WIPO NATIONAL WORKSHOP

on

INTELLECTUAL PROPERTY TEACHING

organized by the

WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)

in cooperation with the

UNIVERSITY OF DELHI

and the

DEPARTMENT OF EDUCATION OF THE GOVERNMENT OF INDIA

New Delhi, India

October 21-25, 1991

TEACHING OF TRADEMARK LAW

by

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I. INTRODUCTION

Intellectual property (IP) law is an extremely complex legal field that covers not only trademarks but also patents, copyrights, trade secrets, know-how and licensing. In today's highly competitive economic environment which includes national and international competitors, the importance of adequate trademark protection cannot be understated.

In the trademark field, unlike in the patent field, there are no special qualifying civil service examinations and no special admission procedures. Nor are there requirements that a trademark practitioner must have a technical academic background in engineering or the sciences. Any attorney can practice trademark law, i.e., represent clients before the U.S. Patent and Trademark Office (USPTO) and before courts in matters of trademark registration and litigation. Of course, registered patent attorneys — but not patent agents — can do the same.

Except for the fact that the USPTO is charged with the registration of trademarks and the granting of patents, that patent law firms and corporate patent departments often handle also trademarks and many trademarks practitioners are registered patent attorneys, there are really no similarities.

Of course, trademarks and patents are both considered to be industrial or intellectual property and trademark law is part of a law school's IP curricula, if any trademark courses are taught at all. Trademark courses are of course only electives, like patent courses since trademark law has not been required for state bar admission purposes and is not a subject covered by state bar examinations. Thus, most trademark attorneys have had to acquire their knowledge and skills on the job, even more so than in the patent field.

The situation as regards trademark law teaching and training has improved over the past decade or so. More law schools now offer trademark courses which has something to do with the advent of a golden age for patents and IP with trademarks riding coattails.

II. POLICY OBJECTIVES OF TRADEMARK LAW

Before going into the specifics of trademark law teaching and curricula, it is appropriate, for background and perspective, to also review and illuminate the policy objectives of trademark law and some substantive aspects of trademark law and practice and trademark licensing.

Trademark law is part of the broader law of unfair competition. Trademark infringement is one kind of unfair competition.

Unfair competition law also protects against a variety of other unfair commercial acts. Examples of unfair competition include trade name infringement (use of a business name likely to cause confusion with an established business), false advertising, copying of trade dress (packaging, labeling, and/or product appearance), and misappropriation (unfairly

benefitting from another's investment).

Trademarks serve the following purposes: identification of origin, quality assurance and goodwill symbols.

The Supreme Court back in 1916 described the primary purpose of a trademark "to identify the origin or ownership of the article to which it is affixed." (*Hanover Star Milling Co. v. Metcalf*, 240 US 403, 412 (1916)). This purpose is at the heart of the Lanham Act definition of trademark: "to identify and distinguish" one manufacturer's or merchant's products from another's. As one court put it:

> Trademarks help consumers to select goods. By identifying the source of the goods, they convey valuable information to consumers at lower costs. Easily identified trademarks reduce the costs consumers incur in searching for what they desire, and the lower the costs of search the more competitive the market. (*Scandia Down Corp. v. Euroquilt, Inc.* 772 F.2d 1423, 1429 (7th Cir. 1985), *cert. denied*, 106 S. Ct. 1801 (1986)).

It is not necessary, however, that consumers know the name of the source. Not many people know that CREST toothpaste is made by Procter & Gamble.

It is also not necessary that the trademark belong to the manufacturer of the product. The source of origin identified by the mark may be a merchant (e.g. Sears), whose goods are manufactured for him.

Trademarks are symbols of quality. The familiar STANLEY trademark on tools assures the consumer that each STANLEY tool he buys is of the same high quality as the last STANLEY tool he bought. This quality assurance function requires the trademark owner to maintain consistent quality standards so that the consumer gets what he expects.

> A trademark also may induce the supplier of goods to make higher quality products and to adhere to a consistent level of quality. The trademark is a valuable asset, part of the "goodwill" of a business. If the seller provides an inconsistent level of quality, or reduces quality below what consumers expect from earlier experience, that reduces the value of the trademark. The value of a trademark is in a sense a "hostage" of consumer; if the seller disappoints the consumers, they respond by devaluing the trademark. The existence of this hostage gives the seller another incentive to afford consumers the quality of goods they prefer and expect. (*Scandia Down Corp. v. Euroquilt, Inc., ibidem*)

If quality control is not maintained, the consumer is deceived and the trademark owner stands to lose his trademark.

Trademarks are symbols of goodwill. The value of this goodwill increases with length of use, advertising, and sales. Trademarks used for a long time on successful, highly-

advertised products have developed tremendous goodwill. The universal goodwill for such famous marks as PEPSI and 7-UP is priceless.

Over forty years ago, the Supreme Court recognized the role of trademark law in protecting the goodwill symbolized by a well-known mark. The court described this goodwill as "commercial magnetism" and warned that poachers would be prosecuted.

> The protection of trade-marks is the law's recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them. A trademark is a merchandising short-cut which induces a purchaser to select what he wants, or what he has been led to believe he wants. The owner of a mark exploits this human propensity by making every effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. Whatever the means employed, the aim is the same — to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears. Once this is attained, the trade-mark owner has something of value. If another poaches upon the commercial magnetism of the symbol he has created, the owner can obtain legal redress. (*Mishawaka Mfg. Co. v. Kresge Co.*, 316 U.S. 203, 205 (1942)).

A network of federal and state statutory and common law insures that a trademark does serve to identify origin, assure quality, and symbolize godwill. The Trademark Act of 1946 (the Lanham Act) is the federal statute governing trademark rights. The states also have their own trademark statutes. In addition to statutes providing for state registration, a number of states have Deceptive Trade Practice Acts and Anti-dilution Statutes (statutes designed to protect a distinctive mark from being "diluted").

Trademarks are acquired in this country only by use, under common law principles. The Lanham Act provides for *registration* of marks already owned; it does not *create* trademarks, which must exist before they *can* be registered. They must also have been used in interstate or foreign commerce since the Lanham Act is a federal statute, which rests in the Commerce Clause of the Constitution.

The Lanham Act is intended to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing products. The Lanham Act accomplishes this intent by providing that the user of a mark likely to cause confusion, mistake, or deception shall be liable in a civil action.

Likelihood of confusion is also the test for common law trademark infringement and unfair competition claims.

What is a trademark? A common synonym for trademark is brand name. COKE and 7-UP are well known trademarks (brand names) for soft drinks. CHRYSLER and CHEVROLET are trademarks (brand names) for automobiles. Trademarks or grand names

identify the product as coming from a particular company. Consumers may not know the name of the company, but they do know that products bearing the same brand originate from a single company. While a brand name is always a trademark, a trademark is not always a brand name. Trademarks can consist of a variety of symbols:

A design can be a trademark. For example, the Ralston Purina Checkerboard Square and the Gucci Red and Green Stripes are trademarks.

A product shape can be a trademark. The shape of the COCA-COLA bottle is exclusively associated with the makers of COCA-COLA.

A number can be a trademark. "4711" is a trademark identifying the cologne of a German manufacturer.

A slogan can be a trademark. "COLOR SO NATURAL ONLY HER HAIRDRESSER KNOWS FOR SURE" identifies the hair coloring made by Clairol.

A trade name may also be used as a trademark to identify products — and a trade name may be used as a service mark to identify services. Thus the IBM company uses IBM in its company name, it uses IBM to identify its computer products, and it uses IBM to identify its computer leasing services.

The critical element in all these trademarks, be they words, designs, shapes, numbers, or slogans, is that they identify and distinguish one company's products from another's.

The Lanham Act defines a trademark this way:

> The term "trademark" includes any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify and distinguish his goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown. (15 USC § 1127).

A service mark is to services what a trademark is to products. A service mark identifies and distinguishes the services of one company from another. Again, the Lanham Act provides a straightforward definition.

> The term "service mark" means a mark used in the sale or advertising of services to identify and distinguish the services of one person, including aunique service, from the services of others and to indicate the source of the services, even if that source is unknown. (*Id.*).

Typical service marks are retail department store names (SAKS and MACY'S), bank names (CITIBANK), and restaurant names (MAXIM'S, LUTECE). The same name can be a trademark and a service mark. SAKS is a service mark for department store services and SAKS is a trademark for clothing sold under the SAKS label.

III. EXAMPLES OF REGISTERABLE MARKS AND OF INFRINGEMENTS

A. Registrability Examples

The Trademark Trial and Appeal Board (Board) affirmed a trademark examiner's refusal of an application to register a configuration, a portion of the shape of a baby's bottle, on the ground that the grippers constituted a design of such utility that the design was de jure functional and therefore not entitled to registration as a trademark. (*In re Babies Beat Inc.*, 13 USPQ2d 1729 (TTAB 1990)).

The Court of Appeals for the Federal Circuit (CAFC) affirmed the Board's decision that BABY BRIE was merely descriptive of small packages of brie cheese. Applicant argued unsuccessfully that, although its packages were smaller than the size described in a recognized dictionary as "small," they were nonetheless larger than those of some other sellers so that BABY BRIE was not merely descriptive of applicant's products. This was characterized as sophistry. Secondary meaning is a question of fact and the court could not find that the Board's determination that it had not been proven was clearly erroneous. The greater the degree of descriptiveness of a term, the heavier is the burden to prove it has attained secondary meaning. (*In re Bongrain International (American) Corp.*, 894 F2d 1316, 13 USPQ2d 1727 (CAFC 1990)).

An application to register THE WASTE-TO-ENERGY COMPANY for engineering consulting services relating to low pollution equipment foundered before the Board largely on evidence from applicant's own literature in which the phrase "waste-to-energy" was used in a descriptive manner. In affirming the Examiner, the Board noted that marks must be viewed, not in the abstract, but in relation to the goods or services for which registration is sought and that the addition of the words "The" and "Company" did not assist applicant because those words have no capacity to distinguish one source of services from another. (*In re Energy Products of Idaho*, 13 USPQ2d 2049 (TTAB 1989)).

