

LAW-670-001: Intellectual Property Law

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Overview

This is a survey course of intellectual property (IP) law, the branches of law that provide exclusive rights over information. It covers the major forms of IP: trade secrets, patents, copyrights, trademarks, and rights of publicity. We will discuss the theoretical and policy justifications for these legal systems, the types of information that each system involves, and how IP rights are obtained, infringed, and litigated.

Students who complete this course will be able to:

- Characterize the major doctrines of intellectual property and apply their general rules.
- Provide useful strategic advice to clients looking to protect information or to respond to potential intellectual property assertion.
- Understand theories and policies behind intellectual property law, and apply these to legal questions and policy debates.
- Explain intellectual property law and theory to clients and others unfamiliar with the field.

This course has no prerequisites and is intended for a wide audience. For students with no intellectual property background, this course will provide an introduction to the law and key issues. Students intending to focus on a specific

area of intellectual property may also find this course helpful to round out their knowledge of the other areas.

A bit about me: I am a former patent attorney who worked primarily in computer software technologies, as both a litigator and a patent prosecutor. For the last ten years, I have been at nonprofit organizations working in intellectual property policy. In this capacity, I have written *amicus curiae* briefs in key patent and copyright cases, commented on legislation, and studied the potential effects of changes to intellectual property law.

Course Logistics

Meetings: Mondays and Wednesdays, 8:00–9:20 PM.
Room: N102.
Prerequisites: None.
Credit hours: 3.

Contact Info

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I am happy to meet in person or virtually; just send me an email to set up a time. I will also try to set up regular office hours.

Materials

The textbook for this course is Peter S. Menell, Mark A. Lemley, Robert P. Merges & Shyamkrishna Balganesh, *Intellectual Property in the New Technological Age* (2022), vols. I–II.

If you are looking for a hornbook, I would recommend James Grimmelman, [↗](#) (ver. 1.1, Aug. 2017), particularly the introductory text sections and discussions of cases. It is also free.

Grading and Evaluation

Your grade will primarily be based on the results of a final examination. It will be a scheduled, three-hour final examination at the end of the semester. The examination will consist of two hours of essay questions and one hour of short-answer questions. The examination will be “open materials/closed Internet,” meaning that students may use any materials they bring with them (including digital materials) but access to the Internet during the examination is prohibited.

I may adjust grades up or down by one step (e.g., B+ to A- or B) based on your preparation for and participation in class. Good participation demonstrates engagement with the subject matter of the course and contributes to your fellow students’ learning. Discussions via email, participation in group in-class exercises, and conversations during office hours will all be considered part of class participation.

Class Groupings

Students will be organized into four groups, each comprising about a quarter of the class. As noted in the schedule below, one or two groups will be responsible for initial discussion of the readings and problems for each day. Students in the on-call group should be prepared to summarize the key facts of cases, explain holdings and legal analysis, apply those holdings to hypotheticals, and analyze assigned problems.

If you are absent or otherwise unable to participate on a day to which your group is assigned, you will be temporarily assigned to the group for the next class, but will otherwise retain your initial group assignment for future classes.

If your group is not on call for a given day, you are still responsible for doing the readings and being prepared to engage in the discussion. I will initially call on students within the group assigned for a day to open the discussion of a case or problem, and then will call on others in the class for further conversation.

Schedule

This course is generally structured as follows. After a brief overview of intellectual property in general, we will discuss each of the major fields of IP law in sequence. The survey of each field generally traces the lifecycle of the IP right: the subject matter covered by the field, procedures and requirements for obtaining the right, the scope of infringement, and defenses. For most of the IP fields, the last day of discussion will include an introduction to a contemporary policy debate or issue.

The last few classes will consider general themes and trends across all of the IP fields, allowing us to take stock of the similarities and differences among different types of IP. In these classes, we will consider doctrinal concepts that are generally common to all types of IP, and we will see how the different types of IP overlap and interact when applied to industries and technologies.

Theory and Types of Intellectual Property

January 9—Theories and principles of IP protection. Overview of types of IP.

Read: Chapter I, pages 1–40. You can skim or skip the Comments and Questions sections, as well as the problems. Focus on I.A.1, I.A.5, and I.B.

Prepare: Bring a T-shirt, if you would like to learn a way of folding it.

Trade Secrets

January 11—Subject matter. Consequences of disclosure. (Group 1)

Read: Chapter II.A.3, pages 49–52.

– Chapter II.B, pages 52–83.

Prepare: Problems II-2, II-3.

January 16—**NO CLASS:** Martin Luther King Jr. Day.

January 18—Misappropriation. Reverse engineering. (Group 2)

Read: Chapter II.C–II.D, pages 83–111.

