2014 Intellectual Property Scholars Roundtable
Drake University Law School

FINAL PROGRAM

FRIDAY, MARCH 28, 2014

8:30  Breakfast

9:00  Welcoming Remarks
Prof. Peter K. Yu, Kern Family Chair in Intellectual Property Law & Director, Intellectual Property Law Center, Drake University Law School

9:15  Panel 1: Copyright and Contract Law

Presenters: B.J. Ard, Postdoctoral Associate in Law and Thomson Reuters Fellow, Yale Law School
“Copyright License Enforcement Through the Contract Lens”

Prof. Kristelia A. Garcia, George Washington University School of Law
“The CRO Paradox”

Prof. Greg R. Vetter, University of Houston Law Center
“Deleveraging the Software License in Health Information Technology”

11:00 Coffee Break

11:15 Panel 2: International Intellectual Property Law

Presenters: Margot Kaminski, Executive Director, Information Society Project, Yale Law School
“Does U.S. IP Law Get Shrunk in the Policy Laundry?”

Prof. Benjamin Liu, John Marshall Law School
“TPP and the Globalization of the Hatch-Waxman Act”

Prof. Ma Zhongfa, Fudan University School of Law (China)
“Bridging the Gap Between Intellectual Property Regime and Green Technology Transfer”

Prof. J. Janewa Osei Tutu, Florida International University College of Law
“The Global Criminalization of Intellectual Property”
Prof. V.K. Unni, Indian Institute of Management Calcutta (India)
“Compulsory Licensing of Pharmaceutical Patents in India: Whether Natco Decision Will Meet the Global Benchmarks?”

1:30  Lunch

2:30  Panel 3: Intellectual Property, Privacy and Constitutional Rights

Presenters:  
Prof. Bryan H. Choi, New York Law School  
“For Whom the Data Tolls: Refracting the Third-Party Doctrine Through the Required-Records Doctrine”

Prof. Lateef Mtima, Howard University School of Law  

Prof. Liam O’Melinn, Claude W. Pettit College of Law, Ohio Northern University  
“Corn, Copyright, and Culture: The Next Great Copyright Act and the Intellectual Property Servitude”

4:00  Coffee Break

4:15  Panel 4: Intellectual Property Theory

Presenters:  
Prof. Shontavia Johnson, Drake University Law School  
“Tattoos, Intellectual Property, and the Thirteenth Amendment”

Prof. Jake Linford, Florida State University College of Law  
“Semantic Shift and Trademark Law”

Prof. Eva E. Subotnik, St. John’s University School of Law  
“Fiduciary Duties and the Stewardship of Intellectual Property”

6:00  Roundtable Adjourns for the Day

6:30  Dinner for Roundtable Participants

Salisbury House  
4025 Tonawanda Drive
SUNDAY, MARCH 29, 2014

9:00 Breakfast

9:30 Panel 5: Copyright and Digital Issues

Presenters: Prof. Pascale Chapdelaine, University of Windsor Faculty of Law (Canada) (beginning fall 2014)
“The Properties of Copyright”

Prof. Tonya M. Evans, Widener University School of Law—Harrisburg
“Is There Any Safer Harbor from Statutory Damages in the Digital Age”

Alexander Goebel, Research and Teaching Fellow, University of St. Gallen (Switzerland)

Prof. Deidré A. Keller, Claude W. Pettit College of Law, Ohio Northern University
“Image Lessons: Navigating Fair Use of Pictorial, Graphic, and Sculptural Works in Educational and Scholarly Contexts” (with Anjali S. Vats)

11:15 Coffee Break

11:30 Panel 6: Patent Law I

Presenters: Prof. Thomas C. Folsom, Regent University School of Law
“Algorithm Methods”

Prof. Daryl Lim, John Marshall Law School
“Standard Essential Patents: Triangulating the End Game”

Prof. Laura Pedraza-Farina, Northwestern Law School
“A Typology of Expert Decision-making: the Federal Circuit as a Case Study”

Prof. W. Keith Robinson, Dedman School of Law, Southern Methodist University
“The War on Induced Infringement: Between Knowledge and Good Faith Belief”

Saurabh Vishnubhatik, Postdoctoral Associate, Duke University Law School
“Cognitive Economy and the Trespass Fallacy”

1:30 Lunch
2:30 **Panel 7: Patent Law II**

**Presenters:**

Prof. Sarah Burstein, University of Oklahoma College of Law  
“The Patented Design”

Prof. Ryan T. Holte, Southern Illinois University School of Law  
“Patent Trolls or Great American Inventors: Case Studies of Patent Assertion Entities”

Prof. Emily Michiko Morris, Robert H. McKinney School of Law, Indiana University  
“The Story of Nanotechnology Patents”

Prof. Jason Rantanen, University of Iowa College of Law  
“A Law and Economics Approach to Patent Assertion Entities”

Prof. Zhang Aiguo, Northwest University of Politics and Law (China)  
“Do We Really Need an Artificial Person to Determine Patentability of Design?”

5:00 **Roundtable Adjourns for the Day**

6:30 **Dinner for Roundtable Participants**

The Des Moines Embassy Club  
666 Grand Avenue
COMMENTATORS

- Prof. Llewellyn J. Gibbons, University of Toledo College of Law
- Prof. Paul M. Janicke, University of Houston Law Center
- Prof. Patricia Hureston Lee, West Virginia University College of Law
- Prof. Joshua Sarnoff, DePaul University College of Law
- Prof. Wang Yuan, School of Law, Lanzhou University (China)
- Prof. Wang Zhenyu, School of Economics and Management, Tongji University (China)
- Prof. Peter K. Yu, Drake University Law School
ABSTRACTS

B.J. Ard, Postdoctoral Associate in Law and Thomson Reuters Fellow, Yale Law School
“Copyright License Enforcement Through the Contract Lens”

Copyright licensing has exploded. Practically any digital work—commercial, free-culture, or free-software—comes with terms attached. How should the law decide which of these terms are enforceable in copyright, and which are enforceable only in contract? Many would answer this question by reference to copyright policy. One camp proposes to protect users by enforcing these terms narrowly, awarding copyright remedies only to terms with a nexus to copyright’s protections or goals; another would award liberal copyright enforcement, citing to the social benefits of open licenses and similar licensing innovations that depend on such enforcement.

