

PRINCIPLES OF COMMON LAW: IP & RECAP

HOLLY J. HOCH

J.D., LL.M., ESQ.

1.12.25

PRESENTATIONS

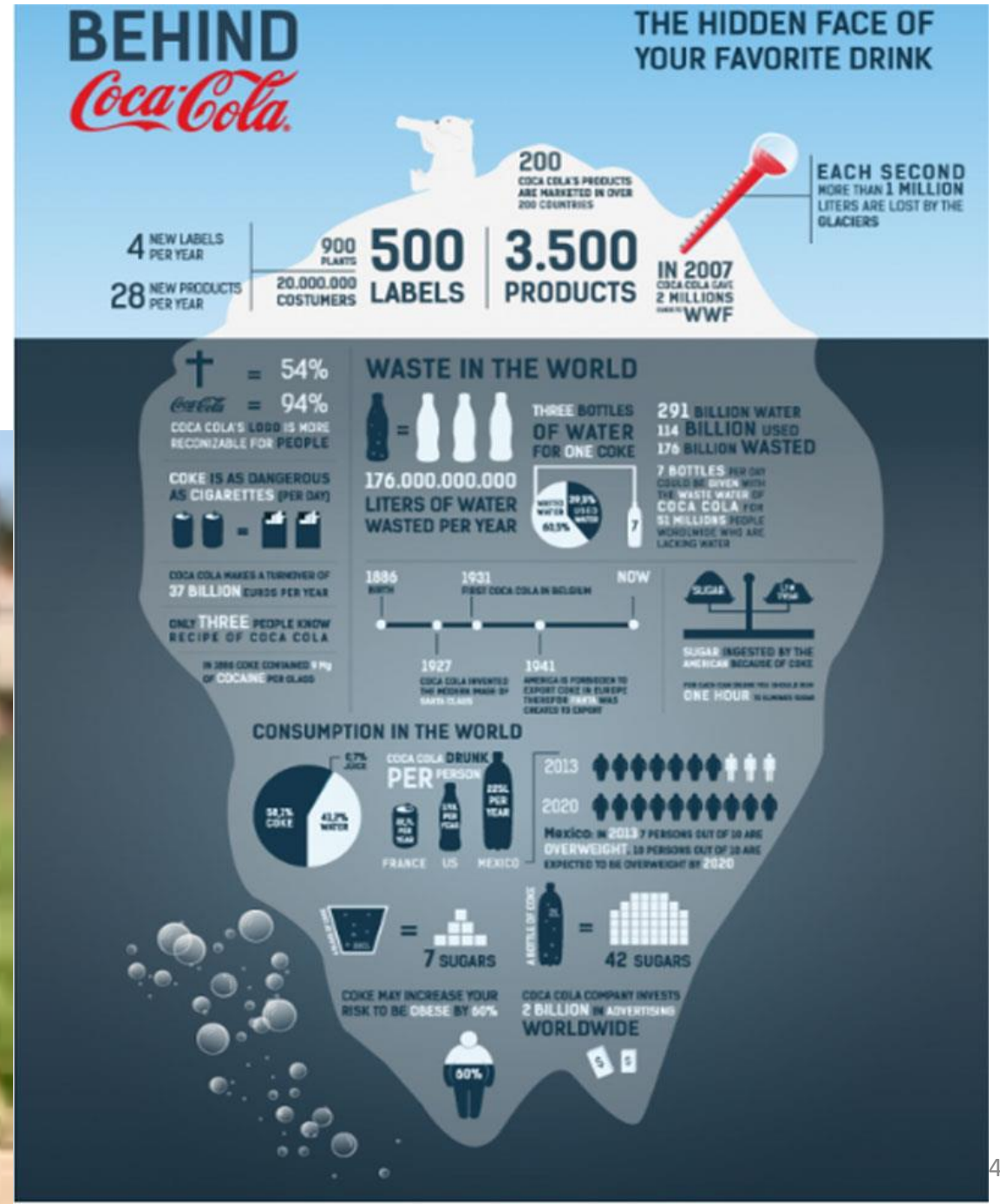
- Extra Credit
- Does not negatively impact grade – full marks still achievable
- First Come First Serve Sign-ups (limited space by time)
- **DEADLINE FOR SIGN UP: MONDAY DECEMBER 8th**
- Must be in Pairs – 10 minutes split evenly
- Individuals are fully responsible for finding a partner, the Chair cannot assist.
- During Break students can announce name and email for online participants to reach out to
- **PRESENTATION SLIDES DUE: FRIDAY DECEMBER 12th 5pm**
- Topic can be on any subject covered in the lectures
- Please contact immediately if you do not receive a confirmation email and timeslot

