

Intellectual Property 442A SURVEY COURSE

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Book Used: Copyright, Patent, Trademark and Related State Doctrines, Cases and Materials on the Law of Intellectual Property, Revised 7th Ed., by Paul Goldstein and R. Anthony Reese; Statutory Supp. to same. If you'd like to get any of the cases or statutes on line, you may, but I think both will be good resources for you once you enter practice. Also, while I'm assigning specific cases from the book, I'll supplement with additional material from time to time. Finally, while I realize that no one is likely to do this, reading the *entire* book – not just what I've assigned – will provide you with a wealth of information. Ok, you can stop laughing now.

Class Participation: *Is expected of everyone.* I am going to treat you folks as I do my associates: I'll expect you to be engaged, thoughtful, creative, and astute. This area of the law is all about products of the mind; it is not rote, it's constantly changing and it is a lot of fun. Embrace it and enjoy it. Keeping up on current developments (we can discuss) will help you in this regard.

Course and Reading Outline (And yes, everyone is expected to read and participate in our class discussions.) This is divided into 13 sections, assuming we'll have 13 classes. If we run out of time towards the end, we'll make some adjustments. Please read the cases and the notes following them. I know that seems onerous but the notes often contain some of the most important information when it comes to actually practicing in this field. As you're reading, feel free to agree or disagree with the court's ruling, but notice and articulate your agreement/disagreement. Are there policy reasons for their reasoning or your own? Do those policies still apply in 2013? Remember that judges are just people and sometimes their rulings are *wrong*. If you believe a case is wrongly decided, let's talk about it in class: persuade us!

Class No. 1

1. INTRODUCTION

The Sources and Limits of IP Law

1. Golan v. Holder (p. 2)
2. Notes (p.13)

The nature and functions of IP Law (p.18)

1. Article in the book (you can skim this, but it will give you a good overview and framework for later discussions).

2. U.S. Const. Art 1, § 8

2. STATE LAW RIGHTS IN UNDEVELOPED IDEAS

Rights in Undeveloped Ideas (p. 37-65)

1. *Sellers v. American Broadcasting Co.*, 688 F.2d 1207 (11th Cir. 1982)

2. *Lueddecke v. Chevrolet Motor-Co.*, 70 F.2d 345 (8th Cir. 1943)

3. *Nadel v. Play-By-Play Toys & Novelties, Inc.*, 208 F.3d 368 (2d Cir. 2000)

4. (Optional) *Stanley v. CBS* (Traynor Dissent) [in the Supplement]

3. STATE UNFAIR COMPETITION LAW AND FEDERAL TRADEMARK LAW

Passing Off (p. 66-77; 167-75)

1. *Board of Trade of City of Chicago v. Dow Jones & Co.* (plus notes)

2. *William R. Warren & Co. v. Eli Lilly & Co.*, 265 U.S. 526 (1924)

Note: Jurisdiction and Courts (p. 163-66)

1. Review of Federal Jx & Courts

Class No. 2

Trademark Subject Matter (p. 232-45)

1. *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159 (1995)

2. 15 U.S.C. §1127 [“trademark” “service mark”]

Incontestability & Notes (p. 249-52)

Standards for protection: Use, Intent to Use, Use in Commerce, Nonuse (p. 175-90)

1. *Blue Bell Inc. v. Farah Mfg. Co.*, 508 F.2d 1260 (5th Cir. 1975)

2. *WarnerVision Entertainment, Inc. v. Empire of Carolina, Inc.*, 101 F.3d 259 (2d Cir. 1996)

3. 15 U.S.C. §1051(a)(1), §1051(b)(1), §1051(c) [Stat. Supplement]

5. 15 U.S.C. §1057(c) [Stat. Supp.]