Contract law offers a lens for better understanding the stakes of this debate and framing a solution. The severity of copyright’s supra-compensatory regime conflicts with contract’s commitment to proportionality between breach and remedy, and the dubious ability of licensees to anticipate copyright liability for breach of seemingly contractual terms implicates questions of notice. Taking the notice issue seriously, copyright enforcement could be justified where notice was unequivocal. Where notice was less certain, licensors would be relegated to contract enforcement, though they could assert breach as grounds for license termination. Copyright liability would accrue only after termination.

This approach leverages the equitable considerations of contract law to reconcile questions that have proven intractable from the perspective of copyright, providing a principled basis to protect users from abuse while leaving space for innovative licenses to proliferate. Moreover, it saves copyright from being distorted in addressing these issues, freeing it to attend other concerns raised by mass licensing.

Prof. Sarah Burstein, University of Oklahoma College of Law
“The Patented Design”

One important provision of design patent law pertains to certain uses of “the patented design.” But there has been little discussion about what, exactly, “the patented design” is. So it is not clear, for example, whether the use of an abstract design on a different type of product constitutes infringement. This Article concludes that it should not, arguing that “the patented design” should be conceptualized as a design as applied to a specific type of product—not as a design in the abstract. Accordingly, the design should remain free to be adapted to different types of products. This conclusion is supported by the nature of product design and policy goals including the promotion of the decorative arts and protection of free expression. This Article will also consider the potential implications of this conclusion for—and problems created by the PTO’s approval of—computer icon/GUI design patents.

Prof. Pascale Chapdelaine, University of Windsor Faculty of Law (Canada) (beginning fall 2014)
“The Properties of Copyright”

In this paper, I look at the property attributes of copyright to inform a more nuanced understanding of the nature of copyright, and of the debate that surrounds the propertization of copyright. I resort primarily to James W. Harris theory in Property and Justice and in particular, on the insights that his ownership spectrum brings to better understand the nature of copyright. Looking at the property attributes of copyright allows me to discern two distinct yet interrelated property interests: the first interest relates to copyright as a whole when considered as the thing that is the object of commercial exploitation, which satisfies all requirements of a proprietary ownership interest. The second interest focuses on the nature of copyright holders’ relationship to the physical embodiment of their works (e.g., the commercial copies owned by consumers or other users): it emerges as a limited, remote, non-ownership proprietary interest.
Viewing copyright through the combination of the ownership proprietary interest and the non-ownership proprietary interest brings important distinctions that shed new light on the scope and limitations of copyright. For instance, it supports the view that copyright holders do not own their works per se. As copyright holders’ legal and technological powers of control increase, as much as users’ powers to use copyright works continue to grow, the temptations of drifting away one way or the other on the debate regarding the property attributes of copyright are high. I discuss the dangers of misinterpreting the consequences of the property attributes of copyright, as well as of vilifying any association of copyright with property.

**Prof. Bryan H. Choi, New York Law School**

“For Whom the Data Tolls: Refracting the Third-Party Doctrine Through the Required-Records Doctrine”

Modern privacy law turns on a basic distinction between “first parties” and “third parties.” What is “mine” is private, and what is “not mine” is not private. Data technologies have muddied that crystalline rule. The severability of personal information from physical bodies allows data to escape first-party dominion without necessarily entering third-party control.

The privacy community has been sounding the alarm against the “third-party doctrine”—the Fourth Amendment dogma that first parties have no reasonable expectation of privacy in information shared with third parties. But data privacy is not just a third-party problem.

A recent set of Fifth Amendment cases has revived an obscure doctrine, the “required-records doctrine,” that stands for the troubling proposition that first parties may be directly compelled to generate data records that otherwise would not exist, with no expectation of privacy in those records. In other words, first-party data regulations are a separate hazard even if third-party data regulations are shored up. Plugging one privacy hole is vain if the other one remains leaky.

This Article argues that data privacy depends on harmonizing the third-party doctrine and the required-records doctrine. The first-party immunities guaranteed by the Fifth Amendment should constrain the third-party doctrine (e.g., automated data aggregators would be off-limits). Likewise, the third-party disabilities inherent to the Fourth Amendment should constrain the required-records doctrine (e.g., records not readily obtainable from third parties would be ineligible). Correlating first-party immunities with third-party disabilities respects the contextual integrity of private data.

**Prof. Tonya M. Evans, Widener University School of Law—Harrisburg**

“Is There Any Safer Harbor from Statutory Damages in the Digital Age”

In *Safe Harbor for the Innocent Infringer in the Digital Age*, I argued that certain classes of direct innocent infringers should be afforded safe harbor from liability in light of current accepted online practices of users deemed essential for the proper functioning and progress of the Internet and digital technology. In that article, I offered a statutory amendment to section 512 of the Copyright Act that applies specifically to direct infringers and protects them in ways similar to current protection of online service providers.

It is unlikely however, that Congress would take such a substantial departure from current law (at least in the short term). Therefore, I argue mental state can and should be evaluated along with notice as factors to be considered in determining whether the minimum damage award should be granted. Knowledge could even serve to create a strong presumption of standard or even willful liability (as currently applied under 504(c)). Notice alone, however, should not serve as a complete bar to a minimum statutory damage award; especially in light of the fact that copyright remains a strict liability offense and exposes even the ordinary,
low level infringer to damage awards questioned by commentators and judges alike as egregious and, in some cases, arguably unconstitutional.