The Board reversed refusals of registration of two marks, each of which consisted of the word WOOLRICH and a design of sheep, one of which had, in addition, a plaid background. The goods of both applications were men's, women's and children's clothing, and the Examiner had refused registration under Section 2(a) on the ground that the marks were deceptive for clothing not made wholly or partly of wool. (*In re Woolrich Woolen Mills Inc.*, 13 USPQ2d 1235 (TTAB 1989)).

An attempt to register SALES FOLLOW-U as a mark for the service of soliciting repeat and referral business for automobile dealerships met with an affirmance by the CAFC of the Board's affirmance of the Examiners' refusal. The court sustained the Board's finding that "sales follow-up" is generic and that the applicant's evidence was insufficient to prove distinctiveness through an acquired secondary meaning. (*In re Automated Marketing Systems Inc.*, 11 USPQ2d 1319 (CAFC 1989)).

MONTRACHET as a trademark for cheese and cheese spreads was refused by the Examiner, who was affirmed by the Board, which was reversed by the CAFC. Noting that the trademark capability of MONTRACHET was unchallenged, the court posed the issue as whether MONTRACHET had lost its original trademark significance and had become the

common descriptive or generic name for cheese. That question turned on how the word was understood by the purchasing public, which is a factual issue. After finding that most of the examples in the record MONTRACHET being used in a classical trademark manner, noting that the burden was on the PTO to show that the public perceived MONTRACHET to be a generic designation for a type of cheese, and finding that the heavy weight of the evidence was contrary to the Board's finding, the curt had no trouble reversing the refusal (*In re Montrachet S.A.*, 11 USPQ2d 1393 (CAFC 1989)).

The Board affirmed an Examiner's refusal of registration of BAUHAUS for general house and office furniture on the ground that a vast number of excerpts from a wide array of publications showed that, as applied to furniture, "Bauhaus" was used generically to indicate a type or style of furniture. (*In re Bauhaus Designs Canada Ltd.*, 12 USPQ2d 2001 (TTAB 1989)).

Refusal of an application to register AMERICAN SYSTEM and design, with a disclaimer of "American," for articles of clothing manufactured in Italy was affirmed on the ground that AMERICAN SYSTEM was deceptive. The test was that the public was likely to believe the mark identified the place from which the goods originated and the goods did not come from that place. that is sufficient to bar registration under Section 2(e)(2) on the ground that a purported mark is primarily geographically misdescriptive. (*In re Biesseci S.p.A.*, 12 USPQ2d 1149 (TTAB 1989)).

The application for registration of RODEO DRIVE for perfume persuaded the CAFC that the public would not make an association of perfume with the famous shopping street in Beverly Hills, California. Without the necessary goods/place association between perfume and Rodeo Drive, the trademark RODEO DRIVE was not primarily geographically deceptively misdescriptive. Nothing in the record of the application indicated that the consuming public would believe that Rodeo Drive was the place where the perfume was produced. (*In re Jacques Bernier Inc.*, 13 USPQ2d 1725 (CAFC 1990), revg 10 USPQ2d 1955 (TTAB 1990)).

In refusing an application to register THE WINE SOCIETY OF AMERICA for wine club membership services, the Board also affirmed the Examiner's refusal on the ground of likelihood of confusion under Section 2(d) of the Trademark Act because of the close resemblance of THE WINE SOCIETY OF AMERICA to the previously registered trademark AMERICAN WINE SOCIETY 1967 and design for a newsletter, bulletin, and journal of interest to members of applicant. Applicant's service of supplying printed materials, as part of a wine club membership service, was found to be highly related to the goods of the prior registration. In deciding the issue of likelihood of confusion, the Board must refer to the identification of goods or services in the application and must read that identification to include all goods or services reasonably described by the words. (*In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989)).

Lastly, the CAFC had no difficulty affirming the Board's holding that "The Journal

of Law and Technology," the subtitle of the journal IDEA, was merely descriptive terminology explaining what type of publication IDEA was and that length of use alone was not proof of secondary meaning. The proof fell far short of showing promotion of the words in the title or that the words has lost their descriptive significant and and had acquired secondary meaning. Letters from ten subscribers solicited by the applicant to support the application did not constitute a scientifically accurate survey. (*Franklin Pierce Law Center v. Georgetown University,* 14 USPQ2d 1255 (CAFC 1990)).

B. Infringement Examples

LEXUS for a new line of automobiles was not confusingly similar to LEXIS for computer-assisted legal research services — product difference was decisive (*Mead Data Central Inc. v. Toyota Motor Sales, U.S. A. Inc.*, 9 USPQ2d 1442 (SDNY 1988) revd on other grounds, 10 USPQ2d 1961 (CA 2 1989)); PENTA for incoming ground tour arrangements — i.e., for arranging hotel accommodations, local transportation and sightseeing for group tours — was not confusingly similar to PENTA for hotel services. The marks coexisted in Europe, albeit somewhat acrimoniously; the relative sophistication of tour operators and travel agents, the difference in services, minimal confusion and a fatally-flawed survey purporting to show confusion appeared to tip the balance. (*Penta Hotels Ltd. v. Penta Tours Reisen GmbH*, 9 USPQ2d 1081 (D Ct 1988)).

McSLEEP for economy lodging services was ruled confusingly similar to Mc-(generic name) marks for a variety of foods and services offered by the pervasive McDONALD'S. Factors leading to the determination appeared to be the enormous renown of McDONALD's "Mc" marks, actual confusion, surveys indicating confusion and the intent to use the reputation McDONALD'S had given the "Mc" formative. (*Quality Inns International Inc. v. McDonald's Corp.*, 8 USQ2d 1633 (D Md 1988)).

AMERICAN OLEAN and AMERICAN MARAZZI for household tile sold to homeowners were not confusingly similar; the former was weak among consumers, in a market in which brand identity was not very important, and defendant used the common word to inform that it was a domestic manufacturer, not an importer. AMERICAN simpliciter was not infringed because the second-comer's use was adjudged, incorrectly, to be "fair". (*American Olean Tile Co. v. American Marazzi Tile Inc.*, 9 USPQ2d 1145 (ED Pa 1988)).

In a trademark infringement controversy between CIBA-GEIGY Corporation and Schering-Plough Corporation the following letter was written by the former (by the present writer) to the latter discussing the infringement issues of terms of the so-called "DuPont Factors":

> As you know, likelihood of confusion is the standard to determine whether the mark DURASOFT COLORS is a "colorable imitation", and thus an infringement, of our registered mark SOFTCOLORS®. There are several

factors to be considered in evaluating likelihood of confusion, and it is helpful to analyze each of those factors.

(1) Type of Trademark

SOFTCOLORS® is a strong mark which is entitled to wide scope of protection. SOFTCOLORS® lenses constitute the major portion of the sales by our subsidiary, CIBA Vision Corporation. SOFTCOLORS® lenses have been heavily advertised throughout the country since their introduction to the marketplace in 1982. The evidence of substantial sales and promotion of the SOFTCOLORS® lenses show that the mark has acquired a very high degree of public recognition and, thus, secondary meaning.

(2) Similarity of Design

"...[T]here is a general rule that a subsequent user may not appropriate another's entire mark and avoid likelihood of confusion therewith by merely adding descriptive or otherwise subordinate matter to it." *In re Rexel, Inc.* 223 USPQ 830, 831 (TTAB 1984). The phrase, "SOFT COLORS" is the determining or dominant portion of your composite mark while the term "DURA" serves in the context of the overall mark only as an amplifier or modifier of "SOFT COLORS", suggesting durability and long life. See, e.g. *In re Cyclone Seeder Co., Inc.*, 189 USPQ 153 (TTAB 1975) (affirming refusal to register "CYCLONE SPEEDY SPREADER" in view of "SPEEDY"). As used by Wesley-Jessen, "DURA" is perceived as nothing more than laudatory expression for our mark SOFT COLORS, resulting in a similarity in meaning between SOFTCOLORS® and DURASOFT COLORS.

The addition of the term "DURA" cannot serve to distinguish the two marks given the large number of registered marks which contain "DURA" and which are used in connection with lenses and related goods i.e., DURALET®, DURACON®, DURA-FLEX®, DURALUX®, and DURAPLASTIC®. That is particularly true since, having purchased Coopervision, Inc., we now own a mark containing "DURA", namely, DURAGEL® for ophthalmic lenses.

Contrary to your assertions as to how the word

COLORS is attempted to be distinguished from DURASOFT, enclosed is a copy of a "multicolor ad" which appeared in the September 28, 1987 edition of People magazine that used the mark DURASOFT COLORS in the text without distinguishing by color the word COLORS from DURASOFT and without the use of the registered symbol "®" in conjunction with DURASOFT. Of course, the use of multicolors for COLORS and the use of "®" do not negate infringement since the overall commercial impression of SOFTCOLORS® and DURASOFT COLORS is the same.

(3) Similarity of Products

The products sold under the respective marks are identical. Therefore, the injury to my company is simple and direct since the confusion caused by your mark has directly caused sales to be diverted to your company.

(4) Identify of Advertising Media

Another factor in evaluating likelihood of confusion is the similarity between the parties' advertising campaign. You are wrong in your assertion that our product is not advertised to the general public. We have had, and continue to conduct, extensive advertising in the identical manner as Wesley-Jessen, namely, television, radio, poster, counter top displays, advertisement in magazines read by the public (such as Sight), patient appointment reminder cards and patient brochures. As one court has noted, "[t]he greater the similarity in the campaigns, the greater the likelihood of confusion.". (*Exxon Corp. v. Texas Motor Exchange, Inc.*, 628 F2d 500, 506 (5th Cir. 1980)).

(5) Identity of Retail Outlets and Purchasers

The ultimate purchasers of the lenses are identical, namely, the public, who buy both lenses in the identical retail outlets. The following from a case involving a predecessor of your company is instructive:

> It is sufficient for purposes herein that the party claiming damage establish that the products are related in some manner, and/or that the conditions and activities surrounding the marketing of these goods are such that they would or could be encountered by the

> same persons under circumstances that could, because of the similarities of the marks used therewith, give rise to the mistaken belief that they originate from or are in some way associated with the same producer.

(*Schering Corp. v. Alza Corp.*, 207 USPQ 504, 507 (TTAB 1980). See also, *MRI Systems Corp. v. Wesley-Jessen, Inc.*, 89 USPQ 214, 219 (TTAB 1975).