6. 15 U.S.C. §1127 [“commerce” “use in commerce” “abandoned”; Stat. Supp]

Abandonment (p. 206-208)

Standards for Protection: Distinctiveness (p. 190-206; 219-222; 229-232 notes 2-55)

1. Security Center, Ltd. V. First Nat’l Security Centers, 750 F.2d 1295 (5th Cir. 1985)
2. King-Seeley Thermos Co. v. Aladdin Industries, Inc., 321 F.2d 577 (2d Cir. 1963)
3. Application of Sun Oil, 426 F.2d 401 (1970)
4. 15 U.S.C. §1052(e) [Stat Supp.]

Standards for Protection: Deceptive, Geographic, & Confusingly Similar Marks (p. 208-217; 222-232; 214-19)

1. In Re Budge Manufacturing Co., 857 F.2d 773 (Fed. Cir. 1988)
2. In re N.A.D., Inc., 754 F.2d 996 (1985)
3. In re CA Innovations, Inc., 329 F.3d 1334 (2003)
4. 15 U.S.C. §1502 [Stat. Supp. P. 50-52]

Class No. 3

Formalities & Duration: Registration, etc. (p. 245-52)

1. Notes in Book
2. 15 U.S.C. §1501 [Stat. Supp.]
3. 15 U.S.C. §1057(a)-(b) [Stat. Supp.]
4. 15 U.S.C. §1065 [Stat. Supp.]
5. 15 U.S.C. §1115 [Stat Supp.]

Rights (p. 253-289)

1. United Drug Co. v. Theodore, 248 U.S. 90, 96098, 100 (1918)
2. Dawn Donut Co. v. Hart’s Food Stores, Inc., 267 F.2d 358 (2d. 1959)
3. 15 U.S.C. §1072
4. 15 U.S.C. §1114(1)

Infringement (p.350-365; 370-73)

1. Pickle-Rite Co. v. Chicago Pickle, Co. 171 F. Supp. 671 (1959) (p.350)
2. McGregor-Doniger, Inc. v. Drizzle, Inc., 599 F.2d 1126 (1979) (p.356)
3. 15 U.S.C. §1114(1)

Class No. 4

Limitations on Rights (p.289-298)

1. Notes (p.295-298)
2. New Kids on the Block v. News American Publishing, Inc. 971 F.2d 302 (9th Cir. 1992)
3. 15 U.S.C. §1115(b)(4)

Remedies & Secondary Liability

1. Maltina Corp. v. Cawy Bottling Co., 613 F.2d 582 (5th Cir. 1980) (p. 326)
2. Tiffany Inc. v. E-bay Inc., 600 F.3d 93 (2010) (p. 337)
3. 15 U.S.C. §1114
4. 15 U.S.C. §1114(1)
5. 15 U.S.C. §1116(a)
6. 15 U.S.C. §1117

Beyond Traditional Trademark Law: Dilution

1. Mead Data Central, Inc. v. Toyota Motor Sales, U.S.A., Inc., 875 F.2d 1026 (2d Cir. 1989) (p. 266)
2. Moseley v. V Secret Catalogue, Inc., 537 U.S. 418 (2003) (p. 275)
3. 15 U.S.C. §1125(c)

Class No. 5

Limits on Dilution Protection (p. 309)

1. Mattel Inc., v. MCA Records Inc., 296 F.3d 894 (9th Cir. 2002) (p. 309)
2. 15 U.S.C. §1125(c)

Domain Names (p. 323-26)

1. Notes from Book

Section 43(a) & Federal Unfair Competition Law: The Case of Trade Dress (p. 386)

1. Two Pesos Inc. v. Taco-Cabana, Inc., 505 U.S. 763 (1992) (p. 386)
2. Walmart Stores Inc. v. Samara Bros. Inc., 592 U.S. 205 (2000) (p. 397)
3. Traffix Devices Inc. v. Marketing Displays, Inc., 532 U.S. 23 (2001) (p. 404)
4. 15 U.S.C. §1125(a)

Class No. 6

4. STATE TRADE SECRET LAW

Trade Secret (p. 78)

1. Metallurgical Industries Inc. v. Fourtek, Inc., 790 F.2d 1195 (1986) (p. 78)
2. E.I. DuPont deNemours & Co. v. Christopher, 431 F.2d 1012 (1970) (p. 94)
3. Rstmnt (Third) Unfair Competition §§39-43 [Stat. Supp.]
4. Uniform Trade Secrets Act §§1-3 [Stat. Supp.]