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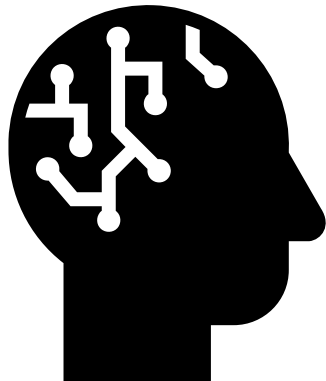
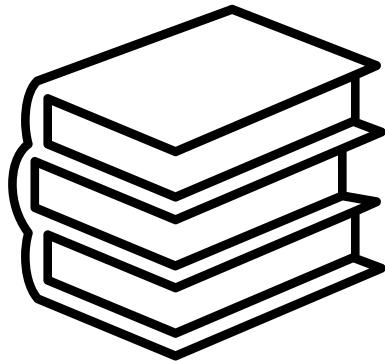
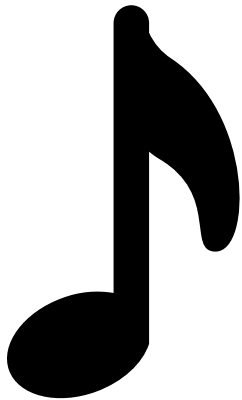
WHAT IS IP?

WHAT MAKES SOMETHING "PROPERTY"?

Coca Cola > JESUS



INTELLECTUAL PROPERTY



CREATION OF THE INTELLECT

WHAT MAKES SOMETHING “PROPERTY”?

WHAT QUALITIES MAKE SOMETHING
PROPERTY?

CAN BE BOUGHT & SOLD, LEASED, ASSIGNED

WHY WOULD WE WANT TO PROTECT THIS TYPE
OF PROPERTY?

WHAT VALUE DOES IT HAVE?

WHO SHOULD HAVE SUCH RIGHT (AND WHEN)?

WHAT ARE THE RISKS OF NOT PROTECTING IP?

ALWAYS ASK: WHAT IS IT? WHAT VALUE
DOES IT HAVE? WHO WANTS THAT VALUE?



GENERALLY, FOUR MAIN TYPES
OF FOUR LEGAL FIELDS:

1. TRADEMARKS
2. COPYRIGHTS
3. PATENTS
4. TRADE SECRETS

WHY ARE THERE DIFFERENT TYPES?

TRADEMARK

SERVICE MARKS/LOGOS/SLOGANS



A TRADEMARK OR SERVICE MARK IS A WORD, NAME, SYMBOL, OR DEVICE USED TO INDICATE THE SOURCE, QUALITY AND OWNERSHIP OF A PRODUCT OR SERVICE.

A TRADEMARK IS USED IN THE MARKETING IS RECOGNIZABLE SIGN, DESIGN OR EXPRESSION WHICH IDENTIFIES PRODUCTS OR SERVICE OF A PARTICULAR SOURCE FROM THOSE OF OTHERS.

THE TRADEMARK OWNER CAN BE AN INDIVIDUAL, BUSINESS ORGANIZATION, OR ANY LEGAL ENTITY.

WHEN DOES// SHOULD PROTECTION START?

WHEN MIGHT A TRADEMARK LOSE ITS PROTECTED STATUS?

TRADEMARK

SERVICE MARKS/LOGOS/SLOGANS



INTERSTATE USE OF TRADEMARKS IS GOVERNED BY FEDERAL LAW: THE UNITED STATES TRADEMARK ACT (ALSO CALLED THE LANHAM ACT), 15 U.S.C 1051 ET SEQ.

FILING A TRADEMARK HAPPENS WITH THE US PATENT AND TRADEMARK OFFICE

IN THE US, TRADEMARKS ARE GENERALLY PROTECTED FROM THEIR DATE OF FIRST PUBLIC USE.

WHY IS THIS DIFFERENCE IMPORTANT?

REGISTRATION OF A MARK IS NOT REQUIRED TO SECURE PROTECTION FOR A MARK, ALTHOUGH IT OFFERS NUMEROUS ADVANTAGES, SUCH AS ALLOWING THE REGISTRANT TO BRING AN ACTION IN FEDERAL COURT FOR INFRINGEMENT OF THE MARK.

