

LAW 691 – REAL WORLD IP LAWMAKING

Andy Halaby
Spring 2022

Class hours: Mondays, 6:00-6:55 p.m.

Office hours: After class and by appointment

Contact information:

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Course Objective

Through the lens of real world experience, with a focus on recent and current events, this one-hour seminar course will use the platform of intellectual property protection to examine the processes by which law is made, and policy implemented, by legislators, courts, administrative agencies, NGOs, academics, and private actors. The law and policy “soup” these participants stir often yields unexpected — and sometimes, undesirable — results. We will see how and why. Intellectual property law aside, this course will teach lessons that can be cross-applied to other subject areas, in law school and thereafter.

There are no prerequisites for this course. Students need no grounding — or intention to pursue further study or a career — in any aspect of intellectual property law, in order to enjoy and learn from the course. Course materials will consist primarily of recent court decisions, news reports, and opinion pieces; no books or other materials need be purchased.

Learning Outcomes

By the end of this course, you will be able to

- describe specific examples how the actors listed above make IP law and policy — sometimes with unintended consequences;

- identify examples of how particular legal and policy issues get resolved in different ways depending on who decides them; and
- understand how different dimensions of the law — substantive legal interests; federal vs. state vs. local control; and others — as well as variables within, and boundaries between, those dimensions, can make differences in law and policy outcomes.

Materials

You don't need to purchase any books for this course. Recent court decisions and other materials available online, or that I distribute or post on Canvas, will supply what you need.

Assignments

See weekly reading assignments appended to this Syllabus.

You should complete each week's assignment, **including Week 1's assignment**, before that week's class.

You should carefully study the assigned material so as to be prepared to participate in class regarding, and ultimately to be examined on, that material.

I may sometimes distribute or post on Canvas additional materials of interest.

Attendance and Grading

See the Statement of Student Policies. Seventy-five percent of your grade will come from a short, semester-end take-home memorandum. Twenty-five percent of your grade will come from class participation, including consistent attendance as well as timely arrival and being prepared for class.

Academic Integrity

All students are subject to ASU Law's Academic Integrity Code. The Code "is intended to preserve the integrity of the educational process at the Sandra Day O'Connor College of Law, to promote principles of ethics and professional responsibility, and to ensure an environment in which students can advance their education fairly and confidently. In addition, integrity and honesty are important elements of every state's bar admissions process."

"The Code is not self-enforcing, nor can it be enforced by the faculty or administration alone. Its value depends upon the commitment of students to its norms. Not only must students observe it individually, but they should actively discourage their peers from committing any

ethical or academic violation. We expect any student who has personal knowledge of an AIC violation to report that violation to the dean's designee."

Students are obligated to abide by this Code, which can be found at <https://law.asu.edu/cs/student-resources>.

Students are also subject to ASU's Student Code of Conduct, which among other things prohibits engaging in conduct that constitutes discrimination or harassment on the basis of race, sex, religion, national origin, ethnicity, disability, age, sexual orientation, gender identity, marital status, or socioeconomic status and may be subject to discipline by the University according to ASU's Student Code of Conduct Procedures.¹ Anyone who becomes aware of such conduct by a student should contact the law school's Director of Student Services or report it directly to the Dean of Students Office.²

Attendance Policy

Per Section IV.B. of the JD Statement of Student Policies,

Attendance at classes, seminars, and other offerings is an essential element in successful academic performance. An instructor in any law school course, seminar, or other offering may withdraw a student for excessive absence.

Withdrawal for excessive absence in any course, seminar, or other offering shall presumptively be recorded as a failing grade (E). Students who believe that they have good cause for failing to attend may petition a committee designated by the dean, which may in its discretion convert the grade to a W.

"Excessive absence" is defined as unexcused absence from more than 15% of class or other instructional time. For courses the administration designates as a "special attendance course" and which are so noted in the course description and syllabus, faculty may define excessive absence differently.

Students should notify the instructor at the beginning of the semester about the need to be absent from class due to religious observances or due to university sanctioned events/activities pursuant to ASU's Academic Affairs Manual §§ 304-04 and 304-02.

Classroom Behavior

Respect for the thoughts, ideas, and speech of classmates and faculty is the foundation of the educational process. Threatening behavior in the classroom will be dealt with in accordance with SSM § 104-02, which requires that "all incidents and allegations of violent or threatening

¹ The University's Student Code of Conduct and procedures can be found at <https://eoss.asu.edu/dos/srr/codeofconduct>.

² Information about the Dean of Students Office may be found at <https://eoss.asu.edu/dos>.

conduct by an ASU student (whether on- or off-campus) must be reported to the ASU Police Department and the Office of the Dean of Students.”

