

Intellectual Property Law

(Spring 2008 – LL41402)
Boston College Law School
Professor Joseph Liu

Texts

- . Robert Merges, et al., Intellectual Property in the New Technological Age (Revised 4th ed. 2007)
- . Robert Merges, et al., Intellectual Property in the New Technological Age: Supplement (2007)

Guidelines and Requirements

A. Grading

The grade for the class will be based on a final exam, which will most likely be some kind of take-home exam (there is a slight chance that I may change this to an in-class exam, if I find that the logistics don't work out). Either way, the exam will be open-book. In addition, very high-quality participation will result in a half-grade increase (e.g. from B to B+, from B+ to A-, etc.).

B. Participation

Participation in class will be handled using a panel system. You must sign up to be on a panel for two classes. The classes should be spaced apart (i.e. not back-to-back, ideally in different months). Those who are on the panel for a given class will be on call for that class. Those who aren't on the panel for that day are, of course, encouraged to participate as well.

C. Syllabus and Readings

The syllabus below provides a rough working outline of the course. However, because it is difficult to predict exactly how much ground we will be able to cover, there will probably be a number of adjustments (e.g. deletions, additions, etc.) during the course, so you shouldn't rely on it too much. The vast majority of the reading assignments will be in the casebook. In many instances, the casebook will reference statutory provisions found in the supplement, and I will expect you to be familiar with these statutory provisions. In addition, I may periodically distribute supplementary materials in the form of handouts in class.

D. Class Web Site

The class web site is: <http://www2.bc.edu/~liujr/courses/ip08s/index.html>. I have posted there a copy of this syllabus and will later post both the panel schedule and copies of the in-class power point presentations, along with any announcements.

E. Contact Information & Office Hours

E-Mail: liujr@bc.edu
Phone: 617-552-6377
Office: East Wing 313
Hours: Mondays, 3:30-5:00 p.m. or make an appointment

Syllabus

(Note: page numbers in parentheses refer to casebook, unless otherwise noted.)

I. Introduction

A. Philosophical Perspectives (1-24) (skim)

Natural Rights Perspective; John Locke, *Two Treatises on Government*; Problem; Personhood Perspective; Margaret Jane Radin, *Property and Personhood*; Utilitarian/Economic Perspective; Promoting Innovation and Creativity; Problem; Ensuring Integrity of the Marketplace

B. Overview of Intellectual Property (24-31) (skim)

Trade Secret; Patent; Copyright; Trademark/Trade Dress; Problem

II. Copyright

A. Introduction (383-92) (skim)

Brief History of Copyright Protection; Overview of Copyright Regime; Philosophical Perspectives on Copyright Protection

B. Requirements

1. *Originality & Fixation* (392-405)

17 U.S.C. § 102; Feist v. Rural Telephone; Problem; Fixation in a Tangible Medium of Expression; H.R. Rep. No. 94-1476

2. *Formalities* (405-11)

Notice; Publication; Problem; Registration; Deposit; Note on Restoration of Foreign Works

C. Subject Matter

1. *Exclusions (Idea-Expression, Useful Articles)* (411-36)

Idea-Expression Dichotomy; 17 U.S.C. § 102(b); Baker v. Selden; Problem; Morrissey v. Procter & Gamble; Problems; Useful Article Doctrine; 17 U.S.C. § 101; H.R. Rep. No. 94-1476; Brandir v. Cascade Pacific Lumber; Problems; Government Works; Problem

2. *Types of Works (Literary, PG&S, ...)* (436-46)

17 U.S.C. § 102; H.R. Rep. No. 94-1476; Literary Works; Pictorial, Graphic, Sculptural; Problem; Architectural Works; Musical Works, Sound Recordings; Dramatic, Pantomime, Choreographic; Problem; Motion Pictures and Other A/V; Derivative Works and Compilations; Roth Greeting Cards v. United Card; Problems

II. Copyright (cont'd)

D. Ownership & Duration (Initial, Duration, Termination) (446-74)

Initial Ownership of Copyrights; Works for Hire; Community for Creative Non-Violence v. Reid; Joint Works; Aalmuhammed v. Lee; Collective Works; Note on the Rights of Authors and Publishers in Electronic Compilations; Problems; Duration and Renewal; Problems; Division, Transfer, and Termination; Under 1909 Act; Under 1976 Act; Reclaiming Copyrights

E. Exclusive Rights

1. *Reproduction* (474-500)

17 U.S.C. § 106; Right to Make Copies; Copying; Arnstein v. Porter; Problem; Improper Appropriation; Nichols v. Universal Pictures; Steinberg v. Columbia Pictures; Problems; Limitations on Exclusive Right to Copy

2. *Derivative Works* (500-10)

Anderson v. Stallone; Problems

3. *Public Distribution, Display, Performance* (510-19)

The Distribution Right; Problem; Public Performance and Display Rights; Statutory Limits; Problems