Accordingly, in this article, I answer the question posed by the title by offering an alternate statutory amendment to resolve the copyright liability and remedy conundrum. Specifically, I argue that in lieu of (or in addition to) the innocent infringer safe harbor proposal I offered in the earlier article, that Congress could adopt a more robust and meaningful minimum statutory damage award under 504 (c) for certain classes of noncommercial infringement. This proposal could apply in the innocent infringement context when safe harbor is not applied and also to other technically infringing activity deemed socially beneficial and/or technologically desirable to support progress. To be sure, limits on statutory damages are desirable even outside of the “innocent infringement context.”

This minimum statutory damages framework could provide “safer harbor” protection for the direct infringers to which it applies from the more onerous and excessive statutory damage awards currently being applied. Instead of discretionary application, a certain class of infringement would lead only to a limited, minimum statutory damage award.

To this end, although I believe the entire statutory damage scheme should be reformed and brought more in line with fair and just results typical and necessary in strict liability offenses across legal disciplines, my proposal seeks: 1) to limit minimum damage awards and 2) to expand the types of activities that might trigger innocent infringement protection during the remedies phase of the infringement lawsuit.

Prof. Thomas C. Folsom, Regent University School of Law
“Algorithm Methods”

The aftermath of CLS Bank Corp. v. Alice Corp. presents a chance for a “do-over” in the law. I propose a functional definition of code within a coded world. Let it be postulated that “code” is a step or a series of steps for performing a function that can be represented by logical operators, wherein the function comprises (a) storing, viewing (perceiving), communicating, reproducing, moving, or modifying information, (b) changing the state of a machine, a virtual machine, another coded construct, a living organism, or a biological carrier, (c) encrypting or decrypting, identifying, hiding or finding, retrieving, attracting or repelling, spoiling, or rerouting information, or (d) creating a visual representation or analogy illustrating the state, or the working of a machine, virtual machine, coded construct or a living organism (and a “virtual machine” is an objectively reproducible coded construct for transforming an input to an output according to a rule).

These definitions are not unheard-of, and they correspond to objective reality. They unify the treatment of computer code, biological code, and other coded phenomena. They correspond to legally operative categories of patent-eligible subject matter and are capable of forensic proof. Moreover, these definitions distinguish subject matter that is functionally distinct. They permit separate consideration of “code” on the one hand and “mental steps” or “business methods” and the like on the other. Decoupling the category of “code” from the category of “mental steps/business methods” provides a principled way to treat the categories independently for purposes of determining patent eligibility.

Prof. Kristelia A. Garcia, George Washington University School of Law
“The CRO Paradox”

The proliferation of private ordering in intellectual property licensing challenges the conventional view of collective rights organizations as optimally efficient licensing mechanisms, and instead demonstrates that they suffer many of the same inefficiencies as statutory licenses. As a consequence, dominant market players are opting out, leaving weaker players with a weaker organization, and setting off a downward
spiral that has negative overall welfare consequences despite the benefits to early-departers. That collective rights organizations save transaction costs is undeniable; that they are being circumvented most frequently in industries—such as music publishing and sound recording—where the call for en masse content licensing initially drove their popularity, suggests this justification is losing ground in the new, digital age. This Article explores the changing role of collective rights organizations in the face of technological development and evolving consumer behavior, questions the justifications for their continued existence, and proposes a reconsideration of the way we think about collectives.

**Alexander Goebel, Research and Teaching Fellow, University of St. Gallen (Switzerland)**


While there are large markets for second hand cars, books and clothing, such markets hardly exist for digital goods. Why? Do the economics of secondary markets not transfer to the digital world? Are digital goods less suitable for resale? Does the digital world bear specific problems requiring more legal protection for rightsholders?

Many of these posed questions have been asked before and numerous diverging answers have been rendered depending on the background—rightsholder vs. consumer—of the person giving the responses. However, the discussion has just recently gained momentum again as courts in Europe and the USA have rendered decisions greatly affecting the legal basis for the resale of digital goods. While the European Court of Justice (ECJ) has allowed the resale of used software in July 2012 in its UsedSoft judgment, the US District Court for the Southern District of New York prohibited the resale of MP3 files by Redigi in March 2013. Of course, both decisions are based on different legal statutes in different jurisdictions; diverging judgments are, therefore, no surprise.

The project reviews the legal frameworks for the resale of digital goods in Europe and the US in light of the underlying economic theories and as affected by the recent court decisions. Building on these findings and using a comparative methodology, an abstract legal solution to the resale dilemma for digital goods will be suggested.

**Prof. Ryan T. Holte, Southern Illinois University School of Law**

“Patent Trolls or Great American Inventors: Case Studies of Patent Assertion Entities”

There has been much debate about the economic harms caused by patent infringement lawsuits filed by patent holders who do not make or sell products covered by their own patents—entities pejoratively referred to as “patent trolls.” This debate has thus far been largely theoretical or based on broad industry-wide data. The purpose of this paper is to present a focused empirical report that has previously been lacking—detailed information regarding the inventors themselves, the patent assertion entities (PAEs) that represent them, and the stories behind their patents. The research for this paper centers on two representative case studies: (1) MercExchange, L.L.C., the prominent PAE whose seminal patent infringement action against eBay continued to the Supreme Court in eBay v. MercExchange, 547 U.S. 388 (2006); and (2) Capital Security Systems, Inc., a lesser-known PAE that has sued some of the largest banks in the world on its patented electronic check processing technology. This paper explores the stories behind the inventors, the patented inventions, and the entities asserting the patents in order to develop a more complete contextualized picture of PAEs and their economic impact. Based on this more complete picture, the paper then assesses whether these patent holders warrant the “patent troll” moniker, lurking under the bridge of innovation waiting to harass and extort innovators attempting to pass, or whether they instead resemble the great American vision of a Horatio Alger novel protagonist, laboring to build that bridge of innovation brick-by-brick and eventually reaping a reward for their hard effort.
Prof. Shontavia Johnson, Drake University Law School
“Tattoos, Intellectual Property, and the Thirteenth Amendment”

Though existing for several millennia, body modification through tattooing has experienced a social renaissance of sorts. Tattoos have become ubiquitous forms of self-expression in modern society; nearly one in four Americans has at least one tattoo, and among Millennials this number skyrockets to almost one in two. As the popularity of tattoos has increased in recent years, so too have questions revolving around concepts of intellectual property and the plausible limitations of any rights stemming therefrom. This Article addresses the implications, for both the tattooist and the tattooed, of providing traditional intellectual property rights for tattoos.