The fact that, as you suggest, CIBA may benefit from confused purchasers asking for SOFTCOLORS® lenses instead of DURASOFT COLORS lenses does not excuse the infringement because the opposite is also true: use of our mark almost certainly will redound to the benefit of Wesley-Jessen. Also, as the *Schering* case pointed out, that physicians are knowledgeable in their field does not mean that they are equally knowledgeable as to trademarks and, thus, are immune from mistaking one mark for another.

(6) Intent

As you know, good faith is not a defense to trademark infringement but bad faith may prove infringement. (*Fuji Photo Film Co. v. Shinohara Shoji Kabushiki Kaisha*, 754 F2d 591 (5th Cir. 1985)).

The fact that you knew of our mark at the time you chose your mark is evidence of bad faith and your intent to trade upon our good will. As the court stated in *Wesley-Jessen Div. of Schering Corp. v. Bausch & Lomb Inc.*, 698 F2d 862 (7th Cir. 1983): "One entering a field already occupied by another has a duty to select a trademark that will avoid confusion."

(7) Actual Confusion

The final factor is actual confusion, but the test of infringement is likelihood of confusion, not the proof of actual confusion. Although we have no proof of actual confusion at this time, there would be a finding of likelihood of confusion since "[t]he evidence shows identical designations used on nearly identical products sold to identical markets through identical advertising media." (*Id.*)

Finally, in addition to the infringement issue, we have a claim for dilution since the uniqueness and distinctive

quality of the SOFTCOLORS® mark as the designation for our product are diminished by your unauthorized appropriation of that mark.

IV. RELEVANCE OF DEVELOPMENTS IN LICENSING PRACTICE

There are interesting and significant trends and open and unsettled questions in several areas of trademark licensing and franchising, as for example, 1) quality control, 2) boundary between trademark licensing and franchising and 3) tie-in practices.

These are indeed problem areas and clearly in a state of flux. It is very difficult to discern, for instance, where we stand on quality control. The traditional, fairly stringent requirements, still on the books and paid lip service to, are one thing but the realities in light of recent court decisions (e.g. *Penta Hotels*, *Nestle*) are another. USTA Bulletin No. 12, Vol. 45 April 3, 1990 on "Licensing" opined that "uncontrolled licensing should [n]ever work an abandonment of the licensor's mark." A startling conclusion!

Or let's take tie-in practices. The traditional view was that the trademark or the license is the tying "product" but courts have started to hold that a trademark or a license is not a separate "product." And as regards the question of when a trademark license is a franchise that can run afoul of any of the multitudinous legislative and regulatory controls, where is the borderline?

In greater particularity. Most trademark licensing nowadays is practiced via franchising, that is, trademarks and trademark licensing actually are the essence of franchising.

Since franchising is really nothing more than a trademark license, the question comes up, is every trademark license a franchise? And does it make any difference whether one calls it a franchise or one calls it a trademark license?

Well, it makes a major difference. One of the major differences that it makes is that if it's a franchise, one has to deal with the disclosure requirements of the Federal Trade Commission as well as either the disclosure requirements or the registration requirements of many states.

What is a trademark license and when does it become a franchise? There are certain rules of thumb. If there are multiple licensees who offer the same service, the same products, then it begins to look like a franchise. If the licensor exercises more control over his licensee than he needs to exercise in order to assure quality of the goods, the quality of the services that the mark represents, then there's a good chance one is dealing with a franchise. If one controls the business aspects of one's licensee, if one's license requirements get into business factors more than simply the quality of the goods or services, there's a good chance one is dealing with a franchise operation.

Now, as trademark licensing is the essence of franchising, control is the essence of

licensing. How can one control one's licensee? Well, one surefire method is to control the source of the materials, the supplies, the equipment the licensee or franchisee uses. And the best control for that, of course, is to sell the supplies and the materials oneself to one's licensee.

Can this be done without running into any kind of problem? First of all, it's always intriguing to do that kind of thing because not only does it offer one adequate control but it's a good income source, and so one will find frequently that one's client, the licensor, the franchisor, does not overlook that as an excellent means for controlling the quality of the goods or services that are being sold under his mark. The problem is that when one does that one runs into possible antitrust problems because there can be contentions that this is an unlawful tying arrangement. Tying is where the seller agrees to sell one product, the tying product, only on the condition that the buyer also purchases a second product, the tied product. This area, it is alleged, is the most frequently litigated area in franchising.

Now, for a tying arrangement to be unlawful — tying arrangements are not automatically unlawful — there are four elements that must be met. The seller must offer two separate and distinct products or services. The second element is that the sale of the tying product must be conditioned on the purchase of the tied product. The third element is that the seller must possess sufficient market power in the tying product which is sufficient to restrain competition in the tied product market. And the fourth element that must be proven is that a not insubstantial amount of interstate commerce must be affected by the arrangement.

With regard to separate products, there are and have been many attempts to consider the trademark or the franchise itself as a product and the related products that go along with the trademark to be a second product and, therefore, a tying arrangement. In other words, the trademark is the tying product and the goods are the tied product.

More recently, many courts have held that a trademark is not a separate product from the products with which the mark is used, and that in order for there to be an illegal tying between the product and the trademark, the product must not necessarily be inextricably interwoven with the reputation of the trademark. When one is dealing with a franchise, that's generally not the case. When one is dealing with a franchise arrangement, most of the time the trademark and the product sold under that mark are so closely interwoven that they are not separate items. There was a recent case involving a gasoline distributorship and it was found that the gasoline and the trademark were not separate products. There was a similar case involving Kentucky Fried Chicken where chicken seasoning and the trademark were held to be so closely aligned that they were not separate products and therefore not two products and, therefore, not an illegal tying arrangement.

The second element is conditioning the sale of the tied product on the sale of the tying product. There must be proof of coercion in order to establish an illegal tying arrangement. The third element is market power. And as a result of recent decisions, the franchisee bears a very heavy burden in demonstrating sufficient market power. In some

recent cases it was found that a market power as high as 30% was not sufficient market power to constitute an illegal tying arrangement.

There are defenses to the charge of illegal tying. If one can establish that there was a good business reason to establish the complained of franchise arrangement, then even though the agreement meets the four elements of the tying claim, the courts will permit that type of arrangement to take place.

In a *Mercedes-Benz* case, for example, the North American distributor of Mercedes-Benz parts, replacement parts, required dealers to buy the replacement parts from the North American distributor, the explanation being that since Mercedes-Benz, the German manufacturer, spent so much time and effort in producing the parts, in running through their own quality control, that it was not unreasonable to require distributors and dealers of Mercedes-Benz vehicles in the U.S. to buy replacement parts from the North American distributor, because that way the distributor would not have to go through a quality control check of his own which can be an extremely expensive proposition. The court found that was sufficient reason to permit a tying arrangement.

Courts have found that protection of trade secrets is also a sufficient reason. If, for example, in a fast food operation there is a particular ingredient which is a very significant ingredient in connection with the food product, and that ingredient is made by a trade secret, there is sufficient business justification for requiring the franchisee to purchase the ingredient from the franchisor without being found to be an illegal tying arrangement.

V. TRADEMARK TRAINING AND TEACHING IN AMERICA

Historically most of the trademark training has been of the on-the-job type and has taken place in a mentor system and this is still generally the case even nowadays in IP law firms hiring new law school graduates and in corporate IP departments doing the same or entrusting or charging a member of the department with whatever trademark practice there is in the corporation. Except in fairly large consumer-oriented businesses which have separate trademark departments of varying sizes or trademark sections in the Legal Department, trademark work is often done by a patent attorney in the Patent Department on a part time basis.

This on-the-job training and mentoring is supplemented attendance at programs held by local and national bar and IP associations, in particular, the U.S. Trademark Association (USTA), as well as the Practicing Law Institute (New York) or Prentice Hall, etc. In states with CLE (Continuing Legal Education) requirements, compliance with those requirements by attendance at professional meetings and trademark courses is an additional motivation.

Some law schools offer basic IP survey courses including Patents, Trademarks and Copyrights or separate Patent, Trademarks and Copyright courses, as for instance, the University of Baltimore Law School and the Dickinson School of Law (Dickinson) of Carlisle, Pennsylvania. The University of Baltimore School of Law offers IP survey

courses, including trademark treatment, which is undoubtedly due to the presence of IP Professor William T. Fryer III. The IP course descriptions and the syllabus of the seminar course are rendered in Annexes I and II. In the seminar course which has an enrollment of about 20 students, IP alumni/ae and other practitioners are enlisted to help out. Dickinson has three elective IP courses — Patents, Trademarks Copyrights — for two semester hours each. This undoubtedly has something to do with the presence of Professor William J. Keating, a former Patent Counsel at AMP Inc., who in fact teaches these courses. Professor Keating assesses the situation as follows: "... the few schools that have an intellectual property program offer a survey course including patents, trademarks and copyrights. Except for Franklin Pierce, John Marshall and the Washington, DC schools, most schools do not have enough students to justify a program." (Personal Communication, March 18, 1991.) But interestingly Professor Keating's classes are relatively large: they "usually have 40 students in Patents; 70 students in Copyrights and 80 students in Trademarks." The course description for the trademark course is as follows:

> Trademarks — 2 semester hours — Fall
> The law of trademarks is central to the concept of fair dealing in the commercial environment. the history of common law and statutory trademarks is explored as well as registration, conveyancing and foreign rights. The course deals with the duty of the merchant to compete honestly and remedies for failure to do so. Prerequisite for Law of Franchising.

The syllabus of the trademark course offered by Dickinson is appended as Annex III.

To give two more instances: Albany Law School, Albany, New York, where IP Professor Michael Hutter has been in residence for many years, has two-or-three-credit survey courses in Industrial Property and in Copyrights, which are taught by adjunct professors and Unfair Trade Practices which Professor Hutter teaches. And Notre Dame Law School, South Bend, Indiana, has two two-credit IP courses, one of which covers Copyright, Trademarks and Trade Regulations and is taught by resident Professor Joseph Banner. It is taught in alternate years with about twenty students taking it. A few additional law schools across the country, possibly increasing in numbers due to the present-day "sex appeal" and glamour of IP law and practice, have such a pattern of basic or survey courses.

