

Syllabus

LAW 691

Topic: Real World IP Lawmaking
Spring 2020

Office hours: After class and by appointment

My contact information

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Course Objective

Through the lens of real world experience, with a focus on recent and current events, this one-hour seminar course will use the platform of intellectual property protection to examine the processes by which law is made, and policy implemented, by legislators, courts, administrative agencies, and private actors. The law and policy “soup” these participants stir often yields unexpected — and sometimes, undesirable — results. We will see how and why. Intellectual property law aside, this course will teach lessons that can be cross-applied to other subject areas, in law school and thereafter.

There are no prerequisites for this course. Students need no grounding — or intention to pursue further study or a career — in any aspect of intellectual property law, in order to enjoy and learn from the course. Course materials will consist primarily of recent court decisions and news reports; no books or other materials need be purchased.

Learning Objectives

- Describe how legislators, courts, administrative agencies, and litigants make law and policy — sometimes with unintended consequences.
- Identify examples of how particular legal and policy issues get resolved in different ways depending on who — legislature, court, administrative agency, other — decides them.
- Learn about how different dimensions of the law — substantive legal interests; federal vs. state vs. local control; and others — as well as variables within, and boundaries between, those dimensions, can make differences in law and policy outcomes.

Attendance and Grading

See the Statement of Student Policies. Eighty-five percent of your grade will come from a short, semester-end take-home memorandum. The remainder will come from class participation, including timely arrival for class and consistent attendance.

Materials

You don't need to purchase any books for this course. Recent court decisions and other materials available online, or that I distribute or post on Blackboard, will supply what you need.

Assignments

You should complete each week's assignment, **including Week 1's assignment**, before that week's class.

Week	Subject Matter	Assigned Reading	Optional Reading
1	Course Overview	a. United States Constitution art. I sec. 8 cl. 8, available at heritage.org/constitution#!/articles/1 b. United States Patent Laws (read pp. 1-5 only) c. Copyright Law of the United States (read chapter and appendix list only; scan section list in Chapters 1-5) d. Charles W. Adams, The Court of Appeals for the Federal Circuit: More Than a Patent Court , 49 Mo. L. Rev. 43 (1984) (read text only; not footnotes)	Re a: Nachbar commentary , available at heritage.org/constitution#!/articles/1/essays/46/patent-and-copyright-clause Re d: Timothy J. O’Hearn, Comment, Patent Law Reform via the Federal Courts Improvement Act of 1982: The Transformation of Patentability Jurisprudence , 17 Akron L. Rev. 453 (1984)
2	Software Copyright I – How well does copyright serve as vehicle for software innovation protection?	a. 17 U.S.C. § 101 (“computer program” and “literary works”), § 102, and § 106 b. Oman, Computer Software as Copyrightable Subject Matter: Oracle v. Google, Legislative Intent, and the Scope of Rights in Digital Works , 31 Harv. J.L. & Tech. 639 (2018). c. Google v. Oracle i. Petition for Writ of Certiorari ii. Brief in Opposition	Halaby, Google v. Oracle Heads to the Supreme Court , SWIPLit (Nov. 18, 2019)
3	Patentable Subject Matter I – What subject matter should be patentable?	a. 35 U.S.C. § 101 b. State Street Bank & Trust v. Signature Financial Group , 149 F.3d 1368 (Fed. Cir. 1998) c. Alice Corp. v. CLS Bank , 134 S. Ct. 2347 (2014) (majority op. only) d. Mayo Collab. Servs. v. Prometheus Labs. , 560 U.S. 10 (2012)	<ul style="list-style-type: none"> • Bilski v. Kappos, 561 U.S. 593 (2010) • CLS Bank v. Alice Corp., 717 F.3d 1269 (Fed. Cir. 2013) (en banc) • Gene Quinn, Federal Circuit says software patent claims not abstract, are patent eligible, IPWatchdog (May 13, 2016)