Neither the courts nor Congress have definitively answered the question of whether tattoos are legally protectable, though a growing majority of scholars have posited that intellectual property rights, particularly copyright protection, should subsist in tattoos. This Article suggests that traditional intellectual property norms are ill-equipped to provide legal protection for tattoos. In addition, the Article builds on earlier suggestions that the Thirteenth Amendment necessitates the creation of a sui generis system of protection for tattoos.

Margot Kaminski, Executive Director, Information Society Project, Yale Law School
“Does U.S. IP Law Get Shrunk in the Policy Laundry?”

The IP chapters of our Free Trade Agreements contain several instances of language selecting one side of a circuit split. Does this language bind US courts’ interpretation of US law? In its amicus brief in Aereo, IFPI claims that the Supreme Court is bound by language in our Free Trade Agreements, because the President confirms that no statutory changes are required to implement the IP chapter, and Congress then approves this statement. The argument goes that if the President confirms that this is how US law should be interpreted, and Congress agrees, then that is in fact how US law should be interpreted.

This is very strange lawmaking. On the face of it, IFPI is arguing that when Congress says “this agreement does not change US law,” the agreement in fact changes US law. On the other hand, there might be something to the argument that both the President and Congress agree on how US statutes should be interpreted, requiring deference. This project looks both to language in past Supreme Court opinions on the relevance of our Free Trade Agreements, and to decisions about the implementation of non self-executing agreements, to try to find an answer. And I argue that as a policy matter, because of how our FTAs have been negotiated, this is not a legitimate way to make law.

Prof. Deidré A. Keller, Claude W. Pettit College of Law, Ohio Northern University
“Image Lessons: Navigating Fair Use of Pictorial, Graphic, and Sculptural Works in Educational and Scholarly Contexts” (with Anjali S. Vats)

This piece will consider when the use of works the Copyright Act of 1976 (the “Act”) refers to as “pictorial, graphic, and structural works” (“PGS works”) in instruction and research constitutes fair use. These works present particular fair use problems because they are not susceptible to use of less than the whole. Moreover although the Educational Guidelines (the “Guidelines”) assert as their purpose, “to state the minimum and not the maximum standards of educational fair use under Section 107 of H.R. 2223,” the vast majority of courts considering the issue of whether educational / instructional uses constitute fair use make reference to the Guidelines. Moreover, while the Guidelines contain specific provisions respecting “Books and Periodicals” and Music, nothing in the Guidelines addresses the use of images in the classroom and there simply are no guidelines for pertaining to scholarly uses.
This piece considers the issues faced by scholars and instructors whose uses are, arguably fair but who get no guidance from the Guidelines and little from the existing jurisprudence. The piece will undertake a review of the legislative history of the Act and the cases decided under it which consider the questions of educational and scholarly fair uses and / or fair uses of PGS works to determine the depth and breadth of fair use immunity in this context. The piece suggests that as Congress undertakes to revise the Copyright Act it ought to consider the importance of educators and scholars engaging with these increasingly important works.

Prof. Daryl Lim, John Marshall Law School
“Standard Essential Patents: Triangulating the End Game”

Modern society subsists on standards, but we are often oblivious to them. Standards ensure different technologies march to a common drumbeat, often drawn up by standard setting organizations (SSOs). Standards allow us to switch seamlessly as our smartphones and tablet PCs connect to Wi-Fi over different hot spots. Computer hardware standards like USB also ensure that our flash drives work across different devices.

The benefits to those who implement standardized technologies come with the risk of hold-ups. Implementers invest in making their devices comply with a standard. These investments also make it expensive to switch out of the standard. Owners of patents essential to using the standard, or standard essential patents (SEPs) may opportunistically target non-licensed implementers with patent infringement suits. The market power gained as a result of standardization could allow SEP owners to extract a bounty from “locked-in” implementers in excess of the value of their patented technology. SEP owners may reinforce their royalty demands with injunctions, which would expel the implementers’ devices from the marketplace if they fail to comply.

SSOs are aware of the risk of hold-ups and require commitments from SEP owners to license their technology on “fair, reasonable and non-discriminatory” (FRAND) terms. Often, this private ordering works well. SEP owners realize that they are trading higher per-unit prices for higher sales volumes. They charge just a few cents on the products that carry their technology, and sometimes not at all. However, disputes that occur reveal a stark disparity of views on what FRAND obligations really mean.

This presentation offers a framework to understand and navigate the controversies surrounding the FRAND and injunction issues in SEP litigation, and predicts how the conclusion of the smartphone wars will look like.

Prof. Jake Linford, Florida State University College of Law
“Semantic Shift and Trademark Law”

Trademark law is fundamentally about symbols and their meanings; yet linguistics—the study of symbols and their meanings—has made only limited inroads in trademark law and scholarship. This article mines a cornerstone concept in linguistics—semantic shift—and shows how its incorporation can strengthen trademark theory and doctrine.

