Seven-Plus on the Richter Scale

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The title of this column warrants brief explanation.

The well-known Richter scale reflects the range and severity of disturbances in physical landscapes. As magnitudes exceed 7, effects are serious and widespread, with increased potential for aftershocks. (See the Nevada Seismological Laboratory's website <www.seismo.unr.edu/>.) Although earthquakes are universally seen as harmful, even devastating, this is rarely true of shifts in legal landscape. Once identified, if beneficiaries are few, most changes can be limited or even reversed.

In assembling and updating a book that surveys the ever-expanding range of intellectual property (IP), I consider whether most lawyers, not to mention IP specialists, should know of any particular development. How long will the topic be relevant when students, preparing for careers of thirty years or more, need to avoid liabilities, exploit opportunities, and secure and retain comprehensive, cost effective protection?

Applying essentially the same Richter-inspired filter to future columns, topics will be selected according to how many people are potentially affected, how much and how long. Examples of ones warranting little attention are the 1975 change from "Patent Office" to "Patent and Trademark Office" (PTO) and the more recent change from "Commissioner" to "Director" to identify the PTO's chief officer. Both have obligated publishers to alter myriad documents and lawyers to revise their vocabularies permanently, but neither is prominent in the grand scheme of things.

In contrast, the 1984 Betamax copyright case (464 U.S. 417) registers high on the Richter scale. Fortunately for Sony, Dean Dunlavey, its primary attorney from trial through two Supreme Court arguments, was aware of the idea of a "staple article of commerce," despite its being codified only in patent law (35 U.S.C. § 271(c)). Had it been otherwise, Sony's 5-4 win could easily have been a loss. (For a compelling account, including extensive background, see James Lardner's 1987 book, Fast Forward.) The case has figured prominently in other litigation and has

spawned a bill apparently designed to make induced infringement, now codified in only 35 U.S.C. § 271(b), explicitly applicable in copyright cases.

Rock and Roll Hall of Fame's (R&R) trademark suit against Charles Gentile, a photographer, also registers high but more as an example of a missed opportunity. Gentile managed to convince the Sixth Circuit, 134 F.3d 749 (1998), that his poster featuring R&R's "unique and inherently distinctive" building did not infringe its trademark rights. Yet, had he been aware of 17 U.S.C. § 120 (exempting such reproductions from copyright liability), his task might have been easier and his appeal unnecessary. It would have been interesting to see the reaction to an argument that congressional objectives would be poorly served if trademark law could be used to forbid what copyright law allows.

The final example involves a criminal conviction apparently unjustified in light of 17 U.S.C. § 301(a), which reads in part "On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright… fixed in a tangible medium of expression… are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State." By moving the boundary between state and federal from publication to fixation, that section clearly registers above 7 on the Richter scale.

Yet, in affirming Robert Nelson's conviction for holding stolen property consisting of unauthorized digital scans of photographs, the N.H. Supreme Court, 842 A.2d 83; 70 U.S.P.Q.2d 1254 (2004), made no reference to it. That is difficult to explain except by resort to N.H. Rev. Stat. Ann. §§ 352.1, 2 (1895) (makes it a misdemeanor to infringe copyright in unpublished works).

Those state provisions seem never to have been used, but, despite § 301's preemptive shift from publication to fixation, they remain on the books. Thus, attorneys who find them have little motivation to urge that one misdemeanor be substituted for another. Worse, because annotations do not mention § 301, those otherwise unaware of it have little reason to look further, leaving the door open for further prosecutions and delayed correction.