INTRODUCTION TO INTELLECTUAL PROPERTY
SPRING 2010
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Introduction and Overview

The communications and information technology revolution(s) of the past several decades have transformed intellectual property law, once a rather tranquil and uninteresting legal backwater, into a major international battleground. An ever-increasing fraction of the world's wealth is now embodied in intangible things – *e.g.,* the sequence of the rice genome, the search algorithm for finding web content, the chemical formulas of Prilosec,™ Viagra™ or Prozac,™ the names "Prilosec," "Viagra," and "Prozac," the Harry Potter plot line and characters, the best way to run an online auction, the words "Just do it" . . . – rather than the tangible things (like land, or factories, or paper clips, or airplanes, or automobiles) with which the law has been dealing for a long time.

Intellectual property law consists of the doctrines through which the legal system controls (and/or allows private parties to control) these intangible things: how they can (or cannot) be "owned," how they are (or are not) protected against duplication or appropriation by others, the rights that owners do (or do not) have with respect to them, the ways that they can (or cannot) be transferred to others, and the like.

This course will survey three of the major bodies of law – copyright, patent, and trademark law – traditionally grouped together under the rubric of "intellectual property." We will focus on the major doctrinal underpinnings of each of these sub-fields, the similarities and differences among them, and the similarities and differences in the way the law treats "intellectual," as opposed to tangible, property. Because all three bodies of law are governed by federal statutes (the Copyright Act, the Patent Act, and the Lanham Act, respectively), we will use our exploration of these legal domains as an opportunity to discuss techniques of statutory construction -- the way(s) that courts (and lawyers) extract meaning from complex and often obscure statutory texts.

We will keep technological details to a minimum; although no IP class can *completely* eliminate all technological matters, if only because some of the cases (particularly in the patent area) cannot be completely understood without some understanding of the technology involved, I can assure you that no special technological expertise is required to understand this material.

Housekeeping Details

My office number is 204-4539. I much prefer communicating by email; my address is David.Post@temple.edu. Feel free to email me with any questions or

comments you have concerning the course (or intellectual property generally); when you do so, put the words "IP course" in the subject line of your message; I get several hundred emails a day, and I am much more likely to read and to respond to one expeditiously if I know that it comes from a student in this class.

My office is in room 622 (Klein), and my office hours are Mondays 2-4 and Tuesdays 10-12 (or by appointment). I'm always happy to set up an appointment to meet with you at other times if these are not convenient, and you should feel free to drop in if I'm around my office at other times.

Exam and Other Requirements

There will be a 3 ½ HOUR OPEN BOOK IN-CLASS EXAMINATION, consisting of around 6 – 12 short essay questions (one or two paragraphs each. I have posted a great deal of material from prior exams (including sample answers, actual student answers (good and bad), and the like) on Blackboard (check the "Course Documents" section), and we will have ample opportunity this semester to discuss in class the makings of a good (and a not-so-good) exam answer.

There will also be a small number of short writing assignments, as noted on the syllabus below. These are required, but they will not be graded; failure to turn one in on time will result in an automatic 1-step decrease in your final grade, but other than that they will have no effect on your grade in the course. The purpose of these assignments is two-fold: for you to get some writing practice, and for me to get an overall sense of how well people are handling and comprehending the material that we are covering.

I expect all students to attend all classes. Our class meeting is a professional obligation of yours (and of mine). I understand that there may be occasions when you can't make it to class for one reason or another, just as there may be occasions when I can't make it to class for one reason or another. If I am unable to make it to class, I will do my best to let you know, as far in advance as possible; if you are unable to make it to class, please do me the reciprocal courtesy and do your best to let me know, as far in advance as possible.

I also expect all of you, obviously, to do the reading for each class. You will get very little (often nothing at all) out of the class discussion if you do not. We move through this material at a rapid pace; if you fall behind, it will take considerable effort to catch up. The best strategy is to try not to fall behind. I will call on people, at random, throughout the semester. Class participation from everyone is encouraged, but will have no effect on your final grade in the course.