The use of electronic devices during class is prohibited with the exception of laptops used for class purposes. Recording the class in any manner without the permission of the instructor is prohibited.

Policy on Threatening Behavior

Students, faculty, staff, and other individuals do not have an unqualified right of access to university grounds, property, or services. Interfering with the peaceful conduct of university-related business or activities or remaining on campus grounds after a request to leave may be considered a crime.

Disability Accommodations

Per ASU Law and university policies, “the College of Law will provide reasonable accommodations for students with documented disabilities. College of Law accommodations can be made after the student requesting accommodations has met with the Student Accessibility and Inclusive Learning Services (SAILS) staff and eligibility has been established. Accommodations that fundamentally alter the prescribed course of studies must be approved by the College of Law. Students with disabilities that require accommodation(s) and/or adjustments should contact the law school registrar to make arrangements for the SAILS-approved accommodations.”

Title IX

Title IX is a federal law that provides that no person be excluded on the basis of sex from participation in, be denied benefits of, or be subjected to discrimination under any education program or activity. Both Title IX and university policy make clear that sexual violence and harassment based on sex is prohibited. An individual who believes they have been subjected to sexual violence or harassed on the basis of sex can seek support, including counseling and academic support, from the university. If you or someone you know has been harassed on the basis of sex or sexually assaulted, you can find information and resources at <https://sexualviolenceprevention.asu.edu/faqs>.

As a mandated reporter, I am obligated to report any information I become aware of regarding alleged acts of sexual discrimination, including sexual violence and dating violence. ASU Counseling Services, <https://eoss.asu.edu/counseling>, is available if you wish to discuss any concerns confidentially and privately. ASU online students may access 360 Life Services, <https://goto.asuonline.asu.edu/success/online-resources.html>.

Syllabus Revisions

Information in this syllabus, other than grading and attendance policies, is subject to change with reasonable notice.

Copyright Material

Pursuant to § 304-06 of the Academic Affairs Manual, “all contents of the lectures, including written materials distributed to the class, are under copyright protection.”

In accordance with ACD 304-10, students must refrain from uploading to any course shell, discussion board, or website used by the course instructor or other course forum, material that is not the student’s original work, unless the students first comply with all applicable copyright laws; faculty members reserve the right to delete materials on the grounds of suspected copyright infringement. Students may not share class materials outside the class, including uploading, selling or distributing course content or notes taken during the conduct of the course. Any recording of class sessions is authorized only for the use of students enrolled in this course during their enrollment in this course. Recordings and excerpts of recordings may not be distributed to others.

Face Coverings

I am an adjunct, not a masking monitor or policy enforcer.

That said, university policy, as of August 11, 2021, is as follows:

As announced on July 30, 2021, consistent with CDC guidelines for colleges and universities, ASU strongly recommends that everyone wear a face cover when inside a university building.

In addition, face coverings will be required in certain indoor settings, i.e., where distancing may not be possible. These include the following:

- Classrooms and teaching or research labs where distancing is not possible.
- All ASU clinical programs and centers that serve the general public, such as the ASU Health Centers, Child Development Laboratory, and Counselor Training Center (the “Programs”), whether on- or off-campus.
- Meeting rooms, workshop, design or production studios, and other indoor settings where distancing is not possible.

Additionally, consistent with CDC guidance, face covers may be recommended in selected outdoor settings or activities where distancing cannot be attained.

As previously stated, the university continues to recommend strongly that people get vaccinated and ASU continues to provide COVID-19 vaccines free of charge to students, faculty and staff. Greater rates of vaccination are the best tool available to reduce the rate of transmission in the community, which could change the applicable face covering guidance.

This and related matters are, of course, fluid. Everyone is encouraged to stay abreast of applicable law as well as University policy.

Class Recordings

Students may use class recordings for an educational purpose only.

ASSIGNMENTS

<u>Week</u>	<u>Date</u>	<u>Subject Matter</u>	<u>Assigned Reading</u>	<u>Optional Material</u>
1	1/10	Course Overview	a. United States Constitution art. I sec. 8 cl. 8 b. United States Patent Laws (read pp. 1-5 only) c. Copyright Law of the United States (read chapter and appendix list only; scan section list in Chapters 1-5)	Nachbar commentary , re art. I sec. 8 cl. 8
2	1/24	Patentable Subject Matter – What subject matter should be protectable?	a. 35 U.S.C. § 101 b. State Street Bank & Trust v. Signature Financial Group , 149 F.3d 1368 (Fed. Cir. 1998) c. Halaby, The “Inventive Concept” Test for Patent Eligibility Contravenes Congressional Intent , 61 IDEA 38 (2020) (read (excluding footnotes) Abstract and §§ I, II.A, II.D, II.E, III.A and IV only)	
3	1/31	Patentable Subject Matter – Continued	a. Yu v. Apple Inc. (Fed. Cir. 2020) (read panel opinion & Newman dissent only) b. Petition for Writ of Certiorari , American Axle & Mfg. v. Neapco Holdings (read brief only, not appendices)	Brief in Opposition , American Axle v. Neapco
4	2/7	Trademark – When may words be appropriated from common usage?	a. 15 U.S.C. § 1064(3) b. USPTO v. Booking.com B.V. , 140 S. Ct. 2298 (2020) (read main op. & Gorsuch dissent only)	

