Texts

. Handouts in Class (Periodically)

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 one class. 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 will periodically be distributing supplementary materials in the form of handouts in class.

D. Class Web Site

The class web site is: http://www2.bc.edu/~liujr/courses/ip06s/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: Wednesdays, 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 (1-19)
   Natural Rights Perspective; John Locke, Two Treatises on Government; Problem; Personhood Perspective; Margaret Jane Radin, Property and Personhood; Utilitarian/Economic Perspective; Problem

B. Overview of Intellectual Property (19-26)
   Trade Secret; Patent; Copyright; Trademark/Trade Dress; Problem

II. Copyright

A. Introduction (319-27)
   Brief History of Copyright Protection; Overview of Copyright Regime; Philosophical Perspectives on Copyright Protection

B. Requirements
   1. Originality & Fixation (327-38)
      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 (338-44)
      Notice; Publication; Problem; Registration; Deposit; Note on Restoration of Foreign Works

C. Subject Matter
   1. Exclusions (Idea-Expression, Useful Articles) (344-66)
      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, ...) (366-78)
      17 U.S.C. § 102; H.R. Rep. No. 94-1476; Literary Works; Pictorial, Graphic, Sculptural; Problem; Architectural Works; Dramatic, Pantomime, Choreographic; Problem; Musical Works, Sound Recordings; Motion Pictures and Other A/V; Derivative Works and Compilations; Roth Greeting Cards v. United Card; Problems; Note on Rights in Electronic Compilations
II. Copyright (cont’d)

D. Ownership & Duration (Initial, Duration, Termination) (378-402) (Supp. 39)

Initial Ownership of Copyrights; Works for Hire; Community for Creative Non-Violence v. Reid; Joint Works; Aalmuhammed v. Lee; Collective Works; Problems; Duration and Renewal; Problems; Note 4 (Supp. 39); Division, Transfer, and Termination; Under 1909 Act; Under 1976 Act; Termination of Transfers

E. Exclusive Rights

1. Reproduction (402-26)

17 U.S.C. § 106; 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 (426-36)

Anderson v. Stallone; Problems

3. Public Distribution, Display, Performance (436-43)

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

4. Moral Rights (443-45)

5. Contributory Infringement (445-50)

Fonovisa v. Cherry Auction; Problem

F. Defenses (Fair Use, Other) (450-96)

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. Digital Copyright Law (496-505; 511-517) (Supp. 40-61)

Digital Copyright Legislation; Record and Software Rental; Audio Home Recording Act; Digital Performance Rights; No Electronic Theft Act; Digital Millennium Copyright Act; Enforcement and Judicial Articulation; MGM Studios v. Grokster (Supp. 40-61); Text

H. Other Issues (517-28)

International Issues; Remedies; Sheldon v. MGM; Note on Injunctive Relief
III. Trade Secret

A. Introduction (27-33)

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

B. Subject Matter (Definition, Reasonable Efforts, Disclosure) (33-54)

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

C. Misappropriation

1. Improper Means (54-59)

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

2. Confidential Relationship (59-66)

Smith v. Dravo; Problems

3. Reverse Engineering (66-72)

Chicago Lock Co. v. Fanberg; Problems

4. Departing Employees (72-92)

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

D. Agreements (92-96)

Warner-Lambert v. Reynolds

E. Remedies (96-104)

Uniform Trade Secrets Act, §§2-4; K-2 Ski v. Head Ski; Note on Criminal Trade Secrets Statutes; Note on Federal Criminal Liability for Trade Secret Misappropriation
IV. Patent

A. Introduction (105-20)

Historical Background; Overview of Patent Laws; Requirements for Patentability; Rights Conferred by Patent; Note on Procedures for Obtaining a Patent; Theories of Patent Law

B. Elements of Patentability

1. Patentable Subject Matter (120-36)

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 (136-47)

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

3. Novelty and Statutory Bars (147-72)

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 the GATT Amendments; Note on American Inventors Protection Act

4. Nonobviousness (172-96)

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

5. Enablement (196-215) (Supp. 3-11)

The Incandescent Lamp Patent; The Gentry Gallery v. Berkline; Note on the Development of the Written Description Requirement; University of Rochester v. G.D. Searle (Supp. 3-11); Note on “Analog” Claims in Chemical and Biotech Patents; Note on Best Mode Requirement; Problem

C. Infringement

1. Claim Interpretation (215-26) (Supp. 11-15)

Interpretive Sources; Claim Language; Patent Specification; Prosecution History; Extrinsic Evidence; Canons of Construction; Claim-Specification Relationship; Patentee as Lexicographer; Claim Differentiation; Presumptive Breadth; Interpretive Procedures; Note on the Proper Role of Judge and Jury; Note on Current Trends (Supp. 11-15)

2. Literal Infringement (226-30)

Larami Corp. v. Amron
IV. Patent (cont’d)

3. **Doctrine of Equivalents** (230-51; 259-63)
   
   Note: What is a Limitation?; Note on the Problem of After-Arising Technologies; Problem

4. **Reverse Equivalents; Means-Plus-Function** (263-67)
   
