TRADEMARK OUTLINE – FALL 2007

INTRODUCTION
- Overview of IP
  o Trade Secret
    - Protection against misuse of confidential information
    - Protection is lost if the secret is disclosed
    - Does not protect against independent discovery of reverse engineering
    - Combination of tort and contract law
  o Patent
  o Copyright
  o Trademark/Trade Dress
    - Trademark law – aims to protect the integrity of the marketplace by prohibiting the use of marks associated w/particular manufacturers in ways that would cause confusion as to the source of the goods – reduces consumer confusion and raises incentives for firms to invest in activities to improve brand reputation
    - Federal power comes from the Commerce Clause
    - Lanham Act
    - TM infringement is a subset of commercial tort law

TRADEMARK LAW
- Introduction
  o Background
    - Trademarks – reduce information and transaction costs, allowing consumers to estimate the nature and quality of the goods before purchase
  o Brief Overview of Trademark Theory
    - Different than patent and copyright b/c it does not depends on novelty, invention, discovery, or any work of the brain
  o The Basic Economics of Trademarks and Advertising
    - Brand differentiation gives TM owner power over prices
    - Advertising w/TM becomes effective when consumers become repeat buyers
- What Can Be Protected as a Trademark?
  o Trademarks, Trade Names and Service Marks
    - Trademarks can be words, phrases, logos, and symbols used to identify goods
      - Strength of marks – arbitrary (strongest) → suggestive → descriptive → generic (weakest, not allowed)
    - Service marks are used to identify services rather than goods
    - Trade names – identify the company itself
      - Must actually function to identify the source of a particular good or service rather than merely identifying a company
  o Color, Fragrance, and Sounds
    - Qualitex Co. v. Jacobsen Products Co. Inc (SCt 1995) pg 626 – when a color meets the ordinary trademark requirements (is not a necessary component and has secondary meaning), there is no special rule prohibiting a color from being a TM
      - Importance is the ability to distinguish the source that serves the TM purpose, not the status as a symbol or word
      - If there is a limited number of colors suitable for that type of good, then functionality doctrine will come into play
  o Certification and Collective Marks
    - Certification marks – generally used by trade associations to identify a particular type of goods
      - Must by open to anyone who meets the standards
    - Collective mark – used by an entity (i.e. union, association, etc.) for use by members who use the mark to identify their goods or services and distinguish them from non-members
  o Trade Dress and Product Configurations
- Trade dress – design and packaging or materials, design and shape of the product itself, if it serves the same source-identifying function as TM
- Most are protected w/o registration

Establishment of Trademark Rights
  - Distinctiveness
    - Classification of Marks and Requirements for Protection
      - Inherently distinctive marks – TM that is immediately capable of identifying a unique product source; rights determined solely on priority of use
      - Other types of TM require secondary meaning in order to receive rights and protection
        - Descriptive TM – word, picture, or symbol that directly describes something about the goods or services in connection with which it is used as a mark (i.e. Tender Vittles, Arthriticare)
        - Geographic TM – i.e. Nantucket soft drinks
        - Personal name TM – i.e. O’Malley’s beer
      - Secondary meaning exists when buyers associate a descriptive term w/a single source of the products
        - Buyers do not need to know the identify of the source, only that the product or service comes from a single source
    - Zatarain’s Inc. v. Oak Grove Smokehouse (5th Cir 1983) pg 635 – Oak Grove has valid fair use defense for “Fish-Fri” (descriptive TM w/secondary meaning) and “Chick-Fri” TM should be cancelled b/c no secondary meaning
      - Fair use defense – when an allegedly infringing TM is used fairly and in good faith only to describe to users the goods or services or their geographic origin
        - Others can use the mark in a descriptive sense as long as it does not confuse consumers as to the source of the goods
  - Zazu Designs v. L’Oreal (7th Cir 1992) pg 661 – ZHD’s limited sales and limited geographic areas were insufficient to establish priority to the TM ‘Zazu’
    - ZHD used the mark first for its salon, but L’Oreal used the mark first for hair products
    - Use must be in good faith to be recognized

