

MAURICE A. DEANE SCHOOL OF LAW
at Hofstra University

INTELLECTUAL PROPERTY SURVEY
Course: Law 3871
Syllabus, Course Information, & Reading List

Prof. Neal R. Platt
Spring 2019

INSTRUCTOR'S COURSE
INFORMATION

In anticipation of the first class, I would like everyone to go to the Reading and Assignments page of the Hofstra Law School website and read the abbreviated introduction to *In re Brunetti*, 877 F.3d 1330 (1st Cir. 2017) (petition for certiorari filed Sept. 7, 2018 at (No.18-302)), particularly the brief concurrence by Circuit Judge Dyk.

Attendance, Preparation, and Participation: Your attendance, preparation, and participation are required, and will contribute to your final grade. Please e-mail me in the event that you must miss a class. If you miss a class, you will be required to listen to the podcast (assuming one is available) for the class you missed. Please see “*The Rules on Attendance and Listening to Podcasts*,” below.

Class members are expected to read and understand the assigned materials *in advance*, so that they may engage in an informed discussion of those materials in class. Those who are late to class or unprepared may be treated as absent. The instructor reserves the right to raise or lower your grade by a half-grade to reflect your attendance, preparation, and participation. In addition, every class member is required to submit an anonymous course evaluation, which will be conducted during class time near the end of the course under the supervision of a secretary or proctor.

The Rules on Attendance and Listening to Podcasts: The rules of the New York State Court of Appeals, the American Bar Association, and the Law School all require law students to be in good and regular attendance in the courses for which they are registered. To comply with these rules, you must attend at least 85% of your regularly-scheduled classes. Thus, you may miss no more than 15% of your classes. As this is a two-credit course, you may miss no more than four hours of class in a semester, and *must also submit notes in conformity with the following*.

To ensure that you have been exposed to all of the available content of this course, I intend to have every class recorded and made available as a podcast. If you must miss a class for any reason, you are required to listen to the podcast for that class *and, within two weeks of the missed class, submit to me by e-mail a complete copy of your notes from that class.* (Listening to the podcast of a class does *not* constitute attendance at that class.) No one will receive a grade in this class unless he or she has attended each class or listened to the podcast (assuming one is available) for any missed class.

I will provide a sign-in sheet for each class. Each student is responsible for signing in. The non-appearance of your signature on such sheet for a given class will be dispositive evidence that you were absent from such class. Falsification of sign-in sheets is a violation of the Code of Academic Conduct. If you exceed the permitted absences by failing to sign in, you will be administratively withdrawn from the course. No prior notice may be given, and you will receive notification from the Office of Academic Records indicating the withdrawal. Any such withdrawal may have serious adverse effects upon your financial aid, academic standing, and date of graduation. If you are excessively absent from several classes, you may face additional sanctions, including but not limited to denial of certification of good and regular attendance to the New York State Board of Law Examiners, or other state bar examiners.

If you believe you must be absent from class for more than the permitted number of hours, you should speak with the Senior Assistant Dean for Student Affairs (or the Director of Student Affairs) and me as soon as possible. Accommodations may be made for students who must be absent for religious reasons and in cases of truly compelling hardship.

Please keep track of your absences, because it would be unfortunate and disappointing if you were to do a substantial part of the required work and receive no credit for it.

Purpose of the Course: The purpose of this course is to familiarize the student with the U.S. law of intellectual property. By the end of the course, the student should be able to identify significant intellectual property issues as they arise in practice, so that he or she may either address them personally or seek the advice of counsel having the knowledge necessary to provide the client with effective intellectual property assistance.

My Availability: You can reach me by telephone at my law office at (212) 332-3311, or by e-mail at Neal.R.Platt@Hofstra.Edu. To make an appointment, please call or e-mail me at Neal.R.Platt@Hofstra.Edu to set up a mutually convenient time.

Class Web Page: You are required to register on the TWEN site for this class with an e-mail address that you check at least once each day. Go to www.lawschool.westlaw.com and select “TWEN” from the menu of items along the top of the page next to the current date. You will then be asked for your Westlaw password and for registration information, including your e-mail address (which, incidentally, need not be the e-mail address issued by the Law School). To maximize the effectiveness of the TWEN system, please provide all requested information. You will then be given the opportunity to register for the TWEN website dedicated to this course (by choosing “Drop/Add a Course”). Registration and participation are an essential part of this course. Each student is responsible for ensuring that his or her e-mail address, as listed on TWEN, is current and in good working order. Students must check the website regularly throughout the semester, and (just in case of last-minute cancellation or delay) immediately before leaving for class.