Week	Subject Matter	Assigned Reading	Optional Reading
4	Patentable Subject Matter II – How to decide whether subject matter is patentable?	a. Briefs of the United States as Amicus Curiae <ol style="list-style-type: none"> i. Hikma v. Vanda¹ ii. HP Inc. v. Berkheimer b. Athena Diagnostics v. Mayo Collab. Svcs.: <ol style="list-style-type: none"> i. Petition for Writ of Certiorari ii. Brief in Opposition 	<ul style="list-style-type: none"> • Jones et al., Section 101 in 2019 (April 11, 2019) • Press Release, Sens. Tillis and Coons and Reps. Collins, Johnson, and Stivers Release Section 101 Patent Reform Framework (Apr. 17, 2019) <ul style="list-style-type: none"> ○ Note linked framework. • Halaby, Solicitor General Weighs in on Section 101, Prompts High Court to Grant Review in Athena Diags. v. Mayo Collab. Svcs., SWIPLit (Dec. 9, 2019)
5	Software Copyright II – How much copying is enough, and of what, to be wrongful?	Oracle v. Google , 750 F.3d 1330 (Fed. Cir. 2014)	<ul style="list-style-type: none"> • 17 U.S.C. §§ 101, 106, 501 • Ninth Circuit Pattern Jury Instrs. 17.17, 17.19 • Antonick v. Electronic Arts, 841 F.3d 1062 (9th Cir. 2016)
6	Patent Infringement Venue – Where should a patent infringement suit be heard, and who gets to decide?	a. eBay v. MercExchange , 547 U.S. 388 (2006) (Kennedy concurrence only) b. 28 U.S.C. §§ 1391, 1400 c. TC Heartland v. Kraft Foods Group Brands , 137 S. Ct. 1541 (2017) d. Barker, District Courts Disagree on Venue-Waiver Issues After TC Heartland , SWIPLit (July 26, 2017)	<ul style="list-style-type: none"> • Fourco Glass v. Transmirra Prods., 353 U.S. 222 (1957)
7	Entitlement to Injunctive Relief – Is a right to exclude enough? Should it be?	a. 35 U.S.C. § 283 b. eBay v. MercExchange	Federal Trade Commission, Patent Assertion Entity Activity: An FTC Study , October 2016

¹ Here and throughout, read only the brief, not the appendix or other exhibits.

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8	Disgorgement of Profits – When and under what circumstances?	a. Halaby & Kelly, Disgorgement of Profits as a California Breach of Contract Remedy: Intellectual Property and Other Guideposts , 19 UC Davis Bus. L.J. 151 (2019) b. Romag Fasteners v. Fossil, Inc., et al. i. Brief of Petitioner ii. Brief of Respondents	
9	Trademark – When may words be appropriated from common usage?	a. 15 U.S.C. § 1064(3) b. USPTO v. Booking.com B.V. i. Petition for Writ of Certiorari ii. Brief in Opposition	Halaby, Is “Booking.com” Generic? We’ll Booking.See , SWIPLit (Nov. 11, 2019)
10	Trademarks – Are they speech? Should they be regulated as such?	a. 15 U.S.C. § 1052(a) b. Matal v. Tam , 137 S. Ct. 1744 (2017) c. Iancu v. Brunetti , 139 S. Ct. 2294 (2019)	<ul style="list-style-type: none"> • Halaby & Long, New Model Rule of Professional Conduct 8.4(g): Legislative History, Enforceability Questions, & a Call for Scholarship, 41 J. Legal Prof. 201 (2017) (pp. 237-39, re <i>Tam</i>, only) • NIFLA v. Becerra, 585 U.S. ___ (2018) (Part II only)
11	Fee Shifting – Should it be easy or hard to make the loser pay?	a. 35 U.S.C. § 285 b. Octane Fitness v. ICON Health & Fitness , 134 S. Ct. 1749 (2014) c. Highmark v. Allcare Health Mgmt. , 134 S. Ct. 1744 (2014)	<ul style="list-style-type: none"> • Brooks Furniture Mfg. v. Dutailier Int’l, 393 F.3d 1378 (Fed. Cir. 2005) • Staren & Barker, Supreme Court Holds “Expenses” Exclude PTO Employee Salaries in Civil Action Challenges Under the Patent Act, SWIPLit (Dec. 12, 2019)
12	Enhanced Damages – What standards apply? What about the attorney-client privilege?	a. 35 U.S.C. § 284 b. Halo Elecs. v. Pulse Elecs. , 136 S. Ct. 1923 (2016) c. Halaby, Explaining Broadcom v. Qualcomm: Adverse Inferences in Inducement of Infringement Cases , 2009 d. 35 U.S.C. § 289	

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13	Trade Secrets – Who should regulate “trade secret” protection?	a. Arizona Trade Secrets Act , A.R.S. §§ 44-401 through -407 (scan) b. Orca Comm’ns Unltd. v. Noder , 337 P.3d 545 (Ariz. 2014) c. Krotoski <i>et al.</i> , Landmark Trade Secret Law Establishes New Rights and Remedies , Nat’l Law Review, April 28, 2016	Federal Defend Trade Secrets Act (2016)