

**Intellectual Property in the New Technological Age**  
*A Conference for Federal Judges Sponsored by*  
*the Federal Judicial Center and the Berkeley Center for Law & Technology*

**PROGRAM**

**Tuesday, May 19, 2015**  
**Boalt Hall, Room 140, UC Berkeley Campus**

- 8:00 am**      **Shuttle leaves the Claremont Hotel to Boalt Hall**
- 8:15 am**      **Breakfast**
- 8:40 am**      **Welcome and Opening Remarks**  
Dean Sujit Choudhry
- 8:45 am**      **Introduction to the Program**  
Professor Peter Menell
- Patent Law Overview: Requirements for Patentability**  
Professor Peter Menell
- 10:30 am**     **Break**
- 10:45 am**     **Patent Law Overview: Infringement and Remedies**  
Professor Mark Lemley
- 12:00 pm**     **Lunch**
- 1:00 pm**      **Patent Local Rules, Pre-Trial Orders, and Early Case Management**  
**Philosophy, Context, Logic, and Departures**  
Moderator: George Pappas  
Panelists: Judge Rodney Gilstrap, E.D. Tex.  
                  Judge Kathleen O'Malley, Fed. Cir.  
                  Judge Ronald Whyte, N.D. Cal.  
                  Chief Judge Leonard Stark, D. Del.  
                  Michael Jacobs
- *Twombly, Iqbal*, and Form 18
  - Venue, Stays, and Parallel Litigation (ITC, PTO, joinder/MDL)
  - Limitations on the Number of Claims/Prior Art References
  - eDiscovery
  - Staging – Vetting Remedies Theories Early
  - Patentable Subject Matter
- 2:45 pm**      **Break**
- 3:00 pm**      **Patent Claim Construction - Substantive Overview**  
Presenter: Professor Peter Menell  
                  Matthew Powers

- 3:30 pm**      **Afternoon Calendar: Claim Construction Hearing**
- Claim Construction Simulations
    - Lux v BrightBlue (“inclusion”/”three-dimensional inclusions”)
    - Mangosoft v. Oracle (“local . . .”)
- 4:30 pm**      **Adjourn & Shuttle to the Claremont Hotel**
- 5:45 pm**      **Shuttle leaves the Claremont Hotel to Professor Peter Menell’s home**
- 6:00 pm**      **Dinner and Reception** (home of Professor Peter Menell)
- 8:30 pm**      **Shuttle leaves Professor Menell’s home to the Claremont Hotel**
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**Wednesday, May 20, 2015**  
**Boalt Hall, Room 140, UC Berkeley Campus**

- 8:15 am**      **Shuttle leaves the Claremont Hotel to Boalt Hall**
- 8:30 am**      **Breakfast**
- 9:00 am**      **Patent Case Management: Selected Issues**  
 Moderators: Peter Menell and Matthew Powers  
 Panelists: Judge Rodney Gilstrap, E.D. Tex.  
 Judge Kathleen O’Malley, Fed. Cir.  
 Judge Ronald Whyte, N.D. Cal.  
 Chief Judge Leonard Stark, D. Del.  
 George Pappas
- Claim Construction Follow-up
  - Patentable Subject Matter
  - Non-obviousness
  - Motions to Dismiss for Willfulness, Indirect Infringement, and Patentable Subject Matter
- 10:15 am**      **Patent Remedies and Expert Witnesses**  
 Moderator: Lynn Pasahow  
 Panelists: Judge Rodney Gilstrap, E.D. Tex.  
 Judge Kathleen O’Malley, Fed. Cir.  
 Judge Ronald Whyte, N.D. Cal.  
 Chief Judge Leonard Stark, D. Del.  
 Michael Jacobs  
 Matthew Powers
- Patent Damages
    - Timing of Vetting Damage Methodologies
    - Expert Witnesses - Daubert
    - Patent Damages Doctrine
    - Post-Judgment Royalties – procedural and substantive
  - Injunctive Relief
  - Attorney Fee Awards

- 11:15 am**      **Break**
- 11:30 am**      **Patent Mediation**  
Moderator:      Kathi Lutton  
Panelists:      Magistrate Judge (Ret.) Edward Infante (JAMS)  
                         Matthew Powers  
                         Sarita Venkat
- 12:15 pm**      **Lunch**
- 1:15 pm**      **Copyright Basics**  
Professor Peter Menell  
Professor David Nimmer
- 2:45 pm**      **Break**
- 3:00 pm**      **Infringement and Fair Use Analysis**  
Professor Peter Menell  
Professor David Nimmer  
Professor Shyam Balganesch  
Lou Petrich
- 4:30 pm**      **Adjourn & Shuttle to the Claremont Hotel**
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**Thursday, May 21, 2015**  
**Boalt Hall, Room 140, UC Berkeley Campus**

