

BOOK REVIEW***McCarthy's Desk Encyclopedia of Intellectual Property, second edition***

by **J. Thomas McCarthy**
BNA Books, Washington, D.C.
505 Pages; \$75.00

Reviewed by **ELIZABETH E. LAUNER** †

I. INTRODUCTION

Today's greatest economic assets are technology, information and ideas, and the legal issues surrounding ownership of intellectual property are among the most significant matters facing business.¹ Over the past ten years, the prominence and importance of intellectual property law has increased tremendously.² Lawyers and legal observers agree that intellectual property is the "golden specialty," the hottest and fastest growing practice area.³

As technology companies continue to drive economic growth,⁴ intellectual property lawyers, who advise companies on how to protect their information, ideas and inventions, are increasingly in demand.⁵ The number of patent filings⁶ and patents issued⁷ is growing steadily. The number of trademark registrations and renewals likewise continues to multiply.⁸ Intellectual property matters now blend with antitrust, mergers and other standard big firm domains.⁹ Intellectual property litigation is not only increasingly common, but more lucrative than ever before.¹⁰ Even the United States Supreme Court, typically fairly quiet on this area of law, has accepted an unusually large number of intellectual property cases during the last two terms. These cases include copyright law in *Lotus v. Borland*¹¹ and *Campbell v. Acuff-Rose*,¹² trademark law in *Qualitex v. Jacobson*,¹³ patent law in *Markman v. Westview*¹⁴ and *Warner-Jenkinson v. Hilton Davis*,¹⁵ and the Plant Variety Protection Act in *Asgrow Seed v. Winterboer*.¹⁶

Specialists, generalists and in-house attorneys alike must comprehend and apply intellectual property law to new situations and in new ways. Attorneys must maintain a firm grasp on the traditional legal foundations while staying abreast of important changes in order to protect and defend their clients' most valuable, albeit intangible, assets.

Although the intellectual property attorney has always had to cross disciplines among the field's subgroups, today more than ever she must be well versed in a variety of changing doctrines. For instance, when faced with a client's new software product, an attorney must consider patent, copyright, trade secret, trademark and trade dress law, as well as international protection in those areas. While many attorneys may be knowledgeable in several areas, few have not only mastered them all, but also stayed abreast of recent changes.

With the intellectual property explosion has come an equally large body of resources to keep practitioners informed. Law review articles, books, periodicals, practice guides and treatises flood the legal libraries or are routed to our in-boxes. There is a booming business for courses and seminars covering all aspects of intellectual property law, such as the Practising Law Institute's extensive catalog of intellectual property events. With such a volume of material available, it is difficult to know which resources to rely on for quick, yet comprehensive, answers to a wide range of questions. The second edition of *McCarthy's Desk Encyclopedia of Intellectual Property* fits the bill.

J. Thomas McCarthy is well suited to the task of compiling such a resource. He is a professor at the University of San Francisco School of Law, where he has taught for almost thirty years. But he is perhaps best known as the author of the leading treatise on trademark law, *McCarthy on Trademarks and Unfair Competition*, which has been cited in over 700 judicial opinions. He is also the author of *The Rights of Publicity and Privacy*¹⁷ and *Federal Antitrust Laws*.

In addition to being an honored scholar,¹⁸ Professor McCarthy has a continuing impact on the direction of intellectual property law. He is a trademark consultant to some of the nation's largest consumer marketing companies and is of counsel at the San Francisco law firm of Limbach & Limbach. He was a member of the American Law Institute advisory committee drafting the 1995 Restatement of

the Law of Unfair Competition and a member of the Trademark Law Revision Commission (1986-1988), and he is on the editorial board of the *Trademark Reporter*. This broad-based experience in both theoretical and practical aspects of intellectual property law has undoubtedly contributed to the comprehensive, carefully documented and eminently useable nature of the *Desk Encyclopedia*.