Trade Secret: Limits on Protection (p. 105)

1. PepsiCo Inc., v. Redmond, 54 F.3d 1262 (7th Cir. 1995) (p. 106)
2. Reed, Roberts Assoc., Inc. v. Strauman, 40 N.Y.2d 303 (1976) (p. 115)

5. Catch up . . . as we bound to be behind schedule by now.

6. SPECIAL TALK RE BUSINESS DEVELOPMENT SKILLS (aka, “This is All Great, but How Do I Actually Make Money at this Thing?”)

Class No. 7

7. COPYRIGHT

Subject Matter (p. 693)

1. Baker v. Selden, 101 U.S. (11 otto) 99 (1879) (p. 700)
2. 17 U.S.C. §§ 102, 103

3. 17 U.S.C. § 101

Originality (p. 706)

1. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903) (p. 707)
2. *Feist Publications Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991) (p. 711)
3. 17 U.S.C. §§ 101, 103

Formalities (p. 681-686)

1. 17 U.S.C. §§ 410, 411(a), 412
2. Optional: 17 U.S.C. §§4401; 407(a), (b); 408(a), (b)

Works Made for Hire(p. 725)

1. *Community for Creative Non-Violence v. Reid*, 490 U.S. 730 (1989) (p. 727)
2. 17 U.S.C. § 201(a), (b)
3. 17 U.S.C. § 101

Class No. 8

Joint Works

1. *Erickson v. Trinity Theatre, Inc.*, 13 F.3d 1061 (1994) (p. 736)
2. *Aalmahammed v. Lee*, 202 F.3d 1227 (9th Cir. 2000) (not in bk; please print)

17 U.S.C. § 101

Term; Termination of Transfers (p. 758-762)

1. Optional: *Eldred v. Ashcroft*, 537 U.S. 186 (2003)
2. 17 U.S.C. §§ 302, 303, 304(a), (b)

3. 17 U.S.C. § 203

Rights and Limitations (p. 766-782)

1. *Mirage Editions, Inc. v. Albuquerque A.R.T. Co.*, 856 F.2d 1341 (1988) (p. 782)
2. *Lee v. A.R.T. Co.*, 125 F. 3d 580 (1997) (p. 785)
3. 17 U.S.C. §§ 106; 109(a)
4. *Columbia Pictures Industries, Inc. v. Redd Horne, Inc.*, 749 F.2d 154 (1984) (p. 790)
5. *Cartoon Network LP, LLLP v. CSC Holdings, Inc.*, 536 F. 3d 121 (2008) (p. 772)
6. 17 U.S.C. § 101

Class No. 9

Infringement (p. 893-902)

1. *Selle v. Gibb*, 741 F.2d 896 (1984) (p. 902)
2. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (1930) (p. 897)
3. 17 U.S.C. § 501(a)

Fair Use

1. *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539 (1985) (p. 804)
2. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994) (p. 814)
3. Amicus brief re *Cariou v. Prince* – I'll provide.
4. *Cariou v. Prince* (Docket No. 11-1197-cv., United States Court of Appeals, Second Circuit, 2013) – Please print
5. 17 U.S.C. § 107

Class No. 10

Secondary Liability

1. Fonovisa, Inc. v. Cherry Auction, Inc., 76 F. 3s 259 (1996) (p. 834)
2. Sony Corp. of America v. Universal City Studios, Inc., 464 U.S. 417 (1984) (p. 842)
3. Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd., 545 U.S. 913 (2005) (p. 861)

Remedies

1. Stevens Linen Associates v. Mastercraft Corp., 656 F.2d 11 (1981) (p. 874)
2. Andreas v. Volkswagen of America, Inc., 336 F.3d 789 (2003) (p. 877)
3. 17 U.S.C. §§ 412, 502, 504, 505