Distinctiveness of Trade Dress and Product Configuration
  - Two Pesos v. Taco Cabana (SCt 1992) pg 648 – proof of secondary meaning is not required for an inherently distinctive trade dress in order to obtain protection
    - Requiring secondary meaning could have adverse effects on small businesses – no protection for when they start up; would have to advertise nationally in order to get nationwide protection
  - Wal-mart Stores v. Samara Brothers (SCt 2000) pg 653 – product design can only be protected when it has acquired secondary meaning and has become distinctive
    - Ambiguous cases b/t product design and product packaging – courts should classify ambiguous trade dress as product design and require secondary meaning
  - Difference b/t cases – assume that trade dress is inherently distinctive but no such presumption prevails when dealing w/product design
  - Product packaging – can be inherently distinctive
  - Product design – never inherently distinctive

- Priority
  - Requirement of first use emphasizes protection of consumer associations b/c those associations can only arise after a TM is placed on goods sold in commerce
    - Zazu Designs v. L’Oreal (7th Cir 1992) pg 661 – ZHD’s limited sales and limited geographic areas were insufficient to establish priority to the TM ‘Zazu’
• Common law and unregistered TM – only protected where products are sold or advertised; 2 exceptions
  • TM gets protection where the mark’s reputation has been established even if not sold or advertised there
    o Also gets protection in area of normal expansion
  • TM gets protection for anyone who intentionally trades in on the owner’s goodwill, even outside the normally protected area
• Registration gives automatic nationwide protection
• Limited area defense – non-registered party can claim priority in a geographic area where they have made continuous use of mark since before the mark was registered by other party; non-registered party cannot expand outside existing territory or natural zone of expansion
• Courts have rejected the idea of protecting secondary meaning in the making
• Temporal priority
  • If TM is inherently distinctive – first to use in commerce
  • If not inherently distinctive – secondary meaning
• Geographic priority
  • If federally registered – nationwide protection automatic
  • Common law – only in areas of actual use or natural expansion
  o Trademark Office Procedures
    • Principal vv. Supplemental Register
      • Principal register – nationwide constructive use and constructive notice – cuts off rights of others using similar marks
        o Possible to become incontestable after 5 years
      • Supplemental register – allows US citizen to register mark domestically so that they could obtain foreign registration
        o Generic names not allowed
        o Mark needs to be capable of distinguishing goods or services – trade dress is allowed
• Grounds for Refusing Registration
  • Immoral or scandalous marks – must be viewed in context of modern attitudes
  • Geographic marks
    o In re Nantucket (CCPA 1982) pg 694 – whether a mark is geographically deceptively mis-descriptive depends on how the public associates the good w/the place which the mark names
    o Note – in 1982 primarily geographically deceptively mis-descriptive marks were registrable upon showing of secondary meaning – today, those marks are inherently unsuitable
  • Marks that are primarily a surname
    o Depends on how the public views the name
    o Rareness of surname is a materially relevant factor
• Opposition
  • Standing – one damaged by the registration may oppose a TM application
  • Opposer must plead and prove
    o It is likely to be damaged by registration (standing)
    o There are valid legal grounds why applicant is not entitled to register the mark
• Cancellation
  • Standing requirement similar to opposition
• Concurrent Registration
  • Concurrent registration cannot be likely to cause confusion of buyers and others
**General rule** – senior use can be awarded registration covering all parts of the US except those regions where the junior user can establish existing rights in its actual area or zones of natural expansion

- **Incontestability**
  - Conditions of obtaining incontestable status
    - Must in use for 5 continuous years after registration
    - No final decision adverse to registrant
    - No pending proceeding involving such rights
    - Affidavit that mark was been in continuous use
    - Cannot be a generic mark
  - Affect on prima facie case of infringement
    - Defenses are limited if mark is incontestable (includes generic-ness and functionality and fair use defense)
    - Registration of incontestability is conclusive evidence of validity of mark, ownership of mark, and exclusive right to use subject only to the enumerated defenses
  - Park ‘N Fly v. Dollar Park and Fly (SCt 1985) pg 693 – claim of infringement of an incontestable mark can not be defended on grounds that the mark is merely descriptive