II. SYNOPSIS

A. Structure and Organization

The *Desk Encyclopedia's* arrangement is familiar and intuitive: it follows the practical format of a dictionary or encyclopedia with an alphabetical listing of entries. Each term is followed by an indication of the subsection of intellectual property law into which the concept falls. For instance, the entry for "prior art" indicates that this term relates to patent law.¹⁹ For each word, there is a simple definition written in clear and understandable language, as well as more detailed and sophisticated information of technical and/or legal significance. Most entries contain references to and quotations from the landmark cases and relevant statutes. Additional references to commentaries, manuals and the leading treatises guide the reader to secondary sources of information. Many entries contain factual examples drawn from litigated cases to explain particularly difficult concepts. Finally, each term is exhaustively cross-referenced to related words in the book. This assistance is particularly valuable-it may suggest ideas and strategies that the reader had not anticipated. While the structure of the entries is consistent throughout, the length and complexity vary according to topic.

The main body of the *Desk Encyclopedia* is preceded by a list of entries, a table of cases and a list of references cited. It is followed by five appendices containing historical data. These appendices include listings of the Superintendents and Commissioners of Patents and Trademarks from 1802 to the present,²⁰ the Assistant Commissioners of Trademarks from 1953 to the present,²¹ a chart showing annual applications filed and patents issued between 1790 and 1994,²² a chart showing annual trademark registrations and renewals between 1870 and 1994,²³ and a list of the Registers of Copyrights from 1897 to the present.²⁴

B. Substantive Content

The main body of the *Desk Encyclopedia* is composed of four general categories of entries: broad or basic intellectual property entries; specific intellectual property entries defining and explaining more complex concepts; technical terminology; and general legal concepts.

The basic entries define such concepts as "intellectual property," "right of publicity," "trade secret" and "patent." For example, the "trade secret" entry supplies a general definition of the concept, followed by subheadings on the sources of trade secret law, relations between federal and state law, the tort versus property approach, requirement of secrecy, reasonable efforts to maintain secrecy, novelty, infringement, proper means of obtaining trade secrets, employee mobility, remedies, assignments and licensing, hybrid patent-trade secret licensing, and protection against trade secret disclosure in other types of litigation.²⁵ Within the text of the subsections, the reader is referred to more specific entries throughout the book. The "trade secret" entry concludes with treatise, statutory, restatement and case references.

The specific entries are specialized to practice area and tend to be briefer than the general entries. Examples include "geographic mark," "entire market value rule" and "publication." Technical entries, such as "genetic engineering" and "semiconductor chip," explain the underlying technology and its legal implications. Finally, some general legal concepts that may accompany intellectual property issues are included, such as "*ejusdem generis*,"²⁶ "hard cases make bad law" and "*ratio decidendi*."²⁷ These entries have definitions followed by usage examples from intellectual property cases.

The interaction of these four types of entries and the efficacy of the *Desk Encyclopedia* may be demonstrated by exploring how our hypothetical attorney might use it to advise her client regarding legal protection of a computer program. Assuming that the attorney is ignorant of both the law and technology of software, she might start by looking up the term "computer program." Professor McCarthy begins this entry by indicating that the term relates to computer, copyright, patent and trade secret law.²⁸ This provides the reader with an idea of the legal doctrines that might apply to her situation. If unfamiliar with these practice areas, she could study their general entries to acquire sufficient background knowledge to understand the discussion in the "computer program" entry.

Professor McCarthy defines "computer program" as "a set of statements or instructions to be used directly or indirectly in a computer to bring about a certain result."²⁹ He explains that this definition is from section 101 of the Copyright Act.³⁰ The definition was part of an amendment which was enacted by Congress in 1980 on the recommendation of the National Commission of New Technological Uses of Copyrighted Works (CONTU).³¹ The reader is referred to the "CONTU" entry which explains the CONTU report and details the effect of the statutes enacted as a result of CONTU. Section 101 was amended to include the above definition of computer program and section 117 was added to clarify that copies made of a software program to load it, or for "archival" or back-up purposes do not

infringe the copyright in the work.³² Thus the attorney is provided with a definition of a computer program and knowledge of what literal copying is allowable.

