

USF Intellectual Property Law Bulletin

2009-2010 Application Form

Thank you for your interest in working on Volume 14 of the *Bulletin* during the academic year. Please fill out this form and return it along with all supplemental material to the IPLB box in the Faculty Services Office (Kendrick 300) or e-mail your application to iplb@usfca.edu by the end of **Tuesday, March 24, 2009**. Please be aware that we may contact you to arrange a short interview in addition to this application.

1. Personal Information

Name: _____

Next year, you will be a 2L/3L/4L (circle one), full/part time (circle one)

Phone: _____ E-mail: _____

2. *Bulletin* Information

Please list your previous positions in the *Bulletin*: _____

Have you written a survey for the *Bulletin*? YES/NO (circle one)

For what position(s) are you applying? (See the reverse side of this page for position descriptions.) Check all that apply.

Editorial Board

- Executive Editor
- Managing Editor
- Technical Editor
- Executive Articles Editor
- Senior Articles Editor
- Symposium Editor
- Senior Surveys Editor

Senior Staff

- Surveys Editor
- Articles Editor

Junior Staff

- Survey Author
- Staff Member (editing)
- Staff Member (symposium)

3. Resume

Please attach a current resume to this application.

4. Writing Sample (required for Editorial Board and Senior Staff applications)

In every issue of the *Bulletin* we publish short briefs of cutting-edge case law called surveys. Please read *Abbott Labs v. Baxter Pharmaceutical Products*, 471 F.3d 1363 (Fed. Cir. 2006). Write a brief summary of the majority opinion in the case, of no more than two pages in length, with the following headings: Background, Issues, Decision, Reasoning. See the attached sample survey or past issues of IPLB for further guidance. Do not use any footnotes or citations, as we are primarily concerned with your writing style and language use. **If you have written a survey previously, as a survey author or for a prior application, you may submit that survey.**

Symposium Editor: Instead of submitting a writing sample, please submit a cover letter explaining why you are qualified to plan the symposium.

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Position Descriptions

Note: Editorial Board Members in their final year of study may earn 2 units of school credit in each of the Fall and Spring Semesters (up to a maximum of 4 units).

Executive Editor: The Executive Editor facilitates contact between the *Bulletin* and prospective authors. This entails contacting professors, practitioners and students directly to solicit manuscripts for publication in upcoming issues, and screening submissions before transmitting articles appropriate for consideration to the Board for voting. The Executive Editor communicates Board decisions to authors and finalizes arrangements for accepted articles before passing them on to the Executive Articles Editor. Finally, the Executive Editor assists the Editor-in-Chief with staff management and coordination.

Managing Editor: The managing editor serves as the interface between the *Bulletin* and the school, the publisher of the *Bulletin*, and the *Bulletin's* subscribers. Thus, the managing editor is responsible for managing the *Bulletin's* financial affairs, which include subscription fees, royalties, and funding from the USF Faculty Services office. The Managing Editor also reviews all surveys and articles before final editing by the Editor-in-Chief.

Technical Editor: The Technical Editor works closely with Executive Articles Editor and Senior Surveys Editor to ensure that citations, quotations and sources follow Bluebook format and are accurate. The Technical Editor is the last editor to look at articles before they are provided to the Managing Editor and Editor in Chief. In addition, the Technical Editor answers questions from staff editors and articles editors about challenging formatting questions and provides at least one training session per semester for staff editors about how to use the Bluebook. Finally, the Technical Editor updates the IPLB Style Guide at least once a year.

Symposium Editor: The Symposium Editor is responsible for creating, scheduling, and coordinating the *Bulletin's* symposium. Working with a team of junior staff members, this Editor is responsible for the acquisition of the topical, logistical, technical, and financial means necessary to support a conference event. Responsibilities include: recruiting symposium staff, topic selection and session coordination; panelist, moderator, and keynote selection and recruitment; fundraising within the legal, academic, and business communities; preparation of communications and marketing for the event; creating and maintaining an event website, and working with members of the Faculty Services Office and Administration at the School of Law in both a liaison and coordination capacity. This position is one-year long with preparation necessary beginning Spring 2009. Please see <http://www.usffairuse.com> for information regarding the 2008-2009 Symposium.

Executive Articles Editor: The Executive Articles Editor reads all submitted articles and recommends papers of interest to the other members of the Board. Upon approval of the Board, the Executive Articles Editor supervises the articles editors and staff members in quickly editing the manuscript to publishable quality, a task that requires tracking the progress of the editing teams throughout the exchange of multiple substantive revisions between the article editors and authors, ensuring that article editors are keeping staff editors on track to meet deadlines for collecting cited sources, validating that cited material supports authors' assertions, and correcting citations in accordance with Blue Book. The Executive Articles Editor works directly with the article authors during the editing process to ensure the preservation of their distinct style and viewpoint.

Senior Articles Editor: The Senior Articles Editor is a 2L or part-time 3L who, in addition to fulfilling Board duties, assists the Executive Articles Editor with article selection, editing team management and article editing responsibilities.

Senior Surveys Editor: The Senior Surveys Editor is responsible for selecting cutting-edge case law to cover in each issue of the *Bulletin*. Once the cases are approved, the Senior Surveys Editor assigns them to survey authors, delivering guidelines, templates and sample surveys to each student author. The Senior Surveys Editor then oversees the survey-writing process, coordinating schedules and ensuring adherence to strict deadlines. The Senior Surveys Editor also manages the editing process that follows; supervising the exchange of drafts between Surveys Editors and authors, and performing the final round of edits to the surveys.