Prepare: Problems II-9, II-12, II.13.

January 23—Trade secrets and employment. Introduction to IP remedies. (Group 3)

Read: Chapter II.F.1, .3–.4, pages 116–118, 124–145.

– Chapter II.G.1–.2, pages 145–153.

Prepare: Problem II-18.

Patents

January 25—Overview of patents. How to read a patent. Claim construction. (Group 4)

Read: *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989), [↗](#).

Focus on the description of the purposes of patents, at 146–152.

– Chapter IV.A.1, pages 169–174 (history of patents).

– *Sealed Crustless Sandwich*, U.S. Patent No. 6,004,596 (issued Dec. 21, 1999), [↗](#).

January 30—Requirements for patentability: novelty. (Group 1)

Read: Chapter III.B.1.ii–.vii (skip .i, .v, and .vi), pages 182–183, 185–202, 214–219.

Prepare: Problems III-2, III-3. Do not apply pre-AIA law; assume for purposes of these problems that the AIA applies to all patent filings.

February 1—Requirements for patentability: obviousness and subject matter. (Group 2)

Read: III.B.2, pages 220–246. Don't spend too much time on the technologies at issue in the cases; focus on the legal principles. **Update:** I have uploaded shorter edited versions of these cases to Canvas.

– *Millennium Pharm., Inc. v. Sandoz Inc.*, 862 F.3d 1356, 1361–1363, 1364–1370 (Fed. Cir. 2017), [↗](#) (sections I.A–I.B, II.A) (also on Canvas). The key facts are as follows: Bortezomib is a useful cancer drug but it is unstable. Freeze-drying (lyophilizing) bortezomib with a chemical called mannitol makes it stable; that's what the patent covers. It was well-known that freeze-drying with a bulking agent was a way to make a drug stable; mannitol was one of a few well-known bulking agents. Yet the combination unexpectedly produced a new chemical (the "ester") that was especially stable. Is the patent obvious?

– *Alice Corp. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014), [↗](#).

Prepare: The *Millennium* case facts, as a problem.

February 6—Obtaining a patent. Written description, enablement, prosecution. (Group 3)

Read: Chapter III.B.4 (skip *O'Reilly v. Morse*), pages 257, 267–287.

- Chapter III.A.2.iii, pages 177–181.
- Optionally: *How Amazon Got a Patent on White-Background Photography*, *Ars Technica* (June 10, 2014), [↗](#).

Prepare: Problem III-8.

February 8—Infringement of patents, indirect infringement. (Group 4)

Read: Chapter III.E.1.ii, III.E.2, pages 389–418.

Prepare: Problem III-17.

February 13—Disputing patents. Litigation, administrative procedures. (Group 1)

Read: Chapter III.C.2, pages 332–337.

- *When Patents Attack!*, *This Am. Life* (July 22, 2011), [↗](#) (Act One, about 30 minutes).
- Optionally: J. Jonas Anderson & Paul R. Gugliuzza, *Federal Judge Seeks Patent Cases*, 71 *Duke L.J.* 419 (2021), [↗](#). If you found the podcast episode interesting, this article has the details and the legal analysis.

Copyrights

February 15—History and overview of copyrights. Introduction to originality. (Group 2)

Read: Chapter IV.A, pages 519–528.

- *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 519–21, 525–27 (1994), [↗](#).
- *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 342–51, 361–64 (1991), [↗](#) (sections I, II.A, III). Do not use the casebook; it omits the best parts.

February 20—More on originality. Fixation and formalities. Copyrightable subject matter. (Group 3)

Read: Chapter IV.B.1 (comments and questions), pages 535–542.

- Chapters IV.B.2–.3 (skip comments and questions), pages 543–544, 549–555.
- Chapter IV.C.1, pages 556–566.

Prepare: Problems IV-3, IV-5.

February 22—The idea–expression dichotomy. (Group 4)

Read: Chapter IV.C.2 (skip *Lotus v. Borland*), pages 566–574, pages 586–590.
– *Bikram’s Yoga Coll. of India, LP v. Evolution Yoga, LLC*, 803 F.3d 1032, 1034–44 (9th Cir. 2015), [↗](#).

Prepare: Problem IV-12.

February 27—Copying and substantial similarity. Exclusive rights. (Group 1)

Read: Chapter IV.E.1.i.a.1–.2, pages 660–685.
– *DC Comics v. Towle*, No. 13-55484, slip op. at 10–19, 29–30 (9th Cir. 2015), [↗](#) (section II.A, appendix).

Prepare: Problems IV-29, IV-31.