Books and Readings

We do not use a Casebook in this class. All readings are available on Blackboard. The readings consist of (a) full-text (*i.e.*, unedited) opinions in the cases listed below, (b) some short explanatory memos that I've prepared, and (c) portions of the relevant federal

statutes. Regarding (a) and (b), most students find it convenient to download and/or print the material as they need it throughout the semester, and they also find it useful to have the material in electronic form on their computers. If, however, you would like to buy a complete printout of the entire semester's readings, I have posted the entire package of readings on Blackboard, which you can download and print out (or bring to a local copyshop for printing and binding or what-have-you).

You must obtain a copy of the current version of the Copyright Act (17 USC §§ 101 *et seq.*), the Patent Act (35 USC §§1 *et seq.*), and the Lanham Act (15 USC chap. 22, §§1051 – 1127). **The statutory material is not optional. Do not come to class without it**. Get in the habit of having the statutory text in front of you at all times when reading and discussing these cases.

I have placed copies of these statutes on Blackboard as well. I have found that many students find it convenient to have all of the statutory material gathered together and bound in one place; if you would like that, any commercially-available IP statutory supplement (from 2007 or later) will do the trick; I believe the Bookstore has some of these, but if not, they can easily be ordered online.

This course, like all courses at the law school, is governed by Temple's policy on Student and Faculty Academic Rights and Responsibilities (Policy # 3.70.02), which can be accessed through the following link:
http://policies.temple.edu/getdoc.asp?policy_no=03.70.02.

The readings for each class are listed below, followed by a set of questions. Spend some time thinking about your answers to each of the questions before class; we will structure at least part of our discussion in each class around them, and I'll expect each of you to be prepared at least to say something about them if called upon to do so.

READINGS

PART I INTRODUCTION

Class 1

A. Memo: Reading Cases
B. *Nadel v. Play-by-Play Toys,* 208 F.3d 368 (2d Cir. 2000)
C. *Lueddecke v. Chevrolet Motors,* 70 F.2d 345 (8th Cir. 1934)

Questions:

1. In *Lueddecke*, what's the plaintiff's claim? What cause of action is he asserting that entitles him, in his view, to money damages from Chevrolet Motors?

2. Why does Lueddecke lose? If you had to explain to him, after the judgment has been handed down, why he lost, what would you say? "Mr. Lueddecke, I'm afraid things didn't go your way, because the court concluded that . . . ?"

3. Does Mr. Nadel "own" the idea of the Tornado Taz?

II. COPYRIGHT LAW

Class 2

A. *Eldred v. Ashcroft*, 537 US 186 (2003)
B. US Constitution, Art 1 section 8
C. Copyright Act, §§ 302(a), (b), and (c)

Note: To make sense of §302, you need to refer to the "Definitions" in Sec. 101 for (at a minimum) the following terms:

create
fixed
copy
phonorecord
joint work
works made for hire

Questions

1. What was Eldred's claim?

2. When does copyright protection begin? How long does it last?

3. What does "fixed in any tangible medium of expression" mean?

Class 3

A. Copyright Act §§ 102(a), 102(b), 103(a) & 103(b) [and relevant definitions in § 101]
B. *Bell v. Catalda*, 74 F. Supp. 973 (SDNY 1947) [excerpt with facts];
C. *Bell v. Catalda*, 191 F.2d 99 (2d Cir. 1951)
You may find the display posted at
http://www.coolcopyright.com/cases/chp2/bellcatalda.htm
helpful for understanding the *Bell v. Catalda* case.
D. Memo – A Note on *Burrow-Giles v. Sarony*
E. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884)

Questions

1. How could Bell's mezzotints be "original" works when they were "copied" from the Old Master paintings?

2. What if Bell's mezzotints had been made not by copying Old Master paintings but from modern works protected by copyright – the paintings of Jackson Pollock, say, or Salvador Dali. Would the result have been different in the case? [Read §103 again, and apply to these new facts].

3. What about Catalda's lithographs – were they "original works"? What does the court have to say about that question?

4. Abraham Zapruder, on November 22, 1963, made a home movie of President Kennedy's motorcade as it passed through Dallas; as it happened, he captured the only images of the moment when Kennedy was shot. Did he have copyright protection in his movie? What does he need to show in order to have the movie protected by copyright?

