited or displayed in such a manner as to permit unrestricted copying by the general public."\textsuperscript{224} However, a performance is not considered a general publication, no matter what the size of the audience is or to what extent the performance receives radio and television coverage.\textsuperscript{225} Case law also supports the notion that distribution of a work to the media for new purposes constitutes merely "limited publication."\textsuperscript{226} Thus, the Eleventh Circuit reversed the district court's grant of summary judgment and remanded the case to determine whether Dr. King's oration was a general or limited publication.\textsuperscript{227}

In \textit{Herzog v. Castle Rock Entertainment},\textsuperscript{228} the Eleventh Circuit held plaintiff's act of delivering a copy of a screenplay to a limited group of people,\textsuperscript{229} combined with the alleged presence of these recipients and defendant at the same film festival, did not establish defendant had a reasonable opportunity to view the screenplay, as required to establish the author's claim of copyright infringement.\textsuperscript{230} The author of the screenplay brought a copyright infringement action against the writer-director, the producer, and the distributor of the motion picture \textit{Lone Star} alleging defendants used the author's screenplay to make the motion picture.\textsuperscript{231} The District Court for the Southern District of Florida granted summary judgment for defendants; the author appealed; and the Eleventh Circuit affirmed the judgment.\textsuperscript{232}

The district court declared, and the Eleventh Circuit agreed, that to "state a claim for copyright infringement, 'two elements must be proven:

\begin{itemize}
\item \textsuperscript{222} \textit{Id.} at 1214-15 (citing \textit{Burke v. National Broad. Co.}, 598 F.2d 688, 691 (1st Cir. 1979)) (quoting \textit{White v. Kimmell}, 193 F.3d 744, 746-47 (9th Cir. 19952))).
\item \textsuperscript{223} \textit{Id.} at 1215 (citing \textit{Burke}, 598 F.2d at 693).
\item \textsuperscript{224} \textit{Id.} (citing \textit{American Tobacco Co. v. Werckmeister}, 207 U.S. 284, 300 (1907)).
\item \textsuperscript{225} \textit{Id.}
\item \textsuperscript{226} \textit{Id.} at 1217.
\item \textsuperscript{227} \textit{Id.} at 1218.
\item \textsuperscript{228} \textit{Id.} at 1220.
\item \textsuperscript{229} \textit{Id.} at 1249. The group included the author's thesis committee, a fellow student, and an adjunct professor. \textit{Id.}
\item \textsuperscript{230} \textit{Id.} at 1249-50.
\item \textsuperscript{231} \textit{Id.} at 1243.
\item \textsuperscript{232} \textit{Id.} at 1243-44.
\end{itemize}
(1) ownership of a valid copyright; and (2) copying of constituent elements of the work that are original." If a copyright infringement plaintiff does not have direct proof of copying, the plaintiff may prove copying circumstantially by demonstrating both that: (1) the defendants had access to the plaintiff’s work and (2) the works are substantially similar. The district court stated that “if the plaintiff cannot show access, the plaintiff may still prevail by demonstrating that the works are ‘strikingly similar.’” To show substantial similarity, a copyright infringement plaintiff “must establish that ‘an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.’” However, the protection granted to a copyright “‘extends only to the particular expression of an idea and never to the idea itself.’” Scenes a faire, which are “‘sequences of events that necessarily follow from a common theme,’” are not protectible under copyright law.

Although some circuits and courts may define access as the actual viewing and knowledge of a plaintiff’s work, the Eleventh Circuit defines access to a copyrighted work as a reasonable possibility of viewing a plaintiff’s work, but may not infer access from mere speculation or conjecture. Further, an inference of access to a copyrighted work based on a third party’s possession of that work requires more than a mere allegation that someone known to the defendant possessed the work in question. For example, unusual speed in the creation of a work may constitute some evidence that there was access to and use of a copyrighted work rather than independent creation. However, in the present case, the district court held, and the Eleventh Circuit agreed, that neither the short three-month period in which the writer-director wrote the motion picture, nor the almost two-year time period between defendant’s alleged access to plaintiff’s copyrighted work and his writing of the motion picture, was sufficiently short to raise the inference that

234. Id. at 1248.
235. Id. (citing Ferguson v. NBC, 584 F.2d 111, 113 (5th Cir. 1978)).
236. Id. (quoting Toy Loft, Inc., 684 F.2d at 829).
237. Id. (quoting Reyher v. Children’s Television Workshop, 533 F.2d 87, 90 (2d Cir. 1976)).
238. Id. (quoting Reyher, 533 F.2d at 91). Scenes a faire include “[i]ncidents, characters, or settings that are indispensable or standard in the treatment of a given topic.” Id.
239. Id. at 1249.
240. Id. at 1252.
241. Id. at 1256.
defendant had access to plaintiff's work, as required to establish copyright infringement. 242