March 1—Fair use. (Group 2)

Read: Chapters IV.F.1.i–.ii (just the introduction), pages 796–798.
– Chapter IV.F.1.ii.b (just the case description), pages 801–802.
– Chapter IV.F.1.iii.a (skip *Dr. Seuss v. ComicMix*), pages 805–819, 830–843.

Prepare: Problems IV-43, IV-44.

March 6—Copyright law and new technologies. (Group 3)

Read: Chapter IV.E.1.iv, pages 763–765 (anti-circumvention).
– Cong. Research Serv., *Digital Millennium Copyright Act (DMCA) Safe Harbor Provisions for Online Service Providers: A Legal Overview* (2020), [↗](#).
– Chapter IV.E.2.ii, pages 778–796 (*Grokster*).
– Chapter IV.F.1.iii.c, pages 859–862 (*Google Books*).

Trademarks

March 8—History and overview of trademarks. Subject matter of trademarks. Distinctiveness. (Group 4)

Read: Chapter V.A–V.C.1.i, pages 930–956.

Prepare: Problem V-1.

March 13–15—**NO CLASS:** Spring Break.

March 20—Genericness of marks. Functional marks. (Group 1)

Read: Chapter V.C.1.ii–.iii, pages 956–975.

– Chapter V.C.1.v, pages 989–1003.

Prepare: Problems V-6 to V-8.

March 22—Priority. Infringement and likelihood of confusion. (Group 2)

Read: Chapter V.C.2.i–.iv, pages 1004–1017.

– Chapter V.D.1–V.D.2, pages 1043–1057.

Prepare: Problems V-13 and V-14, pages 1084–1085.

March 27—Defenses to infringement. (Group 3)

Read: Chapter V.E.1, pages 1134–1149.

– Chapter V.E.3, pages 1151–1166.

Prepare: Problems V-22 and V-23, pages 1168–1170.

March 29—Trademarks and e-commerce. (Group 4)

Read: Chapter V.D.4–V.D.5, pages 1104–1118.

– Chapter V.D.3.iv.a, pages 1071–1082.

– Amazon, *Brand Protection Report* (June 2022), [↗](#).

Personality Rights

April 3—Right of publicity. (Group 1)

Read: Chapter VI.D (skip the final set of comments and questions), pages 1266–1296.

Bringing It Together

April 5—Graphic designs, part 1: Copyrights and trade dress for designs. (Group 2)

Read: Chapters IV.C.1.ii, .2.ii, pages 558, 590–614 (copyrights).

– Chapter V.B.3, page 941 (trade dress, as a refresher).

– Chapter V.C.1.iv, pages 976–989 (product design trademarks).

April 10—Graphic designs, part 2: Design patents. (Group 3)

Read: Chapter III.H.1–.3, pages 474–500.

April 12—Remedies. (Group 4)

Read: Chapter III.G.1, pages 449–458.

- *Virnetx, Inc. v. Cisco Sys., Inc.*, 767 F.3d 1308, 1326–28 (Fed. Cir. 2014), [↗](#) (section V.A) (patent royalties).
- Chapter IV.G.2.i–.ii, pages 902–909 (copyright damages).
- Chapter V.F.2.ii.a, pages 1187–1188 (criminal trademark liability).
- Chapter III.H.4.ii, pages 501–503 (design patent damages).

April 17—Exhaustion and first sale doctrines. (Group 1)

Read: *Impression Prods., Inc. v. Lexmark Int’l, Inc.*, 137 S. Ct. 1523, 1528–35 (2017), [↗](#) (sections I–II) (patents).

- Chapter IV.E.1.i.c.2, pages 719–731 (copyrights).
- *Au-Tomotive Gold Inc. v. Volkswagen of Am., Inc.*, 603 F.3d 1133, 1134–39 (9th Cir. 2010), [↗](#) (sections I, III.A).

April 19—Computer software. (Group 2)

Read: *Ultramercial, Inc. v. Hulu, LLC*, 722 F.3d 1335, 1337–38, 1349–54 (Fed. Cir. 2013), [↗](#) (sections I, V).

- *Ultramercial, Inc. v. Hulu, LLC*, 722 F.3d 709, 711–17 (Fed. Cir. 2014), [↗](#) (optionally read the concurrence).
- Chapter IV.F.1.iii.c (just *Google v. Oracle*, skip sections III–V), pages 862–863, 866–874.

April 24—International IP law and policy. (Groups 3 and 4)

Read: Chapter III.I, pages 505–510 (patents).

- Chapter IV.H.1–IV.H.2.ii, pages 914–920 (copyrights).
- Chapter V.G, pages 1189–1195 (trademarks).
- Cong. Research Serv., *World Trade Organization: “TRIPS Waiver” for COVID-19 Vaccines* (Aug. 31, 2022), [↗](#).

Prepare: The Issues for Congress in the CRS report.