- **Infringement**
  - The Requirement of Trademark Use
    - 1-800 Contacts v. WhenU.com (2nd Cir 2005) pg 699 – WhenU did not ‘use’ the mark when they included the website address in an unpublished directory or caused separate pop up ads to appear on the screen which did not interfere with the website being viewed and does not actually display the trademark
  - Likelihood of Consumer Confusion
    - AMF v. Sleekcraft (9th Cir. 1979) pg 709 – 8 factors to review in determining whether confusion b/t related goods is likely: (1) strength of the mark; (2) proximity of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) type of goods and the degree of care likely to be exercised by the purchaser; (7) D’s intent in selecting the mark; (8) likelihood of expansion of the product lines
      - When infringing goods directly compete – infringement if marks are sufficiently similar that confusion can be expected
      - When infringing goods are related – look to 8 factors
      - When goods are totally unrelated – no infringement b/c confusion is unlikely
  - Types of confusion: confusion as to source, confusion as to sponsorship, initial interest confusion, post sale confusion, reverse confusion

- **Dilution**
  - Federal Trademark Dilution Act of 1995 - creates a federal cause of action to protect famous marks from unauthorized use that attempts to trade in on the goodwill established by the owner and thereby dilute their distinctive quality
  - Dilution - lessening of the capacity of a famous mark to identify and distinguish goods or services regardless of the presence or absence of (a) competition b/t the parties or (b) likelihood of confusion, mistakes, or deception
  - Moseley v. V Secret (SCt 2003) pg 725 – must show actual dilution but not necessarily actual economic loss
    - If marks are not identical, consumer’s association of junior user’s mark w/famous mark is not sufficient to establish actionable dilution – blurring isn’t a necessary consequence
    - Legislatively overruled – statute now says “likely to cause dilution”
  - Blurring dilution
    - Tarnishment – where a junior user undermines the image that consumers hold of a famous mark by using it to advertise unsavory products
    - Marks must be distinctive and famous to be protected from dilution

- **Extension by Contract: Franchising and Merchandising**
Logos are becoming profitable as TMs in and of themselves, not b/c of the product they represent.

**Domain Names and Cybersquatting**

- **Anti-cybersquatting Consumer Protection Act**
  - ACPA: illegal to register or use a domain name that corresponds to a TM where the domain name registrant has no legitimate interest in using the name and acts in bad faith to deprive the TM owner of the use of the name.
  - *Shields v. Zuccarini* (3rd Cir. 2001) pg 742 – typo-squatting is actionable under the ACPA
    - Cause of action: (1) mark is distinctive or famous and entitled to protection; (2) domain names are identical or confusingly similar to owner’s mark; (3) D registered domain name in bad faith w/intent to profit.
    - Different from 1-800 Holiday Inn b/c person taking advantage of the consumer confusion immediately corrected the confusion.
  - *PETA v. Doughney* (4th Cir. 2001) pg 748 – ACPA applies to names registered before ACPA was enacted; even if there is intent to parody, if there is also intent to profit, there is a cause of action.

- **The Uniform Dispute Resolution Procedure**
  - Allows TM owner to file a complaint online.
  - Panel only determines whether to transfer the domain name.

- **Contributory Infringement**
  - D is liable if they do not themselves infringe but assist or encourage others to infringe.

- **False Advertising**
    - If ad is literally false, no need to show confusion.
    - If deceptive intent on behalf of D, then burden is on D to show absence of confusion.
  - §43(a)(1)(A) – unfair competition; unfair to use another mark that will confuse consumers as to the association of goods or services.
    - Only extends to D’s goods or services.
  - §43(a)(1)(B) – trade disparagement – misrepresents another person’s goods.
    - Consumers cannot bring an action for their own confusion under §43(a)(1).

**Defenses**

- **Genericness**
  - *Murphy Door Bed Co v. Interior Sleep Systems* (2nd Cir 1989) pg 770 – genericide occurs when the public appropriates the mark as evidenced here by PTO rejection of application for the mark, use of the mark in dictionaries as a general term, use of the term in newspapers and magazine articles in a generally descriptive sense.
  - Marks may go generic when there is no generic term already in use to describe a unique product.
    - Solution – come up with a generic term when you come up with a TM (i.e. Xerox and photocopy).
  - D has burden of proving generic-ness.
  - If P chooses a mark already in public use, P must prove the mark has been turned into something distinctive.