Class 4

A. Copyright Act, §§ 102(b) (again)
B. *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991)
C. *Baker v. Selden*, 101 U.S. 99 (1879)
D. *Morrissey v Proctor and Gamble*, 379 F.2d 675 (1st Cir. 1967)

Questions

1. What would Rural Telephone Co. have had to have done to have made its white pages directory an "original" work? Suppose it had done those things and the directory was an original work – would that mean that Feist would not have been allowed to copy the names and phone numbers listed there?

2. Was Charles Selden's bookkeeping system "novel"? Was it "original"? Was it protected by copyright?

3. What's the holding of *Baker v. Selden*?

4. If *Baker v. Selden* were decided today (*i.e.*, under the current Copyright Act, including §102(b)), what result?

Class 5

A. Copyright Act, §§ 201, 202, 204
B. Andrien v. Southern Ocean County Chamber of Commerce, 927 F.2d 132 (3d Cir. 1991)
C. *Community for Creative Non-Violence v. Reid*, 490 U.S. 730 (1989)
D. Memo: Issue-Spotting

<u>Writing Assignment #1</u>:

Summarize the *CCNV v Reid* case in no more than two paragraphs. **Due at the beginning of Class 5 – please hand in one (hard) copy at the start of class, and please e-mail me a copy as an attachment; put the words "IP Course Writing Assignment #1" in the subject line of your email.**

<u>Questions</u>

1. Why is the *Andrien* court concerned about Carolyn Haines – is she a party to the lawsuit? Was the map a "work made for hire"?

2. I wrote and published a book earlier this year about Internet law – is Temple University the "author" of that book under §201 and the "work made for hire" provisions?

3. Who owns the "Third World America" sculpture itself – the physical, tangible, 3-dimensional thing?

4. Suppose the Third World America sculpture had been commissioned by CCNV as part of a motion picture that CCNV was producing about the plight of homeless Americans – would that have made it a "work for hire" under the statutory definition?

<u>Class 6</u>

A. *Childress v. Taylor*, 945 F.2d 500 (2d Cir. 1991)
B. Memo: Joint Authorship
C. Memo, The Copyright Regulations

> Read the first subsection (37 CFR §202.1 – "Material not subject to copyright") of the regulations included with that memo carefully; just skim the remainder.

<u>Questions</u>

1. The *Childress* opinion talks about both an "intention to merge their contributions into inseparable or interdependent parts of a unitary whole," and the "intent of both participants in the venture to regard themselves as joint authors." Are these separate requirements for a finding of joint authorship, or is the court just using different language to describe the same thing?

2. Could Carolyn Haines claim joint authorship regarding the map in the *Andrien* case?

Class 7

A, Memo: Copyright Registration

We will spend this class reviewing the material we have covered up to this point. Please prepare an answer (or at the very least the outline of an answer) to Questions 1 and 2 from "Review Questions – Copyright Law (Part One)" You do not need to hand these in – however, if you would like to do so and get my reactions to your answer/outline, please feel free to do so.

Class 8

A. Memo: The Copyright Claim
B. Copyright Act, §§ 501(a) & 501(b)
C. Copyright Act, §§106, 109(a) and 109(c)
D. Memo: The First Sale Doctrine(s)
E. H.R. Report No 94-1476, 94th Cong. 2d Sess. 61 – 65 (1976)

> This Report, prepared by the House Judiciary Committee, accompanied the bill (the "Copyright Act of 1976") that was signed into law by President Ford in 1976, and has been quite influential in subsequent judicial decisions interpreting the meaning of its various terms. Section 106 is in many ways the heart of the Copyright Act, inasmuch as it sets forth the "bundle of rights" belonging to the owner of the copyright. As you might expect, there has been a great deal of case law dealing with the precise meaning of each of the section 106 rights. We will only have a chance to look at a few of those cases; this excerpt from the House Report, however, provides a good overview of the entire bundle.