The *Desk Encyclopedia* breaks down the question of protection for computer programs into three subheadings: copyright, patent and trade secret protection. The copyright section first introduces the "idea-expression dichotomy" and explains that "application programs," "operating systems," "object code" and "source code" may be protected whether stored in a "ROM" or loaded into "RAM."³³ If our attorney is not familiar with these technical terms, she need only turn to their cross-referenced entries for clear definitions and more specific information. Professor McCarthy explains that the scope of protection available for nonliteral elements of a computer program has been heavily litigated and refers the reader to entries on "structure, sequence, and organization" (SSO) and "look and feel."³⁴ Following this is a discussion of international protection for software covering the European Union Software Directive, General Agreement on Tariffs and Trade (GATT) and North American Free Trade Agreement (NAFTA). Concluding the copyright section are case and treatise references. The quotations from the leading cases, such as the passage outlining the *Altai* test,³⁵ serve not only to educate the reader but are tailor-made to plug into brief or memo.

Taking a detour, our attorney might look up "structure, sequence, and organization" and "look and feel" to determine whether these principles might support her client's position. The SSO entry reveals that the term originated in the *Whelan* case³⁶ and was largely superseded by the *Altai* test.³⁷ It then outlines the viable remains of SSO with quotations from *Johnson Controls v. Phoenix*³⁸ and *Brown Bag Software v. Semantec*³⁹ and commentary references to the *AIPLA Quarterly Journal* and the *Columbia Law Review*.

The "look and feel" entry describes early attempts to protect software and introduces the concept of "user interface" with a definition, explanation and cross-reference to that term. It also devotes considerable attention to the two key cases, *Apple v. Microsoft*⁴⁰ and *Lotus v. Borland*,⁴¹ giving factual background and analysis of the opinions for each.⁴² It concludes with several commentary reference quotations which further explain this challenging issue in copyright law.⁴³

Returning to the "computer program" entry, our attorney reads the patentability section and learns that "[p]atent protection is available for a process that uses a computer program to carry it out. Patent protection is not available for an algorithm or mathematical formula used to define the steps in a computer program."⁴⁴ Professor McCarthy then outlines the Freeman-Walker-Abele test⁴⁵ for patentability and provides relevant excerpts from *Diamond v. Diehr*,⁴⁶ *In re Iwahashi*⁴⁷ and *In re Alappat*.⁴⁸

The section on patentability of computer programs is a good example of where Professor McCarthy has been cautious not to over commit himself or his reader in an area of law that is changing rapidly. While the *Desk Encyclopedia* is not updated on a yearly basis, it is intended to be a lasting resource. The number of software patents applications submitted to the Patent and Trademark Office (PTO) is increasing rapidly⁴⁹ and that office is currently reviewing examination guidelines for computer-related inventions that will define and streamline the process.⁵⁰ Although software patents are a growing reality, it is difficult to predict the direction they will take at the PTO or in the courts. Where an issue is controversial or changing rapidly, Professor McCarthy has provided the legal and technical underpinnings and the resources for further inquiry without including faddish material that may quickly become obsolete or incorrect. The downside, of course, is the fact that the *Desk Encyclopedia* may not be as current as one might require. This is discussed further in part III of this review.

The final section of the "computer program" entry explores trade secret protection. It outlines the requirements for a valid claim of trade secret misappropriation: the computer program must have been kept confidential and that confidentiality must have been breached through improper means.⁵¹ After a discussion of these means, Professor McCarthy explains that custom-made and limited-edition software are generally protectable because they are not mass-marketed and usually are accompanied by confidentiality agreements.⁵² This entry also concludes with case references.