- 8:15 am**      **Shuttle leaves the Claremont Hotel to Boalt Hall**
- 8:30 am**      **Breakfast**
- 9:00 am**      **Copyright Case Management**  
Professor Peter Menell  
Professor David Nimmer  
Professor Shyam Balganesch  
Lou Petrich
- 10:15 am**      **Break**
- 10:30 am**      **Copyright in the Digital Age**  
Professor Peter Menell  
Professor David Nimmer
- 12:00 pm**      **Lunch**
- 1:00 pm**      **Trademark Basics**  
Sally Abel  
David Bernstein  
Kathryn Fritz

- 3:00 pm**      **Break**
- 3:15 pm**      **Afternoon Calendar: Preliminary Injunction Hearings**
- Polar Corp. v. PepsiCo. (“Polar”)
  - Wrigley v. Swerve (“Swerve”)
- 4:30 pm**      **Adjourn & Shuttle to the Claremont Hotel**
- 5:45 pm**      **Shuttle leaves the Claremont Hotel for the Optional Hike/Run in the East Bay Hills** (please assemble in the hotel lobby) (return shuttle back to the Claremont when the hike/run is over)
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**Friday, May 22, 2015**  
**Empire Ballroom, Claremont Hotel**

- 8:30 am**      **Breakfast (submit decision forms)**
- 9:00 am**      **Trade Dress**  
Presenters:    Professor Peter Menell  
                      David Bernstein
- 9:25 am**      **Trademark Case Management Panel**  
Moderator:    Kathryn Fritz  
Panel:          David Bernstein  
                      Peter Harvey  
                      Annette Hurst
- Distinctive Aspects of TM Case Management
  - Key TM Case Management Issues
  - TM Case Management Typology and Timeline
  - Pre-Trial and Trial Case Management Issues
- 10:30 am**      **Break**
- 10:45 am**      **Trademark Law Issues in Cyberspace**  
Sally Abel
- 12:00 pm**      **Adjourn**

## Speaker Biographies

**Sally M. Abel** is a partner at Fenwick & West, where she specializes in international trademark and trade name counseling, including the development and management of international trademark portfolios and trademark rights in cyberspace. She represents several major technology companies, including Cisco and Sun Microsystems. She co-teaches the trademark law course at Berkeley Law and is co-authoring the TRADEMARK CASE MANAGEMENT JUDICIAL GUIDE. She received her undergraduate and law degrees from UCLA.

**Shyamkrishna Balganes** is Professor of Law at University of Pennsylvania Law School (Penn Law), where his scholarship focuses on copyright law and common law theory. He earned his B.A. and LL.B. (Hons.) at the National Law School of India, his B.C.L. and M.Phil. at Oxford University (Rhodes Scholar), and his J.D. at Yale Law School.

**David H. Bernstein** is a litigation partner at Debevoise & Plimpton (New York), where he specializes in trademark, false advertising, right of publicity, and other areas of intellectual property. He has authored or co-authored numerous articles and chapters on intellectual property, as well as THE LAW OF ADVERTISING, MARKETING AND PROMOTION (2011). He is co-authoring the TRADEMARK CASE MANAGEMENT JUDICIAL GUIDE. He received his A.B. from Princeton University, his M.S. at the London School of Economics and Political Science, and his J.D. from Yale Law School. He clerked for Judge Robert E. Keeton in the District of Massachusetts.

**Kathryn Fritz** is the Managing Partner of Fenwick & West. Her practice concentrates on business and intellectual property litigation, with particular emphasis trademark, trade dress, advertising, right of publicity, trade secret, and unfair competition matters. She co-teaches the trademark law course at Berkeley Law and is co-authoring the TRADEMARK CASE MANAGEMENT JUDICIAL GUIDE. She received her undergraduate education at UC Santa Barbara and her JD from Georgetown University Law Center.

**Michael A. Jacobs** is a partner at Morrison Foerster, where he co-founded the firm's Intellectual Property Practice Group and concentrates his practice on litigation of high-technology and intellectual property matters. Mr. Jacobs has earned his undergraduate degree from Stanford University and his law degree from Yale Law School. He is recognized as one of the top intellectual property trial lawyers.

**Hon. J. Rodney Gilstrap** has served on the U.S. District Court for the Eastern District of Texas since 2011, where he handles a large volume and wide variety of patent cases. He received his B.A. and J.D. degrees from Baylor University.

