Introduction to Intellectual Property Law

Syllabus

Learning Outcomes: This course will provide an overview of current intellectual property law and practice, including patents, trademarks and copyrights. The course will be taught by David Jafari who can be reached via email at djafari@jafarilawgroup.com. Please note that the page numbers listed below refer to the main casebook identified below. The italicized statutory references appearing below form part of the assignment as well, and you should read and study them using either a current supplement or the online resources available through links on [the online course page/course management system]. For some assignments, I will post other required materials. Although this schedule of assignments appears more rigid than you might have expected, it will ultimately prove to be a treasure trove of knowledge and insight that will help you gain not only a theoretical but also a practical understanding of IP law, which is critical in finding an entry point into this evolving and exciting practice area.

Text: Intellectual Property, Cases and Materials, Fifth Edition, by M. LaFrance, G. Meyers, L.A. Lockridge, and David Lange. The following resources will also be used:

- The Manual of Trademark Examining Procedure (TMEP), available online at https://tmep.uspto.gov/RDMS/TMEP/current

Homework and Participation: This will be a discussion-based course. As required by ABA Standard 310, it is expected that you will devote at least six hours, on average, to preparation outside of this three-unit class.

Grading and Final Exam: Grading for the course will be based on in-class participation (25%), a midterm exam (25%), and a final exam (50%). The final exam will be three hours.
I. INTRODUCTION & FOUNDATIONS OF INTELLECTUAL PROPERTY LAW

(Week 1)
A. The “Toll House Cookie” Story—v.1 versus v.2
   http://www.slate.com/articles/life/food/2014/03/who_invented_the_chocolate_chip_cookie_ruth_wakefield_and_no_i
   t_wasn_t_an.html
B. A Few Foundations and Distinctions pp. 3–32

II. TRADEMARK AND UNFAIR COMPETITION LAW

A. The Nature & Function of Trademarks
   1. Introduction pp. 35–41
   2. Validity of Marks—Spectrum of Distinctiveness pp. 41–54
   3. Descriptive Marks & Secondary Meaning pp. 55–61
   15 U.S.C. § 1052
   4. Surnames pp. 61–66
   5. Trade Dress
      a. In general pp. 67–70

(Week 2)
   b. Some specific types of trade dress pp. 71–82
   c. Functionality pp. 82–98

B. Establishing Trademark Rights
   2. Federal Trademark Registration
      §§ 1051(a)-(b), 1052(d), 1057(c), 1062(a)–(b), 1063, 1065, 1115(b)
   3. Federal Registrations, cont’d pp. 149–54
      §§ 1051(d), 1052, 1053, 1054, 1057(a)–(b), 1072

(Week 3)
C. Causes of Action
   1. Infringement via Likelihood of Confusion pp. 155–82
      §§ 1114(1), 1121(a), 1125(a)
   2. Dilution § 1125(c) pp. 215–23
   3. Cybersquatting § 1125(d) pp. 223–28
(Week 4)

D. Defenses and Limitations—§ 1115
   1. Descriptive Fair Use—§ 1115(b)(4) pp. 229–38
   2. Nominative Fair Use
   3. Abandonment—§ 1115(b)(2); definition in § 1127 pp. 238 – 48
   4. Comparative Advertising
   5. Used or Reconditioned Goods/First Sale
   6. First Amendment / Freedom of Speech
   7. Functionality—§ 1115(b)(8) [see II.A.5.c. above]

E. Secondary Liability & Remedies
   2. Remedies—§§ 1116(a) & 1117 pp. 281–84

III. RIGHT OF PUBLICITY AND FALSE ENDORSEMENT

   A. Nature and Scope— Rest. (3d) of Unfair Comp. §§ 46–49 pp. 287–303
   B. Limitations pp. 303–17

(Week 5)

IV. TRADE SECRETS AND IDEA PROTECTION

   A. Trade Secrets (Statutory reading—Uniform Trade Secrets Act) pp. 321–42
      1. Introduction
      2. Protectable Subject Matter & Requirements
      3. Ownership

(Week 6)

   B. Non–Competition Agreements pp. 355–65
   C. Idea Protection
      1. Misappropriation pp. 367–91
      2. Contracts
      3. Unjust Enrichment (or Quasi–Contract)
V. Patent Law

A. Patent Protection for Inventions
      a. Utility Patents
         i. Products pp. 395 – 412 (inc. n.1)
         ii. Processes pp. 436-41 (inc. n.3)
         iii. Utility Requirement pp. 444-50 (7)
      b. Design Patents pp. 453–62

