

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 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://tmept.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%) and a final assignment (75%).

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 pp. 67–70
 - a. In general

(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

(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 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— *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
 - 4. Misappropriation & Defenses pp. 343–55

(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

1. Introduction—**28 U.S.C. §§ 1295 & 1338**
2. Patentable Subject Matter—**35 U.S.C. §§ 100, 101, 161 & 171**
 - 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”
 - 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 *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 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 *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

- A. Subject Matter of Copyright - **17 U.S.C. §§ 102-103** pp. 729-35
 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; pp. 1009 – 1023
 - 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 [*TBD if time permits*] - **§ 106A**
[*for expand fair use time*]

- D. Fair Use – **§ 107** pp.1095-1128
[*Helpful for practice analysis: pp. 1129-31, nn.8-12*]

(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, socioeconomic, 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.

Requirements for Students in Zoom Sessions:

Find a dedicated quiet space to attend Zoom sessions, to minimize the chances that you will be disrupted during the session.

Arrive to class early and dressed as you would to attend an in-person class.

Your camera must be turned on for the duration of the class. If desired, you can use the background settings in Zoom to create an artificial background that blocks the view of your space while still allowing you to be seen on camera.

Come prepared, as you would for an in-person class. Participation in Zoom classes is as important as it is during an in-person class session.

Do not multitask – stay focused on the class discussion – do not wander in and out of the Zoom session.

If you have to miss a Zoom session, or arrive late or leave early, notify the professor in advance, as you would for an in-person class.

If you have connectivity issues, whether it be long-term or short-term, that impact your ability to participate (e.g., if you are limited to dial-in without video), notify your professor so other accommodations can be explored.

Do not post screenshots or recordings of any Zoom classes on social media. Such actions would constitute a violation of the Student Honor Code. If you need access to a recording of the Zoom session, please contact your professor.

Sign into Zoom with the name under which you are registered for class. If you prefer to be called by a different name or nickname, please notify your professor in advance so you are not marked absent.

Unless your professor instructs you otherwise, mute your microphone when you are not speaking. Unmute to speak or to ask or answer questions.

Zoom classes are not on YouTube or Netflix. You should be actively engaged in answering questions, taking notes, writing down questions you wish to ask later during class or during office hours, etc. This will not only help you stay engaged and participating in class, but it will also help your learning in the online format.

If you are using your computer to take notes and/or using an e-casebook, remember that you may not be able to easily switch between those apps and the Zoom session. This could undermine your ability to pay attention to the class discussion. Figure out how you will resolve that technological issue before your first class session and consider possible modifications to your normal note taking style (e.g., handwritten notes) or using a two-screen set-up.

Zoom has a number of tools available to you as a student: yes/no symbols, raise hand and thumb icons, share screen (with permission of the professor), chat windows, etc. Please familiarize yourself with those tools before class so that you can use them as requested by the professor. Your professor will inform you about the ways in which you should use these tools in that particular class.

Professors may use a number of interactive functions in Zoom to engage with students, e.g., polling questions, breakout rooms, as well as asking you to share your screen, type in the chat window. Like being called on in a live classroom, you are expected to participate fully in these activities and functions, i.e., answer polling questions, speak with your classmates in breakout groups, share your screen as requested, etc.