The study of semantic shift, in historical and cognitive semantic literatures, is the study of how a given word changes over time. Semantic shift is driven both by a need to communicate and a need to resolve confusing ambiguity. Like other types of semantic shift, trademarks are created to fill a communicative need. Every trademark, in a way, identifies something new—a particular product or service from a singular source. And trademark law sets rules for if and how a word, name, symbol, or device can become a trademark, and how to handle confusing ambiguity when it arises.
An understanding of semantic shift provides crucial insight into how trademark owners as “speakers” initiate and maintain semantic shifts that create new trademark lexemes, and how the public as “listeners” accept, reject, and reshape the communication of trademark owners recognized in the literature. Analyzing the lifecycle of the trademark through the lens of semantic shift has several payoffs. First, the categorical bar against generic terms acquiring distinctiveness should be abandoned, as should the presumption that a suggestive mark is inherently distinctive. Second, the transformative effort of the mark owner provides important context for consumer comprehension, and thus can serve a vital function in determining whether a mark has acquired secondary meaning, and whether a junior user’s mark is likely to confuse consumers. Third, fanciful marks—new words that came into existence as trademarks—are likely perceived as the strongest type of mark precisely because they lean towards singular, rather than shared meaning. But that same affinity makes fanciful marks particularly vulnerable to a semantic shift toward ex post genericness. Finally, trademark’s ex post genericness standard should be modified to better reflect the capacity of consumers to hold multiple concepts in mind simultaneously.

Prof. Benjamin Liu, John Marshall Law School
“TPP and the Globalization of the Hatch-Waxman Act”

Recent U.S. free trade agreements (FTAs) often feature a patent linkage requirement—a controversial regulatory scheme designed to expand the exclusivity of proprietary pharmaceuticals beyond patent protection. During the negotiation of the Trans-Pacific Partnership Agreement (TPP), United States proposed a patent linkage system that departs from its past practice in FTAs. First, past FTAs often contain a general statement prohibiting drug regulation authorities from approving generic drugs. In contrast, TPP mandates a detailed regulatory regime that closely approximates U.S. domestic law. Second, past FTAs contain only linkage provisions protecting the patentee. In contrast, TPP incorporated a number of features from the Hatch-Waxman Act that were originally designed to assist generics companies. Together, TPP appears to export the Hatch-Waxman scheme whole cloth.

This new breed of linkage proposal notwithstanding, U.S. trade partners are unlikely to improve pharmaceutical IP protection or encourage generic drug development. Provisions that foster generic drug entry in the United States may fail to account for the characteristics of the local pharmaceutical sector, the legal system and the market demographics, thereby exacerbating the problem of access to generic medicine in developing countries. And even if developing countries partners ultimately adopt this enhanced patent linkage, their frail administrative institutions may fail to deliver heightened protection.

Prof. Ma Zhongfa, Fudan University School of Law (China)
“Bridging the Gap Between Intellectual Property Regime and Green Technology Transfer”

Environmental pollution is one of the most serious challenges for human beings, which international community has taken seriously since 1970s. The pollution is mainly caused by man’s inappropriate utilization of technology and the solution basically relies on green technologies, most of which exist in form of certain types of intellectual property (IP) rights, and their transfer. To facilitate technology transfer is one of the objectives of TRIPs Agreement, and there’re many provisions concerning green technology transfer in the related international treaties, but IP regime has become the barrier to technology transfer according to some studies. The main reason may be that except for Convention on Biological Diversity, the environmental protection treaties seldom concern IP issues, which has developed a great gap to enforce the provisions on technology transfer, although there’re many other defects of the current international technology transfer regimes. In the context of globalization, considering human’s common and long-term interests, human rights protection, co-benefits of stakeholders and sustainable development, and recognizing the inventors’ multi-motivations, IP regime shall be reformed to facilitate green technology transfer, such as shortening protection duration, disclosing technical information earlier, promoting fast-track examination process and allowing most developing countries to adopt more flexible
policies to enforce international IP treaties in accordance with the exceptions provided in them. Besides these, the other issues on IP concerning technology transfer in field of addressing environmental pollution, such as compulsory licensing, competition concerning technology transfer, patent pool and public funded R&D technologies, shall also be attached importance to.

Prof. Emily Michiko Morris, Robert H. McKinney School of Law, Indiana University
“The Story of Nanotechnology Patents”

Nanotechnology, or the study and application of the unique properties of matter at the nanoscopic level, is thought to be the next big technological wave. Commentators such as Mark Lemley and others have expressed concerns, however, that patent thickets, anticommons, and other transaction costs may unduly hinder nanotechnology development. As the purportedly first major new technology to emerge since implementation of the Bayh-Dole Act, creation of the Federal Circuit, and relaxation of patentable subject matter and other patentability requirements all converged to favor greater patenting of basic scientific research, nanotechnology may face a higher level of upstream patenting than previously seen in other similarly disruptive technologies. Many commentators have therefore expressed concern that, absent patent pools, widespread and non-exclusive licensing, government exercise of march-in rights, or dedication to the public domain, nanotechnology will develop much more slowly than it might have otherwise.

This analysis explores two possible alternative storylines for what nanotechnology development may look like, however. One possible alternative storyline is that the proponents of Bayh-Dole Act and similar proposals were correct: without patents and the opportunity for exclusive rights, government-funded basic research will languish unexploited for lack of private industry investment. Under this storyline, technological innovation in fields such as nanotechnology and biotechnology are multi-stage endeavors that are both expensive and uncertain. Without the safeguards of patent protection, the story goes, private fund sources will be unwilling to take of these risks. This book chapter therefore takes a closer look at what kinds of technologies may face the so-called “valley of death” and whether returns on investments in the intermediate stages of technological development truly cannot be appropriated except through patent protection on the enablin upstream research on which they are based.

A second possible alternative storyline is that the unprecedented degree of upstream patenting seen in nanotechnology may, at worst, be irrelevant. As seen in biotechnology and other fields in which university research figures prominently, patents are only one factor, and a relatively minor factor, in the transfer and translation of basic research into commercializable applications. Factors with potentially greater influence on downstream development are access to materials and to tacit knowledge, both of which are more rivalrous and excludable than the technical knowledge disclosed and protect in upstream patents. Moreover, technological development cycles in nanotechnology, biotechnology, and other “science-based” technologies may in many cases be so lengthy that many upstream patents may have expired before exerting much of a hold-up effect.