This guided tour through *McCarthy's Desk Encyclopedia* via "computer program" illustrates the accessibility and adaptability of the resource. The novice can learn the basics of the technology and terminology as well as the origins and current status of the legal doctrines protecting software. The more experienced attorney might refer to a specific entry to remind herself of the exact ruling in a key decision, thus saving a trip to the library. Another might use it to field a telephone call requesting a quick opinion. A sophisticated client might study the entries related to software and shrink-wrap licenses in order to have a more meaningful meeting with his attorney to plan strategies for an upcoming software release.

C. Improvements in the Second Edition

In the four years since the publication of the first edition of the *Desk Encyclopedia*, intellectual property has changed considerably. The second edition not only significantly updates existing entries, but adds 70 new terms to reflect new technology, and recent

legislative and case law developments. Some of the new entries act to remedy gaps in coverage in the first edition, particularly in the area of patent law. A few of the major additions are discussed below while others are merely mentioned.

Professor McCarthy explains in his *Preface to the Second Edition* that the most notable event since the first edition was the Trade-Related Aspects of Intellectual Property Rights, Including Counterfeit Goods (TRIPS) Agreement and its incorporation into U.S. law through the Uruguay Round Agreements Act of 1994.⁵³ He explores the trend toward global unification of the intellectual property field in new entries such as "NAFTA," "GATT," "TRIPS," "Trademark Law Treaty," "European Trademark," "World Trade Organization" and "harmonization." For example, the "GATT" and "TRIPS" entries outline the objectives of GATT and its domestic and international impact on intellectual property via the TRIPS Agreement, the creation of the World Trade Organization and the Uruguay Round of multilateral trade negotiations. A clear understanding of these international developments is essential for attorneys whose clients market products globally or might fall victim to counterfeiting, gray market goods⁵⁴ or international infringement. Professor McCarthy has synthesized the huge volume of law and commentary that addresses intellectual property harmonization into a complete, well organized and understandable package that provides the basic, essential information and guides further inquiry.

The changing scope of international intellectual property laws is further explored in other entries. Of particular interest is the series of entries on trademark law, Professor McCarthy's primary area of expertise. The "Trademark Law Treaty," "Trademark Registration Treaty" and "European Trademark" entries explore the efforts toward harmonization of the world's trademark law. The requirements and impact of this trend are vital considerations for clients with wide-ranging product markets. The "European Trademark" section explains in detail the history of the European Community Trademark, its scope, the application procedure and enforcement mechanisms.⁵⁵

Along with terms and concepts specific to intellectual property, the *Desk Encyclopedia* also includes relevant general legal concepts. A significant development in the second edition is its coverage of the increasing popular alternate means for resolving conflicts between parties. Their reduced expense, heightened speed and increased confidentiality make these means attractive alternatives to traditional intellectual property litigation. The second edition includes an "alternate dispute resolution" entry which discusses mediation, arbitration, minitrials and early neutral evaluation and supplies several book references for further study.⁵⁶

In addition to the new entries discussed above and the significant updates to old terms, the second edition includes many new words and concepts. Some originate in recent changes in law or technology, while others have been added to make the coverage of certain topics more comprehensive. To give the reader a taste of the scope of the new material, here is a partial list by practice area. For copyright law: "Copyright Arbitration Royalty Panels," "corporate receipt doctrine," "Digital Audio Recording Technology," "display," "Kaminstein Legislative History Project" and "sweat of the brow." For trademark law: "ambush marketing," "amendment to allege use," "bootleg merchandise," "co-branding," "famous mark," "INTA," "logo" and "Statement of Use." In the area of international law related to intellectual property, new terms include: "apostille" and "Dunkel Text." General entries related to intellectual property include: "due diligence," "multimedia," "syndication rules" and "value-added retailers."