Text: There is no assigned case book, as reading assignments are compiled in the Compiled Handouts and various handouts to be distributed in class. Special thanks to Emeritus Professor of Law Thomas G. Field, Jr. of the University of New Hampshire School of Law for posting his casebook FUNDAMENTALS OF INTELLECTUAL PROPERTY (2012) and his permission to reproduce free of charge for educational purposes many of the materials included in the Compiled Handouts. All handouts will also be posted on the TWEN site. If you do not receive a handout in class at the time of distribution, or if you lose your copy, it will be your responsibility to download and print a copy from the TWEN site.

Examination: Subject to possible adjustment for class attendance, preparation, or participation, the course will be graded on the basis of a final, sit-down, closed-book examination to which you may bring no printed, written, or recorded materials of any kind. The examination will be 2½ hours in duration, and will consist of short answers and one or more essays.

Computers and Cell Phones: Computers are to be used during class for taking notes and for no other purpose. During class, *you may not load a browser or be online*, whether for text-messaging, surfing the web, instant messaging, BLACKBERRY MESSENGER, e-mail, or any other functionality. Your cell phone ringer and vibrator must be turned *off* during class, as incoming calls and messages are distracting to you, even if no one else knows they’re coming in. If, during any particular class, you have no choice but to be available in case of a medical or other emergency threatening a child or an incapacitated person in your care, you must obtain permission from me to leave your cell phone on during that class. Even a single violation of this rule may result in your being prohibited from bringing a laptop or cell phone to class.

READING LIST

UNIT I. - COMPETITION, FAIR AND UNFAIR.

White v. Samsung Elecs. America, Inc., 971 F.2d 1395 (9th Cir. 1992), *cert. denied*, 508 U.S. 951 (1993), Compiled Handouts at Page 12, particularly the dissent of Kozinski, J. from an order rejecting the suggestion for rehearing *en banc*, 989 F.2d 1512 (9th Cir.), Compiled Handouts at Page 18.

Wendt v. Host International, Inc. U.S. Court of Appeals, 197 F.3d 1284 (9th Cir. 1999), dissent of Kozinski, J. from an order rejecting the suggestion for rehearing *en banc*, Compiled Handouts at Page 28.

Lotus Dev. Corp. v. Borland Int'l, Inc., 49 F.3d 807 (1st Cir. 1995), *aff'd by an equally divided Court*, 516 U.S. 233 (1996), Compiled Handouts at Page 32, and particularly the concurrence of Boudin, J., Compiled Handouts at Page 44.

E.I. duPont de Nemours & Co., Inc. v. Christopher, 431 F.2d 1012 (5th Cir. 1970), *cert. denied*, 400 U.S. 1024 (1971), Compiled Handouts at Page 48.

UNIT II. - OVERVIEW OF INTELLECTUAL PROPERTY PROTECTION & ITS LIMITATIONS.

Chart of Relationships Between Patents, Trademarks & Copyrights from 1 J. MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 6.6 (2014), Compiled Handouts at Page 52.

UNIT III. - PATENTS & THEIR LIMITATIONS.

U.S. CONST. art. I, § 8, cl. 8, Compiled Handouts at Page 54.

Professor's Notes on Patent Requirements, Compiled Handouts at Page 55.

Wheeler's Patent, Compiled Handouts at Page 56.

O'Reilly v. Morse, 56 U.S. (15 How.) 62 (1853), Compiled Handouts at Page 58.

Tilghman v. Proctor, 102 U.S. (12 Otto) 707 (1880), Compiled Handouts at Page 65.

Application of Tarczy-Hornoch, 397 F.2d 856 (C.C.P.A. 1968), Compiled Handouts at Page 69.

Funk Bros. Seed Co. v. Kalo Inoculant Co., 333 U.S. 127 (1948), Compiled Handouts at Page 84.

Diamond v. Diehr, 450 U.S. 175 (1981), Compiled Handouts at Page 88.

Brenner v. Manson, 383 U.S. 519 (1966), Compiled Handouts at Page 95.

Professor's Notes on *The Hazard of the "Retrospective Eye,"* Compiled Handouts at Page 99.

Alice Corp. Pty. Ltd. v. DLS Bank Int'l, 134 S. Ct. 2347 (2014), Compiled Handouts at Page 105.

AMERICA INVENTS ACT (2011) - Lecture only. (Patent goes to first to file, *not* first to invent).

UNIT IV. - COPYRIGHTS & THEIR LIMITATIONS.

U.S. CONST. art. I, § 8, cl. 8, Compiled Handouts at Page 54, as above.

Copyrightable Subject Matter, Compiled Handouts at Page 117.

Baker v. Selden, 101 U.S. (11 Otto) 99 (1879), Compiled Handouts at Page 119.