Prof. Lateef Mtima, Howard University School of Law

Throughout the global community, historically marginalized groups and developing nations continue to struggle to achieve political, social, and economic parity in the information society. For many of these groups and nations, their prospects for ultimate success are largely dependent upon their ability to redirect their strategic focus toward the development, protection, use, and commercial exploitation of intellectual property. In a forthcoming book, Intellectual Property, Social Justice, and Entrepreneurship, I propose a schema for combining legal theories of intellectual property social justice with an entrepreneurship-
centered social action framework, reminiscent of the litigation and civil protest framework of the Civil Rights Movement, toward the construction of a socio-economic movement for “Intellectual Property Empowerment.”

The central thesis of Intellectual Property, Social Justice, and Entrepreneurship is that social activists, legal scholars, entrepreneurs and others can and should collaboratively advocate for a doctrinal shift in the predominant intellectual property legal regimes to acknowledge fundamental obligations to social justice and the precepts of inclusion, access, and empowerment in the intellectual property law. Whereas Western intellectual property systems have generally been misused to promote and perpetuate the economic subjugation of historically marginalized groups and developing nations, in the global information society, intellectual property law should instead be regarded as a means for promoting ecumenical socio-economic development and self-determination.

Equally important to the actualization of Intellectual Property Empowerment is the construction of a progressive intellectual property social action platform. While the incorporation of intellectual property social justice principles into the law will enhance protection for the legal rights and interests of those who have historically underserved, a correlative social action strategy is necessary to provide intellectual property education and to stimulate intellectual property activity, especially entrepreneurial intellectual property endeavor, within these communities. Entrepreneurship principles and strategies offer an accessible and pragmatic structure for intellectual property-oriented social action intended to benefit historically marginalized communities and developing nations. There is a long tradition of socio-economic upward mobility through “middleman” entrepreneurship throughout the Western world, rendering entrepreneurship a familiar and proven empowerment path. Moreover, entrepreneurial solutions are particularly well-suited to addressing some of the unique socio-economic problems with which many historically marginalized communities and developing nations currently grapple.

Intellectual Property, Social Justice, and Entrepreneurship therefore undertakes to place the intellectual property social justice agenda in the context of the Civil Rights Movement by (i) reviewing how legal theories of equal protection provided a symbiotic foundation for a social action plan of civil protest; (ii) exploring how intellectual property social justice theory can be similarly interconnected with a social action plan of social entrepreneurship; and (iii) suggesting Intellectual Property Empowerment as the revitalized Civil Rights/development economic agenda. In keeping with the collaborative structure of Intellectual Property Empowerment, various legal and entrepreneurial scholars, theorists, practitioners, and experts thereafter explore the doctrinal bases and strategic stages of IP Empowerment, including foundational issues such as social justice-oriented law and policy amendment, community-focused professional and social activism, and the application of basic entrepreneurship concepts and social entrepreneurship mechanisms; identification of intellectual property social justice deficiencies and opportunities for social entrepreneurship solutions; IP Empowerment in the development context; and systemic issues such as communal and extra-communal resource assessment, and “Best Practices” for socially equitable intellectual property access, licensing, and rights enforcement.

Prof. Liam O’Melinn, Claude W. Pettit College of Law, Ohio Northern University

“Corn, Copyright, and Culture: The Next Great Copyright Act and the Intellectual Property Servitude”

Now that it is becoming fashionable to ruminate about the next great copyright act, the time is propitious to think about the consequences of the extension of intellectual property protection and the nature of the theory that has, in part, led to those consequences. Having examined the mythology of common law copyright in the past, both as it operated in the seventeenth and eighteenth centuries in England, and in the extension of copyright to sound recordings in the twentieth century in the United States, I am turning my attention the operation of the common law theory in the present.
“I Have a Dream©” This article will assess the effects that the extension of copyright has had on culture and law. First, the theory of common law copyright has led to a distension of culture that results from placing copyright before culture. The legal career of the Rev. Martin Luther King Jr.’s “I Have a Dream” speech is a perfect example of what comes of forcing culture to take the shape of its copyrighted bottle. A dispute between the King estate and CBS, which used significant portions of the speech in a documentary on the civil rights movement, led the Eleventh Circuit into tortured reasoning about whether King’s “performance” had been dedicated to the public—a speech of vast cultural significance, “performed” on public property in the presence of 200,000 people, with security provided by federal Marshals. This is the result of placing copyright ahead of culture.

Legal doctrine has also suffered distortion in the effort to secure effective protection of a species of property that is inherently unstable and is becoming more unstable. As it becomes more difficult to protect intellectual property, the law has shown an increasing determination to do so. As I have argued elsewhere, the conception of property has itself come under stress; people are finding that products which they have purchased are accompanied by servitudes. Customers are paying not only for the products but also for the digital fences that are intended to prevent them from making full use of what they thought was their property. Likewise, contract law has been pressed into the service of this desperate attempt at preservation, and as the famous ProCD v. Zeidenberg case suggests, a federal common law of contract appears to be undermining a belief in the importance of assent to the process of contracting.

Still more ominously, the content industries have for a long time been proposing a program of educating young people in copyright thoughtways. Cory Doctorow reports that the “MPAA, RIAA, and America’s major ISPs have teamed up to produce a stilted, propagandistic copyright curriculum for California’s public schools.” The program takes aim at students as early as the first grade, with the ostensible goal, as stated in the first-grade plan, entitled “It’s great to create,” of helping “students understand that when they create something, they own it.” Part of this exercise in learning to respect the property of others involves a game entitled “He’s Copying Me!” In the course of this game two student artists draw on the board and then are deceived into leaving the classroom for a few minutes, during which time the other students are told to copy their drawings. Upon their return the original artists are apparently supposed to feel terrible that their “ideas” were copied. The sequence of events in the game as laid out by these educators is not completely clear, but clarity of thought seems neither to be the hallmark nor the goal of the program: Reordering moral sensibilities so they align with the interests of copyright holders is the goal, even if teachers must deceive their students in order to teach them honesty.