VI. LAW SCHOOLS WITH IP LAW SPECIALIZATION

A. George Mason University School of Law

The George Mason University School of Law (George Mason) in Arlington, Virginia — first on a list of five "up and coming" U.S. law schools, published in U.S.

News & World Report (March 19, 1990, p.60) — touts as its "contemporary approach to legal education" several areas or "tracks" of specialization, in addition to its day and evening division standard programs. One is the "Patent Law Track" which is a four-year evening division program "designed to provide students with a level of expertise usually found only in attorneys with post-J.D. study or several years of experience" (George Mason's Admissions Prospectus 1991, p.4).

For graduation 87 semester hours are required, with 22 in IP Law courses (of which 14 semester hours are patent-specific and 8 are in Unfair Trade Practices, Copyrights, and Trademarks), 40 in required Standard Program courses, and 25 in courses considered valuable for practice in most areas of law, and at the same time clearly of value for a career in Patent Law.

During their initial year in law school, Patent Law Track students take the same first-year courses that are required for the Standard Program Evening Division students.

The Patent Law courses are evenly distributed over the last three years of this four-year evening program. Three-fourths of the course work is outside Patent law ensuring that students "become well-rounded lawyers."

Interestingly, the Patent Law Track "is only for students with scientific or engineering training who intend to practice patent law. Other students interested in trademark practice presumably can take trademark and the other non-patent courses as electives.

The detailed curriculum of the Patent Law Track is given as Annex IV.

The IP faculty is headed by George Mason University Foundation Professor Irving Kayton (formerly at George Washington in a similar capacity) and includes such part-time lecturers in law as David Kera, a former official of the "U.S. Trademark Office", and Richard Schwab who practice in the Washington area.

B. The John Marshall Law School

The John Marshall Law School (John Marshall) of Chicago, Illinois is one of the largest independent law schools in the nation, with an enrollment of over 1,200 students.

John Marshall has a day and evening division as well as an eight-week summer session. In the evening division at least four years and one summer session are required for completion. The day division is standard. The requirements for the J.D. degree program are at least 90 semester hours. John Marshall also has two graduate programs: Taxation and IP requiring 24 semester hours or 21 semester hours and an independent study project to obtain an LL.M.

The faculty of the IP Division consists of Associate Professor Albert G. Tramposch as its Director and adjunct professors from the Chicago IP bar, i.e. local practitioners, e.g. Messrs. Louis Altman, John Crystal, Raymond Geraldson, Thomas Hoffmann, Donald

Peterson, Leonard Rubin, etc.

According to its most recent brochure on its "Center for Intellectual Property Law", John Marshall offers one of only a few programs in the country dedicated solely to training lawyers and law students in U.S. IP law. "... [T]he Intellectual Property Division... offers J.D. candidates, LL.M. candidates, practicing attorneys and paralegals specialized training in all aspects of patent, trademark and copyright law, trade secrets, unfair competition and international intellectual property law."

Its J.D. and LL.M. Programs are described therein as follows:

> "After completion of their first year of required core courses, J.D. students may take classes in Patent and Trade Secret Law, Trademark and Copyright Law, IP Law and Practice, Unfair Competition and Trade Regulation, and Entertainment Law. Internships allow students to work with an IP law firm while studying in the program. LL.M. courses are also available to advanced J.D. students.
>
> ....
>
> John Marshall offers an advanced degree, Master of Laws in IP, for law school graduates who want to obtain specialized and advanced training in all aspects of intellectual property law.
>
> A comprehensive patent program is offered for students with a science or engineering background, including advanced courses in Substantive Patent Law, Patent Office Practice, Interference Practice, Patent Litigation, Technology Licensing and International Patent Law. Trial Advocacy for Intellectual Property Attorneys trains students in trial techniques unique to patent cases.

The IP course offerings are attached as Annex V. Four graduate trademarks courses are among them: Trademark Law and Practice, Trademark Litigation, International Trademark Law and Franchise Law and Practice.

C. The George Washington University

The National Law Center of the George Washington University (George Washington) has a J.D. degree program with day and evening divisions and a summer session as well as graduate (LL.M. and D.J.S.) programs. It has several specialized LL.M. programs, one of which is IP Law. Total student enrollment numbers over 1600.

According to the George Washington's 1990-91 Bulletin, the Patent Law Program, under the direction of Professor Donald W. Banner of the Washington firm of Banner, Birch, McKie & Beckett,

> "has been developed to offer as complete and as integrated a collection of courses in this field of law as possible. The program is one of the most extensive in the U.S. The object of the IP Law Program is to

provide the student with a concentration in this field of law at a level of specialization and maturity that can enable advancement far more rapidly than usual in this field." (Bulletin, p.69)

The curriculum of the IP Law Program includes the following:

Licensing of IP Rights [2]
Chemical and Biotech Patent Practice [2]
Advanced Topics in Patent Law [2]
Interference Law and Practice [2]
Enforcement of Patent Rights [2]
Electronics and Computers: Patent Practice [2]
Foreign and Comparative Patent Law [2]
Copyright Law [2]
Trademark Law [2]

LL.M. candidates in the area of Patent Law "who have not taken the following courses or their equivalent as part of a (J.D.) program" are to include them in their LL.M. program:

Federal Antitrust Laws [3]
Trade Secret and Patent Law [3]
PTO Practice in Patent Matters [2]
Unfair Trade Practices [3]

In addition to the Director, Professor Banner, the IP law faculty includes as adjunct faculty, such patent attorneys of the D.C. area as Messrs. Brian Brunsvold, Lawrence Hefter (a trademark expert), Maurice Klitzman, Rene Tegtmeyer, Harold Wegner, etc.

VII. FRANKLIN PIERCE LAW CENTER

Franklin Pierce Law Center (FPLC) began in 1973 as a small, pioneering law school and as New Hampshire's only law school.

Now FPLC has a faculty of over twenty full-time professors and twenty adjunct lecturers, a student body of close to 400 students (about 25% of whom specialize in IP law), and a record of innovations in training students to meet the challenges of practice.

As one of the leading institutions of IP Law training in the U.S. today, FPLC differs from such other leaders as George Mason, John Marshall or George Washington. Instead of emphasizing advanced-degree or evening-school programs, it provides a well-rounded, full-time curriculum leading to the basic legal degree, the Juris Doctor (J.D.). FPLC is the only law school having more than one full-time IP professor. FPLC, in fact, has five. In addition, the President and Founder of FPLC, Robert H. Rines is a practising IP attorney and an inventor with over 60 patents to his name.

The number of course credits at FPLC pertaining to Patent Law is higher than any

other U.S. law school's offerings designed for J.D. degree students. The current list of courses, is as follows:

International Patent Law [2]
International Trade Regulation [2]
Legal Skills II — IP Sections [2]
Licensing IP [3]
Patent Practice & Procedure I [2]
Patent Practice & Procedure II [2]
Proactive IP Management [2]
Science, Technology & Administrative Process [3]
Selected Topics in IP Law I [2]
Selected Topics in IP Law II [2]
Survey of IP [3]
Trademarks & Deceptive Practices [3]
Trial Advocacy — IP Section [3]
Patent Litigation [2]

Description for the above courses are reproduced in Annex VI. Also appended are Professor Tom Field's Syllabi for his Trademark and IP Survey courses. See Annexes VII and VIII.

Apart from the trademark course, the Licensing, Proactive IP Management and IP Survey courses deal also with trademark and franchising to a significant extent.

FPLC has a half-year-long or a year-long, full-time course of study leading to a Diploma or a Master of Intellectual Property (MIP) degree. The MIP has been created as a master level degree but not a graduate LL.M.-type law degree inasmuch as some students have technical backgrounds but do not have law degrees. For both foreign and U.S. nationals who do not need law degrees to become licensing experts, the Diploma and MIP Programs are very appropriate. Many of the students enrolled in these programs are lawyers or administrators in foreign countries without technical backgrounds.

MIP Program participants spend two semesters at FPLC taking a thorough curriculum of academic courses, practical skills training and comparative law exposure. Subjects intensively treated are contract law, trademarks, patents technology licensing, copyrights, trade secrets, the law of international trading and business relationships and international patent law. In addition, students unfamiliar with the U.S. legal structure are introduced to it through special lectures as well as research and writing exercises.

The third MIP semester places foreign students for one month each at the USPTO or Copyright Office in Washington, DC, in an IP law firm and in the IP department of an American corporation.

FPLC also offers a shortened, one-semester Diploma Program for applicants who cannot spend an entire year in residence. The six-month Diploma Program includes the

same courses as required in the first semester of the MIP Program; upon completion of the semester, participants take part in a one-month internship at a single U.S. institution.

FPLC also offers six-week two-credit courses each summer in IP subjects for law students, lawyers, engineers, scientists and managers, as follows: Trademarks, Patent and Trade Secret Law, Patent Practice and Procedure, Licensing/Technology Transfer, and Copyrights.

VIII. CONCLUSION

I will end where I began. The training situation in trademarks is quite different from that in the patent field. Trademark law is sort of in-between — in between patent and general law. It is a very narrow speciality which comes into its own only in large consumer-oriented companies. Formal academic training hardly exists; it's even more a matter of on-the-job training and trademark practice is as much of a black art and maybe even more than patent practice. Attorneys and only attorneys can practice trademark law. A degree in engineering or sciences is not a requirement at all, nor is admission to practice before the USPTO. Nonetheless, many patent attorneys in private as well as corporte practice do trademark work — mostly on a part-time basis.

The situation has improved in recent years with trademarks riding the coattails of patents in present the Golden Age for patents. More law schools now offer basic trademark courses or IP survey courses with trademark treatment. But any course offerings are but an appendage to a more extensive patent or IP curriculum.

KFJ/Ruh/10.15.91

ANNEX I

Baltimore School of Law

Law 902 — Basic Course I — Fall Semester
Patents, Trademarks and Technology — 3 credits

Introduction to product image and technology protection and utilization, including computer law. Basic principles and application of trade secrets, employment agreements, research and development proposals, patents. Semiconductor Chip Protection Act, trademarks, tradenames, unfair competition, licensing practices, antitrust considerations for technology transfer, and enforcement procedures, including litigation.