GENERALLY VALID 10 YEARS

TRADEMARK

SERVICE MARKS / LOGOS / SLOGANS



THE UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO) WILL NOT TRADEMARK:

- a living person's name, unless that person has given consent
- confusingly similar marks
- a government's flag or coat of arms
- local or federal government insignias
- name or image of deceased u.s. presidents, unless consents has been given by their widows

DESCRIPTIVE OR MISDESCRIPTIVE MARKS
DESCRIPTIVE OF GOODS

DESCRIPTIVE OF QUALITIES OR FEATURES OF GOODS

GEOGRAPHICALLY DESCRIPTIVE

DESCRIPTIVE OF INDIVIDUALS' NAMES OR SURNAMES

CAN LOSE TRADEMARK WHEN GENERIC/HOUSEHOLD
NAME: GOOGLE, POPSICLE, KLEENEX, XEROX
ESCALATOR, DUMPSTER, BUBBLE WRAP, LAUNDROMAT,
CHAP STICK, FRISBEE, TASER, PHOTOSHOP

COPYRIGHT

WHAT ISNT COPYRIGHT?

Copyright is a form of protection provided to authors of "original works of authorship" fixed in any tangible medium of expression. 17 U.S.C 101 et seq

The manner and medium are virtually unlimited. Creative expression may be captured in sounds, pictures, words, numbers, notes, or any other graphic or symbolic media.

The subject matter of copyright is extremely broad, including literary, dramatic, musical, artistic, audiovisual, and architectural works.

Copyright protection is available to both published and unpublished works.

Filed with the Copyright Office.

COPYRIGHT

WHAT ISNT COPYRIGHT?

Copyright protection is available for all kinds of creative, including marketing materials, advertising and even cartoons.

Copyright is also available for other original works such as titles, names, short phrases, or lists of ingredients.

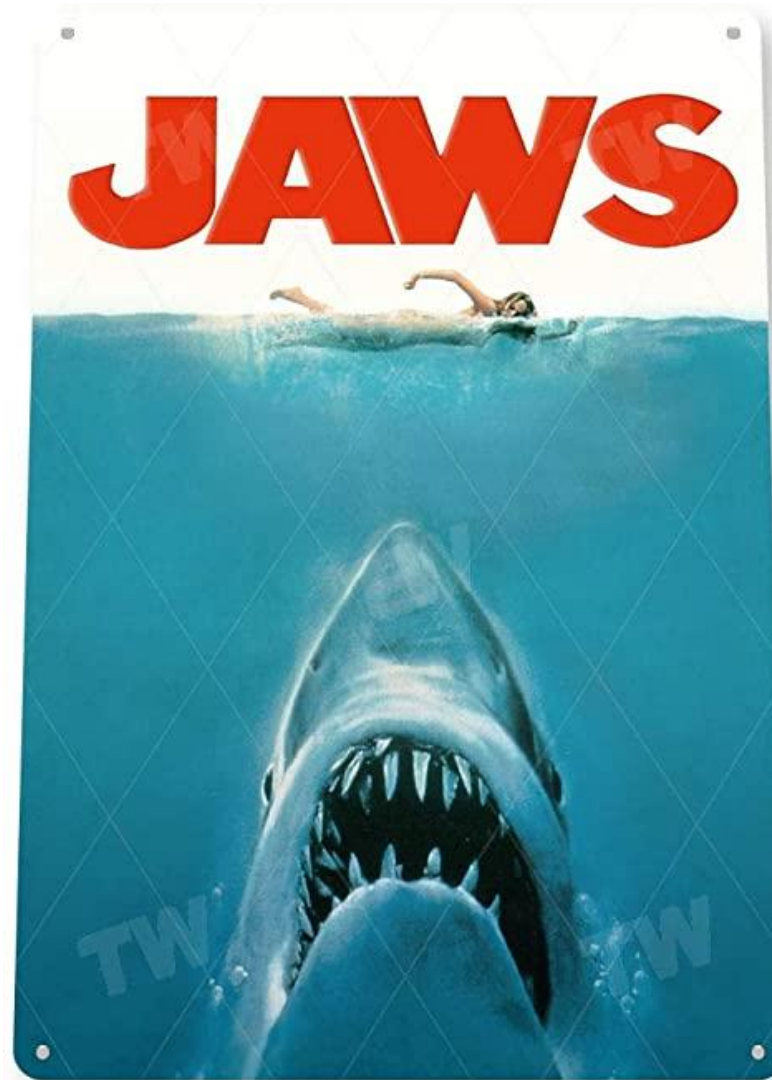
What is the difference between copyright and trademark?