In the area of patent law, new entries include: "Bayh-Dole Act," "embodiment," "equitable estoppel," "inventive step," "march in," "nanotechnology," "new use for old product," "Orphan Drug Act," "prima facie case," "provisional application," "publication of pending patent application," "scarecrow patent," "submarine patent" and "whereby clause." Many of the patent terms new to the second edition are not new concepts in patent law. Their addition brings the *Desk Encyclopedia's* coverage of patent law more in line with the coverage of other areas of law, such as trademark and copyright.

III. ANALYSIS

Professor McCarthy explains that "[m]y basic goal in writing this reference book was to help make intellectual property law understandable and easily accessible, to demystify it. Law that is incomprehensible and inaccessible to all but a few seasoned experts is not the 'rule of law' of a democratic and free society."⁵⁷ The *Desk Encyclopedia* succeeds in this respect and goes on to do even more.

An outstanding attribute of the book is its versatility and usefulness for a range of needs. Its primary value is as a "quick and dirty" reference book to be kept close at hand. Lawyers are frequently called upon to react with swift opinions; the *Desk Encyclopedia* provides an overview sufficient to produce quick preliminary answers without a trip to the library or going on line to consult a treatise or find cases.

While it is true that a seasoned attorney might not find within it anything new about her own field of expertise, the *Desk Encyclopedia* is still an asset in areas where she has less experience. It is often important to know the implications of several areas of intellectual property law for a particular problem. The book is unique in its comprehensive, accessible and fairly equal coverage of the various

disciplines. Even in one's own field, the *Desk Encyclopedia* is handy for refreshing one's memory on specific points of law and leading cases, or for obtaining a description of an unfamiliar case.

The *Desk Encyclopedia* also functions as an introductory text on intellectual property law that allows the pupil to select both the area of study and the sophistication level. Professor McCarthy's skill as an educator is evident in the intuitive organization, clear definitions and helpful examples. While providing underlying theory, he is careful to maintain a practical orientation that shows the reader how to apply the theory to real life situations. A neophyte might look up basic entries to learn about patent, copyright or trademark law and then use the cross-references to solve a specific problem. The book would be particularly useful to new associates starting out in intellectual property practice. A minor criticism in this regard is that there is no index of entries by practice area. Such an index would make the book more useful in a teaching capacity and allow the pupil to be certain she had not missed any specific entries on a subject of interest.

The *Desk Encyclopedia* also saves research time by providing necessary case quotes, statutory references and guidelines for further inquiry. This allows the attorney to plan research strategies instead of spending excessive time searching for a starting point. Finally, it is worth noting that the *Desk Encyclopedia* is relatively cost effective. Law books are expensive to own and maintain and most law firms cannot afford to provide each intellectual property attorney with treatises on trademark, copyright and patent law. While the *Desk Encyclopedia* does not replace these volumes, it may provide answers to many of the same questions while being inexpensive enough to be at the elbow of most attorneys.

Finally, in his introduction to the first edition, Professor McCarthy suggests that the *Desk Encyclopedia* would make a good business gift from the intellectual property attorney to the sophisticated business client.⁵⁸ His intention is not that the book make legal counsel obsolete, but that it be used to enhance communication between attorney and client. The *Desk Encyclopedia* lays a groundwork for mutual understanding of complicated legal and technological concepts.

The principal shortcoming of the *Desk Encyclopedia* lies not in what it currently lacks, but what it may lack in the near future. Intellectual property law changes as technology changes; sometimes this means swift and significant change. Unlike some legal resources, the book is not updated frequently with pocket parts. As discussed in the "computer program" entry section, Professor McCarthy attempts to address this problem by not speculating on the direction the law will take. But, for instance, if a definitive decision on the issue of software patents were to be published next month, the *Desk Encyclopedia* would not refer to this decision until the third edition.

A possible solution to this problem would be for the next edition to include recommended key words to use in on-line searches for the most current cases on a particular topic. This would be a significant undertaking, but might ameliorate concerns about infrequent updates. Nonetheless, a conscientious reader will find that the second edition has ample references to relevant section numbers in treatises that are frequently updated.