   “Reverse” Doctrine of Equivalents; Equivalents for Means-Plus-Function Claims

5. **Contributory Infringement** (267-74)
   
   C.R. Bard v. Advanced Cardiovascular; Note on Inducement; Problem

D. **Defenses (Experimental, Inequitable Conduct, Misuse)** (274-91) (Supp. 15-23)

   “Experimental Use” Defense; Madey v. Duke (Supp. 15-23); Inequitable Conduct;
   Kingsdown Medical Consultants v. Hollister; Patent Misuse; Motion Picture Patents Co. v. Universal Film; 35 U.S.C. § 271(d); Note on the Scope of the Patent Misuse Doctrine

E. **Other Issues** (291-307) (Supp. 29-37)

   International Patent Law; Procedural Rules; Substantive Harmonization and GATT-TRIPS; Remedies; Injunctions; H. H. Robertson v. United Steel Deck; Damages; Knorr-Bremse v. Dana (Supp. 29-37); Note on the Frontiers of Lost Profits Damages

F. **Design & Plant Patents** (307-318)

   Design Patents; Introduction; Requirements for Patentability; Novelty; Nonobviousness;
   Ornamentality; Functionality; Claim Requirements and Procedure; Infringement; Plant Patents; The Plant Patent Act; The Plant Variety Protection Act

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V. Intersection: Computer Software

A. Introduction (855-62)

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

B. Copyright

1. Scope (869-907)

Protection for Literal Elements of Program Code; Problem; Protection for Nonliteral 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 (917-32)

Note on Reverse Engineering; Sega Enterprises v. Accolade

C. Patent

1. Subject Matter (932; 941-49)

Is Software Patentable; State Street Bank v. Signature Financial

2. Examination and Validity (949-50; 956-61)

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

D. Sui Generis (979-88)

Peter Menell, Tailoring Legal Protection for Computer Software

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VI. Trademark

A. Introduction (529-36)

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

B. Subject Matter (536-46) (Supp. 71-79)


C. Establishment of Rights

1. Distinctiveness (546-72)

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 (572-91)

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 (591-607) (Supp. 79-81)

Principal vs. Supplemental Register; Grounds for Refusing Registration; Immoral or Scandalous Marks; Harjo v. Pro-Football; Pro-Football v. Harjo (Supp. 79-81); Geographic Markets; In re Nantucket; 15 U.S.C. § 1052(a); Marks Which are “Primarily Merely a Surname; Problem; Opposition; Cancellation; Concurrent Registration

4. Incontestability (607-14)

Park ‘N Fly v. Dollar Park and Fly

D. Infringement

1. Likelihood of Consumer Confusion (614-25)

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

2. Dilution (625-29) (Supp. 81-98) (639-47)

H.R. Rep. 104-374; Moseley v. V Secret Catalogue (Supp. 81-88); Playboy v. Netscape (Supp. 88-98); Note on Dilution and “Search Theory”; Problem; Extension by Contract: Licensing and Franchising; Problem

3. Domain Names (647-65)

Anticybersquatting Consumer Protection Act; Shields v. Zuccarini; People for the Ethical Treatment of Animals v. Doughney; Uniform Dispute Resolution Procedure
VI. Trademark (cont’d)

4. Contributory Infringement (665-66)

5. False Advertising (666-75)

Johnson & Johnson *Merck v. Smithkline Beecham

E. Defenses

1. Genericness (675-86)

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

2. Functionality (686-96)

TrafFix Devices v. Marketing Displays; Problems

3. Abandonment (696-710)

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 (710-22)

Mattel v. MCA Records; Problems

F. Other Issues (722-38)

International Issues in Trademark; Note on the “Gray Market”; Remedies; Injunctions; Damages; Infringer’s Gain and Mark Owners Loss; Lindy Pen Co. v. Bic Pen Corp.; Problem; Corrective Advertising; Big O Tire Dealers v. Goodyear Tire & Rubber; Note on the Trademark Counterfeiting Act of 1984

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VII. State Intellectual Property and Preemption

A. Misappropriation (739-52)

International News Service v. Associated Press

B. Contract (752-68)

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

C. Idea Submissions (768-89)

Nadel v. Play-by-Play Toys; Desny v. Wilder; Problem; Note on Institutions for Effectuating Idea Submissions; Problem

D. Publicity (789-818)

Midler v. Ford Motor; White v. Samsung Electronics; Comedy III Productions v. Gary Saderup; Problem

E. Other Claims (Moral Rights; Trespass) (818-31) (Supp. 99-114)

State Moral Rights; Note on Resale Royalties; Trespass to Chattels; eBay v. Bidder’s Edge; Intel v. Hamidi (Supp. 99-114); Problem

F. Preemption

1. Copyright (841-52)

ProCD v. Zeidenberg; Note on the “Additional Element” Test; Note on Supremacy Clause Preemption; Problem; Note on Preemption of Right of Publicity; Note on the Special Case of Moral Rights; 17 U.S.C. § 301(f)

2. Patent (831-41)

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

VIII. Conclusion