Perhaps most ominously, we are seeing the emergence of something like a private intellectual property police force, serving as part of grander effort by the content industries to recast moral and legal sensibilities so as to turn the norms of intellectual property into the fundamental norms of society.

Prof. J. Janewa OseiTutu, Florida International University College of Law
“The Global Criminalization of Intellectual Property”

Scholars have offered various theoretical rationales for protecting intellectual property rights, and debated whether these are rights at all or if they are better treated as privileges. In addition, some commentators have lamented the “propertization” of patents, copyrights and trademarks, and the corresponding strengthening of these rights in general. Many scholars have criticized the extant intellectual property rules as overprotective, detrimental to the public commons, tending to restrict the distribution and exchange of knowledge, and an impediment to the public health. Some would argue that the current intellectual property system is imbalanced such that it impedes the progress of science and the useful arts rather than promoting it. Yet, there is a trend toward mandating global criminal enforcement of intellectual property rights. As we struggle to offer sound theoretical justifications for intellectual property protections, this paper queries the rationale for efforts at criminalizing infringement of
intellectual property through international agreements. For instance, what makes intellectual property infringement a crime rather than a form of protest? How does intellectual property infringement differ from stealing a CD or robbing a bank, and how is it similar? Is the criminalization of intellectual property simply part of the “upward ratcheting” of intellectual property protection, or does the infringement amount to a public harm that warrants a criminal condemnation?

Prof. Laura Pedraza-Farina, Northwestern Law School
“A Typology of Expert Decision-making: the Federal Circuit as a Case Study”

The creation of the Federal Circuit—the single appeals court in charge of virtually all patent cases—marked a significant departure from the system of generalist courts that many believe is a defining feature of the American judiciary. Decades later, several scholars and members of the judiciary are calling for an end to the Federal Circuit’s exclusive jurisdiction over patent law. To its critics, lack of inter-circuit competition renders patent law too rigid and insular. In contrast, proponents of specialization extol the virtues of uniformity, predictability, and efficiency of a specialized judiciary. This article offers a novel perspective on the specialization debate by reframing it as a dispute about the role, meaning, and limitations of expert decision-making.

The article argues that analogizing Federal Circuit behavior to that of a community of experts yields novel insights about the effects of judicial specialization. Drawing and expanding upon studies from the sociology of the professions and the sociology of expertise, it develops a typology of six features that are closely associated with communities that self-identify as experts in a particular subject matter: (1) codification; (2) epistemological autonomy; (3) epistemological monopoly; (4) typecasting; (5) maintenance and policing of jurisdictional legitimacy; and (6) inability to self-coordinate. The article then argues that these six features help explain certain puzzling aspects of Federal Circuit jurisprudence, such as a preference for rules over standards, defiance of Supreme Court precedent, and lack of deference to findings of fact from District courts and the Patent and Trademark Office. Moreover at least two of these features—typecasting and inability to self-coordinate—are often normatively undesirable. Reframing the specialization debate as a dispute about both the value and limits of expertise escapes the dichotomy of the current scholarly commentary, in which the main solution to the perceived problems with specialization is to despecialize. Instead, this article proposes an approach that focuses on optimizing expertise. It concludes by illustrating how this analytical framework can yield insights on judicial behavior in other bodies with subject-matter specialization.

Prof. Jason Rantanen, University of Iowa College of Law
“A Law and Economics Approach to Patent Assertion Entities”

This paper will examine the primary argument made in support of Patent Assertion Entities (a/k/a “patent trolls,” “non-practicing entities,” and “patent privateers”): that these entities act as transaction-cost reducers and enablers whose activities result in a more economically efficient patent system. After framing the argument in law and economics terms, I then test whether its underlying assumptions are, in fact, true and explain what this means for rules relating to both the patent system as a whole and those specifically directed at Patent Assertion Entities.

Prof. W. Keith Robinson, Dedman School of Law, Southern Methodist University
“The War on Induced Infringement: Between Knowledge and Good Faith Belief”

Under current law, a party that causes another to infringe a patent may be liable for induced infringement. Recently, the Supreme Court and the Federal Circuit have interpreted the statute governing inducement in a way that most likely weakens a plaintiff’s assertion of induced infringement. For example, a plaintiff must show that an accused infringer had a specific intent to cause infringement. Further, a defendant can
rebut allegations of induced infringement by showing that he had a good faith belief that the patent was invalid or that the patent was not infringed. In addition, Ted Sichelman has recently argued that the Supreme Court has repeatedly subverted Congress with respect to the standard for indirect patent infringement.

Are these narrowing interpretations just a natural evolution of the statute, or are the courts responding to larger policy and economic concerns? To explore this question, this article analyzes recent decisions in inducement cases. I argue that the effect of the recent decisions is that it makes patents asserted under an induced infringement theory nearly unenforceable. Further, I call for a stop to further judicial refinement of inducement. If, in fact, larger policy and economic concerns are at play, then the rule for induced infringement liability should be left to the machinery of the legislature and the USPTO to modify and implement.