IV. CONCLUSION

As ideas, technology, information and entertainment continue to drive the economic growth of the United States, intellectual property lawyers are increasingly relied upon to safeguard that growth, both at home and around the world. Busy with the tasks of anticipating and satisfying a wide range of clients' divergent intellectual property needs, the practitioner often cannot keep up with the flood of commentary, case law and legislation. McCarthy's *Desk Encyclopedia* is a giant step towards keeping the changing law and technology of intellectual property at our fingertips.

11996 Elizabeth E. Launer.

† Candidate for J.D., 1996, Boalt Hall School of Law, University of California, Berkeley; B.A., 1988, San Francisco State University. This reviewer was one of several research assistants to Professor McCarthy during the writing of the second edition.

. BUS. WIRE, Feb. 13, 1996 (quoting Richard L. Beattie, Chairman, Executive Committee, Simpson Thacher & Bartlett).

2. See generally Sandra Torrey, *Economy, Business, Government Fuel Hot Specialties*, WASH. POST, Jan. 1, 1996, at F07; Daniel B. Kennedy, *Prosper Or Perish In '96: It's Up To You*, CHI. DAILY L. BULL., Dec. 19, 1995, at 6; Amy Boardman, *Associates With The Right Stuff; Demand Grows, But Selectively*, LEGAL TIMES, Dec. 4, 1995, at S27; Traci R. Gentilozzi, *Law Firms Striving To*

'Maintain,' MICH. LAW. WKLY., Sept. 4, 1995, at 1; Ann Davis, *What's Hot What's Not*, NAT'L L.J., Aug. 14, 1995, at C1; Susan Gembrowski, *I.P. Lawyers Becoming Hot Ticket Items*, SAN DIEGO DAILY TRANSCRIPT, Aug. 14, 1995, at A1.

3. See sources cited *supra* note 2.

4. Torry, *supra* note 2, at F07.

5. See sources cited *supra* note 2.

6. Gembrowski, *supra* note 2, at A1 (quoting Ned Israelsen of Knobbe, Martens, Olson & Bear).

7. J. THOMAS MCCARTHY, MCCARTHY'S DESK ENCYCLOPEDIA OF INTELLECTUAL PROPERTY 500-01 (2d ed.1995).

8. *Id.* at 502-03.

9. Eric Herman, *Boutiques Hold No Patent On Intellectual Property Practices*, CHI. LAW., Apr. 1995, at 8 (quoting Stephen P. Durchslag of Winston & Strawn).

10. See generally *id.* at 8.

11. Lotus Dev. Corp. v. Borland Int'l, 116 S. Ct. 804 (1st Circuit decision affirmed without opinion by an equally divided Court); 64 U.S.L.W. 3592 (1996) (petition for rehearing denied). The First Circuit decision can be found at 49 F.3d 807.

12. Campbell v. Acuff-Rose Music, 114 S. Ct. 1164 (1994).

13. Qualitex Co. v. Jacobson Prods. Co., 115 S. Ct. 1300 (1995).

14. Markman v. Westview Instruments, 116 S. Ct. 40 (1995) (petition for writ of certiorari granted).

15. Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 134 L. Ed. 2d 95 (1996) (petition for writ of certiorari granted).

16. Asgrow Seed Co. v. Winterboer, 115 S. Ct. 788 (1995).

17. *The Rights of Publicity and Privacy* is the only treatise focusing on the relatively new field of the right of publicity, the inherent right of every person to control the commercial use of her identity.