<u>Week</u>	<u>Date</u>	<u>Subject Matter</u>	<u>Assigned Reading</u>	<u>Optional Material</u>
5	2/14	Software Copyright – How well does copyright serve as a vehicle for software innovation protection?	a. 17 U.S.C. § 101 (“computer program” and “literary works”), § 102, and § 106 b. Oman, Computer Software as Copyrightable Subject Matter: Oracle v. Google, Legislative Intent, and the Scope of Rights in Digital Works , 31 Harv. J.L. & Tech. 639 (2018) (read text only, not footnotes) c. Google v. Oracle America (Sup. Ct. 2021) (read main op. & Thomas dissent only)	
6	2/21	Trademarks – Are they speech? Should they be regulated as such?	a. 15 U.S.C. § 1052(a) b. Matal v. Tam , 137 S. Ct. 1744 (2017) c. Iancu v. Brunetti , 139 S. Ct. 2294 (2019) d. Halaby & Long, New Model Rule of Professional Conduct 8.4(g): Legislative History, Enforceability Questions, & a Call for Scholarship , 41 J. Legal Prof. 201 (2017) (read pp. 237-39, re <i>Tam</i> , only)	NIFLA v. Becerra , 138 S. Ct. 2361 (2018) (Part II only) Ernst, Section 1052(c) of the Lanham Act: A First Amendment-Free Zone? (Dec. 12, 2021)
7	2/28	Trade Secrets	a. Arizona Trade Secrets Act , A.R.S. §§ 44-401 through -407 (scan) b. Krotoski <i>et al.</i> , Landmark Trade Secret Law Establishes New Rights and Remedies , Nat’l Law Review (Apr. 28, 2016) c. Horstman <i>et al.</i> , Former Coca-Cola Employee Convicted of Stealing Trade Secrets for the Chinese Government (May 11, 2021)	Orca Comm’ns Unltd. v. Noder , 337 P.3d 545 (Ariz. 2014) Federal Defend Trade Secrets Act (2016)
8	3/14	Intellectual Property Protection and Vaccines	a. Halabi <i>et al.</i> , COVID-19 Vaccines & Intellectual Property (Nov. 29, 2021) b. Abbott <i>et al.</i> , COVID Vaccine IP Waiver: A Pathway to Fewer, Not More, Vaccines (Oct. 28, 2021)	Locke <i>et al.</i> , The Shot Heard Around the World: The Strategic Imperative of U.S. Covid-19 Vaccine Diplomacy (Nov. 17, 2021)
9	3/21	Entitlement to Injunctive Relief – Is a right to exclude enough? Should it be?	a. 35 U.S.C. §§ 154, 261, 283 b. eBay v. MercExchange , 547 U.S. 388 (2006) c. McDermott, DOJ Issues Revised Draft Joint Policy Statement on Remedies for SEPs Subject to FRAND (Dec. 7, 2021) d. Pillar <i>et al.</i> , (Near) Half-Year Review and Update: Trademark Modernization Act’s Revival of ‘Irreparable Harm’ Presumption (June 21, 2021)	

<u>Week</u>	<u>Date</u>	<u>Subject Matter</u>	<u>Assigned Reading</u>	<u>Optional Material</u>
10	3/28	Patent Infringement Venue	a. eBay v. MercExchange (read Kennedy concurrence only) b. 28 U.S.C. §§ 1391, 1400 c. TC Heartland v. Kraft Foods Group Brands , 137 S. Ct. 1541 (2017)	Davis, <i>Albright Transfer Drama Will Keep Eyes on Texas in 2022</i> (to be distributed)
11	4/4	Patents as “Property”	Oil States Energy Servs. v. Greene’s Energy Group , 138 S. Ct. 1365 (2018) (read main op. & Gorsuch dissent only)	
12	4/11	Fee Shifting – Should it be easy or hard to make the loser pay?	a. 35 U.S.C. § 285 b. Octane Fitness v. ICON Health & Fitness , 572 U.S. 545 (2014) c. Highmark v. Allcare Health Mgmt. , 572 U.S. 559 (2014)	
13	4/18	Patents – Assignor Estoppel	Minerva Surgical v. Hologic (U.S. June 29, 2021) (read opinion of the Court and Barrett dissent only)	