Law 901 — Seminar — Spring Semester
Patent, Copyright and Trademark Law — 3 credits

Advanced study concerning current problems in patent, trademark, trade secret and copyright law. The course includes an analysis of the interrelationship of these areas, and the effectiveness of controls that are designed to prevent misuses of these rights. Each student is to prepare and present a paper concerning at least one of these four areas of IP law.

PATENT, COPYRIGHT AND TRADEMARK SEMINAR
U OF B SCHOOL OF LAW
SPRING 1991
PROFESSOR FRYER

TENTATIVE SCHEDULE

Date	Topic
1/14/91	Session 1 Topic: Course Introduction Session 2 Topic: Trademark Surveys - Part I
1/21/91	NO CLASS - HOLIDAY
1/28/91	Session 1 Topic: Trademark Surveys - Part II Session 2 Topic: Research Topics Discussion
2/4/91	Sessions 1 and 2 topic: Review of significant, recent cases, laws and legislation.
2/11/91	Students turn in written description of research topic for approval, and list initial, anticipated research sources. This paper will be turned in at the beginning of class. Sessions 1 and 2 Topic: Role playing of Simulated Patent Law Harmonization Diplomatic Conference (real one to be held on June 3 - 28 at the Hague; we will used the same documents and represent the various political groups, EC, US, Japan, Third World, and non-governmental organizations). It is expected that several guests will participate who are interested in this topic.
2/18/91	Sessions 1 and 2 Topic: Continue Patent Law Harmonization Simulated Diplomatic Conference.
2/25/91	Sessions 1 and 2 Topic: Copyright law - Teachers' Right to Reproduce Copyrighted Material for Classroom Use Now that US is a Member of Berne. It is expected that University and State Attorney General representatives will be present.
3/4/91	Sessions 1 and 2 Topic: Trademark Dilution. There will be a debate on whether a state and/or the Federal Government should Adopt

a dilution statute.

3/11/91 — Sessions 1 and 2 Topics: A Practical Exercise on Negotiating Transfer of Technology Agreements. This class will be conducted by Charles E. Yocum, patent attorney, Black & Decker Corp. (U of B Law School graduate). He introduces this topic by asking the question "[why] do trade secrets give me more gray hairs than any intellectual property?"

Each student will submit a written outline of their research paper. The professor will review it and may set up conferences this week to discussion the research paper work. This outline will be submitted at the beginning of the class.

3/18/91 — NO CLASS - SPRING BREAK

3/25/91 — Sessions 1 and 2 Topic: Genetic Engineering and Intellectual Property, including Farmers' Right to Reproduce Patented Animals (Congressional legislation). Guests are expected who will contribute to this discussion.

4/1/91 — NO CLASS - STUDENTS WILL WORK ON THEIR PAPERS

4/8/91 — Sessions 1 and 2 Topics: Student Research Papers Oral Presentations (20 minutes per student, approximately).

4/15/91 — Sessions 1 and 2 Topics: Same as 4/8/91.

4/22/91 — Sessions 1 and 2 Topics: Same as 4/8/91

4/29/91 — NO CLASS

Each student will have a conference with the professor this week to discuss the research paper. The research paper will be turned in prior to the conference, to allow sufficient time for the professor to review it. The research paper must be completed by the end of this week, unless other arrangements are made with the Professor.

NO FINAL EXAM

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PATENT, COPYRIGHT AND TRADEMARK SEMINAR
UNIVERSITY OF BALTIMORE SCHOOL OF LAW
1/18/91
PROFESSOR FRYER

ASSIGNMENT FOR CURRENT IP DEVELOPMENTS CLASS ON 2/4/91

General Note: Each case will have two students preparing it, one examining the plaintiff's side and the other the defendant's side. These students can work together and decide how to present the case. There will be 2 or 3 students reporting on each of the new laws. Students are encouraged to do some further reading to prepare their oral presentations (no written report is required). A handout or blackboard diagram may help present the topic. Student should indicate selection of topic on the sign-up sheet. The case presentations will be approximately 15 minutes and the new law presentations will be approximately 30 minutes. Each student should prepare an explanation of the topic that lasts about 5 minutes. There will be time for questions and the students presenting the topic should be prepared to answer them.

Session 1 - Computer Software

1. New law - computer software rental
Resources (handed out to all students): See 41 BNA-PTCJ 5 (11/1/90) for legislative history summary; see 41 BNA-PTCJ 18-20 (11/1/90) for Congressman Kastenmeier's statement on the legislation; see 40 BNA-PTCJ 548 - 554 (10/25/90) for the statute [bill S198 (101 Cong., 2nd sess.) corresponds in all respects to the enacted law, except for a provision on coin-operated video games].
Special Note: Explain the significance of the new law, including how software owners will take advantage of it and any problems they may have in applying the law.

2. Patent and computer program related cases
In re Grams, 888 F.2d 835, 12 USPQ2d 1824 (Fed. Cir. 1989);
In re Iwahashi, 888 F.2d 835, 12 USPQ2d 1908 (Fed. Cir. 1989).
Special Note: Compare these cases on the issue of statutory subject matter protection under the patent law for computer programs.

3. Trade secret and computer program related case
Otis Elevator Co. v. intelligent Systems, Inc., Superior Court of Conn. 1990 (found only on Lexis). The Lexis case numbers are 147 and 1689.
Special Note: Review the issue of what standard of care should be used in protecting computer software.

Session 2 - Other Intellectual Property

4. Trademark - protection of fragrance
In re Celia Clark (TTAB 1990). This case is only on Lexis
Lexis number is 53.
Special Note: What is the criteria for trademark protection of fragrance.?

5. New law - Copyright protection of architectural works
Resources: Same as item 1 above resources.

6. New law - Moral rights
Resources: Same as item 1 above.

ANNEX III

Dickinson School of Law

TRADEMARKS
*Indicates Law Firm Presentation

Prof. Keating
Fall 1990

Sep.	5	In re Minnetonka (p. 50) In re Gold's Gym (p.53)
	6	American Meat Institute v. Longacre (p.37)
	12	Greyhound Corp. v Both Worlds (p.59) Levi Strauss v. Blue Bell (p. 89)
	13*	Jonbill v Int'l Multifood (p 65) Hi Country Food v Hi Country Beef (p 69)
	19	McDonald v. Quality Inn (p. 73)
	20*	In re Gastown (p.85)
	26	First National Bank of Omaha v. Autoteller Systems Service Corp (p.270)
	27*	Ace Hardware Co. v. Ace Hardware Corp. (p.246)
Oct.	3	Park N Fly v. Dollar Park N Fly (p.249)
	4*	In re Nantucket (p. 99) Sears Roebuck v Stiffel (p 113) Compco v Day Brite (p 121)
	10	Champion Spark Plug v Sanders (p 181)
	11*	In re Smith (p. 128) In re Morton-Norwich (p. 131)
	17	Pagliero v. Wallace China (p.141)
	18*	Smith v. Chanel (p184) Chanel v. Smith ((p.191) Charles of the Ritz v. Quality King (p.195)
	24	L'Aiglon Apparel v Lana Lobell (p 199) Discussion of Trademark Applications
	25*	American Home Products v. J.& J. (160)
	31	Freddie Fuddruckers v. Ridgeline (p.171) Prufrock v Lasater (p. 176)

Nov.	1*	Boston Hockey v. Dallas Cap (p.204) Rolls Royce v. A.A.Fiberglas (p.210) Jobs Daughters v. Lindeburgh (p.220)
	7	Speaker(?)
	8*	Gilliam v ABC ((p. 225)
	14	Colligan v. Activities Club (p.235) Thorn v. Reliance Van (p.243)
	15*	SKF & Co. v Premo Pharmaceutical (p 147)
	Nov. 21 & 22	Holiday
Nov.	28	"Intent To Use " article (p.276)
	29*	Big O Tire Dealers v Goodyear (p. 256)
Dec.	5	
	6	

ANNEX IV

George Mason University
School of Law

Patent Law Track
(Evening Division Only)

First Year
Fall

Legal Research, Writing, and Analysis I	1
Contracts I	3
Property I	3
Quantitative Methods I	4
	11

Spring

Contracts II	3
Property II	2
Constitutional Law	4
Quantitative Methods II	2
	11

Second Year
Fall

Legal Research, Writing, and Analysis II	2
Criminal Law	3
Torts	4
Patent Law	2
	11

Spring

Civil Procedure I	4
Patent Office Practice	2
Copyrights	3
	9

Third Year
Fall

Civil Procedure II	2
Evidence & Trial Procedure	3
Antitrust	3
Trademark Law	2
Advanced Topics in Patent Law	2
	12

Spring

Administrative Law	3
Trusts and Estates	3
Unfair Trade Practices	3
+Chemical Patent Practice OR	
+Electronics & Computer Patent & Copyright Practice	2
	11

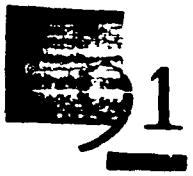
Fourth Year
Fall

Business Associations	4
Commercial Paper	3
Professional Responsibility	2
+Patent & Copyright Litigation in Electronics & Computer Cases OR	
+Patent Litigation in Chemical Cases	2
	11

Spring

Income Taxation	4
Conflict of Laws	3
Patent & Know-How Licensing	2
+Appeals from Patent Trials & Patent Office Proceedings OR	
+Biotechnology Patent Practice	2
	11

(+) Denotes elective courses.



Course Descriptions: Master of Laws Degree

INTELLECTUAL PROPERTY DIVISION
INTELLECTUAL PROPERTY 400
SUBSTANTIVE PATENT LAW I (3)

Prerequisite: Patent and Trade Secret Law or acceptance for LL.M. in Intellectual Property Law or waiver thereof based upon equivalent in academic credits or practical experience.

Not open to students who have taken IP 415 Law of Patents.

A study of the modern law of patentability and patent validity fundamentals with emphasis on the impact of the Patent Act of 1952 and modern Supreme Court and Federal Court cases. Controlling case law is analyzed in depth on statutory categories (35 U.S.C. 101), and novelty, utility, and unobviousness as conditions of patentability (35 U.S.C. 101, 102, and 103). Prior art and loss of right acts under 35 U.S.C. 102 and their relevance to patentability under 103 are thoroughly covered. Consideration is given to the substantive aspects of the disclosure and claiming requirements (35 U.S.C. 112). General requirements for obtaining Design Patents, Plant Patents and Plant Variety Protection Act (PVPA) certificates are addressed.