18. His contributions to intellectual property law have earned him numerous honors. He received the 1965 Watson Award of the American Intellectual Property Law Association, the 1979 Rossman Award of the United States Patent and Trademark Society, and the Jefferson Medal from the New Jersey Intellectual Property Law Association. He delivered the 1995 H.S. Manges Lecture at Columbia University and the 1989 Boal Memorial Lecture, sponsored by the Brand Names Education Foundation, at Northwestern University. In 1994, he was the Biebel & French Distinguished Visiting Scholar in Law & Technology at the University of Dayton. MCCARTHY, *supra* note 7, at 505.

19. *Id.* at 341.

20. *Id.* at 493 app. 1.

21. *Id.* at 495 app. 2.

22. *Id.* at 496 app. 3.

23. *Id.* at 502 app. 4.

24. *Id.* at 504 app. 5.
25. *Id.* at 450-54.
26. "A Latin legal term meaning the same kind or class. It is a rule of statutory interpretation that where general words follow the enumeration of specific terms, the general words are read as applying only to other terms akin to those specifically enumerated." *Id.* at 143.
27. "A Latin legal term literally meaning 'the reason for deciding.' It is the basic principle or rule of law upon which a court rests its written opinion in a decision." *Id.* at 361.
28. *Id.* at 69.
29. *Id.*
30. 17 U.S.C. § 101 *et seq.*
31. Pub. L. No. 96-517 § 10(a), 94 Stat. 3028.
32. *Id.* at 88; 17 U.S.C. § 117 (1980).
33. MCCARTHY, *supra* note 7, at 69-70.
34. *Id.* at 70.
35. Computer Assoc. Int'l v. Altai, 982 F.2d 693 (2d Cir. 1992). The *Altai* abstraction-filtration-comparison test for determining whether any copyrightable expression in a computer program has actually been copied is recognized by courts and commentators as the answer to the long debate over software copyright. *See generally* Mark A. Lemley, *Convergence In The Law Of Software Copyright?*, 10 HIGH TECH. L.J. 1 (1995).
36. Whelan Assoc. v. Jaslow Dental Lab., 797 F.2d 1222 (3d Cir. 1986).
37. MCCARTHY, *supra* note 7, at 417.
38. Johnson Controls v. Phoenix Control Systems, 886 F.2d 1173 (9th Cir. 1989).
39. Brown Bag Software v. Semantec Corp., 960 F.2d 1465 (9th Cir. 1992).
40. Apple Computer v. Microsoft Corp., 35 F.3d 1435 (9th Cir. 1994).
41. Lotus Dev. Corp. v. Borland Int'l, 49 F.3d 807 (1st Cir. 1995), *aff'd without opinion by an equally divided Court*, 116 S. Ct. 804, *reh'g denied*, 64 U.S.L.W. 3592 (1996).
42. MCCARTHY, *supra* note 7, at 254.
43. *Id.* at 254-55.
44. *Id.* at 70.
45. *See* Arrhythmia Research Technology v. Corazonix Corp., 958 F.2d 1053 (Fed. Cir. 1992). The test is based on *In re Freeman*, 573 F.2d 1237 (C.C.P.A. 1978), *In re Walter*, 618 F.2d 758 (C.C.P.A. 1980) and *In re Abele*, 684 F.2d 902 (C.C.P.A. 1982).
46. 450 U.S. 175 (1981).

47. 888 F.2d 1370 (Fed. Cir. 1989).

48. 33 F.3d 1526 (Fed. Cir. 1994).

49. Gembrowski, *supra* note 2, at 1.

50. Examination Guidelines for Computer-Related Inventions, 61 Fed. Reg. 7478 (1996).

51. MCCARTHY, *supra* note 7, at 71.

52. *Id.*

53. *Id.* at v, 184; Pub. L. 103-465, 108 Stat. 4809.

54. Gray market goods are "[g]oods manufactured abroad with the permission of the trademark owner that are imported into the United States without the permission of the trademark owner." MCCARTHY, *supra* note 7, at 194.

55. *Id.* at 154.

56. *Id.* at 12.

57. *Id.* at vii.

58. *Id.* at vii.