Ownership of Copyright, Compiled Handouts at Page 121.

Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340 (1991), Compiled Handouts at Page 123.

Professor's Notes on Elements of Cause of Action in Copyright Infringement and Affirmative Defense of Fair Use, Compiled Handouts at Page 127.

U.S. COPYRIGHT OFFICE, CIRCULAR 09 ("Works Made for Hire"), Compiled Handouts at Page 109, especially Copyright Act § 201(b), Compiled Handouts at Page 129.

Community for Creative Non-Violence v. Reid, 490 U.S. 730 (1989), Compiled Handouts at Page 133.

ABKCO Music, Inc. v. Harrisongs Music, Ltd., 722 F.2d 988 (2d Cir. 1983), Compiled Handouts at Page 137.

Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569 (1994), Compiled Handouts at Page 139.

Metro-Goldwyn-Mayer Studio Inc. v. Grokster, 545 U.S. 913 (2005), Compiled Handouts at Page 147.

Lotus Dev. Corp. v. Borland Int'l, Inc., 49 F.3d 807 (1st Cir. 1995), *aff'd by an equally divided Court*, 516 U.S. 223 (1996), Compiled Handouts at Page 32, as above.

UNIT V. - TRADEMARKS & THEIR LIMITATIONS.

U.S. CONST. art. I, § 8, cls. 1, 3 & 8, Compiled Handouts at Page 54.

Platt, *Good Will Enduring: How To Ensure that Trademark Priority Will Not Be Destroyed by the Sale of a Business*, 99 TRADEMARK REP. 788 (2009), Compiled Handouts at Page 150.

A. Trademark Infringement:

Lanham Trademark Act of 1947, 15 U.S.C. § 1051, § 1057(a),(b), & (c); § 1058(a); § 1059(a); § 1060; § 1065, § 1072, Compiled Handouts at Page 172.

Professor's Notes on three elements of a cause of action in trademark infringement: (1) distinctiveness; (2) likelihood of confusion; and (3) priority, Compiled Handouts at Page 180.

1. The Distinctiveness Element:

Professor's Notes on the Scale of Distinctiveness, Compiled Handouts at Page 181.

Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763 (1992), Compiled Handouts at Page 185.

Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205 (2000), Compiled Handouts at Page 188.

Matal v. Tam, 137 S. Ct. 1744 (2017), Compiled Handouts at Page 191.

2. The Likelihood-of-Confusion Element:

Quality Inns Int'l v. McDonald's Corp., 695 F. Supp. 198 (D. Md. 1988), Compiled Handouts at Page 217 (especially commencing at Page 224, concerning "survey evidence").

Professor's Notes on the *Polaroid* factors, Compiled Handouts at Page 242.

3. The Priority Element.

Priority (non-registration vs. registration), lecture.

B. Trademark Dilution Theory:

Lanham Trademark Act of 1947, 15 U.S.C. § 1125(c), Compiled Handouts at Page 244.

Moseley v. V Secret Catalogue, Inc., 537 U.S. 418 (2003), Compiled Handouts at Page 246.

END OF READING LIST

CERTAIN UNIVERSITY & LAW SCHOOL POLICIES

Hofstra prohibits sexual and other discriminatory harassment, stalking, domestic and dating violence, sexual assault and other sexual misconduct (collectively, “Gender Based Offenses”). If you or someone you know believes they have been subjected to any of these Gender Based Offenses, help is available. To make a report, or for more information about Hofstra’s Student Policy Prohibiting Discriminatory Harassment, Relationship Violence, and Sexual Misconduct (available at <http://hofstra.edu/sexualmisconduct>), please contact the Title IX Coordinator at (516) 463-5841 or TitleIXCoordinator@hofstra.edu, or Public Safety at (516) 463-6606. Confidential resources and support are also available from clinicians in Student Counseling Services (516-463-6791), medical professionals at the Health and Wellness Center (516-463-6745), and clergy in the Interfaith Center.

The Law School has adopted a “Credit Hour Policy.” A “credit hour” is an amount of work that reasonably approximates not less than one hour of classroom or direct faculty instruction (calculated as 50 minutes of classroom time) and two hours (120 minutes) of out-of-class student work per week for fifteen weeks (including one week for final exams), or the equivalent amount of work over a different amount of time. These requirements apply equally to all courses taught in the Law School, including distance education courses.

For specific policy wording relating to the following important matters: Academic Dishonesty; Student Access Services; Deadlines and Grading Policies; Absences for Religious Observance; Discrimination, Harassment, Sexual Misconduct; the Center for Academic Excellence, see Hofstra Policies: Wording for Syllabuses: <https://www.hofstra.edu/about/administration/provost/provost-hofstra-policies.html>