

Intellectual Property and Technology Law

James E. Beasley School of Law
Temple University

Intellectual property law – the body of law that is primarily concerned with providing protection for the intangible creations of the human mind – has traditionally been comprised of three major subfields: Patent Law, Copyright Law, and Trademark Law. The boundaries of each of these three subfields are set largely by the federal statutes that govern each -- The Patent Act (35 USC Secs. 1-376), the Copyright Act (17 USC Secs. 101-1203), and the Lanham Act (15 USC Secs. 1051 – 1127), respectively.

Patent law deals with the legal protection afforded to “inventions”: new and useful technological developments of all kinds. Because of the role played by the US Patent and Trademark Office in the review and granting of patents, patent law has a strong ‘administrative law’ component. Copyright law protects “original works of authorship” – creative expression embodied in literary, musical, graphic, and other primarily “artistic” works. Trademark law protects signs or symbols of all kinds – logos, words, phrases, musical jingles, etc. – that are used in commerce to identify the source and origin of goods or services.

The boundaries of “technology law” are a little more difficult to make out. Many different bodies of law, including the three listed above but also including Antitrust, Contracts, Commercial Law, Sales, Constitutional Law, Health Law, Payment Systems, and many, many others, may bear on legal issues involving new and emerging technologies.

Technology has long played a key role in IP law, particularly in patent law; the critical role that patents have always played in the development of new technologies – from the cotton gin, the telegraph, and the transistor, up to and including the more recent innovations in biotechnology and computer networking – has meant that patent lawyers often find themselves at the cutting edge of technological development. As a consequence, entry into the field of patent law is restricted to those with substantial technical expertise; for example, in order to call oneself a “patent lawyer” and to practice before the United States Patent and Trademark Office, you must pass a separate examination (the Patent Bar examination) in addition to a State Bar exam, and the Patent Office allows only lawyers with demonstrated areas of technical competence to sit for that examination.¹

Increasingly, however, technological issues are also becoming central to the other sub-disciplines within IP law. While many trademark and copyright lawyers continue to have successful practices without the slightest interest, or expertise, in technological issues, the rise of the Internet, in particular, has meant that technological issues are becoming more important in

¹ See “General Requirements for the Admission to the Examination for Registration to Practice in Patent Cases before the US Patent and Trademark Office,” <http://www.uspto.gov/web/offices/dcom/olia/oed/grb0104.pdf>

these subfields (and, conversely, that “technology law” is becoming more concerned with copyright and trademark issues).

The Course of Study. The study of Intellectual Property at Temple begins with the introductory course, “Introduction to Intellectual Property.” This course covers the broad outlines of patent, copyright, and trademark law (along with a fourth body of law, the law of ‘trade secrets,’ which is a curious amalgam of intellectual property and tort law doctrines). It is designed both for students who plan to work in the IP field and for those who, though they have no plans to specialize in this area, are looking to learn something about the general rules of IP.

The “second tier” of IP courses consists, first, of specialized courses devoted to each of the three major subfields: Patents (Law 552), Copyrights (Law 553), and Trademarks and Unfair Competition (Law 551). In addition, this second tier includes a number of courses that cut across one or more of the boundaries between the IP subfields: International Intellectual Property (Law 467), Entertainment Law (Law 535), and Intellectual Property Licensing Law (Law 447).

The “third tier” of IP courses consists of more specialized patent law offerings: Patent Litigation (Law 472), Biotechnology Law (Law 473), and Patent Prosecution (Law 471).

Beginning in Fall 2001, Introduction to Intellectual Property will be a required prerequisite for each of the courses in the second and third tiers. Accordingly, students who wish to go beyond the introductory course and study any of the IP subfields in more depth are strongly encouraged to take “Introduction to Intellectual Property” in their second year so that they can have maximum flexibility in designing their schedules in subsequent semesters. We will be offering Introduction to Intellectual Property in both the Fall and Spring semesters, once in the evening and once in the day session, in order to maximize its accessibility to students.

Finally, four other courses cover various other aspects of relationship between law and technology: Law of Electronic Commerce (Law 921), Cyberspace (Law 652), Law, Science and Technology (Law 817), and Cyberlaw and Policy: Practical Applications in Organizational Settings (Law 652) . These courses are open to any students whether or not they have taken any of the Intellectual Property courses

COURSE DESCRIPTIONS FOR INTELLECTUAL PROPERTY AND TECHNOLOGY LAW COURSES CURRENTLY OFFERED

Law 547. Introduction to Intellectual Property (Professors Post & Harris)

3 Credits

This course will cover the broad outlines of the four major branches of intellectual property law: patent, copyright, trademark, and trade secret law. Time permitting, the course also will look at the emerging doctrine of "misappropriation" as applied to intellectual property. The course will look generally at why (and how) intellectual property law differs from the law governing real property or tangible personal property, as well as at the special features of each of these sub-fields of intellectual property law. The course should provide a helpful overview of this area of the law for students who do not plan to specialize in intellectual property, as well as providing those who plan to go on to more detailed study of, and practice in, this area with an introductory exposure to the kinds of problems that are common to all intellectual property disciplines.