Class No. 11

8. PATENT

Subject Matter (p. 415-418)

1. Diamond v. Chakrabarty, 447 U.S. 303 (p. 418)
2. State Street Bank & Trust Co. v. Signature Financial Group, Inc. (please print)
3. Bilski v. Kappos (p. 427)
4. 35 U.S.C. §§ 100(a), (b), 101

Novelty (p. 453)

1. Application of Borst, 52 C.C.P.A. 1398 1398 (1965), 345 F.2d 851 (p. 453)
2. 35 U.S.C. § 102(a)

Priority

1. Paulik v. Rizkalla, 760 F.2d 1270 (1985) (p. 478)

2. 35 U.S.C. § 102(g)(2)

Loss of Right: The statutory basis

1. Pfaff v. Wells Electronics, Inc., 525 U.S. 55 (1998) (p. 460)
2. TP Laboratories, Inc. v. Professional Positioners, Inc., 724 F.2d 965 (1984) (p. 466)
3. 35 U.S.C. § 102(b)

Class No. 12

Nonobviousness (p. 485)

1. Stratoflex Inc. v. Aeroquip Corp., 713 F.2d 1530 (1983), 167 L. Ed. 2d 705 (p. 494)
2. KSR International Co. v. Teleflex Inc., 550 U.S. 398, 127 S.Ct. 1727 (2007) (p. 509)
3. 35 U.S.C. § 103(a)(c)

Prior Act

1. Hazeltine Research, Inc. v. Brenner, 382 U.S. 252 (1965) (p. 524)
2. 35 U.S.C. § 102(e)

Utility

1. Brenner v. Manson, 383 U.S. 519 (1966) [optional] (p.531)

Inventorship—NO CASES -- Special Guest (p.541-544)

Enabling Disclosure

1. W. L. Gore & Associates v. Garlock, Inc., 721 F.2d 1540 (1983) (p. 544)
2. 35 U.S.C. §112

Administrative Procedures—No Cases

Rights and Term

1. Paper Converting Mailhine Co. v. Magna-Graphics Corp.. 745 F.2d 11 (1984) (p.568)

2. Wilbur-Ellis Co. v. Kuther, 377 U.S. 422 (1964) (p. 577)
3. 35 U.S.C. §§ 154(a), 271 [skip (d), (e)]

Infringement and Equivalent Rights

1. Graver Tank & Mtg. Co. v. Linde Air Products Co., 339 U.S. 605 (1950) (p. 610)
2. Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co., 520 U.S. 17 (1997) (p.617)
3. Festo Corp. V. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd, 535 U.S. 722 (2002) (p.627)
4. 35 U.S.C. §§ 154(a), 271 [skip 271(d), (e)]

Remedies

1. Rite-lite Corp. v. Kelley Co., Inc., 56 F.3d 1538 (1995) (p.590)
2. 35 U.S.C. §§ 283-86, 287(a)

Federal-State Interaction

1. Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225 (1964) (p. 642)
2. Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234 (1964) (p.645)
3. Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470 (1974) (p.650)
4. Aronson v. Quick Point Pencil Co., 440 U.S. 257 (1979) (p. 664)
5. Bonita Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141 (1989) (p. 670)

Class No. 13

9. RIGHT OF PUBLICITY (page 123-46, including cases; plus several downloads)

1. Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1977) (please download)
2. Carson v. Here's Johnny Portable Toilets (698 F.2d 831, 6th Cir. 1983) (p.123)
3. Midler v. Ford Motor Co. 849 F.2d 460 (9th Cir. 1989) (please print)

4. Comedy III Productions, Inc. v. Gary Saderup, Inc., 25 Cal. 4th 387 (2001)
(please print)
5. Hoffman v. Capital Cities/ABC, Inc., Los Angeles Magazine (please print)
6. Client memo re Net-a-Porter's use of celebrity image for purposes of selling product (I'll provide this).

Final Exam Review: We'll schedule a final review of the material prior to the final. This review will not be mandatory, but will be available for those who want to attend.