**Peter Harvey** is a founding partner of a Harvey Siskind LLP in San Francisco and counsel for the International Trademark Association. His practice emphasizes trademark, trade dress, copyright, trade secrets, and unfair competition litigation in U.S. federal courts. He also advises on IP rights clearance, registration and management. He also teaches Entertainment and Media Law at the University of San Francisco School of Law. He is co-authoring the TRADEMARK CASE MANAGEMENT JUDICIAL GUIDE. He received his undergraduate degree from Cornell University and his JD from Yale Law School.

**Annette Hurst**, a partner in Orrick's San Francisco office, is a member of the Intellectual Property Group where she focuses on intellectual property litigation, particularly copyright, trademark and trade secrets litigation, as well as patent litigation and disputes involving complex commercial transactions in the software and Internet industries. She is co-authoring the TRADEMARK CASE MANAGEMENT JUDICIAL GUIDE. She got her undergraduate education at Miami University and her JD from New York University School of Law.

**Magistrate Judge (Ret.) Edward Infante** (JAMS) is known for his ability to mediate complex cases involving a wide range of issues. A former Chief Magistrate Judge of the U.S. District Court, Northern District of California, Judge Infante has more than 30 years of dispute resolution experience. He has particular expertise in complex business litigation, securities class actions, securities, employment, intellectual property, and antitrust cases.

**Professor Mark A. Lemley** is William H. Neukom Professor of Law at Stanford Law School, Director of the Stanford Program in Law, Science and Technology, and Director of Stanford's LLM Program in Law, Science and Technology. He is also a partner at Durie Tangri and the founder of Lex Machina, an IP litigation data clearinghouse and analytics firm. He received his B.A. from Stanford University and his JD from University of California at Berkeley, after which he clerked for Judge Dorothy W. Nelson of the U.S. Court of Appeals for the Ninth Circuit. Professor Lemley has written widely in the fields of intellectual property law and antitrust law.

**Kathi Lutton** is a principal in Fish & Richardson's Silicon Valley office, where she has led the firm's litigation group. Ms. Lutton received her B.S. and M.S. in Electrical Engineering before attending the University of Pennsylvania Law School. She clerked for Judge Alvin A. Schall of the U.S. Court of Appeals for the Federal Circuit. She worked for five years as a systems and software design engineer with General Electric, where she graduated from the Edison Engineering Program and designed one of the first leading edge expert systems (neural networks, fuzzy logic) for aircraft. She has extensive high-tech patent litigation in a myriad of technologies.

**Professor Peter S. Menell** is Koret Professor of Law at the University of California at Berkeley School of Law (Boalt Hall). Professor Menell founded and serves as a Director of the Berkeley Center for Law & Technology. He received his S.B. from the Massachusetts Institute of Technology, his M.A. and Ph.D. (economics) from Stanford University, and his J.D. from Harvard Law School. After graduating from law school, he clerked for Judge Jon O. Newman of the U.S. Court of Appeals for the Second Circuit. Professor Menell has organized more than 50 intellectual property education programs for the Federal Judicial Center and written extensively in the fields of intellectual property law, environmental law and policy, and property law. He has co-authored the PATENT CASE MANAGEMENT JUDICIAL GUIDE (now in its third edition) and is leading efforts to produce the COPYRIGHT CASE MANAGEMENT JUDICIAL GUIDE and the TRADEMARK CASE MANAGEMENT JUDICIAL GUIDE.

**David Nimmer** is of counsel to Irell & Manella LLP in Los Angeles. He also teaches as a Visiting Professor at UCLA Law School and is a Distinguished Scholar at the Berkeley Center for Law and Technology. In 2000, he was elected to the American Law Institute. Since 1985, Professor Nimmer has updated and revised *NIMMER ON COPYRIGHT*, the standard reference treatise in the field, first published in 1963 by his late father, Professor Melville B. Nimmer. That treatise is routinely cited by U.S. and foreign courts at all levels in copyright litigation. Mr. Nimmer has written numerous articles and books on copyright and related topics. He has also participated in the litigation of a wide range of copyright cases. He earned his undergraduate degree from Stanford University and his law degree from Yale Law School. He clerked for Judge Warren Ferguson on U.S. Court of Appeals for the Ninth Circuit.

**Hon. Kathleen M. O'Malley** was elevated to the Court of Appeals for Federal Circuit in 2010 after serving sixteen years on the District Court for the Northern District of Ohio. She is the first district judge to serve on the Federal Circuit. Prior to her appointment to the federal bench, Judge O'Malley was Chief of Staff and First Assistant in the Ohio State Attorney General's Office. She received her undergraduate degree from Kenyon College and her law degree from Case Western Reserve University School of Law.