4. *Moral Rights* (519-22)

F. Defenses (Fair Use, Other) (522-69)

17 U.S.C. § 107; Harper & Row v. Nation; Problems; Videotaping; Sony v. Universal City Studios; Problem; Photocopying; American Geophysical Union v. Texaco; Parodies; Campbell v. Acuff-Rose Music; Problems; Other Defenses

G. Indirect Liability (569-80)

Sony v. Universal City Studios; Problem

H. Digital Copyright Law (581-616)

Digital Copyright Legislation; Record and Software Rental; Digital Audio Tape Devices; Webcasting; Criminal Enforcement; Anticircumvention; Online Service Providers; Problem; Enforcement; Digital Hardware; Search Engines; MGM Studios v. Grokster; Problem; End Users; Fair Use in Cyberspace; Kelly v. Arriba; Problem

III. Trade Secret

A. Introduction (33-39) (skim)

History; Overview; Uniform Trade Secrets Act; Theory of Trade Secrets

B. Subject Matter (Definition, Reasonable Efforts, Disclosure) (39-62)

Defining Trade Secrets; Metallurgical Indus. v. Fourtek; Problems; Reasonable Efforts to Maintain Secrecy; Rockwell Graphic Systems v. DEV Indus.; Problems; Disclosure of Trade Secrets

C. Misappropriation

1. *Improper Means* (62-67)

E.I. duPont de Nemours v. Rolfe Christopher; Problem

2. *Confidential Relationship* (67-74)

Smith v. Dravo; Problems

3. *Reverse Engineering* (74-80)

Kadant v. Seeley; Problems

4. *Departing Employees* (80-100)

Employee Trade Secrets; Wexler v. Greenberg; Note on Common Law Obligation to Assign Inventions; Problem; Note on Trailer Clauses; Noncompetition Agreements; Note on “Inevitable Disclosure”; Note on Nonsolicitation Agreements; Problem

D. Agreements (101-04)

Warner-Lambert v. Reynolds

IV. Patent

A. Introduction (117-27) (skim)

Historical Background; Overview of Patent Laws; Requirements for Patentability; Rights Conferred by Patent; Theories of Patent Law

B. Elements of Patentability

1. *Patentable Subject Matter* (128-44)

Diamond v. Chakrabarty; Parke-Davis v. H.K. Mulford; Problem; Note on Patenting “Abstract Ideas”; Note on Patenting Business Methods and “Printed Matter”; Problems

2. *Utility* (144-58)

Brenner v. Manson; In re Fisher; Note on Patent Office Utility Guidelines; Problems; Note on Different Types of Utility

3. *Enablement* (158-85)

Procedures for Obtaining a Patent; Disclosure Doctrines; The Incandescent Lamp Patent; Note on “Analog” Claims in Chemical and Biotech Patents; The Gentry Gallery v. Berkline; Note on “Written Description” and Biotechnology; Note on the Best Mode Requirement; Problem

4. *Novelty and Statutory Bars* (185-212)

35 U.S.C. § 102; Nature of Novelty; Rosaire v. National Lead Co.; Note on Inherency Doctrine; Problem; Statutory Bars: Publication; In re Hall; Problem; Statutory Bars: Public Use; Egbert v. Lippmann; Problem; Experimental Use Exception; City of Elizabeth v. Pavement; Priority Rules and First to Invent; 35 U.S.C. § 102(g); Griffith v. Kanamaru; Note on Recent Changes

5. *Nonobviousness* (212-50)

Graham v. John Deere Co.; Combining References; KSR v. Teleflex; In re Vaeck; In re Dembiczak; Note on Nonobviousness and Biotechnology Inventions; Problem; Secondary Considerations

C. Infringement

1. *Claim Interpretation* (250-68)

Proper role of Judge and Jury; Phillips v. AWH

2. *Literal Infringement* (268-74)

Larami Corp. v. Amron

IV. Patent (cont'd)3. *Doctrine of Equivalents* (274-304)

Basic Issues; Prosecution History Estoppel; Festo v. Shoketsu Kinzoku Kogyo Kabushiki; Subject Matter “Disclosed but Not Claimed”; Johnson & Johnson v. R.E. Service; After-Arising Technologies; Problem

4. *Reverse Equivalents; Means-Plus-Function* (304-11)

“Reverse” Doctrine of Equivalents; Equivalents for Means-Plus-Function Claims

5. *Contributory Infringement* (311-16)

C.R. Bard v. Advanced Cardiovascular; Note on Inducement; Problem

6. *Foreign Activities* (316-21)

Microsoft v. AT&T

D. Defenses (Experimental, Inequitable Conduct, Misuse) (321-43)

“Experimental Use” Defense; Inequitable Conduct; Kingsdown Medical Consultants v. Hollister; Patent Misuse; Motion Picture Patents Co. v. Universal Film; 35 U.S.C. § 271(d); Problem; Note on the Scope of the Patent Misuse Doctrine