KEY TAKEAWAY : Copyright protects original work, trademark protects identifiers of a particular business. Copyright is generated upon the creation of original work, whereas a trademark is established upon use of the mark.

FAIR USE

I'LL ALLOW IT

FAIR USE GRANTS CERTAIN UNAUTHORIZED USES OF PROTECTED MATERIAL, PROVIDED THAT THEY SERVE PUBLIC EDUCATION AND THE STIMULATION OF INTELLECTUAL PRODUCTIONS. (§107 OF THE U.S. COPYRIGHT ACT (17 U.S.C.))



tinworld

PAWS



P A T E N T

- ❖ A patent for an invention is the grant of a property right to the inventor, issued by the USPTO. Generally, the term is 20 years from the application filing date or, in special cases, from the date an earlier related application was filed. U.S. patent grants are effective only within the United States + territories & possessions.
- ❖ UTILITY PATENTS may be granted to anyone who invents or discovers any new and useful process, machine, article of manufacture, or composition of matter, or any new and useful improvement thereof;
- ❖ DESIGN PATENTS may be granted to anyone who invents a new, original, and ornamental design for an article of manufacture; and
- ❖ PLANT PATENTS may be granted to anyone who invents or discovers and asexually reproduces any distinct and new variety of plant.

P A T E N T

A B O M B I N V E N T O R W A S A M A Z E D B Y
H I S I N V E N T I O N . . .

- ❖ An accepted patent is “the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States, and, if the invention is a process, of the right to exclude others from using, offering for sale or selling throughout the United States, or importing into the United States, products made by that process, referring to the specification for the particulars thereof.”
- ❖ The process can be lengthy and expensive – but can be critical to a business's success – WHY?

I T B L E W H I M A W A Y



TRADE SECRET

BUSINESS SECRETS TO BE GUARDED AT ALL COSTS

THERE IS NO LIMIT TO THE TYPE OF INFORMATION THAT CAN BE PROTECTED AS TRADE SECRETS

NO REQUIREMENT THAT A TRADE SECRET BE UNIQUE OR COMPLEX

WHY WOULD WE WANT THIS KIND OF BROAD PROTECTION?

KEYWORD: SECRET

TRADE SECRETS ARE PROTECTABLE UNDER VARIOUS STATE STATUTES AND CASES AND BY CONTRACTUAL AGREEMENTS BETWEEN PARTIES.



IP Type	What It Protects	When You Use It	How Long It Lasts	Why Choose It
Patent	New inventions (machines, processes, chemicals, software methods, gadgets)	When you invented something new and useful and don't want others copying it	~20 years	Gives you a legal monopoly to make money from your invention
Copyright	Creative works (books, music, art, films, software code, photos)	When you want to protect your creative expression	Author's life + 70 years (most cases)	Stops others from copying your creative work
Trademark	Brand identifiers (names, logos, slogans)	When you want to protect your brand identity and prevent customer confusion	As long as you keep using it	Protects your brand and reputation
Trade Secret	Valuable secret info (recipes, formulas, manufacturing methods)	When something is useful because it's secret and can be kept secret	Potentially forever	No need to disclose anything publicly; lasts indefinitely if kept confidential



H Y P O

B U D D Y U P

BURGER KING WANTS TO PROTECT THE SMELL OF THE WHOPPER - CAN THEY?

IF YES, HOW? UNDER WHAT PROTECTION SCHEME?

IF NO, WHY? WHAT WOULD YOU ADVISE THEM TO DO?



HINT

GET A CLUE

According to the U.S. Patent and Trademark Office, “sense” marks can only be eligible for trademark protection if they meet two tests:

1. They do not have any utilitarian functionality with respect to the product; and
2. They must have been promoted for a sufficient period of time that consumers view them as a source identifier - also known as consumer “*secondary meaning*”



REALITY

BUDDY UP

KFC HAS PROTECTED THEIR CHICKEN RECIPE.
HOW DID THEY DO THIS?

UNDER WHAT LEGAL SCHEME?

WHAT CRITERIA DID THEY (HAVE TO) FULFILL?





QUESTIONS TO CONSIDER

WHAT ABOUT PROTECTING DOMAIN NAMES?

WHAT MODERN CHALLENGES FACE PROTECTION RIGHTS?