**Lou Petrich** is a member of Leopold, Petrich & Smith, a Los Angeles firm that specializes in the defense of claims for copyright and trademark infringement, defamation, invasion of the rights of privacy and publicity, and idea submission cases. Mr. Petrich is a Fellow in the American College of Trial Lawyers. He regularly renders legal opinions on special clearance problems in the motion picture and television fields, including termination rights, fair use and the like. He argued the *Stewart v. Abend* ("Rear Window") case to the United States Supreme Court, and has defended motion picture studios in copyright cases in trial and appellate courts around the country.

**George Pappas** is a partner at Covington & Burling, where he specializes in patent litigation. He is a Fellow of the American College of Trial Lawyers and Chairman of its Complex Litigation Committee. He is also Chairman of the Editorial Committee and one of the co-authors of the *ANATOMY OF A PATENT CASE* (2009), published in conjunction with the Federal Judicial Center. Mr. Pappas is a co-author of the third edition of the *PATENT CASE MANAGEMENT JUDICIAL GUIDE*. Mr. Pappas received his undergraduate and law degrees from the University of Maryland.

**Lynn H. Pasahow** is a partner at Fenwick & West LLP, where he focuses on patent and other intellectual property litigation, counseling, licensing, and mediation, principally relating to bioscience, software, and Internet technologies. Mr. Pasahow is a co-author of the *PATENT CASE MANAGEMENT JUDICIAL GUIDE*. He earned his J.D. from the University of California at Berkeley (Boalt Hall) School of Law and his undergraduate degree from Stanford University.

**Matthew Powers** is the lead partner at Tensegrity Law Group, LLP. He is one of the nation's most experienced patent trial lawyers. He has litigated and tried cases in jurisdictions nationwide involving a wide range of technologies, including semiconductor, biomedical, computer, computer peripherals, cellular, holographic, digital media and specialty chemical products. Mr. Powers has published articles on various aspects of intellectual property law and litigation. He is a co-author of the *PATENT CASE MANAGEMENT JUDICIAL GUIDE*. Mr. Powers received his J.D. from Harvard Law School and a B.S. from Northwestern University.

**Hon. Leonard P. Stark** is Chief Judge of the District of Delaware. After serving in private practice and as an Assistant U.S. Attorney in Wilmington, Delaware, Judge Stark served as a magistrate judge. He was appointed to the District of Delaware in 2010 and became Chief Judge in 2014. Chief Judge Stark earned B.A. degrees (history, political science) and an M.A. (history) at the University of Delaware, a D. Phil (politics) at Oxford University (Rhodes Scholar), and his J.D. from Yale Law School. He clerked from Judge Walter King Stapleton on the U.S. Court of Appeals for the Third Circuit.

**Sarita P. Venkat** is Senior Counsel at Apple Inc., where she manages complex, high-risk patent and commercial litigations worldwide. She has secured multiple trial wins and judgments in the U.S. and China on behalf of Apple. She has managed numerous cases to favorable resolutions through mediations and settlement negotiations. Prior to joining Apple, she managed a docket of pharmaceutical and medical device litigation worldwide at Abbott Laboratories Inc. – including Hatch Waxman cases in the U.S., and defending the company’s IP in Europe, Asia, South America and Russia. She is a registered patent attorney, has a B.S. in Biology and a minor in Psychology.

**Hon. Ronald M. Whyte** has served on the Northern District of California District Court since 1992. He received an undergraduate degree in Mathematics from Wesleyan University and a law degree from the USC Gould School of Law. After serving as a Lieutenant in the United States Navy from 1968 to 1971 as part of the Judge Advocate General Corps, he worked in private practice for nearly two decades in San Jose, California before being appointed to the Santa Clara Superior Court in 1989. While on the federal bench, Judge Whyte played a central role in the development of the Northern District of California’s Patent Local Rules and model patent jury instructions. Although he took senior status in 2009, Judge Whyte continues to maintain an active docket and is among the designated judges in the Northern District of California’s Patent Pilot Program.