Prerequisite: **Law 418 (Property)**

Law 551. Trademarks and Unfair Competition (Professor Casey)

2 Credits

This course examines the development of the law of trademarks including the creation and maintenance of trademark rights, trademark registration, infringement of trademark rights and dilution, special defenses and limitations, unfair competition and remedies.

Prerequisite: **Law 547 (Introduction to Intellectual Property)**

(Also approved as a three-credit writing seminar: Law 813.)

Law 552. Patents (Professor Harris)

2 Credits

This course will provide a broad overview of the law and policy of the U.S. patent system. Topics to be covered include the nature of patentable subject matter, the standards for assessing patent validity (novelty, utility, and non-obviousness), Patent Office procedures, infringement and the doctrine of equivalents, and remedies for patent infringement.

Prerequisite: **Law 547 (Introduction to Intellectual Property)**
(Also approved as a three-credit writing seminar: Law 940.)

Law 553. Copyrights (Professor Post)

3 Credits

The goal of this course is to introduce students to the basics of US copyright law. Without detracting from this goal of covering the (domestic) copyright basics, we will also look at these issues in the specific context of these new technologies and the growing internationalization of copyright law, in order to introduce you to some of the problems that are likely to arise as copyright law enters the next century. Topics to be covered include the subject matter of copyrights, copyright ownership, the scope of copyright protection, the nature of the copyright infringement inquiry, the "fair use" and other defenses, and selected issues concerning the international enforcement of copyrights.

Prerequisite: **Law 547 (Introduction to Intellectual Property)**

(Also approved as a three-credit writing seminar: Law 862.)

Law 447. Intellectual Property Licensing Law (Professors Bramson and Pressman)

2 Credits

The most valuable corporate assets today are intellectual property (IP)- patents, trademarks, copyrights and trade secrets. IP protects technology, computer programs, brand names, TV characters, information, books and marketing plans, to name just a few. IP is usually transferred by contracts called "License Agreements." IP License Agreements are unique in many legal and business ways and are important to all aspects of the business world today, national and international. The course has four components: first, a brief primer on what is IP, next, a case law study of the law of IP licensing, then, a short introduction to the business of IP licensing, and finally, analyses of and drafting several different types of IP license agreements, domestic and

international, in their legal, business and negotiating contents.

The course does not have an exam. Students will receive letter grades based on their performance in individual and group drafting and negotiation exercises.

Prerequisite: **Law 547 (Introduction to Intellectual Property)**

Law 467. International Intellectual Property (Professor Harris)

2 Credits

Obtaining Rights by Registration in the United States and other typical Examination Countries; joint Examination by the European Patent Office. Effect of the Patent Cooperation Treaty and proposals toward Patent Harmonization under the General Agreements on Tariff and Trade (GATT); focus on: Application Requirements, Coverage, Appeal Rights, Term of Protection and Maintenance Costs. Exploitation of Intellectual Property Rights with a focus on: Technology Transfer including Compulsory Licensing, Foreign Ownership Requirements in Ventures and Anti-Trust and Anti-Monopoly considerations. Protection of Rights with a focus on: the difficulties of protecting intellectual property rights by litigation, policing the property rights, preventing international distribution, international trade piracy, gray market goods and other topics as time permits.

Prerequisite: **Law 547 (Introduction to Intellectual Property)**

Law 472. Patent Litigation (Professor Bernstein)

2 credits

This course will address the manner in which patent cases are litigated, with special emphasis on a number of special issues that frequently arise in that context. Topics to be covered include preparation and content of the complaint and answer, discovery, the role of expert witnesses, preliminary injunctions, claim construction and the “Markman hearing,” proof of infringement and damages, jury instructions, and appeals. There will be a number of hands-on exercises, and a final examination.

Prerequisites: **Law 402 (Civil Procedure I)**
 Law 547 (Introduction to Intellectual Property)
Recommended: **Law 552 (Patents)**

Law 652. Cyberlaw and Policy: Practical Applications in Organizational Settings
(Professor Bollinger)

2 Credits

This course is a practical and concrete course applying Cyberlaw to pseudo-clients in legal practice. Legal principles needing to be addressed in an Acceptable Use Policy will be studied. Students will be expected to prepare for each class by reading the week's required readings and by accessing the Internet websites for guided current information. During the in-class period, the students will become involved with resolving a problem, a hypothetical, or a vignette that will apply the out-of-class preparation of the week and will supply information to enhance the student's Acceptable Use Policy.

By the end of the course, students will have the legal principles, experience at practical application and an Acceptable Use Policy that applies to their selected public or private corporation-employer.