F. *Columbia Pictures v. Redd Horne,* 749 F.2d 154 (3d Cir. 1984)

> Note: You may skip the discussion of "defendant's counterclaims" at the end of this opinion.

Questions

1. Suppose the Court had found that the sculpture "Third World America" was a work for hire. What would the consequences of such a finding have been for the parties? Would CCNV have been able to make changes to the sculpture? Take it on tour?

2. Who was Redd Horne, Inc.? What role did it play in the infringements of Columbia Pictures' copyright-protected motion pictures?

3. Suppose the patrons of Maxwell's Video Showcase were actually given the videocassettes, which they would then take into the viewing rooms, place into a VCR

located there, and "play." Would they be "performing" the copyrighted works? Would they be performing those works "publicly"?

4. Many of you, I'm sure, have been in hotels which allow you to choose movies to watch on the television located in your room. Are you "publicly performing" those copyrighted works when you watch a movie in your room? Is the hotel "publicly performing" those works when you watch a movie in your room?

Class 9

A. Memo: Licenses, Exclusive Licenses, and Copyright Ownership
B. *Selle v. Gibb*, 741 F.2d 896 (7th Cir. 1984)
C. *Nichols v. Universal Pictures Corp.,* 45 F. 2d 119 (2d Cir. 1930)

Questions

1. Suppose the first 16 bars of Selle's song ("Let it End") and the BeeGees song ("How Deep is Your Love") are *identical* – absolutely indistinguishable from one another. Would that demonstrate that the BeeGees "copied" from Selle's work? Why (or why not)?

2. In *Nichols*, pay particular attention to what has come to be known as Judge Hand's "abstractions test" (on page 2 of the opinion, beginning "Upon any work, and especially upon a play, . . ."). How does he apply that "test" to the facts of this case?

3. Is the question of whether "The Cohens and the Kellys" infringes on "Abie's Irish Rose" a "question of fact" or a "question of law"?

Class 10

A. Memo: Section 106 Hypotheticals
B. *Steinberg v. Columbia Pictures,* 663 F.Supp. 706 (SDNY 1987)
Note: "Memo: The Steinberg Posters" has reproductions of the two works at issue in the Steinberg case
C. *Nash v. CBS*, 899 F.2d 1537 (CA 7 1990)
D. *Nash v. CBS*, 704 F.Supp 823 (ND ILL 1989)

Note: Reading (D) is a short excerpt from the district court opinion that was reviewed by the Seventh Circuit in the opinion in "C," containing the district court's understanding of the "substantial similarity" inquiry in copyright law.

WRITING ASSIGNMENT #2 – Due at the beginning of Class 10 – please hand in one (hard) copy at the start of class, and e-mail me a copy as an attachment; put the words "IP Course Writing Assignment #2" in the subject line of your email.

Consider the Saul Steinberg poster "New York from the Air," and the infringing poster created by Columbia Pictures for its film "Moscow on the Hudson." Your firm represents Columbia Pictures. Ridgeview Printing, Inc., a publishing company in Philadelphia, has made 1,000 reproductions of the "Moscow on the Hudson" poster and distributed them by sale to the public. Your client (Columbia Pictures) wants to know whether it has a cause of action against Ridgeview for infringing its copyright in the poster. Summarize, in two paragraphs maximum, your response.

Class 11 Copyright Defenses

A. Copyright Act §107; **Skim** §§108 & 110
B. *Campbell v. Acuff Rose*, 510 U.S. 569 (1994)
C. *Castle Rock Entertainment v. Carol Publishing,* 150 F.3d 132 (2d Cir. 1998)

Class 12

A. **Skim** Copyright Act, §§ 502 – 507
B. Memo – Homer's Fallacy: The Logic of Facts
C. Memo – Exam-Taking

COPYRIGHT REVIEW

We will spend this class reviewing the copyright material. Please prepare an answer (or outline of an answer) to Questions 2, 6, and 8 from "Review Questions – Copyright Law (Part Two)" You do not need to hand these in – however, if you would like to do so and get my reactions to your answer/outline, please feel free to do so.