Intellectual Property Seminar  
Berkeley, California  
May 19-22, 2015

**Participant List**

Hon. Cathy Ann Bencivengo	Southern District of California
Hon. Celeste F. Bremer	Southern District of Iowa (Mag. Judge)
Hon. Joe B. Brown	Middle District of Tennessee (Mag. Judge)
Hon. Renee M. Bumb	District of New Jersey
Hon. Jill L. Burkhardt	Southern District of California (Mag. Judge)
Hon. Paul G. Byron	Middle District of Florida
Hon. Sheri P. Chappell	Middle District of Florida
Hon. R. Guy Cole, Jr.	Sixth Circuit Court of Appeals (Chief Judge)
Hon. George B. Daniels	Southern District of New York
Hon. James Donato	Northern District of California
Hon. Stanwood R. Duval, Jr.	Eastern District of Louisiana
Hon. Jay Gandhi	Central District of California (Mag. Judge)
Hon. Louis Guirola, Jr.	Southern District of Mississippi (Chief Judge)
Hon. Yvette Kane	Middle District of Pennsylvania
Hon. Leslie E. Kobayashi	District of Hawaii
Hon. John Z. Lee	Northern District of Illinois
Hon. Donna F. Martinez	District of Connecticut (Mag. Judge)
Hon. Douglas F. McCormick	Central District of California (Mag. Judge)
Hon. Susan O. Mollway	District of Hawaii (Chief Judge)
Hon. Steven E. Rau	District of Minnesota (Mag. Judge)
Hon. Douglas L. Rayes	District of Arizona
Hon. Richard A. Schell	Eastern District of Texas
Hon. Robert Schroeder III	Eastern District of Texas
Hon. Lorna G. Schofield	Southern District of New York
Hon. Manish S. Shah	Northern District of Illinois
Hon. Kevin H. Sharp	Middle District of Tennessee (Chief Judge)
Hon. James A. Soto	District of Arizona
Hon. Leonard P. Stark	District of Delaware (Chief Judge)
Hon. George C. Steeh III	Eastern District of Michigan
Hon. Nita L. Stormes	Southern District of California (Mag. Judge)
Hon. Alicia Valle	Southern District of Florida (Mag. Judge)
Hon. C. Roger Vinson	Northern District of Florida
Hon. Kandis A. Westmore	Northern District of California (Mag. Judge)

<https://www.law.berkeley.edu/centers/berkeley-center-for-law-technology/upcoming-events/ipnewtechnologicalage2015/resources/>

Password: bclt

# Intellectual Property in the New Technological Age 2015

<a href="#">Schedule</a>	<a href="#">Speakers</a>	<a href="#">Resources</a>
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**MAY 19 – 22, 2015**

The Berkeley Center for Law & Technology (BCLT) and the Federal Judicial Center (FJC) are proud to host the 18th Intellectual Property in the New Digital Age Program in Berkeley, California. This three and a half day program will feature an integrated set of lectures by Berkeley Law Faculty and Distinguished Scholars, as well as judicial members and leading law practitioners and professors with particular experience in intellectual property. For details on the lecturers, please visit our [speakers](#) page.

## Resources

<a href="#">Schedule</a>	<a href="#">Speakers</a>	<a href="#">Resources</a>			
<a href="#">Patent Law</a>	<a href="#">Patent Case Management</a>	<a href="#">Copyright Law</a>	<a href="#">Digital Copyright Law</a>	<a href="#">Trademark Law</a>	<a href="#">Digital TM Law</a>

### **SIMULATION MATERIALS FOR MAY 2015 PROGRAM**

**Tab 1** Claim Construction Simulation: [Mangosoft v. Oracle](#)

**Tab 2** Claim Construction Simulation: [Lux v. BrightBlue](#)

**Tab 3** Trademark Preliminary Injunction Simulation 1: [Polar Shock — Polar Corp. v. PepsiCo.](#)

**Tab 4** Trademark Preliminary Injunction Simulation 2: [Swerve](#)

### **PATENT LAW**

#### **A. Validity**

1. [Subject Matter](#)

#### **Software and Business Methods**

– [Bilski v. Kappos](#), 130 S.Ct. 3218 (2010)

– [Alice Corp. v. CLS Bank, Int'l](#), 134 S.Ct. 2347 (2014)

#### **Biotechnology**

– [Association for Molecular Pathology v. Myriad Genetics](#), 133 S.Ct. 2107 (2013)

– [Mayo Collaborative Services v. Prometheus Laboratories, Inc.](#), 132 S.Ct. 1289 (2012)

– [Diamond v. Chakrabarty](#), 447 U.S. 303 (1980)

2. [Utility](#)

– [Brenner v. Manson](#), 383 U.S. 519 (1966)

– [In re Fisher](#), 421 F.3d 1365 (Fed. Cir. 2005) (DNA express sequence tags)

3. [Novelty](#)

#### **Inherency**

– [Schering Corp. v. Geneva Pharm.](#), 339 F.3d 1373 (Fed.Cir. 2003)

