

Introduction to Intellectual Property Law Spring 2022 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 Patent Examining Procedure (MPEP), available online at <https://www.uspto.gov/web/offices/pac/mpep/index.html>
- The Manual of Trademark Examining Procedure (TMEP), available online at <https://tmep.uspto.gov/RDMS/TMEP/current>
- The Compendium of U.S. Copyright Office Practices, Third Edition, available online at <https://www.copyright.gov/comp3/comp-index.html>

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.women-inventors.com/Ruth-Wakefield.asp	
	http://www.slate.com/articles/life/food/2014/03/who_invented_the_chocolate_chip_cookie_ruth_wakefield_and_no_it_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	
	1. Common Law Trademark Use	pp. 99–117
	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
	D. Defenses and Limitations— § 1115	
	1. Descriptive Fair Use— § 1115(b)(4)	pp. 229–38
		(Week 4)

2. Nominative Fair Use	
3. Abandonment—§ 1115(b)(2); <i>definition in § 1127</i>	pp. 238 - 48
4. Comparative Advertising	pp. 248–62
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	
1. Secondary Liability	pp. 263–80
2. Remedies—§§ 1116(a) & 1117	pp. 281–84
III. RIGHT OF PUBLICITY AND FALSE ENDORSEMENT	
A. Nature and Scope— <i>Rest. (3d) of Unfair Comp. §§ 46–49</i>	pp. 287–303
	(Week 5)
B. Limitations	pp. 303–17
IV. TRADE SECRETS AND IDEA PROTECTION	
A. Trade Secrets (Statutory reading— <i>Uniform Trade Secrets Act</i>)	pp. 321–42
1. Introduction	
2. Protectable Subject Matter & Requirements	
3. Ownership	
4. Misappropriation & Defenses	pp. 343–55
	(Week 6)
5. Remedies	
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	
1. Introduction— <i>28 U.S.C. §§ 1295 & 1338</i>	
2. Patentable Subject Matter— <i>35 U.S.C. §§ 100, 101, 161 & 171</i>	
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
3.	Novelty Requirement— § 102 (both pre- and post-AIA)	(Week 7)
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”	
ii.	“Described in a Printed Publication”	pp. 482–501
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)
e.	Novelty of Design Patents	<i>brief class disc’n</i>
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)	
C.	Patent Infringement	
1.	Literal Infringement § 27(a) – (c)	pp. 589-609
2.	Infringement by Equivalents	
3.	Infringing Activities	pp.621-35
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	<i>brief class discussion</i>
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
VI.	COPYRIGHT LAW	
A.	Subject Matter of Copyright - 17 U.S.C. §§ 102-103	pp. 729-35
1.	Fixation Requirement	pp. 751-52 (Week 11)
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 (Week 12)
a.	Joint Works	
b.	Works made for hire	
2.	Formalities & Publication – § 401, 408(a), 411(a) <i>read stats, class discussion</i>	
3.	Copyright Term – § 302-305 (skim)	
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
d.	Public Performance	pp. 999-1000 (Week 13)
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
2.	Section 106A Moral Rights [<i>TBD if time permits</i>] - § 106A [<i>for expand fair use time</i>]	
D.	Fair Use – § 107	pp.1095-1128 [<i>Helpful for practice analysis: pp. 1129-31, nn.8-12</i>]
E.	Infringement	
1.	Concept of Infringement §§ 501, 506(a), 602-603	pp. 1143-49

(Week 14)
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.