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III. PATENT LAW

Class 13

A. *Metallurgical Industries v. Fourtek*, 790 F.2d 1195 (5th Cir. 1986)
SKIP Parts VII and VIII dealing with Evidentiary and Remedial Matters

B. Patent Act §§ 100, 101
C. **SKIM** Patent Number 6,328,163 (Morphing Candy Holding Device)
D. Memo – Introduction to Patents

Questions:

1. Who is Smith? What did he do that embroiled him in this lawsuit? What is the court's disposition of Metallurgical's claim against Smith?

2. What are the elements of the cause of action for misappropriation of trade secrets?

Class 14

A. *Diamond v. Chakrabarty*, 447 US 303 (1980)
B. Patent Act §102 (especially §§102(a) and 102(b))
C. *Pennock v. Dialogue*, 2 Pet. 1 (1829)

Questions

1. What statutory provision is the Court construing in *Chakrabarty*?

2. Can Congress "overturn" the holding in *Chakrabarty*? If so, how?

3. Why does Pennock lose his right to patent his new hose? Wasn't it a "novel" invention?

Class 15

A. *In re Lyle Borst*, 345 F.2d 851 (CCPA, 1965)
B. *Rosaire v. National Lead Co*. 218 F.2d 72 (5th Cir. 1955)
C. Memo: A Note on the Patent Process

Questions

1. If the Atomic Energy Act had never been passed, what result in *Borst*?

2. In *Rosaire*, who gets the patent to the new method of prospecting for hydrocarbons?

3. Rosaire admits that Teplitz-Gulf work was done before he (and Horvitz) conceived of the prospecting method. How, then, could he possibly argue that he is entitled to a patent?

Class 16

A. *In re Hall* 781 F.2d 897 (Fed. Cir. 1986)

IMPORTANT: There is a **TYPOGRAPHICAL ERROR** on page 898, 2d full paragraph, the court meant "prior to February 27, 1978," not "prior to February 27, 1979" [Can you tell how I know that that's a typographical error?]

B. Memo: The Language of Invention
C. *In re Cronyn*, 890 F.2d 1158 (Fed. Cir. 1989)

D. *Mahurkar v. Bard,* 79 F.3d 1572 (Fed. Cir. 1996) [**SKIP** the section on patent damages beginning on page 5 of the *Mahurkar* opinion and continuing to the end of the opinion]

Questions

1. What accounts for the difference in result between *Hall* and *Cronyn*?

2. Sec. 102(a) (and, as we'll see in few classes, §103(a) also) requires an analysis of the conditions pertaining before the applicant invented the invention for which he/she seeks a patent. What rule(s) can you extract from *Mahurkar* regarding the definition of the "date of invention"?

Class 17

A. Patent Review Problems: Review Problem #1
B. *In re Paulsen,* 30 F.3d 1475 (Fed. Cir. 1994)
Read only through page 4 (dealing with Claims 1 and 18)
C. *Egbert v. Lippmann*, 104 US 333 (1881)
D. *Metallizing Engineering Co v. Kenyon Bearing & Auto Parts,* 153 F.2d 516 (2d Cir. 1946)

Class 18

A. *Lough v Brunswick*, 86 F.3d 1113 (Fed. Cir. 1996)
B. Pfaff v Wells Electronic, 525 US 55 (1998)
C. Memo – Patent Ownership

Questions

1. Does the *Pfaff* opinion modify the definition of the "date of invention" set forth in *Mahurkar*?

Class 19

A. Patent Act §103(a)
B. *Hazeltine Research v. Brenner*, 382 US 252 (1965)
C. *In re Paulsen*, *supra*
Read the remaining sections of this opinion, dealing with the obviousness rejection
D. *KSR v. Teleflex*, 550 US 398 (2007)

Questions

1. Read 103(a) carefully. Fill in the blanks below:

IF the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious to a person of ordinary skill at the time the invention was made, THEN _________ even though ____________.