- **Functionality**
  - *Traffix Devices v. MDI* (SCt 2001) pg 780 – a utility patent does not completely foreclose the possibility of trade dress protection but it does impose a heavy burden on the party seeking protection to prove that the features is not functional.
    - A feature is functional when it is essential to the use or purpose of the device or when it affects the cost of quality of the device.
    - If functionality is established, secondary meaning doesn’t matter.
- Functionality is a basis for refusing registration of a mark, grounds for opposition and cancellation, and a defense to incontestability
  - *Inwood* test for functionality – (1) essential to use or purpose of article; or (2) affects cost or quality of the article

  - Abandonment
    - Nonuse
      - *MLB Properties v. Sed Non Olet Denarius* (SDNY 1993) pg 790 – a mark that has been abandoned due to nonuse only gets protection for the specific items on which the mark has been used since the resumption of use
      - §45 – presumptive abandonment period is 3 years
        - Requires bona fide use of the mark in the ordinary course of trade and not merely to reserve the right in the mark
      - 2 types of abandonment – nonuse or misuse
    - Unsupervised Licenses
      - *Dawn Donut v. Hart’s Food* (2nd Cir 1959) pg 798 – TM owner has an affirmative duty to take reasonable measures to detect and prevent misleading uses of the mark by its licensees – cancellation can result if such measures are not taken
  - The Rule Against Assignments in Gross
    - Outright assignments of TM w/o any underlying assets or goodwill are invalid
      - Goodwill can be in the form of customer lists, production formulas, etc.
    - Equivalent to abandonment
  - Non-trademark (or Nominative) Use, Parody, and the First Amendment
    - *Mattel v. MCA* (9th Cir 2002) pg 803 – no TM infringement b/c titles do not usually identify the source and the title is appropriate to the song’s subject matter – while there is dilution by blurring, the song is a parody and is included in the FDTA exemptions
      - Rule – literary titles do not violate the Lanham Act unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or content of the work
      - 3 exemptions to dilution – comparative ads, news reporting and commentary, noncommercial use
        - Use has to be commercial to qualify as dilutive, so noncommercial use means either entirely noncommercial or fully constitutionally protected speech
    - Nominative fair use defense – when mark is being used in a way that does not deceive the public
      - Elements of defense
        - Product or service in question must be one not readily identifiable w/o use of the TM
        - Only so much of the mark may be used as is reasonably necessary to identify the product or service
        - User must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the TM owner
  - International Issues in Trademark
    - Paris Convention
      - Article 2 – provides for non-discriminatory treatment against foreigners in protection of industrial property (patents, utility models, industrial design, TMs, SMs, trade names)
      - Article 4 – creates an international priority date based on the first filing in a member country if subsequent filings occur w/in a specific time period
    - Madrid TM Agreement
      - Allows for one international TM filing application which is sent to WIPO which then distributes the registration application to the designated countries
o Madrid Protocol
  ▪ Allows for an international filing based on a US application or registration
  ▪ Does not apply doctrine of central attack
o Lanham Act §44 – no obligation for foreign applicants to prove use of mark if US application is filed w/in 6 months of foreign filing date and there is a bona fide intent to use
o Gray market goods – goods that are legitimately identified by the mark on them, but have entered the US w/o consent of the US TM owner

• Remedies
  o Injunctions – provides for the property right to exclude others
    ▪ Injunctions are the means to provide the right to be free from likelihood of confusion or dilution
  o Damages
    ▪ Infringer’s Gain and Mark Owner’s Loss
      ▪ §34(a) – P’s are entitled to (1) D’s profits; (2) any damages sustained by P; and (3) costs of the actions
      ▪ Lindy Pen v. Bic Pen (9th Cir 1993) pg 821 – proof of willful intent required to award D’s profits on own – need proof of D’s profits as to the infringing products to award profits in place of P’s damages
    ▪ Corrective Advertising
      ▪ Big O Tires v. Goodyear (10th Cir 1977) pg 826 – reverse confusion is an actionable claim – corrective advertising damages are available even if P did not spend any money on such before trial
      ▪ Calculation of corrective advertising damages
        ▪ Percent of P’s share of market taken out of the amount D spent on initial advertising reduced by 75% (doesn’t require dollar for dollar to correct the wrong)