Prof. Eva E. Subotnik, St. John’s University School of Law
“Fiduciary Duties and the Stewardship of Intellectual Property”

Intellectual property laws are primarily justified on the grounds of spurring authorship and inventorship. But, particularly in the case of copyright law, with its lengthy term of protection as well as the possibility of termination rights, works of authorship that are in fact produced will be tended to and exploited by others long after the creator’s death but before they enter the public domain. This paper will explore several threads that are raised by the prospect of downstream stewardship of IP: what is the right legal prism through which to understand the nature of later-in-time decision-making that occurs with respect to the exploitation of a work? For example, should these stewards in some sense be conceived of as authors themselves by virtue of the control they exert over these works? Does their status depend on whether they are exercising rights in an individual role (say, as a family member) or in a fiduciary capacity (say, as a trustee)? This paper will examine the nature of downstream control exerted in the context of copyright law, making applicable comparisons to the laws governing patents and rights of publicity, in an attempt to offer a coherent theory of the nature and legal consequences of downstream control of intellectual property.

Prof. V.K. Unni, Indian Institute of Management Calcutta (India)
“Compulsory Licensing of Pharmaceutical Patents in India: Whether Natco Decision Will Meet the Global Benchmarks?”

The need to find a balance between the rights of pharma patent holders and public health has triggered some highly passionate debates in the last three decades. Although the scientific community has been fairly successful in inventing medicines to treat some of the most deadly disease like AIDS and certain types of cancer most of these medicines have remained beyond the reach of poor people in developing countries because of patent protection. The existing tension between the proponents who advocate access to medication and those who support stringent intellectual property protection gets exacerbated by varied ideologies and economic models among developed and developing countries.

After the pharmaceutical product patent regime became fully applicable to India under TRIPS Agreement, the country began to seriously consider the options available through compulsory licenses which can be issued with respect to such patents. Thus in March 2012 the Patents Controller for the first time issued a compulsory license in favour of an Indian generic drug manufacturer called Natco Pharma with respect to a patent granted on a pharmaceutical product to Bayer. This has created lot of apprehension amongst the global pharmaceutical companies who fear that many Indian pharmaceutical companies will apply for such licenses which will effectively make their patents useless. This presentation covers the existing tension between the two important stakeholders in the fast evolving Indian patent landscape.
Prof. Greg R. Vetter, University of Houston Law Center
“Deleveraging the Software License in Health Information Technology”

A software product provider does not want to negotiate its standard software license. The ultimate implementation of this principle is retail software products and the click-wrap EULA. The success of the EULA induces normative pressure for enterprise software to resist sale-by-sale tinkering with standard licenses. This raises policy concerns about the effect of boilerplate. Related to this is a suggestion in the literature for top-down, mass-market contract terms approved by a governmental authority.

There is a small but perhaps significant natural experiment ongoing in relation to top-down promotion of better licensing terms for a certain class of software. The federal Medicare program has created monetary incentives for health care providers (such as physician offices) to install electronic health record (EHR) software: providers making “meaningful use” of EHR software will receive additional Medicare payments. The “meaningful use” rubric is itself a complex regulatory structure in Medicare.

In conjunction with this, a grant-based program from the federal government established regional extension centers (RECs) with a mission to assist providers, and particularly physician offices, with information technology procurement, including license negotiation.

Meeting “meaningful use” is mostly a function of the EHR software. Once installed in a physician office, the software implements the business processes and clinical processes of the office. REC efforts to assist providers include user-side advocacy in negotiating EHR software contracts that speak to meaningful use obligations and other license points. This has an anti-leveraging effect, revising some typical pro-licensor terms to the betterment of the health care provider as licensee.

Saurabh Vishnubhatkat, Postdoctoral Associate, Duke University Law School
“Cognitive Economy and the Trespass Fallacy”

Patent protection must continually resolve not one, but two subjects of indeterminacy: notice and teaching. The literature distinguishes between the notice and teaching functions in that claims that deliver proper notice of boundaries are considered precise proxies for the invention, and claims that deliver proper teaching are considered accurate proxies. Through a discussion of these functions and of metaphors commonly invoked in their application, this project responds to a recent argument about patent law’s undue reliance on trespass in framing patent indeterminacy.

Prof. Zhang Aiguo, Northwest University of Politics and Law (China)
“Do We Really Need an Artificial Person to Determine Patentability of Design?”

The ordinary consumers are considered to be appropriate to determine patentability of design by State Intellectual Property Office and courts in China. However, unlike trademark law where a product is sold both to consumers and to wholesalers and retailers, the issue of likelihood of confusion will usually revolve around the consumer who is the lowest level of the reasonably prudent buyer, existence of a niche market makes it nearly impossible to pin down the right group of ordinary consumers in design patent cases since patent law is not design to prevent lowest level of the reasonably prudent buyer from confusion about source of product.

In the U.S., concept of designer having ordinary skill (DHOS) in the art in the design patent actually evolves from the definition of person of ordinary skill in the art in utility patent law. Nevertheless, DHOS makes no sense at all in design patent case. First, DHOS may create paradox where a design meeting the requirement of non-obviousness is unable to pass the novelty standard because the minor details that would be noticeable to the designers but might be overlooked by the ordinary observers. Second, DHOS
is nonsensical in the real world. Approximately half of the members of the Industrial Designers Society of America (IDSA) are design consultants who work on designs for a wide variety of products, as needed by their clients. In the case of a design patent application directed to a chair, for example, is the proper “ordinary designer” the in-house designer who works for a chair company or the consultant who may design chairs only occasionally?

According to the Council Regulation on Community Designs in the E.U., an informed user is tasked to tell if the design meet novelty and individual character. In *PepsiCo v. Grupo Promer Mon Graphic* (2011), the Court of Justice held that informed user could be a child in the approximate age range of 5 to 10 or the marketing manager in a company that makes goods which are promoted by giving away “pogs,” “rappers” or “tazos.” However, it is deeply doubtful that a child at the age between 5 and 10 has the same degree of attention as the marketing manager does.

The reason why an artificial person is needed in the IP law field is that we hope to facilitate realization of the specific goal of law and keep judicial objectivity with the help of this artificial person. Indeed, judges or examiners themselves in design patent law are completely able to fulfill the two objectives without the aid of artificial person.