

SYLLABUS

LAW 691

Topic: Real World IP Lawmaking
Spring 2021

Office hours: After class and by appointment

My contact information

Andy Halaby
Snell & Wilmer L.L.P.
One Arizona Center
400 E. Van Buren
Phoenix, AZ 85004-2202
Phone: (602) 382-6277
Email: ahalaby@swlaw.com
Twitter/Parler: @andyhalaby

Assistant: Cheri Zwiwacz
Phone: (602) 382-6110
Email: czwiwacz@swlaw.com

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 Outcomes

By the end of this course, you will be able to

- describe specific examples how legislators, courts, administrative agencies, and litigants make IP 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; and
- understand 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.

<u>Week</u>	<u>Subject Matter</u>	<u>Assigned Reading</u>	<u>Optional Reading/Listening</u>
1	Course Overview	a. United States Constitution art. I sec. 8 cl. 8 b. United States Patent Laws (read pp. 1-5 <u>only</u>) c. Copyright Law of the United States (read chapter and appendix list <u>only</u> ; <u>scan</u> section list in Chapters 1-5)	Nachbar commentary , re art. I sec. 8 cl. 8
2	Software Copyright – 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) (read text only, not footnotes) c. Oracle v. Google , 750 F.3d 1330 (Fed. Cir. 2014)	Halaby, Google v. Oracle Heads to the Supreme Court , SWIPLit (Nov. 18, 2019)
3	Software Copyright (cont’d)	Google v. Oracle i. Brief for the Petitioner ii. Brief for Respondent	<ul style="list-style-type: none"> • 17 U.S.C. §§ 101, 106, 501 • Ninth Circuit Pattern Jury Instrs. 17.17, 17.19 • Oral argument audio: Google v. Oracle
4	Trademark – When may words be appropriated from common usage?	a. 15 U.S.C. § 1064(3) b. USPTO v. Booking.com B.V. , 140 S. Ct. 2298 (2020)	
5	Patentable Subject Matter – 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. Halaby, The “Innovative Concept” Test for Patent Eligibility Contravenes Congressional Intent , 61 IDEA 38 (2020) (read text only, not footnotes)	
6	Trademark vs. Patent – Which should protect product configuration?	a. Halaby, “The Trickiest Problem with Functionality” Revisited: A New Datum Prompts a Thought Experiment , 63 N.Y.U. Ann. Surv. Am. L. 151 (2008) (read text only, not footnotes) b. Blumenthal Distrib. v. Herman Miller, Inc. , 963 F.3d 859 (9th Cir. 2020)	

Week	Subject Matter	Assigned Reading	Optional Reading/Listening
7	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)	Fourco Glass v. Transmirra Prods. , 353 U.S. 222 (1957)
8	Entitlement to Injunctive Relief – Is a right to exclude enough? Should it be?	a. 35 U.S.C. §§ 154, 261, 283 b. eBay v. MercExchange (revisit) c. Ryan Davis, <i>Late-Night Relief Bill Will Spur Big Changes to IP</i> , Law360 (Dec. 22, 2020) (to be distributed)	
	Patents – Property? Who decides? (start)	a. Oil States Energy Servs. v. Greene’s Energy Group , 138 S. Ct. 1365 (2018)	
9	Patents – Property? Who decides? (finish)	b. United States v. Arthrex i. Opening Brief of Smith & Nephew and Arthrocare ii. Response brief to be added	
10	Disgorgement of Profits – When and under what circumstances?	a. Romag Fasteners v. Fossil, Inc., et al. (U.S. Apr. 23, 2020) b. Halaby & Kelly, <i>Disgorgement of Profits as a California Breach of Contract Remedy: Intellectual Property and Other Guideposts</i> , 19 UC Davis Bus. L.J. 151 (2019) (read text only, not footnotes)	
11	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, <i>New Model Rule of Professional Conduct 8.4(g): Legislative History, Enforceability Questions, & a Call for Scholarship</i>, 41 J. Legal Prof. 201 (2017) (pp. 237-39, re <i>Tam</i>, only) • NIFLA v. Becerra, 138 S. Ct. 2361 (2018) (Part II only)

<u>Week</u>	<u>Subject Matter</u>	<u>Assigned Reading</u>	<u>Optional Reading/Listening</u>
12	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 , 572 U.S. 545 (2014) c. Highmark v. Allcare Health Mgmt. , 572 U.S. 559 (2014)	Brooks Furniture Mfg. v. Dutailier Int'l , 393 F.3d 1378 (Fed. Cir. 2005)
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)

Zoom Connection Info

Join from PC, Mac, Linux, iOS or Android: <https://asu.zoom.us/j/2296319642>

Or Telephone: Dial (for higher quality, dial a number based on your current location):