      (Week 7)
   3. Novelty Requirement—§ 102 (both pre- and post-AIA)
      a. Overview and Basic Structure pp. 465-472
      b. Section 102 Public Prior Art pp. 472–82
         i. “Known or Used” or in “Public Use” pp. 482–501
         ii. “Described in a Printed Publication”
         iii. “On Sale”
         iv. Patented
      c. First to File—post-AIA § 102 pp. 501–03
         d. Other Obstacles and Issues in § 102—pre-AIA § 102(e)-(f)

      (Week 8)
      c. Novelty of Design Patents brief class disc’n
   4. Nonobviousness Requirement—§ 103 pp. 520-46
   5. The Written Specification § 112 pp. 548-54

B. Inventorship, Ownership and Prosecution
   1. Inventorship and Ownership pp. 555-700
      a. Nature of Inventorship - § 116
      b. Rights of Joint Owners - §§ 261-62
      c. Invention by Employees
   2. Processes for Obtaining a Patent pp. 577-88
   3. Patent Term - § 154(a)

      (Week 9)
   C. Patent Infringement
      1. Literal Infringement § 27(a) – (c) pp. 589-609
      2. Infringement by Equivalents
3. Infringing Activities
   a. Direct Infringement
   b. Contributing or Inducing Infringement § 271(b)-(c)
   c. Cross-Border Infringement § 271(f)-(g) pp. 637, 645-48
4. Infringement of Design Patents brief class discussion

(Week 10)

D. Defenses & Remedies
1. Defenses
   a. Invalidity § 282(a)-(b) pp. 658-60
   b. Exhaustion pp. 660-69
   c. Good Faith Prior Use § 273 pp. 679-82
   d. Estoppel and Laches
2. Infringement Adjudication 28 U.S.C. § 1400(b) pp. 684-87
3. Remedies
   a. Injunctions - § 283 pp. 692-97
   b. Monetary Relief - §§ 284-86 & 287(a) pp. 705-09

(Week 11)

VI. COPYRIGHT LAW
   1. Fixation Requirement pp. 751-52
   2. Original Works of Authorship pp. 736-50
      a. Originality pp. 762-75; 785-86
      b. Distinguishing Expression from Ideas & Facts pp. 801-08; 811-17
      c. Useful Articles pp. 848-61
   3. Subject Matter Excluded Due to Origin pp. 867-68
B. Establishing Rights
   1. Ownership § 201, 202, 204 pp. 871 – 90
      a. Joint Works
      b. Works made for hire
   2. Formalities & Publication – § 401, 408(a), 411(a) read stats, class discussion
   3. Copyright Term – § 302-305 (skim)

(Week 12)

C. Exclusive Rights and Limitations
   1. Section 106
      a. Reproduction § 106(1) pp. 965-81
      b. Preparation of Derivative Works § 106(2) p. 981; 988-93
c. Public Distribution
   i. Scope of the Right § 106(3) pp. 993-99
   ii. First Sale Limitation § 109(a)-(b)(1) pp. 1037-46

   (Week 13)

d. Public Performance pp. 999-1000
   i. Scope of the Right § 106(4) pp. 1004-05; 1009-23
   ii. Limitations § 110 (skim); § 114(a)-(c) pp. 1064-65

e. Public Display
   i. Scope of the Right § 106(5)
   ii. Limitations §§ 109(c); 110

f. Limited Rights for Sound Recordings - § 106(6) pp. 1028-30

   fair use time]


   (Week 14)

E. Infringement
   1. Concept of Infringement §§ 501, 506(a), 602-603 pp. 1143-49
      pp. 1158-50 (last paragraph) pp. 1159-93

   2. Prima Facie Case

DISABILITY SERVICES STATEMENT:

Western State College of Law provides accommodations to qualified students with
disabilities. The Disabilities Services Office assists qualified students with disabilities
in acquiring reasonable and appropriate accommodations and in supporting equal
access to services, programs, and activities at Western State College of Law.

To seek reasonable accommodations, a student must contact Senior Assistant Dean
Donna Espinoza, Student Services Director and Disabilities Services Coordinator,
whose office is in the Students Services Suite 119. Dean Espinoza’s phone number
and email address are: (714) 459-1117; despinoza@wsulaw.edu. When seeking accommodations, a student should notify Dean Espinoza of her or his specific limitations and, if known, her or his specific requested accommodations. Students who seek accommodations will be asked to supply medical documentation of the need for accommodation. Classroom accommodations are not retroactive, but are effective only upon the student sharing approved accommodations with the instructor or professor. Therefore, students are encouraged to request accommodations as early as feasible with Dean Espinoza to allow for time to gather necessary documentation. If you have a concern or complaint in this regard, please notify Dean Espinoza; or please notify Dean Allen Easley at aeasley@wsulaw.edu, 714-459-1168. Complaints will be handled in accordance with the College of Law’s “Policy against Discrimination and Harassment.”
Western State College of Law – Programmatic Learning Outcomes

Western State College of Law’s curriculum is designed so that every student achieves a level of competency prior to graduation in each of the eight Programmatic Learning Outcomes listed below:

(1) **Doctrinal Knowledge**
Students will demonstrate knowledge of substantive and procedural law in the core curriculum subjects, including Contracts, Criminal Law, Criminal Procedure, Torts, Real Property, Business Association, Evidence, Civil Procedures, Constitutional Law, Estates, Community Property, Remedies, and Professional Responsibility.