4. **Non-Obviousness**
  - KSR International Co. v Teleflex Inc., 550 U.S. 398 (2007)
5. **Written Description/Indefiniteness**
  - Nautilus v. Biosig Instruments, 134 S.Ct. 2120 (2014)
  - Johnson & Johnston Associates Inc. v. R.E. Service Co., Inc, 285 F.3d 1046 (Fed. Cir. 2002)
  - Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co., 598 F.3d 1336 (Fed. Cir. 2010)

## **B. Infringement**

### **“Within the United States”**

- NTP v. Research In Motion, 392 F.3d 1336 (Fed. Cir. 2004)

### **Doctrine of Equivalents**

#### **Prosecution History Estoppel**

- Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 535 U.S. 722 (2002)
- Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 344 F.3d 1359 (Fed. Cir. 2003)  
(on remand from Supreme Court)

#### **Divided Infringement**

- Limelight Networks v. Akamai Technologies, 134 S.Ct. 2111 (2014)

## **Indirect Liability**

- Global-Tech Appliances, Inc. v. SEB S.A., 131 S.Ct. 2060 (2011)

## **C. Defenses**

### **Experimental use**

- Madey v. Duke University, 307 F.3d 1351 (Fed. Cir. 2002)

## **D. Remedies**

### **Injunctions**

- eBay v. MercExchange, 126 S.Ct. 1837 (2006)

### **Damages**

- Apple Inc. v. Motorola, Inc. —F.3d—, 2014 WL 1646435 (Fed. Cir. 2014)
- Microsoft Corp. v. Motorola, Inc., 2013 WL 2111217 (W.D. Wash. 2013)
- Uniloc USA, Inc. v. Microsoft Corp., 632 F.3d 1292 (Fed. Cir. 2011)

### **Extraterritorial damages**

- Microsoft v. AT&T, 550 U.S. 437 (2007)
- Eolas v. Microsoft Corp., 399 F.3d 1325 (Fed. Cir. 2005)

### **Willfulness**

- In re Seagate Technology, LLC, 497 F.3d 1360 (Fed. Cir. 2007) (en banc)
- Knorr-Bremse v. Dana, 383 F.3d 1337 (Fed. Cir. 2004) (en banc)

### **Attorney Fees**

- Octane Fitness, LLC V. Icon Health & Fitness, Inc., 134 S.Ct. 1749 (2014)
- Highmark Inc. v. Allcare Health Management System, 134 S.Ct. 1744 (2014)

## **PATENT CASE MANAGEMENT**

### **A. Patent Local Rules**

- James Ware & Brian Davy, The History, Content, Application and Influence of the Northern District of California’s Patent Local Rules, 25 Santa Clara Computer & High Tech. L.J. 965 (2009)
- Patent Case Management Judicial Guide (Second Edition) Appendix D

### **B. Protective Orders and Discovery**

- Stipulated Protective Order, Northern District of California
- eDiscovery Model Order

### **C. Model Jury Instructions**

- Patent Case Management Judicial guide (Second Edition) Appendix E

#### **D. Claim Construction (Process and Principal Issues)**

- Teva Pharmaceuticals v. Sandoz, 135 S.Ct. 831 (2015)
- Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005)
- Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996)

#### **E. Education of Judge and Jury about Technology**

- Fed.R. Civ.P. 53 (special masters)
- FRE 706 (court appointed experts)
- TechSearch v. Intel, 286 F3d. 1360 (Fed. Cir. 2002)
- Association of Mexican Am. Educators v. California, 231 F3d. 572 (9th Cir. 2000)

### **COPYRIGHT LAW**

#### **A. Protectability, Ownership, and Duration**

#### **B. Infringement Analysis**

- Arnstein v. Porter, 154 F.2d 464 (2d Cir. 1946)
  - Nichols v. Universal Pictures Corporation, 45 F.2d 119 (2d Cir. 1930)
1. Music
    - Bright Tunes Music Corp. v. Harrisongs Music, Ltd., 420 F.Supp. 177 (S.D.N.Y. 1976)
    - Selle v. Gibb, 741 F.2d 896 (7th Cir. 1984)
    - Three Boys Music Corporation v. Michael Bolton, 212 F.3d 477 (9th Cir. 2000)
    - Grand Upright Music Limited v. Warner Brothers Records, Inc., 780 F.Supp. 182 (S.D.N.Y. 1991)
    - Newton v. Diamond, 349 F.3d 591 (9th Cir. 2003)
    - Bridgeport Music, Inc. v. Dimension Films, 383 F.3d 390 (6th Cir. 2004)
    - Swirsky v. Carey, 376 F.3d 841 (9th Cir. 2004)
  2. Graphic Works
    - Mannion v. Coors Brewing Co., 377 F.Supp.2d 444 (S.D.N.Y. 2005)
  3. Software
    - Computer Associates v. Altai, 982 F.2d 693 (2d Cir. 1992)
    - Lotus v. Borland, 49 F.3d 807 (1st Cir. 1995), aff'd by an equally divided Court, 516 U.S. 233 (1996)