INTELLECTUAL PROPERTY 401
SUBSTANTIVE PATENT LAW II (3)

Prerequisite: IP 400 **

Scope and construction of patents, infringement; contributory infringement; inducement to infringe; unenforceability defenses; jurisdiction in patent infringement and related actions; relief in patent infringement actions.

INTELLECTUAL PROPERTY 402
PATENT OFFICE PRACTICE (3)

Prerequisite: IP 400 or IP 401 **

The formal requirements of the patent application, communications from the Examiner, requirements for restriction, rejection of applications and claims, interviews, appeal, certificates of correction, reissues, and other aspects of proceedings before the Patent and Trademark Office. This course includes a treatment of the art of preparing patent applications, including the drafting of claims.

INTELLECTUAL PROPERTY 403
TRADEMARK LAW AND PRACTICE (3)

The historical development and nature of trademark law; creation and maintenance of trademark rights; trademark registration and administrative proceedings; loss of trademark rights; infringement of trademark rights; proof of infringement; special defenses and limitations; unfair competition law; juriscition and remedies.

INTELLECTUAL PROPERTY 404
ANTITRUST (3)

Restraint of trade under the common law; the Sherman Act, Federal Trade Commission Act and State Anti-Trust Laws; agreements, combinations, and conspiracy in restraint of trade; monopolization under the Sherman Act; mergers under Section 7 of the Clayton Act; refusals to deal in relation to the antitrust law; exclusive dealing under the Sherman and Clayton Acts; tying clauses; criminal and civil enforcement pro-
ceedings.

INTELLECTUAL PROPERTY 405
INTERFERENCE PRACTICE (1)

Prerequisites: IP 400 and IP 401 **

Theory of interferences; affidavits under Patent Office Rule 202; setting up interferences; preliminary statements, motion period; hearings, review and determination of motions; form of testimony; testimony period and procedure; discovery; final hearing; review of interference decisions; proof (including corroboration) requirements; estopple issues, law of priority.

INTELLECTUAL PROPERTY LAW 406
COPYRIGHT LAW AND PRAC-
TICE (3)

Scope and applicability of U.S. copyright law, including review of: those portions of the 1909 Copyright Act that continue in force; the 1976 Copyright Act now in effect; and the 1988 Berne Convention Implementation Act as it affects both domestic and foreign copyrights in the United States.

INTELLECTUAL PROPERTY 434
CLINICAL EDUCATION IN INTELLECTUAL PROPERTY LAW (2)

Students selected to participate in this program work with intellectual property attorneys in private and corporate practice approved by the law school. The student will receive either a "pass" or "fail" grade based upon an evaluation of the student's work.

** Prerequisites may be waived only by written permission of the Director.

INTELLECTUAL PROPERTY 407
TECHNOLOGY CONTRACTS (2)

Implied licenses, express licenses, enforcement of license provisions, title interest in intellectual property and their transfer.

INTELLECTUAL PROPERTY 408
PATENT LITIGATION (2)

Prerequisites: IP 400 and IP 401 **

Preliminary considerations in patent litigation including jurisdiction, venue, and potential relief; the pleadings; pretrial activities, including discovery; the trial, including witness and evidence considerations; injunctive and damage remedies; and appellate procedures.

INTELLECTUAL PROPERTY 409
TRADEMARK LITIGATION (2)

Prerequisite: IP 403 **

Preliminary considerations in trademark litigation including jurisdiction, venue and potential relief; the pleadings; pretrial activities including discovery; the trial, including witness and evidence considerations; and appellate procedures.

INTELLECTUAL PROPERTY 410
PRICING REGULATION (2)

Federal and state regulation of price discrimination; promotional allowance and service discrimination; buyer's liability for inducement of discriminatory prices, services, and allowances; predatory pricing and below-cost selling; legal relationships with brokers and manufacturers representatives.

INTELLECTUAL PROPERTY 411
ANTITRUST AND MISUSE ASPECTS OF INTELLECTUAL PROPERTY (3)

The Sherman Act, the Clayton Act, and the "Misuse Doctrine" as applicable to the acquisition, enforcement, and licensing of patents, trademarks, copyrights, and "know-how."

INTELLECTUAL PROPERTY 412
TAXATION OF INTELLECTUAL PROPERTY (1)

Federal tax law as it applies to patents, trademarks, copyrights, and "know-how." Consideration will be given to federal tax treatment of development and acquisition expenditures, proceeds from licensing and transfers, litigation expenses and recoveries, and evaluations.

INTELLECTUAL PROPERTY 413
INTERNATIONAL PATENT LAW (2)

Prerequisite: IP 400 **

The Paris Convention and its revisions, the Patent Cooperation Convention, review of principal foreign patent systems including the European Patent Convention; approaches to obtaining patent protection and enforcement in foreign countries, etc.

INTELLECTUAL PROPERTY 414
INTERNATIONAL TRADEMARK LAW (1)

Prerequisite: IP 403 **

Study of foreign trademark and unfair competition practice including selection, searching, filing, prosecution, renewals, licensing, assignments, watching, opposition, cancellation, infringement, use, marking, and review of existing and proposed international treaties, including European Trademark, Madrid Arrangement, and Pan American Convention.

INTELLECTUAL PROPERTY 415
LAW OF PATENTS (1)

Not open to students who have taken IP 400 Substantive Patent Law I and IP 401 Sunstantive Patent Law II.

A survey of concepts and terminology of American patent law designed for the degree candidate who has no intention of prosecuting patent applications before the United States Patent and Trademark Office. Emphasis is placed on the distinctions between patents and other forms of intellectual property.

INTELLECTUAL PROPERTY 416
INTERNATIONAL ANTITRUST ISSUES (1)

Prerequisite: IP 404, IP 413 & IP 414 **

The developing antitrust laws relating to patents and trademarks in Europe and the Pacific Rim countries. A look at a unified EEC after 1992.

** Prerequisites may be waived only by written permission of the Director.

INTELLECTUAL PROPERTY 417
ADVERTISING COMPLIANCE LAW (2)

Advertising litigation under the Lanham Act; private, state and local public remedies for consumer protection against deceptive advertising, FTC regulation of deceptive advertising and consumer protection, consumer protection under other federal statutes.

INTELLECTUAL PROPERTY 418
BUSINESS FRANCHISE LAW AND PRACTICE (2)

This course provides a theoretical foundation appropriate to representation of clients in a number of the situations peculiar to business franchise systems and operations. Federal and state statutes, regulations and cases are examined. Particular attention is given to: procedures, documents and disclosures required to comply with restrictions upon and conditions precedent to the establishing of business franchise systems; and legal limits on franchisors and franchisees relative to terminations and nonrenewals of individual franchises in business franchise systems.

INTELLECTUAL PROPERTY 419
ENTERTAINMENT LAW (2)

A concentrated review of the areas of law most often involved in entertainment litigation, including: copyright, defamation, privacy, publicity and unfair competiton, and their applicability to the principal areas of the entertainment industry. The course includes synopses of the practical workings of the principal entertainment media, including: music, broadcasting, theater, motion pictures, publishing and sports.

INTELLECTUAL PROPERTY 420
CONTEMPORARY PROBLEMS IN COMPUTER LAW (2)

A seminar analyzing contemporary problems in Computer Law. Topics to be covered include: introduction to technology, intellectual property overview, recurring and significant contract provisions, integrated system transactions, liability and litigation, computer generated evidence/expert testimony, privacy/security, government contracting issues, bankruptcy and software escrows, taxation, international law and transactions, antitrust and domestic and international distribution, and software and database acquisitions.

INTELLECTUAL PROPERTY 421
CONTEMPORARY TECHNOLOGY AND INTELLECTUAL PROPERTY LAW (2)

A seminar examining problems in the law of Intellectual Property presented by new forms of technology. A study of the difficulties faced by the United States Patent and Trademark Office and the Courts in applying existing patent, copyright and trademark law to promote progress on the frontiers of science and proposed solutions. Areas to be considered include: the patentability of forms of life, inventions made in space, semiconductor topology, non traditional forms of property, look and feel of computer programs, biotechnology, colorization of movies, moral rights, industrial designs, shrink wrap licenses, states rights versus preemption and supremacy, copying for home use.

INTELLECTUAL PROPERTY 430
TRIAL ADVOCACY FOR INTELLECTUAL PROPERTY ATTORNEYS (3)

Prerequisites: IP 408 and knowledge of current rules of evidence **

The mechanics of trying patent lawsuits, opening statements, preparation, direct and cross-examination of, in-trial motions, closing arguments. The course is compacted into an intensive 9 a.m. to 6:30 p.m., 9½ day format. Faculty members and students believe this concentrated format aids learning and gives a more realistic understanding of the rigors of trial practice. The final examination is a simulated patent trial. Limited to ten students. Not available to J.D. candidates.

INTELLECTUAL PROPERTY 431, 432
INDEPEDENT STUDY (2 OR 3)

The undertaking of a project approved by the Director of the Division requiring scholarly independent study which will result in a significant contribution to the law of Intellectual Property.

INTELLECTUAL PROPERTY 433
DISSERTATION (3)

The preparation of a scholarly thesis suitable for publication adding significant new contributions to the fund of writing already in existence relating to the law of Intellectual Property and not merely a recapitulation. The topic to be approved by the Director of the Division. Available to degree candidates who have completed a major of 21 semester hours of subjects, including IP 400 Substantive Patent Law I or IP 415 Law of Patents, with a minimum grade point average 2.75.

** Prerequisites may be waived only by written permission of the Director.

COPYRIGHT LAW William Strong — 2 Credits
IP0001-01 — Fall Semester

This course examines copyright law as applied to the full range of eligible works, from fine art to computer programs. The emphasis is on close analysis of both statutory and case law, as they relate both to principles and to technical issues. The Berne Convention and oral rights are also discussed.

The grade is based on a take-home exam.

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INTERNATIONAL PATENT LAW Michael Meller — 2 Credits
IP0002-01 — Spring Semester

Open to second- and third-year students interested in patents who have taken at least some basic U.S. patent law courses or to MIP students who have taken basic patent law courses in their respective countries.