(2) **Practice Skills**
Students will demonstrate the development of other law practice skills. Each student’s chosen outcomes within this category will be varied based on the student’s particular interests, coursework and work experiences. They may include, but are not limited to, the following topics: oral presentation and advocacy; interviewing; counseling; client service and business development; negotiations, mediation, arbitration, or other alternate dispute resolution methods; advanced legal research and writing (excluding purely academic papers and the first four units earned in introductory first-year legal research and writing class); applied legal writing such as drafting contracts, pleadings, other legal instruments; law practice management or the use of technology in law practice; cultural competency; collaboration or project management; financial analysis, such as accounting, budgeting project management, and valuation; cost benefit analysis in administrative agencies; use of technology, data analyses, or predictive coding; business strategy and behavior; pre-trial preparation, fact investigation, such as discovery, e-discovery, motion practice, assessing evidence, or utilizing experts; trial practice; professional civility and applied ethics; a law clinic that includes a classroom component; or a legal externship that includes a classroom component.

(3) **Legal Analysis**
Students will demonstrate the ability to identify the factual and legal issues implicated by a fact pattern and to appropriately use cases (including identifying the salient features of an appropriate precedent case, identifying legally significant similarities or differences between the precedent case and a fact pattern and explaining why those are legally significant) and rules (including the ability to connect legally significant facts in a fact pattern to the rule) to predict how a court would decide the issue. Students will also demonstrate the ability to identify and evaluate the public policies of a precedent case or rule, and be able to evaluate how public policy can impact the application of a rule to the legal issue.
(4) **Legal Research**
Students will demonstrate the ability to locate relevant legal authority using a variety of book and electronic resources, and to properly cite to such legal authority.

(5) **Communication**
Students will demonstrate the ability to communicate both orally and in writing in a manner appropriate to a particular task to effectively convey the author or speaker’s ideas. This includes audience sensitivity in written and oral communication (the ability to adopt a tone, style and level of detail appropriate to the needs, knowledge and expertise of the audience); and written communication basic proficiency (the ability to use the conventions of grammar, spelling, punctuation, diction and usage appropriate to the task and sufficient to convey effectively the author’s ideas).

(6) **Advocacy of Legal Argument**
Students will demonstrate the ability, in both oral and written formats, to evaluate the legal, economic and social strengths and weaknesses of a case and use case and statutory authority as well as public policy to persuade others. Making policy-based arguments includes the ability to identify and evaluate the public policies of a precedent case or rule and their implications, and be able to assert such appropriate arguments to support a particular application or distinction of a precedent case to a legal controversy or a particular resolution of the application of a rule to the legal controversy.

(7) **Client Sensitivity and Cultural Competency**
Students will demonstrate an awareness of clients’ needs and goals, including a sensitivity to clients’ background and circumstances (including, but not limited to, socio-economic, gender, race, ethnicity, educational, disability and/or religious background(s)), the ability to make decisions that reflect an appropriate focus on those needs and goals, and awareness that cultural issues may affect the relevance of facts and application of the law.

(8) **Legal Ethics**
Students will demonstrate the ability to identify ethical issues in law practice contexts and make appropriate decisions to resolve such issues.
Argosy University

Institutional Learning Outcomes:

1. **Analytical Reasoning**
   Analyze issues objectively, interpret and synthesize data and ideas, and develop feasible, flexible, and creative solutions to real world problems

2. **Effective Communication**
   Identify audiences, assess information provided, interpret needs, and present relevant information using appropriate written, oral, and listening skills and media to meet the needs of the situation

3. **Information Competency**
   Gather, evaluate, and ethically use information from a variety of relevant technological and library resources to make decisions and take action

4. **Interpersonal Effectiveness**
   Develop individual and group interpersonal skills to improve and foster participation and interaction critical for achieving individual and group goals

5. **Personal and Professional Integrity and Ethical Behavior**
   Demonstrate a multi-dimensional awareness of individual and social responsibility to act ethically and with integrity in a diverse, global society.

6. **Professional Competence**
   Apply skills appropriate to program objectives and employ critical reasoning to contribute to one's field and profession