WHAT IF YOU'RE A FOREIGN COMPANY ENTERING THE US MARKET?

WHAT IF YOU WANT PROTECTION OUTSIDE
OF THE US?

❖ MADRID PROTOCOL (Trademark)

❖ BERNE CONVENTION (Copyright)

❖ WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)

❖ PARIS CONVENTION (PATENT & TRADEMARK)



TYING IT TOGETHER



Qualitex v. Jacobson (U.S. Supreme Court, 1995)

WHAT HAPPENED?

- Qualitex used a specific shade of green-gold for its dry-cleaning pads. The Court held that a color can be a trademark *if it has acquired distinctiveness*.
- The U.S. Trademark Act (Lanham Act) never said “colors can be trademarks.”
- **Courts expanded the law through precedent.**
- After this case, color trademarks became widely accepted in the U.S.

The law changed because judges decided it should.

Compare EU/CH: Color trademarks can be registered, but only if allowed by statute and administrative rules. The rules for distinctiveness are defined by codified law, not by open-ended judicial creativity. Authorities apply stricter standards based on written legal criteria. Example: EUIPO/Swiss IPI require strong proof of acquired distinctiveness, higher standard than the US. Courts cannot simply expand the category because they think it’s logical, they must stay within statutory definitions.

KEY POINTS AND TAKEAWAYS

- Common law is judge-made and precedent-driven.
- For example, American law amplifies the power of courts
- Practice (precedent, distinguishing, overruling) often matters more than abstract history.

If judges are making law, how do we ensure democracy and accountability?

WHERE DO WE START?



COMMON LAW TRADITION

- ❖ Sources of law: Constitutions, Statutes and Regulations, Cases/Precedent, Restatements & scholarly works (persuasive)
- ❖ Judges' role: Apply and make law through rulings.
- ❖ Reasoning style: Analogical → compare with past cases.
- ❖ Effect of judgments: Binding precedent (stare decisis).





KEY DIFFERENCES

- ❖ Source of authority: Codes vs. Cases
- ❖ Role of judges: Appliers vs. Makers
- ❖ Reasoning style: Deduction vs. Analogy
- ❖ Effect of decisions: Party-Only vs. Binding Precedent.



HOW LAW IS MADE & APPLIED

- ❖ In civil law, elected legislators write the code. Judges mostly apply it.
- ❖ In common law, (un)elected judges create binding law through precedent.
- ❖ U.S. judges may cite history, tradition, and moral/political theory in ways uncommon in code-centric opinions.
- ❖ Is there a tension between democratic legitimacy and judge-made law?

Should unelected judges be allowed to “make law” that binds society?

Which system gives citizens more legal certainty? Which adapts better to new problems?

WHAT IS A “VEHICLE”?

A new city ordinance says: “No vehicles are allowed in the park.”

A man is fined for riding an electric **scooter** in the park. He challenges the fine.

Ordinance Text: “No vehicles in the park.”

Supreme Court Case A: City v. Cars (2010) — Cars are clearly “vehicles.”

Supreme Court Case B: City v. Bicycles (2015) — Bicycles are not “vehicles” because they don’t create the same safety concerns.

Court of Appeal Case C (neighboring state): Scooters are not vehicles because they are light and personal mobility devices.

Restatement of Torts: Defines “vehicle” as “a mechanized conveyance primarily designed for road use.”

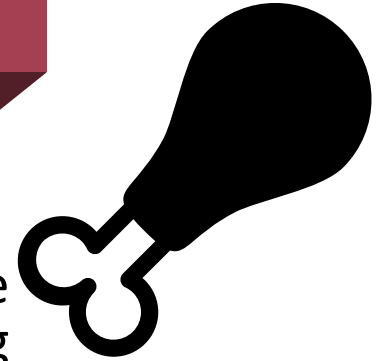
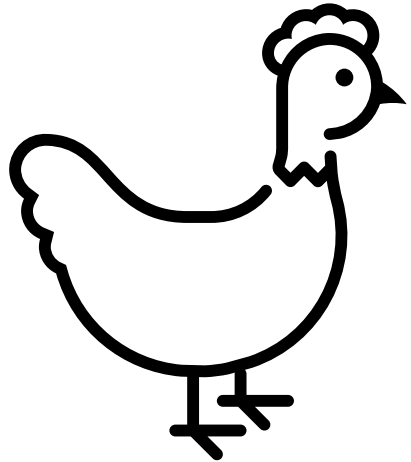


HOW DO WE INTERPRET?