Next, to establish substantial similarity between a copyrighted work and an allegedly infringing work, a plaintiff must satisfy both an extrinsic or objective test and an intrinsic or subjective test. 243 “Under the extrinsic test, the court will inquire into whether, as an objective matter, the works are substantially similar in protected expression [and] . . . determine whether a plaintiff seeks to protect only uncopyrightable elements . . . .” 244 The court noted that “under the intrinsic test, a court will determine whether, upon proper instruction, a reasonable jury would find that the works are substantially similar.” 245 Often, a plaintiff will present a list of similarities between the copyrighted work and the allegedly infringing work. However, this court found these lists of similarities are “‘inherently subjective and unreliable,’ particularly where the list contains random similarities, and many such similarities could be found in very dissimilar works.” 246

Once a copyright infringement plaintiff shows that the person who composed the defendant’s work had access to the copyrighted material and that substantial similarity between the two works exists, the burden shifts to the defendant to prove that his or her work was not a copy, but rather was an independent creation. 247 In Herzog the Eleventh Circuit held a screenplay author could not establish a claim of copyright infringement against the writer-director of a motion picture unless substantial similarities existed between the works. 248 Although plaintiff alleged the works’ characters, themes, plots, and other elements were similar, the court declared these similarities were not copyrightable and no reasonable person could find substantial similarities between the works. 249

242. Id.
243. Id. at 1257 (citing Beal v. Paramount Pictures, 806 F. Supp. 963, 967 (N.D. Ga. 1992)).
244. Id. (citing Beal, 20 F.3d at 461-64).
245. Id. (citing Beal, 806 F. Supp. at 967). Under the extrinsic test, expert testimony and analytic dissection are appropriate. Id. (citing Beal, 20 F.3d at 461-64).
246. Id. (quoting Beal, 20 F.3d at 460). The court cited several examples of themes that are prevalent in literature: crooked law enforcement officers brought to justice by their peers is a basic, unprotectible police story convention; characters who keep secrets are a basic, unprotectible murder mystery convention; and death due to foul play instead of natural causes is a standard unprotectible element of murder mysteries. Id. at 1261-62.
247. Id. at 1247-48.
248. Id. at 1257-63.
249. Id. at 1263.
In *Korman v. HBC Florida, Inc.*, the Eleventh Circuit held that "[w]hile an exclusive license to use copyrighted material must be written, a nonexclusive license can be granted orally or can be implied from the conduct of the parties." Plaintiff wrote a jingle while an employee for the radio station and then brought a copyright infringement action against the owner of a radio station that allegedly played the jingle without authorization on the grounds that plaintiff's authorization ended with her employment. The District Court for the Southern District of Florida granted summary judgment for the owner, and the writer appealed to the Eleventh Circuit.

In *Korman* the Eleventh Circuit held the author of a jingle granted a radio station an implied, nonexclusive license to use the jingle based on the author's conduct. The Copyright Act provides that transfers of copyright ownership must be in writing. However, the court held this writing requirement has no application to nonexclusive licenses, which do not transfer ownership. Hence, the nonexclusive license granted by the author of the jingle to the radio station went into effect when the author permitted the radio station to use the jingle notwithstanding the absence of a writing.

The Eleventh Circuit also held that the Copyright Act provision for the termination of exclusive and nonexclusive licenses to use copyrighted materials may not be applicable to *Korman*. Although this provision applies to implied, as well as express, nonexclusive licenses, the Eleventh Circuit held the implied nonexclusive license, which was granted by the jingle author to the radio station for use of the jingle for an infinite duration, was not subject to the minimum term of thirty-five years under the Copyright Act so long as the license would otherwise be subject to earlier termination under state contract law. When a license is granted for an indefinite period, the Ninth Circuit has held the Copyright Act provision mandating a minimum license term of thirty-five years preempts state law, which might allow for earlier termina-
The court in Korman declined to follow the Ninth Circuit, but instead agreed with the Seventh Circuit, which has held the provision does not preempt state law.\textsuperscript{261} The court noted that “it is a well-established principle that state law is read into and becomes a part of a contract.”\textsuperscript{262}

In Epic Metals Corp. v. Souliere,\textsuperscript{263} the Eleventh Circuit held that a plaintiff in an infringement action may be entitled to both statutory damages and injunctive relief and that it was within the trial court’s discretion to allow both.\textsuperscript{264} Plaintiff produced a “steel decking product” and brought a copyright infringement action against defendant and its president. The District Court for the Middle District of Florida entered judgment for plaintiff, and defendant appealed to the Eleventh Circuit. The court of appeals affirmed in part, reversed in part and remanded. On remand, the district court entered an order preventing the competitor from holding out its decking to the public as having a fire rating until the decking was tested, and the competitor again appealed.\textsuperscript{265}

Defendant’s supposed fire rating was obtained without any independent testing and by defendant’s admitted infringement of plaintiff’s copyrighted materials on plaintiff’s decking.\textsuperscript{266} In effect, the defendant copied the plaintiff’s materials on similar decking, including the fire rating of the plaintiff’s decking.\textsuperscript{267} The Eleventh Circuit held the trial court’s injunctive relief was not overbroad because the injunction merely regulated defendant’s actions rather than activities of nonparties.\textsuperscript{268}