TRADE SECRET PROTECTION
• Introduction
  o Uniform Trade Secret Act – adopted in 40 states and DC
  o 3 general elements of a trade secret claim
    ▪ Subject matter qualifies for trade secret protection
    ▪ P took reasonable precautions to prevent disclosure
    ▪ D acquired the information wrongfully
  o UTSA – trade secret is something that “(1) derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable by proper means by, other persons who can obtain economic value from its disclosure or use, and (2) is the subject of efforts that are reasonable under the circumstances to maintain its secrecy”
  o Restatement of Torts – a trade secret may consist of any formula, pattern, device, or compilation of information which is used in one’s business, and which gives him an opportunity to obtain an advantage over competitors who do not know or use it
  o Restatement of Unfair Competition – A trade secret is any information that can be used in the operation of a business or other enterprise and that is sufficiently valuable and secret to afford an actual or potential economic advantage over others
• Subject Matter
  o Defining Trade Secrets
    ▪ Metallurgical Industries v. Fourtek (5th Cir 1986) pg 39 – modifications to a furnace qualified as a trade secret b/c they were secret, gave an advantage over competitors, and required time, effort and money
      ▪ Limited disclosure that is not public and done only to further the company’s economic interests does not defeat trade secret status
  o Reasonable Efforts to Maintain Secrecy
    ▪ Rockwell Graphic v. DEV Industries (7th Cir 1991) pg 49 – factual dispute whether additional precautions would have outweighed the cost when the
company kept the drawings in a vault, limited access but did allow copies to be made and did not require copies to be returned

- Disclosure of Trade Secrets
  - Trade secrets only last until their disclosure
  - Disclosure can occur through: publication, selling a commercial product that embodies the secret, disclosure by a third party, inadvertent disclosure, gov’t required disclosure

- Misappropriation of Trade Secrets
  - Acquisition or use of a trade secret is illegal in two situations
    - When it is done through improper means
    - Where it involves a breach of confidence
  - Improper means
    - El DuPont v. Rolfe Christopher (5th Cir 1970) pg 62 – Restatement of Torts
      - treatment of trade secrets does not limit protection to only where there is trespass, illegal conduct, or a breach of confidentiality – also encompasses ‘improper means’ such as aerial photography of a plant in construction
      - P only has to take reasonable precautions – does not have to guard against unanticipated, undetectable, or unpreventable methods of economic espionage
      - Balancing the factors like in nuisance law – only unreasonable interference w/another’s property interest will be found to be a nuisance

- Confidential Relationship
  - Smith v. Dravo (7th Cir 1953) – negotiations for a sale of business creates an implied agreement of confidentiality for any trade secrets disclosed so that the buyer may fairly evaluate whether or not to purchase the business
    - Criticized for focusing only on whether there was a confidential relationship instead of looking at whether there was a protectable trade secret since the items in question were sold on the open market
  - Confidential relationships can be created through express contract, or implied in fact contracts through an inference based on the circumstances that the person knew or had reason to know that the disclosure was intended to be in confidence and the other party was reasonable in inferring that the person consented to an obligation of confidentiality
  - Arrow’s Information Paradox – Seller possesses information that will lose value once disclosed, but Buyer needs to be able to evaluation the information in decision whether to buy; have to imply a confidential relationship in this context
  - Unsolicited providing of an idea does not give rise to an implied contract for compensation or confidentiality

- Reverse Engineering
  - Proper means of obtaining a trade secret: (1) independent invention; (2) reverse engineering; (3) observation of the item in public; (4) obtaining information from published literature
  - Kadant v. Seeley Machine (NDNY 2003) pg 75 – reverse engineering is permissible as long as the means used to get the information necessary to reverse engineer the item is in the public domain and not through a confidential relationship with the trade secret owner
  - Reverse engineering exception to trade secret protection weakens it in relation to patent protection
  - Reverse engineering does not prove that the trade secret was readily ascertainable – just absolves D of liability in this particular situation

- The Special Case of Departing Employees
  - Employee Trade Secrets
    - 3 types of employment agreements
      - Confidentiality agreements
      - Invention assignments
      - Non-competition agreements
Generally, reasonable contract restrictions on employees are enforceable even in the absence of a protectable trade secret.

**Wexler v. Greenberg** (SCt PA 1960) pg 82 – when the employer has no protectable trade secret, and the employee’s skills and knowledge obtained during the course of their employment are not the property of the employer, the right to use and expand these powers remains the employees property unless restricted by a covenant.

- Employee was hired to reverse engineer a competitor’s products, not invent.

**Common law invention assignments**

- Employees hired to invent – results in employer ownership of the invention.
- Employees who invent on employer’s time or w/their resources – limited ‘shop right’.
- Employees who invent on own time – owned by employee.

**Trailer clauses** – generally enforceable if reasonable.

If employees are hired to design or invent, courts are more likely to imply a contract to assign inventions.