This course introduces the patent law student to international patent law theory and practice, as well as the substantive aspects of patent law and how they differ from a comparative law standpoint between respective jurisdictions in the U.S., Canada, the English system countries, as well as Western Europe, Eastern Europe, including the Soviet Union, and in the Orient: Japan, China, Korea, Taiwan, as well as Australia, New Zealand, and the Latin American countries. The course also covers the international treaties, including EPC and PCT as well as some licensing law, especially as developed in the EEC, and International Litigation concepts.

The course is offered once every three weeks in five six-hour sessions, with class participation strongly encouraged, constituting 15 percent of the grade. The remainder of the grade will be based on a final exam to be given at the end of the course (60 percent), and a paper involving original research (25 percent).

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INTERNATIONAL TRADE REGULATION—Minicourse William Hennessey — 1 Credit
CM0003-01 — Fall Semester

Open to all second- and third-year students.

This minicourse will cover U.S. import and export regulations, the role of the U.S. International Trade Administration, International Trade Commission, and U.S. Trade Representative, the General Agreement on Tariffs and Trade (GATT), free trade agreements, and other regulations affecting international trade. Basis for a grade will be a short-answer final examination.

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LEGAL SKILLS II — 2 Credits
RQ0014 — Spring Semester

Skills II is a required second-semester course for every first-year student. The course consists of a moot court appellate argument. Each faculty member publishes a legal problem covering a particular area of the law. Small groups of eight students work on each of these problems and are supervised by that particular faculty member. Each student prepares a ten-page brief arguing her side (appellant or appellee) of the case. Each student then makes a 15-minute oral argument of her case before three judges (the faculty member involved, as well as two practicing attorneys from the community). Oral arguments are held in The

LICENSING INTELLECTUAL PROPERTY (Technology Transfer) — **Karl Jorda** — **3 Credits, Fall Semester**
IP0003-01

Grade is based on an exam and several class problems.

The emphasis will be on creative licensing arrangements involving intellectual property (including franchising), their negotiation and implementation, actual licensing situations, antitrust and misuse problems, understanding and drafting some of the more important basic clauses, royalty determinations and valuation of intellectual property, and administration of license agreements.

This course will include both licensing your client's intellectual property to another, and licensing intellectual property from another to your client.

A knowledge of intellectual property law (patents, trade secrets, know-how, trademarks, and copyrights) is not a prerequisite, nor is a technological background necessary for this course.

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PATENT PRACTICE & PROCEDURE I & II — **Robert Shaw** — **2 Credits Each Semester, Fall & Spring Semester**
IP0004-01 & IP0009-01

This is a year-long offering. No prerequisite.

This highly specialized course sequence is designed to provide comprehensive and intensive training in preparing patent claims and complete applications, and in meeting the objections to patenting raised by the Patent and Trademark Office (PTO), as well as a case study of the patent law. The overall reason for this offering is to provide training not now otherwise available, especially now that the PTO is more a place of career employment than of apprenticeship, as it formerly was.

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PROACTIVE INTELLECTUAL PROPERTY COUNSELING — **Karl Jorda** — **2 Credits, Spring Semester**
IP0005-01

Grade is based on an exam and two or more class problems.

Topics included are employer/employee law as it relates to inventions and confidential information, dealing with inventors and their inventions as clients or as co-employees, various types of patent and trademark searches and investigations, uncovering clients' inventions, invention records, criteria and procedures for decisions on whether to file patent applications in the U.S. and other countries, patents and the development of new products, public disclosure problems, secrecy agreements, avoiding infringement of the patents of others, employed inventor incentive plans, corporate/outside inventor problems, trademark problems, dealing with corporate management of your client or employer, and the difference between private and corporate intellectual property law practice.

This will also include such advanced licensing topics as U.S. export control laws, international transfer of technology practice, U.S. antitrust law in international patent and know-how licensing, etc., as well as an overview of Interference and Chemical Practice with emphasis on practical corporate aspects.

This course is intended for the sixth semester as it is designed as both a "capstone" course building on all of the intellectual property courses taken in the second and third years, and a "bridging" course spanning academic and real-life private or corporate practice. As such it is a very practical course on how to get a head start in intellectual property/licensing practice with effective proactive counseling.

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SELECTED TOPICS IN INTELLECTUAL PROPERTY I & II Robert Shaw 2 Credits Each Semester
IP0006-01 & IP0010-01 Fall & Spring Semester

This is a year-long offering. Prerequisite: Patent Practice & Procedure I & II.

This second course is a continuation of the second-year course, but the focus is changed. In the third-year course principal direction is toward expanding the view of the students. Each is required to present several papers to the class which then engages in in-depth discussion of the issues presented. In this way issues are addressed in a mature fashion, much as those same issues would be presented in the practice of patent law. The subject matter includes patents, but it includes as well, trademarks, copyrights, unfair competiton, and related subjects. The discussions are far-reaching.

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SURVEY OF INTELLECTUAL PROPERTY Thomas Field 3 Credits
IP0007-01 Fall Semester

Open to second- and third-year students. No technical background is necessary and there are no prerequisites. This is the basic introduction to intellectual property. Students intending to take other courses in the intellectual property program should take this course in their *second* year.

Grade based on an open-book examination.

The course, focusing on ***preventing*** client problems ***rather than reacting*** to situations after the fact, introduces: (1) Patents, copyrights and other law (e.g., trade secrets, misappropriation) designed to protect commercially valuable information; (2) Rights of artists, authors, performers, and independent inventors; and (3) Trademarks and other law designed to prevent consumer source deception and to protect commercial goodwill. The scope of protection and the necessary steps to secure and retain it are the primary emphasis. However, jurisdictional requirements, defenses, remedies and other procedural matters are also covered—as are pervasive overlaps and conflicts between, e.g., state and federal law.

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TRADEMARKS & DECEPTIVE PRACTICES William Hennessey 3 Credits
IP0008-01 Spring Semester

Open to second- and third-year students. No prerequisites, but Survey of Intellectual Property may be helpful. Prelaw training in marketing, business, languages, communication or psychology would also be helpful.

Grade based on an open-book exam or nonanonymous research paper.

The course examines the choices a firm may have in preventing and redressing unfair and deceptive marketing practices of other firms. The primary focus is on obtaining, maintaining and enforcing legal protection for commercial goodwill. However, related laws are also considered. In addition to exploring substantive law, the course explores federal/state conflicts, administrative procedure, jurisdictional requirements, (particularly equitable) remedies and defenses, and other constitutional and procedural issues which arise in a host of substantive contexts.

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TRIAL ADVOCACY 3 Credits
SK0007-01 Fall & Spring Semesters

Open to third-year students.

Prerequisites: Completion of or simultaneous enrollment in Evidence.

Grade will be based upon class exercises, written analyses of exercises, and final trial.

Sections of this course are taught by appellate and trial judges, and experienced trial attorneys. If course is over-enrolled, selection of students will be made by lottery.

This course is designed to teach students how to prepare a case for trial and how to competently advocate on behalf of a client during trial. Through the use of exercises designed to simulate segments of civil and criminal trials, students prepare and execute portions of trials (for example, drafting pleadings, drafting and arguing pretrial motions, conducting discovery, making opening statements, conducting direct and cross-examinations, arguing objections, and making closing arguments) during class sessions and a full trial at the conclusion of the semester. Students learn how to research and argue issues of substantive law, apply the rules of evidence, and develop an effective advocacy style.

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FRANKLIN PIERCE LAW CENTER

Trademarks & Deceptive Practices
Syllabus

Tom Field

Spring 1991

I. Objectives

The main course objective is to cover trademark and other state and federal law designed to protect trade identity (commercial goodwill). A second is to explore the tension between trademark and related rights as commercial property, on the one hand, and as devices to further competition and to prevent consumer deception, on the other — as well the problems of resolving occasional conflicts between those goals. The course will also briefly examine state and federal laws designed to prevent consumer deception not directly related to source — particularly those giving competitors standing to bring an action.

II. Materials

PATTISHALL & HILLIARD, TRADEMARKS (Matthew Bender 1987).

See also: Trademarks: What's in a Name? for an elementary introduction to the subject.

[Several tutors may also be available, depending on the availability of my time to prepare them.]

III. Methodology

Aside from an occasional introductory or summary lecture, I am counting on lively class discussion. If we do not have volunteers, I will call on people at random.

IV. Evaluation

A. *Examination:* Unless a student chooses to do one of the optional exercises discussed below, a more-or-less traditional [open book] examination will be the sole basis for determining the course grade.

B. *Optional Exercises:* Up to 25% of the course grade can be earned by:

1. researching and writing a paper on a topic chosen from the appended list. A well-done class presentation [with good handouts and/or visual aids] may be done for an additional 25% (more details below),

2. participating in a mock trademark arbitration; this, too, will require a paper, the format of which will depend somewhat on the role of the participant (attorney or arbitrator),

3. preparing a computer exercise covering at least three class sessions worth of material in the casebook.

V. Attendance and Preparation

People who abuse the ABA's requirement for regular attendance will be given the option of missing no more classes or being "disenrolled.. Also, if it appears that someone is abusing the ancillary expectation for preparation, similar measures will have to be taken.

VI. Semester Assignments

Classes	*Subject matter*	[Casebook assignments; classes separated by semicolons.]
1–2	Overview	[pp. 1–17]
3–5	Creating and maintaining rights	[pp. 19–41; 42–64; 64–86]
6	Introduction to trademark registration process	[pp. 87–106]
7–8	Loss of Rights	[pp. 107–32; 132–149]
9–11	Infringement	[pp. 151–72; 172–90; 201–22]
12–14	Special Defenses and Limitations	[pp. 223–46; 246–64; 265–271, 278–292]
15–17	Dilution and other Trademark-related Laws	[pp. 293–316; 317–49; 349–373(skim 373–384)]
18	Jurisdiction and Remedies	[pp. 385–406, (skim190–199)]

Remainder: To be announced as arbitration exercises, student presentations of papers and outside speakers are scheduled. At least one last class will be used for review.

VII. Possible Paper/Discussion Topics

As explained in part IV.B., above, 25% of the course grade can be earned by researching and writing (and another 25% for doing an oral presentation) a paper on a topic chosen from this list.