US: +1 602 753 0140 or +1 971 247 1195 or +1 213 338 8477 or +1 253 215 8782 or +1 346 248 7799 or +1 669 219 2599
or +1 669 900 6833 or +1 720 928 9299 or +1 301 715 8592 or +1 312 626 6799 or +1 470 250 9358 or +1 470 381 2552
or +1 646 518 9805 or +1 646 876 9923 or +1 651 372 8299 or +1 786 635 1003 or +1 267 831 0333

Meeting ID: 229 631 9642

International numbers available: <https://asu.zoom.us/j/2296319642>

Or iPhone one-tap (US Toll): +16027530140,,2296319642# or +19712471195,,2296319642#

Academic Integrity

All students are subject to ASU Law’s Code of Academic Integrity. The Code “is intended to preserve the integrity of the educational process at the Sandra Day O’Connor College of Law, to promote principles of ethics and professional responsibility, and to ensure an environment in which students can advance their education fairly and confidently. In addition, integrity and honesty are important elements of every state’s bar admissions process.”

“The Code is not self-enforcing, nor can it be enforced by the faculty or administration alone. Its value depends upon the commitment of students to its norms. Not only must students observe it individually, but they should actively discourage their peers from committing any ethical or academic violation. We expect any student who has personal knowledge of an AIC violation to report that violation to the dean’s designee.”

Students are obligated to abide by this Code, which can be found at <https://law.asu.edu/cs/student-resources>.

Students are also subject to ASU’s Student Code of Conduct, which among other things prohibits engaging in conduct that constitutes discrimination or harassment on the basis of race, sex, religion, national origin, ethnicity, disability, age, sexual orientation, gender identity, marital status, or socioeconomic status and may be subject to discipline by the University according to ASU’s Student Code of Conduct Procedures.¹ Anyone who becomes aware of such conduct by a student should contact the law school’s Director of Student Services or report it directly to the Dean of Students Office.²

Classroom Behavior

Respect for the thoughts, ideas, and speech of classmates and faculty is the foundation of the educational process. Threatening behavior in the classroom will be dealt with in accordance with SSM § 104-02, which requires that “all incidents and allegations of violent or threatening conduct by an ASU student (whether on- or off-campus) must be reported to the ASU Police Department and the Office of the Dean of Students.”

The use of electronic devices during class is prohibited with the exception of laptops used for class purposes. Recording the class in any manner without the permission of the instructor is prohibited.

Policy on Threatening Behavior

Students, faculty, staff, and other individuals do not have an unqualified right of access to university grounds, property, or services.

¹ The University’s Student Code of Conduct and procedures can be found at <https://eoss.asu.edu/dos/srr/codeofconduct>.

² Information about the Dean of Students Office may be found at <https://eoss.asu.edu/dos>.

Interfering with the peaceful conduct of university-related business or activities or remaining on campus grounds after a request to leave may be considered a crime.

Disability Accommodations

Per ASU Law and university policies,

The College of Law will provide reasonable accommodations for students with documented disabilities. College of Law accommodations can be made after the student requesting accommodations has met with the Disability Resource Center (DRC) staff and eligibility has been established. Accommodations that fundamentally alter the prescribed course of studies must be approved by the College of Law. Students with disabilities that require accommodation(s) and/or adjustments should contact the law school registrar to make arrangements for the DRC-approved accommodations.

Title IX

Title IX is a federal law that provides that no person be excluded on the basis of sex from participation in, be denied benefits of, or be subjected to discrimination under any education program or activity. Both Title IX and university policy make clear that sexual violence and harassment based on sex is prohibited. An individual who believes they have been subjected to sexual violence or harassed on the basis of sex can seek support, including counseling and academic support, from the university. If you or someone you know has been harassed on the basis of sex or sexually assaulted, you can find information and resources at <https://sexualviolenceprevention.asu.edu/faqs>.

As a mandated reporter, I am obligated to report any information I become aware of regarding alleged acts of sexual discrimination, including sexual violence and dating violence. ASU Counseling Services, <https://eoss.asu.edu/counseling>, is available if you wish discuss any concerns confidentially and privately.

Syllabus Revisions

Information in this syllabus, other than grading and attendance policies, is subject to change with reasonable notice.

Copyright Material

Pursuant to § 304-06 of the Academic Affairs Manual, “all contents of the lectures, including written materials distributed to the class, are under copyright protection.”

In accordance with ACD 304-10, students must refrain from uploading to any course shell, discussion board, or website used by the course instructor or other course forum, material that is not the student’s original work, unless the students first comply with all applicable copyright laws; faculty members reserve the right to delete materials on the grounds of suspected copyright infringement. Students may not share class materials outside the class, including uploading, selling or distributing course content or notes taken during the conduct of the course. Any recording of class sessions is authorized only for the use of students enrolled in this course during their enrollment in this course. Recordings and excerpts of recordings may not be distributed to others.

4816-3158-8563