- **Non-Competition Agreements**
  
  Courts may look to whether the agreement is reasonable in time, manner, and place.
  
  CA – any contract restricting an employee is void, but will still prevent a departing employee from disclosing trade secrets.

**Agreements to Keep Secrets**

- **Warner-Lambert v. John Reynolds** (SDNY 1959) pg 101 – royalties paid under a trade secret license do not expire as a general rule when the trade secret becomes publicly known unless expressly contracted for.

**Remedies**

- **Winton Research v. 3M Corp.** (9th Cir 1965) – congruence of right and remedy; D had not sold any products, so could not award D’s profits and could not award future profits since D was enjoined from using the secret information; enjoin use of the trade secret for the approximate time it would take a legitimate competitor to develop similar technology after public disclosure of the trade secret through the inevitable placement of the products on the open market.

**STATE INTELLECTUAL PROPERTY & UNFAIR COMPETITION LAW & FEDERAL PREEMPTION**

**State Intellectual Property Law**

- The Tort of Misappropriation
  
  - INS v. AP (SCt 1918) pg 836 – while there is no property right in the news b/t the parties and the public, there is a quasi-property right b/t direct competitors.
  
  - Does not require misrepresentation to consumers.
  
  - Good law where: (1) P generates or gathers info at cost; (2) info is time sensitive; (3) D’s use of info constitutes free-riding on P’s efforts; (4) D is in direct competition w/a product or service offered by P; (5) ability of other parties to free-ride on P’s efforts or others would so reduce the incentive to produce the produce that its existence or quality would be substantially threatened.

- Protection by Contract
  
  - **ProCD v. Zeidenberg** (7th Cir 1996) pg 848 – end user license agreement in software program is an enforceable contract.
  
  - **Specht v. Netscape** (2nd Cir 2002) pg 856 – where consumers are urged to download free software at the click of a button, a reference to license terms on a submerged part of the screen is not sufficient to place consumers on notice as to those terms.

- Idea Submissions.
- **Nadel v. Play-by-Play Toys** (2nd Cir 2000) pg 864 – for contract based claims, proof of novelty to buyer is sufficient consideration; for misappropriation claims, general novelty and originality must be proven to sustain a claim
  - Evidence of contract based on industry custom – customary to treat toy idea submissions as confidential and compensate for the idea
- **Desny v. Wilder** (CA 1956) pg 876 – idea supplier must prove that there was an express promise to pay either before or after the disclosure or the circumstances show an implied in fact contract in order to obtain compensation; no liability for use of general idea, may be liability b/c script was so similar to P’s outline

  o **Right of Publicity**
    - Creates a property like interest in the use of an individual’s name, likeness, photograph, voice, or other personal characteristics in connection w/marketing goods and services
    - **Midler v. Ford Motor Co.** (9th Cir 1988) pg 886 – when a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and have committed a tort
      - Not a finding of unfair competition
      - Right conclusion but wrong reason – should have decided case based on unfair competition
    - **White v. Samsung** (9th Cir 1993) pg 890 – dissent – right of publicity was granted when D did not use White’s voice, likeness, or signature which conflicts w/Copyright Act allowance of parody and w/First Amendment rights
    - **Comedy III Productions v. Gary Sanderup** (CA 2001) pg 900 – balancing test b/t First Amendment and right of publicity based on whether the work in question adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation
      - 1st amendment protection is not diminished b/c of commercial nature, entertainment vs. informative nature, use of nonverbal visual representation, no discernible message, or b/c it appears on T-shirts
      - Also look to whether the marketability and economic value of the challenged work comes primarily from the fame of the depicted celebrity
    - **State Moral Rights**
    - **Trespass to Chattels**
      - **eBay v. Bidder’s Edge** (CA 2000) pg 915 – trespass where an intentional interference w/the possession of personal property has proximately caused injury; P must prove (1) D intentionally and w/o authorization interfered w/P’s possessory interest in the computer system and (2) D’s unauthorized use proximately resulted in damage to P
  - **Federal Preemption of State Law**
    - **Kewanee Oil** – no patent preemption of state trade secret law
    - **Bonito Boats** – patent preemption of state direct molding statute
      - Example of INS type misappropriation – limiting what someone can do w/a hull that is in the public domain when it doesn’t have patent protection