A. Topics:

1. How much effect on interstate commerce is required for jurisdiction under the Lanham Act [for purposes of either registration or § 43(a) litigation]?
2. What is the role of the FTC with regard to trademarks?
3. Should use in the U.S. be required prior to U.S. registration of foreign marks?
4. When is survey evidence necessary/unwarranted in infringement litigation?
5. When is survey evidence necessary/unwarranted in ex parte PTO proceedings?
6. When is survey evidence necessary/unwarranted in 43(a) litigation?
7. What is the practical value of the supplemental register?
8. What are the consequences of premature use of registration symbols (®)?
9. What are the consequences of a registrant's failure to use proper trademark notice?
10. What do antidilution statutes add to a trademark owner's rights?
11. Under what circumstances, if any, should a mark be "per se generic"?
12. Whatare the advantages/disadvantages of state trademark registration?
13. What are the consequences for registering a trademark if the labels on which it appears fail to contain all of the information required by various statutes?
14. What constitutes "unclean hands" in trademark infringement litigation?
15. What is accomplished by refusal to register "scandalous" (etc.) marks?
16. What is the range of ITC jurisdiction over trademarks?
17. Should color and shape of prescription drugs be protected from imitation?
18. Do we need a federal anti-dilution statute?
19. How much litigation is occuring under state Unfair Trade Practice and Consumer Protection statutes?
20. Arbitration problem— for this we need two students to serve as counsel on opposite sides of a dispute. *Any two* of you who are interested should see me for details.

B. Logistics:

Deadlines: In order to do one of the extra credit presentations, your topic has to be selected no later than the 4th week of the term. [This deadline is necessary in order to be able to schedule in-class presentations and figure out how much time is available for each presentation — both will depend, in part, on the number of people who want to present papers.] The final paper is due on the last day of classes for the term.

Oral presentations: It is doubtful that everyone who wants to present a paper orally will have the opportunity to do so (not enough time). So, I will schedule these on a first-come basis. Also keep in mind that, while two papers can be *written* on the same topic, we will not need two *presentations* on the same topic. *A person who schedules a paper, upon finding that s/he is unable to do it, must notify me by the end of the 6th week* (see below). An fairly detailed outline must be turned in at least a week prior to your scheduled presentation.

Penalties: If you miss any of the deadlines you run the risk of having your grade reduced. *Failure to be prepared for a scheduled in-class presentation* (*or* failure *to give* adequate advance *notice* to allow something else to be scheduled) — in the absence of truly extraordinary circumstances — *will have particularly serious consequences.* **In the unlikely circumstances that anyone would let the whole class down in that way, their course grade will be reduced by a full letter from their examination grade.**

ANNEX VIII
FRANKLIN PIERCE LAW CENTER

SURVEY OF INTELLECTUAL PROPERTY
SYLLABUS

Professor Field

I. Objectives

The course is designed for those (with and without arts or engineering/science backgrounds) who are interested in general business practice (even in relatively small towns), as well as those who have a more specialized interest, for example, in patents, trademarks, or copyrights.

It is a comprehensive, introductory survey of statutory and common (e.g., trade secret and unfair business practices) law for protecting commercially valuable information and business good will. Twin objectives are to introduce each of the topics and to explore their relative strategic importance to a business in trying to prevent competitors from getting a "free ride" by stealing information or from misrepresenting their goods or services. Conversely, it explores the extent to which other business can compete without fear of serious legal sanctions being imposed. Throughout, the problems of free-lance artists, independent inventors, and similar persons are also considered.

See semester assignments below. For even more detail, see II.2., below.

II. Materials: (All written materials are available in the bookstore.)

A. KITCH & PERLMAN, LEGAL REGULATION OF THE COMPETITIVE PROCESS (4th ed. 1989) — *with latest* Statutory Supplement. [The Supplement should be adequate for several courses.]

B. Field, *Brief Survey of Intellectual Property* (photocopied ms.), *forthcoming* IDEA.

C. **So You Have an Idea, Copyright in Visual Arts, Trademarks: What's in a Name?** [Innovation clinic booklets — also available on Macintosh computers].

III. Methodology

Lecture and discussion. Questions and open discussion are encouraged — so long as there is a reasonable relationship to the topic of the day (or ones previously discussed). Advance preparation is necessary; discussion will proceed on the assumption that everyone has read the material.

IV. Evaluation

A. Exam

The exam will be "open book," similar to those previously given, and emphasize matters discussed in class. Detailed statutory knowledge is not expected.

B. Attendance and preparation

Attendance and preparation for class (probably participation, too) should improve exam grades but will not otherwise be counted. Nevertheless, **both attendance and preparation are expected in conformance with ABA requirements** — if classes are boring or confusing, tell me; don't stay home.

C. Optional Papers

Students can raise their *course* grades (up to one letter higher than their *examination* grades). See part VI below.

V. Class Assignments (In Kitch & Perlman or Stat. Supp. unless otherwise indicated.)

Class 1:[1] Basics (Syllabus; Survey at 1–8 and notes; 35 U.S.C. §§ 31–33, 111, 131, 261–62).

Class 2: Con'd. (Survey at 8–15 and notes; 17 U.S.C. §§ 102, 201–202).

Class 3:[2] Con'd. (Survey at 15–23 and notes; 15 U.S.C. §§ 1051, 1059–60)

Class 4:[3] Patents from the inventor's perspective (**So You Have an Idea**; K&P at 1026–33).

Class 5:[4] Patent subject matter and scope-related-to-disclosure (35 U.S.C. §§ 101, 112; pp. 774–810).

Class 6: Con'd. (pp. 810–20, 950–65).

Class 7:[5] Utility, novelty and nonobviousness (35 U.S.C. §§ 101–103; pp. 820–55).

Class 8:[6] Con'd. (pp. 855–80); Scope of rights (35 U.S.C. §§ 154, 271, 282; pp. 965–72).

Class 9: Con'd. (pp. 972–86, skim 986–1003, 1003–1026).

Class 10:[7] Copyright from the author's perspective (**Copyright in Visual Arts**; [skim pp. 754–66]); subject matter (17 U.S.C. §§ 101–102, 201(b), 409; pp. 553–63, 566–89).

Class 11:[8] Con'd. (589–605); Infringement (17 U.S.C. §§ 106, 410–12, 501–10; pp. 605–21).

Class 12: Con'd. (645–88).

Class 13: Fair use (17 U.S.C. § 107; pp 688–723).

Class 14: Con'd. (pp. 723–54); enforcement [skim 766–70].

Class 15:[9] Preemption (pp. 16–41, 446–64).

Class 16: Con'd. (pp. 501–532, 41–46).

Class 17:[10] Trade secrets (pp. 464–501).

Class 18: Appropriation (pp. 437–45, 564–66, 532–52).

Class 19:[11] Trademark basics (**Trademarks: What's in a Name?**; 15 U.S.C. § 1051; pp. 244–53, 242–44, 307–17, 324–41).

Class 20: Generic, functional and descriptive marks (15 U.S.C. §§ 1052; pp. 235–42, [reconsider 33–40], 294–301, 253–75).

Class 21: Con'd. (pp. 275–81, 370–77, 281–94, 317–24).

Class 22: Noncompeting goods (pp. 341–70).

Class 23:[12] Other unfair trade practices (15 U.S.C. § 1125(a); pp. 73–107).

Class 24: Con'd. (pp. 107–32, 195–203, 232–234).

Class 25: Con'd. (pp. 1–8, 408-411, 421–36).

Class 26–28: Open (e.g., overflow, speakers or review.)

VI. Possible paper topics

As mentioned in part IV.C. above, a student can raise his or her course grade by writing a paper. They should be in the 5–10 pp. range and must be typed. Grades, on a scale of 0–3, will be based on organization, conciseness, documentation and readability. Full credit will also require proper spelling and citation form!

You may choose a topic from the list below *or write a memorandum of law on one of the issues in the GSR Moot Court problem* [available each year by mid-October].

Papers are due by the last day of classes. Put only your examination number on your paper. **Do not give your paper to me; give it to the Registrar!**

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1 Superscripts indicate computer exercises. In addition to numbered exercises, there are also files which correspond to the booklets listed in Part II.C above.

1. Under what circumstances will prior secret use of an invention by another invalidate a patent claiming the same technology?
2. What is the effect of *Chakrabarty*, if any, on prior decisions to the effect that methods of doing business do not fall within the scope of 35 U.S.C. § 101?
3. What is the statutory foundation for the proposition that a "product of nature" cannot be patented? In spite of that, to what extent can claims drawn to a product comprising a naturally occurring product constitute patentable subject matter?
4. How does one determine whether a patent claim is over broad under 35 U.S.C. § 112?
5. Under what circumstances, if any, is the risk posed by a new and unobvious product such as a pharmaceutical, food additive or pesticide relevant to the patentability of the product?
6. Under what circumstances, if any, do patent claims directed to a process of treating disease in humans cover unpatentable subject matter?
7. To what extent may a patent claim be denied because it covers a product or service that is arguably illegal to sell?
8. What effect do the Berne amendments have on "moral rights" in the U.S.?
9. Under what circumstances are "idea" and "expression" sufficiently indistinguishable as to negate copyright in the expression?
10. Under what circumstances is the common law right of publicity likely to be preempted by § 301 of the Copyright Act?
11. To what extent is copyright available to protect the creators of a standardized test, e.g., the LSAT or an intelligence test?
12. To what extent is the tort of "slander of title" available to the owner of a trademark? Under what circumstances would the tort be a useful supplement to, e.g., dilution or infringement causes of action?
13. To what extent is "plagiarism" actionable beyond the circumstances in which it would constitute copyright infringement?
14. To what extent is it necessary to use a mark "in" interstate commerce to satisfy the PTO that it qualifies for registration?
15. Under what circumstances, if any, is "contributory infringement" an useful alternative or supplement to "induced infringement" in trademark actions?
16. What role, if any, does the trade dress of a prescription pharmaceutical play in its sale? What are the implications for an action for unfair competition?
17. Under what circumstances is a company liable in tort for recruiting employees of a competitor?
18. Under what circumstances is a company liable in tort for recruiting customers of a competitor?
19. To what extent should a commercial product or service be essentially regarded as a public "figure" for purposes of limiting liability for another's disparaging statements about it?
20. To what extent are a firm's statements enjoy privileges *beyond* the First Amendment when they concern a competitor or competing products or services?