V. Intersection: Computer SoftwareA. Introduction (971-79) (skim)

Economics of Computer Markets; Market for Computers and Computer Software; Market Failures

B. Copyright1. *Scope* (986-1024)

Protection for Literal Elements of Program Code; Problem; Protection for Non-literal Elements of Program Code; Computer Associates v. Altai; Problems; Protection for Functional Elements and Protocols; Lotus Development v. Borland; Protection for Program Outputs: User Interfaces; Problem

2. *Fair Use and Derivative Works* (1034-54)

Lewis Galoob Toys v. Nintendo; Note on Reverse Engineering; Sega Enterprises v. Accolade

3. *Open Source* (1054-61)

Carver, *Share and Share Alike*

C. Patent1. *Subject Matter* (1061-74)

Is Software Patentable; Note on “Floppy Disk” Claims; State Street Bank v. Signature Financial

2. *Examination and Validity* (1074-76; 1081-87)

Novelty and Statutory Bars; Nonobviousness; Amazon.com v. Barnesandnoble.com

D. Sui Generis (1109-14)

Peter Menell, *Tailoring Legal Protection for Computer Software*

VI. Trademark

A. Introduction (633-40) (skim)

Background; A Brief Overview of Trademark Theory; The Basic Economics of Trademarks and Advertising

B. Subject Matter (640-50)

Trademarks, Trade Names, and Service Marks; 15 U.S.C. § 1127; Color, Fragrance and Sounds; Qualitex v. Jacobson Products; Certification and Collective Marks; Trade Dress and Product Configurations; 15 U.S.C. § 1125

C. Establishment of Rights

1. *Distinctiveness* (650-76)

Classification and Requirements; Zatarains v. Oak Grove Smokehouse; Distinctiveness of Trade Dress and Product Configuration; Two Pesos v. Taco Cabana; Wal-Mart Stores v. Samara Bros.; Problem

2. *Priority* (676-95)

Zazu Designs v. L’Oreal; Note on Geographic Limitations; Note on Priority and Trademark Theory; Note on Secondary Meaning in the Making; Problems

3. *Trademark Office Procedures* (695-708)

Principal vs. Supplemental Register; Grounds for Refusing Registration; Immoral or Scandalous Marks; Problem; Geographic Marks; In re Nantucket; 15 U.S.C. § 1052(a); Marks Which are “Primarily Merely a Surname; Problem; Opposition; Cancellation; Concurrent Registration

4. *Incontestability* (709-15)

Park ‘N Fly v. Dollar Park and Fly

D. Infringement

1. *Trademark Use* (715-25)

1-800 Contacts v. WhenU.com; Problem

2. *Likelihood of Consumer Confusion* (725-37)

AMF v. Sleekcraft Boats; Note on Other Types of Confusion; Problems

3. *Dilution* (737-59)

15 U.S.C. §1125(c); Nabisco v. PF Brands; Note on Dilution and “Search Theory”; Problem; Extension by Contract: Licensing and Franchising; Problem

VI. Trademark (cont'd)4. *Domain Names* (759-77)

Anticybersquatting Consumer Protection Act; *Shields v. Zuccarini*; *People for the Ethical Treatment of Animals v. Doughney*; Uniform Dispute Resolution Procedure

5. *Contributory Infringement* (777-78)6. *False Advertising* (778-87)

*Johnson & Johnson *Merck v. Smithkline Beecham*

E. Defenses1. *Genericness* (787-98)

The Murphy Door Bed Co. v. Interior Sleep Systems; Note on Genericide, Language, and Policing Costs

2. *Functionality* (798-808)

TraFFix Devices v. Marketing Displays; Problems

3. *Abandonment* (808-21)

Major League Baseball Properties v. Sed Non Olet Denarius; Problems; Unsupervised Licenses; *Dawn Donut Co. v. Hart's Food Stores*; Rule Against Assignments in Gross

4. *Nontrademark Use, Parody, First Amendment* (821-33)

Mattel v. MCA Records; Problems

VII. State Intellectual Property and PreemptionA. Misappropriation (853-66)

International News Service v. Associated Press

B. Contract (866-74)

ProCD v. Zeidenberg; Note on “Clickwrap” Licenses and Electronic Commerce

C. Publicity (901-31)

Cal. Civ. Code § 3344; Midler v. Ford Motor; White v. Samsung Electronics; Comedy III Productions v. Gary Saderup; Problem

D. Preemption1. *Copyright* (957-67)

ProCD v. Zeidenberg; Problem; Note on Preemption of Right of Publicity; Note on the Special Case of Moral Rights; 17 U.S.C. § 301(f)

2. *Patent* (947-57)

Kewanee Oil v. Bicron; Bonito Boats v. Thunder Craft Boats; Note on “Electing” Trade Secrets or Patents

VIII. Conclusion