FRAMEWORK FOR ANALYSIS

- Statute sets the rule → “No vehicles.”
- Precedent interprets statute → “Vehicles = cars, but not bicycles.”
- Persuasive authorities fill gaps but don’t bind.
- Lawyers on each side will need to rank, frame, and *spin* authorities to persuade the court.

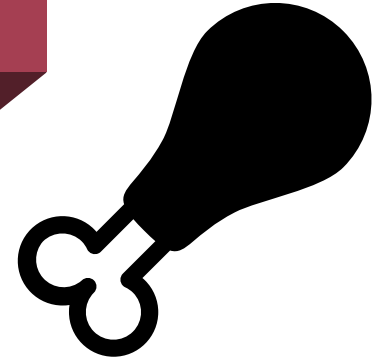
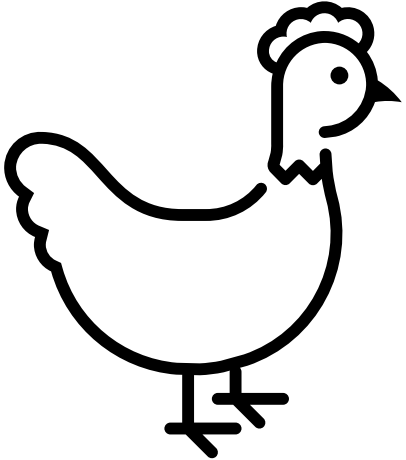
CONTRACT INTERPRETATION: WHEN WORDS MATTER



- "WHAT IS CHICKEN?"
- BNS sold chickens to Frigaliment, a Swiss Company. When the chickens arrived, Frigaliment discovered they were "stewing hens," not "broiler chickens," the former being lower-quality.
- BNS was American and "chicken" was ambiguous - in English it could refer to any bird of that species, while Frigaliment claimed it referred only to young, tender broilers. This case is about determining the definition of a word when each party has a different interpretation of an ambiguous word.
- *WHO WINS?*
- **Consider: The key question isn't just what the words say, but what the parties meant and reasonably understood.*

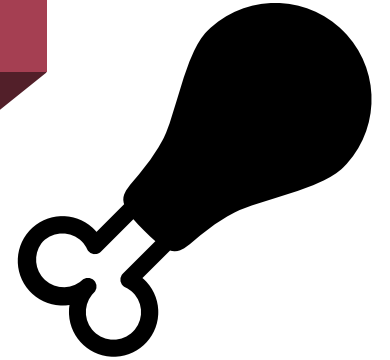
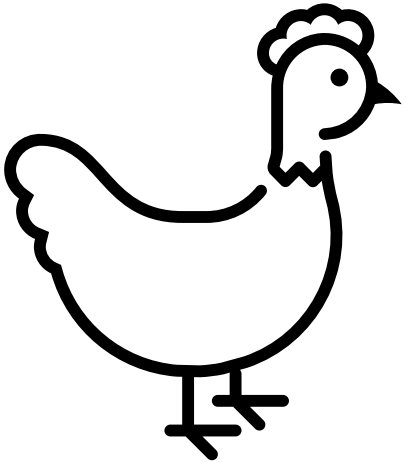
WHY INTERPRETATION MATTERS

- Contracts depend not only on what is written, but on what the parties *meant*.
- Ambiguity arises when language allows more than one reasonable meaning.
- Courts must decide: Whose meaning governs?
- **COMMON LAW**
 - Objective meaning, what a reasonable person in that context would understand.
 - Interpretation guided by context, trade usage, and conduct (e.g. *Frigaliment*).
- **CONTRAST CH**
 - Subjective meaning: search for the true common intent of the parties (Art. 18 OR).
 - If intent unclear → interpret by good faith (Vertrauensprinzip).



CONTRACT INTERPRETATION: WHEN WORDS MATTER

- "WHAT IS CHICKEN?"
- Common Law Approach:
 - What would a reasonable person in that context (chicken trade) understand?
 - Whose burden is it to prove the meaning?
- Swiss Law (Art. 18 OR):
 - Is there a common intent?
 - If not, what meaning follows from good faith (Vertrauensprinzip)?



THANK YOU



PLEASE FEEL FREE TO
CONTACT WITH QUESTIONS



HOLLY.HOCH@IUS.UZH.CH



Portions of this lecture were
created or assisted by AI
(Hypotheticals, charts, etc.)