#### **C. Fair Use**

- Pierre Leval, Toward a Fair Use Standard, 103 Harv. L. Rev. 1105 (1990)
- David Nimmer, “Fairest of them All” and Other Fairy Tales of Fair Use, 66 Law & Contemp.Probs. 263 (Winter/Spring 2003)

#### 1. Parody

- Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569 (1994)
- Leibovitz v. Paramount Pictures Corp., 137 F.3d 109 (2d Cir. 1998)
- Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc., 109 F.3d 1394 (9th Cir. 1997)
- Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257 (11th Cir. 2001)
- MasterCard Intern. Inc. v. Nader 2000 Primary Committee, Inc., 2004 WL 434404, 70 U.S.P.Q.2d1046, (S.D.N.Y., Mar. 8, 2004)

#### 2. Software – Reverse Engineering

- Sega Enterprises Ltd. v. Accolade, Inc., 977 F.2d 1510 (9th Cir. 1992)

#### 3. Transformative

- Bill Graham Archives v. Dorling Kindersley Ltd., 448 F.3d 605 (2d Cir. 2006)
- Blanch v. Koons, 467 F.3d 244 (2d Cir. 2006)
- Cariou v. Prince, 714 3d 694 (2d Cir. 2013)

#### **D. Remedies**

- Salinger v. Colting, 607 F.3d 68 (2d Cir. 2010)
- UMG Recordings, Inc. v. MP3.Com, Inc., 2000 WL 1262568

## **DIGITAL COPYRIGHT LAW**

– Peter S. Menell, This American Copyright Life: Reflections on Re-equilibrating Copyright for the Internet Age, 61 Journal of the Copyright Society 235 (2014) (42nd Brace Lecture)

– Peter S. Menell, Envisioning Copyright Law’s Digital Future 46 N.Y. Law School Law Review 63 (2002-03)

– Peter S. Menell and David Nimmer, Unwinding Sony, 94 Cal. L. Rev. 941 (2007)

– Peter S. Menell and David Nimmer, Legal Realism in Action: Indirect Copyright Liability’s Continuing Tort Framework and Sony’s De Facto Demise, 55 UCLA L. Rev. 1 (2007)

### **A. Indirect Liability**

– Metro-Goldwyn-Mayer Studios, Inc. v. Grokster Ltd., 545 U.S. 913 (2005)

– Sony Corp. of America v. Universal City Studios, 464 U.S. 417 (1984)

– Perfect 10, Inc. v. Amazon.com, Inc., 508 F.3d 1146 (9th Cir. 2007)

– Perfect 10, Inc. v. Visa Intern. Service Ass’n, 494 F.3d 788 (9th Cir. 2007)

### **B. DMCA – Online Service Provider Safe Harbors and Copyright Enforcement**

#### 1. Scope Online Service Provider Safe Harbor and General Immunity for Passive Conduits

– UMG Recordings, Inc. v. Shelter Capital Partners LLC, 718 F.3d 1006 (9th Cir. 2013)

– Viacom Int’l, Inc. v. YouTube, 679 F.3d 19 (2d Cr. 2012)

– Perfect 10, Inc. v. CCBill LLC, 488 F.3d 1102 (9th Cir. 2007)

– CoStar Group v. LoopNet, 373 F.3d 544 (4th Cir. 2004) (continued viability of immunity of passive conduits)

#### 2. Notice and Takedown Process

– Corbis Corp. v. Amazon.com, Inc., 351 F. Supp. 2d 1090 (W.D. Wash. 2004) (identifying and terminating repeat infringers)

– Rossi v. Motion Picture Ass’n of America, 391 F.3d 1000 (9th Cir. 2004) (knowledge required to trigger DMCA takedown requirements)

#### 3. Subpoenas to OSPs

– London-Sire Records, Inc. v. Doe 1, 542 F.Supp.2d 153 (D.Mass 2008)

– RIAA v. Verizon Communications, 351 F.3d 1229 (D.C. Cir. 2003) (holding that DMCA Section 512(h) subpoena provision applies only to Section 512(c) on-line service providers and cannot be used to identify filesharers’ identity)

– In re Charter Communications, Inc. Subpoena Enforcement Matter, 393 F.3d 771 (8th Cir. 2005) (same) In re Subpoena to University of North Carolina at Chapel Hill, 2005 WL 1027099 (M.D.N.C. April 14, 2005) (same)

– Sony Ent. Corp. v. Does 1-40, 326 F. Supp. 2d 556 (S.D.N.Y. 2004) (addressing procedural issues relating to Doe filesharing lawsuits; holding that First Amendment did not bar ISP’s disclosure of defendants’ identities)

– Elektra Ent. Group v. Does 1-9, 2004 WL 2095581 (S.D.N.Y. 2004) (granting motions to dismiss for lack of personal jurisdiction when the copyright owner has not filed suit in a jurisdiction with which a particular Doe has minimum contacts).