V. TRADE SECRET CASES

In Lamb v. Turbine Designs, Inc.,\textsuperscript{269} the Eleventh Circuit held the issue of whether “a nonresident is subject to personal jurisdiction under the Georgia long-arm statute when he improperly discloses another nonresident’s trade secret to a federal agency at its Georgia office” was an unsettled and pivotal issue essential to the disposition of the case and warranted certification to the Georgia Supreme Court.\textsuperscript{270} Plaintiffs, nonresident former shareholders of a corporation, brought an action

\begin{itemize}
  \item \textsuperscript{260} Id. at 1295 (citing Rano v. Sipa Press, Inc., 987 F.2d 580, 585 (9th Cir. 1993)).
  \item \textsuperscript{261} Id. (citing Walthal v. Rusk, 172 F.3d 481, 484-85 (7th Cir. 1999)).
  \item \textsuperscript{262} Id. at 1297.
  \item \textsuperscript{263} 181 F.3d 1280 (11th Cir. 1999).
  \item \textsuperscript{264} Id. at 1284.
  \item \textsuperscript{265} Id. at 1282.
  \item \textsuperscript{266} Id.
  \item \textsuperscript{267} Id. at 1282-83.
  \item \textsuperscript{268} Id. at 1284.
  \item \textsuperscript{269} 207 F.3d 1259 (11th Cir. 2000).
  \item \textsuperscript{270} Id. at 1260.
\end{itemize}
against defendant, a nonresident competitor, alleging violations of the Florida Uniform Trade Secrets Act,\textsuperscript{271} the Georgia Trade Secrets Act,\textsuperscript{272} and various other state statutory and common law duties.\textsuperscript{273} The United States District Court for the Northern District of Georgia dismissed the action, and plaintiffs appealed to the Eleventh Circuit.\textsuperscript{274}

In general, a state's assertion of personal jurisdiction over a nonresident who commits a tort in that state would not offend the United States Constitution.\textsuperscript{275} Thus, if the Georgia Supreme Court decides that, under the given circumstances, the Georgia long arm statute would confer jurisdiction over defendants, the Georgia courts could have jurisdiction.

VI. TRADE DRESS CASES

In \textit{Wal-Mart Stores, Inc. v. Samara Bros.},\textsuperscript{276} the Supreme Court found the design of a product is not "inherently distinctive," and therefore, the Lanham Act provides protection of it as unregistered trade dress only if it is proven that the design has acquired "secondary meaning."\textsuperscript{277} The Court noted that availability of a patent on a design of a product that has not acquired secondary meaning offsets the harm that might be caused by the imposed requirement for relief under the Lanham Act.\textsuperscript{278} Samara Brothers designs and manufactures a line of children's clothing.\textsuperscript{279} Petitioner, Wal-Mart Stores, Inc., "contracted with a supplier to manufacture outfits based on photographs of Samara garments. After discovering that Wal-Mart and other retailers were selling the so-called knockoffs, Samara brought this action for . . . infringement of unregistered trade dress under \$ 43(a)" of the Lanham Act.\textsuperscript{280} After the jury returned a verdict in favor of the designer, the District Court for the Southern District of New York denied the retailer's motion for judgment as matter of law ("JMOL") and its request for a new trial. The retailer appealed. The Second Circuit affirmed the denial of JMOL. The retailer again appealed, and the Supreme Court granted \textit{certiorari}.\textsuperscript{281}

\textsuperscript{271} FLA. STAT. §§ 495.011 to 495.181 (1997 & Supp. 2000).
\textsuperscript{272} O.C.G.A. §§ 10-1-760 to 10-1-767 (2000).
\textsuperscript{273} Id.
\textsuperscript{274} Id.
\textsuperscript{275} Id.
\textsuperscript{276} 529 U.S. 205 (2000).
\textsuperscript{277} 207 F.3d at 1344.
\textsuperscript{278} Id.
\textsuperscript{279} Id. at 1340.
\textsuperscript{280} Id.
\textsuperscript{281} Id. at 1342.
The holding of *Samara* depended on whether trade dress was protectable without a showing of secondary meaning. After the jury found for Samara, Wal-Mart renewed a motion for JMOL, claiming there was insufficient evidence to support a conclusion that Samara's clothing designs could be legally protected as distinctive trade dress for the purposes of Section 43(a) of the Lanham Act. 282 The Supreme Court felt the text of Section 43(a) provided little guidance as to the circumstances under which unregistered trade dress may be protected with the exception that the trade dress not be functional. 283 The Court held that, similar to color, trade dress is not inherently distinctive because it is not primarily intended to identify the source but rather to render the product itself more useful or more appealing. 284 The Court also considered utilitarian arguments of deterring competition for trade dress and held that in a Section 43(a) action for infringement of unregistered trade dress, a product's design is distinctive, and therefore protectible, only upon a showing of secondary meaning. 285

VII. FINAL NOTES

June 1, 1999 through May 31, 2000 was an active period in the field of intellectual property. With the geometrically increasing popularity of the Internet, the mobility of the country's workforce, and the country's thirst for anything new under the sun, there are bound to be many more cutting-edge decisions concerning patents, trademarks, copyrights and the rest of the intellectual property field.

283. 207 F.3d at 1343.
284. *Id.* at 1344.
285. *Id.* at 1342-43.