2. The KSR case is one where it is especially difficult to see what the legal issues involved are without some level of detail about the relevant technology. To help get us to those legal issues, here's my understanding of the various automobile pedal innovations the Court is discussing. The Teleflex patent is for an adjustable pedal with a "fixed pivot point" and an electronic sensor mounted on the pivot point. The prior art already contained adjustable pedals with fixed pivot points (that's in the Asano patent), AND pedals with electronic sensors located at the fixed pivot points (the '936 patent and the Smith patent). The question in the case, therefore, is whether it would have been obvious to a POSITA to combine the two – to make an adjustable pedal with a fixed pivot to which the sensor was attached. See page 13 ("The . . . legal question, then, is whether a pedal designer of ordinary skill starting with Asano would have found it obvious to put the sensor on a fixed pivot point."). The District Court found that it would have been obvious, the Court of Appeals that it would not have been obvious, and the Supreme Court that it would have been obvious.

3. Why wasn't the patent at issue in *KSR* invalid under the novelty provisions of sec. 102(a)?

<u>Class 20</u>

A. Patent Act §§ 154(a) and 271(a) – 271(c)
B. *Larami Corp. v. Amron*, 27 USPQ 2d 1280 (ED Pa 1993)

NOTE: Pay particular attention to the discussion of "literal infringement" in the *Larami* case; you may **<u>skip</u>** the discussion of infringement under the "doctrine of equivalents."

<u>Class 21</u>

A. *Graver Tank v. Linde Air Products,* 339 US 605 (1950)
B. *Warner-Jenkinson v. Hilton Davis*, 520 US 17 (1997)

<u>Questions</u>

1. Assume the following:

A has received a patent for invention X.

Device Y is infringing the patent under the doctrine of equivalents – it has all the elements (or their equivalents) listed in A's claim.

Information becomes available showing that device Y was in the publicly-accessible "prior art" in this country one month before A invented X.

Is A’s patent invalid? If so, why?

2. The *Warner-Jenkinson* opinion has a particularly helpful summary of its holdings at the end of the opinion. Make sure you read and understand each of the points the Court lists there.

Class 22

Patent Review

Please prepare an Answer/Outline to Questions 2 and 3 of the Patent Review Questions.

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IV. TRADEMARK LAW

Class 23

A. Memo – Introduction to Trademarks
B. *William R. Warner & Co. v. Eli Lilly & Co.,* 265 U.S. 526 (1924)
C. *Qualitex Co. v. Jacobson Products Co.,* 514 U.S. 159 (1995)

Questions:

1. What was Eli Lilly trying to stop Warner from doing, exactly?
2. Why does the Court hold that Lilly has no trademark protection for the name “Coco-Quinine”?
3. In order for Qualitex’s green-gold color to have protection as a trademark, the Court holds that it must have developed “secondary meaning”; what does that mean?

CLASS 24

A. *Blue Bell, Inc. v. Farah Manufacturing Co*., 508 F.2d. 1260 (5th Cir. 1975)
B. *Zatarain’s Inc. v. Oak Grove Smokehouse, Inc.* 698 F.2d 786 (5th Cir. 1983)

Questions

1. Why do you think that Farah Manufacturing Co. sent a single pair of “Time Out” pants to each of its regional sales managers (and charged them for the privilege)?
2. Does Zatarain’s have any trademark protection for “Fish-Fri” or “Chick-Fri”? Only in New Orleans?

Class 25

A. *In re Sun Oil. Co.,* 426 F.2d 401(CCPA 1970)
B. *In re Budge Manufacturing Co.,* 857 F.2d 773 (CAFC 1988)
C. *In re Nantucket*, 677 F.2d 95 (CCPA 1981)

Class 26

A. *Zazu Designs v. L'Oreal*, 979 F.2d 499 (CA 7 1992)
B. *Moseley v. Victoria's Secret Catalogue*, 537 US 418 (2003)

Class 27

A. *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126 (2d Cir. 1979)
B. *Volkswagenwerk Aktiengesellschaft v. Church*, 411 F.2d 350 (9th Cir. 1969)

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1. Isn't Church using VW's trademark without their authorization? Does the court allow him to continue doing that? Why?

Class 28

Review – Please prepare answers to the Fall 2009 Exam, which we will go over in class.