– BMG v. John Does 1-203, 2004 WL 953888 (E.D. Pa. 2004) (declining to consolidate filesharing cases)

– Virgin Records America, Inc., v. John Does 1-35, 2006 WL 1028956 (D.D.C. Apr. 18, 2006)

#### 4. P2P Enforcement – “Making Available”

– Peter S. Menell, In Search of Copyright’s Lost Ark: Interpreting the Right to Distribute in the Internet Age, 59 J. Copyright Soc’y 1 (2011)

– Matthew Sag, Copyright Trolling, An Empirical Study

#### 5. Public Performance

– American Broadcasting Companies v. Aereo, 134 S.Ct. 2498 (2014)

– Cartoon Network LP, LLLP v. CSC Holdings, Inc., 536 F.3d 121 (2d Cir.2008) (Cablevision)

### **C. DMCA – Anticircumvention**

– David Nimmer, A Riff on Fair Use in the Digital Millennium Copyright Act, 148 U. Pa. L. Rev. 673 (2000)

– Lexmark v. Static Control Components, 387 F.3d 522 (6th Cir. 2004) (interaction with copyright law’s protectability doctrines)

- Chamberlain Group, Inc. v. Skylink Technologies, 381 F.3d 1178 (Fed. Cir. 2004)
- Davidson & Associates v. Jung, 422 F.3d 630 (8th Cir. 2005)

#### **D. Fair Use on the Internet**

- Perfect 10 v. Amazon, 508 F.3d 1146 (9th Cir. 2007)
- Kelly v. Arriba Soft Corp., 336 F.3d 811, 817 (9th Cir.2003)
- Field v. Google, 412 F.Supp.2d 1106 (D.Nev. 2006) (caching)

### **TRADEMARK LAW**

#### **A. Protection Distinctiveness**

- Wal-Mart Stores, Inc. v. Samara Bros., Inc. 529 U.S. 205 (2000) (trade dress)

#### **B. Infringement Right of Attribution**

- Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23 (2003)

#### **C. Defenses Functionality**

- TrafFix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23 (2001)
- Christian Louboutin S.A. v. Yves Saint Laurent America Holdings, Inc., 696 F.3d 206 (2d Cir. 2012)

#### **Fair Use**

- KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 125 S.Ct. 542 (2004)
- Brown v. Electronic Arts, Inc., 724 F.3d 1235 (9th Cir. 2013)
- Century 21 Estate Corp. v. LendingTree, Inc., 425 F.3d 211 (3rd Cir. 2006)
- New Kids on the Block v. News America Pub., Inc., 971 F.2d 302 (9th Cir. 1992)

#### **Remedies**

##### Preliminary Injunction

- Herb Reed Enterprises, LLC v. Florida Entertainment Management, Inc. 736 F.3d 1239 (9th Cir. 2013)

#### **Dilution**

- Trademark Dilution Revision Act of 2006
- Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252 (4th Cir. 2007)

### **DIGITAL TM LAW**

#### **A. Domain Names**

- Uniform Domain Name Dispute Resolution Policy, Internet Corporation for Assigned Names and Numbers (August 26, 2001).

#### **B. Keyword Advertising**

- Rosetta Stone Ltd. v. Google, Inc., 676 F.3d 144 (4th Cir. 2012)
- Rescuecom Corp. v. Google Inc., 562 F.3d 123 (2d Cir. 2009)

#### **C. Contributory Infringement**

- Tiffany (NJ) Inc. v. eBay Inc., 600 F.3d 93 (2d Cir. 2010)

#### **D. Defenses: Nominative Use, Fair Use, 1st Amendment**

- Bally Total Fitness Holding Corp. v. Faber, 29 F.Supp.2d 1161 (C.D.Cal.1998)
- Playboy Enterprises, Inc. v. Welles, 279 F.3d 796 (9th Cir. 2002)
- Bosley Medical Institute, Inc. v. Kremer, 403 F.3d 672 (9th Cir. 2005)