Prerequisites: **Law 406 (Contracts I)**
 Law 408 (Contracts II),
 Law 404 (Constitutional Law)
 Law 420 (Torts)

Law 817. Law, Science and Technology (Professor Kairys)

3 Credits

This seminar explores the interrelationship between law, science and technology and the role of science and technology in law by examining a series of specific problems. Examples include the legal ramifications of recent technological developments such as polygraph testing, clinical testing of new treatments on human subjects, cable television and the newest vehicle for mass communications, Internet, and fiber optics. Another issue that will be explored is the influence of new statistical and mathematical methods on the law. Students write and make a presentation to the class on a topic of their choosing.

Prerequisite: Law 414 (Legal Research and Writing I & II)

Law 848. Cyberspace (Professor Post)

3 Credits

The emergence of the global digital electronic communications network--the "Internet" and its constituent networks--and the associated "digital revolution"--the ability to access, store, and transmit vast amounts of information in digital form (computer software, video games, music, text, etc.)--present an array of new problems and opportunities for lawyers preparing to practice in the 21st Century. It is becoming increasingly evident that the process of "mapping" existing legal concepts and tools into this new domain presents certain difficulties, and that a number of familiar legal concepts will need to be rethought before they can be effectively applied in this new environment.

The goal of this course is to introduce students, by means of a series of specific case studies chosen to illustrate the clash between existing legal regimes and new technologies, to a reasonably comprehensive subset of the legal problems that are being addressed as part of the developing "online law." Topics to be covered include the law of copyright as applied to electronic information, trademark law as applied to Internet "domain names," application of the First Amendment to the regulation of Internet communications, privacy concerns on the Internet, the law of anonymous communication and the regulation of encryption technology, and the difficult international jurisdictional questions presented by Internet activity.

Each student will be required to write a substantial research paper focused on one of these topics (or another chosen in consultation with the Professor), and to present preliminary findings in class. Although there are no prerequisites for this course, it is strongly recommended that students have had a course on intellectual property prior to enrolling in this course.

Prerequisites: **Law 418 (Property)**
 Law 414 (Legal Research and Writing I & II)
Recommended: **Law 547 (Introduction to Intellectual Property)**

Law 921. Law of Electronic Commerce (Professor Boss)

3 Credits

This seminar will focus on key issues confronting businesses as they migrate to an electronic environment. The seminar will exam the problems confronting the application of existing law to on-line commerce and then explore possible solutions to those problems. Authentication and integrity issues in cyberspace, electronic contracting, click wrap contracting, warranty liability in cyberspace, controlling the use of information in cyberspace, electronic payment models, marketing on the Internet, data mining - using customer information/lists, employer/employee

relationships on the Internet, raising capital in high-tech businesses, taxation of electronic commerce and negotiability in electronic commerce are examples of topics to be covered.

Prerequisite: Law 414 (Legal Research and Writing I & II)

Law 471. Patent Prosecution (Professors Farley and Fullmer)

2 Credits

This course will focus on the legal issues that arise during the process of drafting patent applications and negotiating with patent examiners over patent validity. We will look at the prosecution history of a single successful patent application, and examine the kinds of decisions that the prosecuting attorneys were called upon to make and the ways in which questions about patent law, patent licensing, and the enforceability of patents and possible litigation concerns, help to shape the prosecution process.

Prerequisites: **Law 402 (Civil Procedure I)**
 Law 418 (Property)
 Law 547 (Introduction to Intellectual Property)
 Law 552/940 (Patents – exam course/writing seminar)

Law 473. Biotechnology Law (Professor Doyle)

2 Credits

This course will focus on how U.S. patent law is applied to biotechnology. We will begin by looking at various recent landmark cases that form the foundation of biotechnology patent law, including the policy concerns that surround biotechnology and the ownership of biotechnology. We will study Patent Office procedures in the Biotechnology Group and discuss how they relate to the legal standards governing infringement of biotechnology patents. We will also discuss inventorship and ownership issues using case law that is directed specifically to biotechnology inventions, and we will cover issues which relate to the Hatch-Waxman Act, and the protection afforded by the "exception from infringement" provision of the Patent Statute. Time permitting, we will also look at current problems of special interest.

Prerequisites: **Law 418 (Property)**
 Law 547 (Introduction to Intellectual Property)

Law 552/940 (Patents - exam course/writing seminar)*

* Law 552/940 (Patents) may be waived with the permission of the professor and a program exception waiver form issued by the Assistant Dean for Student Affairs.

Law 535. Entertainment Law (Professor Remick)

2 Credits

This course deals with selected legal issues which affect persons active in various aspects of the entertainment industry. These include pertinent contract, copyright, business association, securities regulation, communications and tax law issues. Special emphasis is given to the theater and to the recording and television industries. (Also approved as a three-credit writing seminar: Law 844.) NOTE: Students may not register for both this course and Law 844 (Entertainment Law).

Law 601. Sports Law

2 Credits

This course deals with the regulation of amateur athletics and with the legal relationships in professional sports. Course coverage includes issues of liability arising from injuries in sports activities and the unique tax problems affecting the athlete and the sports team owner. Special attention is given to issues of professional responsibility faced by the lawyer agent. (Also approved as a three-credit writing seminar: Law 878.) NOTE: Students may not register for both this course and Law 878 (Sports Law).