Articles Editor: Articles Editors report to the Executive Articles Editor, editing articles selected for publication. Articles Editors supervise a team of staff members through successive rounds of technical and substantive edits, with keen attention to detail and the ability to meet strict deadlines.

Surveys Editor: Surveys Editors report to the Senior Surveys Editor, editing briefs of recent IP case law written by USF students. Attention to detail and ability to meet editing deadlines is required.

Survey Author: The Survey Author is a USF student who writes a short summary of a cutting-edge intellectual property law case for publication in the IPLB. The case may be assigned by the Senior Surveys editor or chosen by the Survey Author.

Staff Member (editing): Staff Members work in teams under the Articles Editor, performing technical and substantive edits under tight deadlines. Staff Members must be quick to learn, willing to work diligently both individually and collaboratively, and dedicated to achieving the highest possible standards in publication.

Staff Member (staff): Symposium staff members work as a team under the Symposium Editor to coordinate the *Bulletin's* annual symposium. Staff members must be willing to commit time during both the summer break and winter break to facilitate the symposium's success. Duties include content preparation, fundraising, marketing, technology support, and logistical support for the event.

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Sample Survey

KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., et al.
125 S.Ct. 542 (2004)

Background

Both Petitioner KP Permanent Make-Up, Inc (KP) and Respondent Lasting Impression I, Inc., et al (Lasting) manufacture permanent makeup, a mixture of pigment and liquid for injection under the skin, and each company used some version of the term “micro color” (either as one word or two, singular or plural) in marketing and selling products. Since 1990 or 1991, KP claims that it used the single-word version “microcolor” on advertising flyers and on pigment bottles (starting 1991). In 1992, Lasting applied to the United States Patent and Trademark Office (PTO) under 15 U.S.C. § 1051 for registration of a trademark consisting of two words “Micro Colors” in white letters separated by a green bar within a black square. The PTO registered the mark to Lasting in 1993 and in 1999 the registration became incontestable. In 1999 when KP produced a 10-page advertising brochure using “microcolor” in a large, stylized typeface, Lasting demanded that KP cease using the term. Instead of ceasing, KP sued Lasting in the Central District of California, seeking a declaratory judgment that the use of the word “microcolor” infringed no exclusive rights held by Lasting. Lasting then counterclaimed, alleging that KP infringed their “Micro Colors” trademark. On this counterclaim, KP sought summary judgment based on the statutory affirmative defense of fair use, 15 U.S.C. § 1115(b)(4).

The District Court held that KP acted fairly and in good faith after finding that Lasting conceded that KP used the term “microcolor” only to describe its goods rather than as a trademark. The Court further concluded that KP made its affirmative defense and entered summary judgment for KP on Lasting’s infringement claim. On appeal, the Court of Appeals for the Ninth Circuit thought it error that the District Court addressed the fair use defense without addressing the matter of possible confusion on the part of consumers about the origin of KP’s goods. The Court of Appeals decided that no use can be fair where any consumer confusion is probable and seems to have placed the burden on KP to show absence of consumer confusion. Since the Court found disputed material facts relevant under the Circuit’s eight-factor test for assessing the likelihood of confusion, it reversed the summary judgment granted by the District Court and remanded the case. Meanwhile, the United States Supreme Court granted KP’s petition for certiorari to address both the disagreements among the Courts of Appeals on the significance of likely confusion for a fair use defense to a trademark infringement claim and the obligation of a party defending on that ground to show that its use is unlikely to cause consumer confusion.

Issues

The issue here is whether a party raising the statutory affirmative defense of fair use to a claim of trademark infringement under 15 U.S.C. § 1115(b)(4) has a burden to negate any likelihood that the alleged violating practice will confuse consumers about the origin of the affected goods or services.

Decision

A party asserting a statutory affirmative defense of fair use to a claim of trademark infringement has no burden to negate any likelihood that the alleged violating practice would confuse consumers about the origin of the affected goods or services. Furthermore, some possibility of consumer confusion about the origin of the goods or services affected is compatible with fair use of a mark.

Reasoning

Under the Trademark Act (Lanham Act) of 1946, the holder of a registered trademark (incontestable or not) has a civil action against anyone employing an imitation of it in commerce when “such use is likely to cause confusion, or to cause mistake, or to deceive.” Although an incontestable registration is “conclusive evidence of the registrant’s exclusive right to use the . . . mark in commerce,” the petitioner’s success is still subject to “proof of infringement” and that requires a showing that the respondent’s actual practice is likely to produce confusion in the minds of consumers about the origins of the questioned goods or services. Based on their reading of the Trademark Act, the Supreme Court reasoned that (1) Section 1115(b) places a burden of proving likelihood of confusion (infringement) on the party charging infringement even when relying on an incontestable registration; and (2) Congress said nothing about likelihood of confusion in setting out the elements of the fair use defense in § 1115(b)(4).

According to the Court, analyzing the typical course of litigation in an infringement action “points up the incoherence of placing a burden to show nonconfusion on a defendant.” For, “it is only when a plaintiff has shown likely confusion by a preponderance of the evidence that a defendant could have any need of an affirmative defense, but under Lasting’s theory the defense would be foreclosed in such a case.” For emphasis, the Court cited the Shakespeare court, “it defies logic to argue that a defense may not be asserted in the only situation where it even becomes relevant.” Therefore, since the burden of proving likelihood of confusion rests with Lasting and not KP, and since the fair-use respondent (KP) has no independent need to show confusion unlikely, the Supreme Court held that some possibility of consumer confusion must be compatible with fair use. The Court concluded that because the Court of Appeal’s decision placed the burden of showing consumer confusion upon KP, the judgment for Lasting could not stand. The Court vacated the judgment and remanded the case for further proceedings.