



5th Annual Texas A&M Intellectual Property Scholars Roundtable

FINAL PROGRAM

FRIDAY, SEPTEMBER 27, 2019

11:30 Lunch

12:00 Panel 1: Patent Law (I)

Moderator: Prof. Glynn S. Lunney, Jr., Texas A&M University School of Law

Presenters: Prof. Roberto Garza Barbosa, Tecnologico de Monterrey (Mexico)
“Mexican Patent Litigation, International Intellectual Property Treaties and the Extension of Patent Term of Protection”

Prof. Srividhya Ragavan, Texas A&M University School of Law
“Global Perspectives of Data Exclusivity”

Prof. V.K. Unni, Indian Institute of Management Calcutta (India)
“Pharmaceutical Evergreening and ‘Enhanced Efficacy’ Under Indian Patent Law: Exploring the Scope for a Broader Interpretation”

1:30 Coffee Break

1:45 Panel 2: Intellectual Property Law (I)

Moderator: Prof. H. Brian Holland, Texas A&M University School of Law

Presenters: Prof. Eric E. Johnson, University of Oklahoma College of Law
“The Macroeconomics of Intellectual Property”

Prof. W. Keith Robinson, Dedman School of Law, Southern Methodist University
“Access to the Patent System”

Prof. Matthew Sipe, George Washington University Law School
“Headaches and Handbags: A Dissipation Theory of Trademark Functionality”

3:15 Coffee Break

3:30

Special Guest

Simon Tam, founder of The Slants and author of *Slanted: How an Asian American Troublemaker Took on the Supreme Court*

4:15

Panel 3: Trademark Law—*Matal v. Tam* and Beyond

Moderator: Prof. John T. Cross, University of Louisville School of Law

Panelists: Prof. Ann Bartow, University of New Hampshire School of Law

Prof. Llewellyn J. Gibbons, University of Toledo College of Law

Prof. Yvette Joy Liebesman, Saint Louis University School of Law

Prof. Glynn S. Lunney, Jr., Texas A&M University School of Law

Prof. Ned Snow, University of South Carolina School of Law

5:15

Performance

Simon Tam and Joe Jiang

6:00

Roundtable Adjourns for the Day

7:00

Dinner for Roundtable Participants

Waters

301 Main Street, Fort Worth

SATURDAY, SEPTEMBER 28, 2019

8:30 Breakfast

9:00 Panel 4: Patent Law (II)

Moderator: Prof. Saurabh Vishnubhakat, Texas A&M University School of Law

Presenters: Prof. Jeremy Bock, Tulane University School of Law
“Compartmentalizing Patent Law”

Dr. Dhanay Cadillo Chandler, Faculty of Law, University of Turku (Finland)
“Creating Incentives and Regulation for New Health Technologies”

Prof. Stefania Fusco, Notre Dame Law School
“Monetization Strategies of University Patents and Their Impact on Technology Diffusion” (with Francesco Lissoni, Catalina Martínez and Valerio Sterzi)

Prof. Dmitry Karshedt, George Washington University Law School
“Obviousness: Before and After”

10:45 Coffee Break

11:00 Panel 5: Intellectual Property Law (II)

Moderator: Prof. Jeff W. Slattery, Texas A&M University School of Law

Presenters: Prof. Daryl Lim, UIC John Marshall Law School
“Futurecasting”

Prof. Zvi S. Rosen, George Washington University Law School
“Examining Copyright”

Prof. Elizabeth Rosenblatt, U.C. Davis School of Law
“Intellectual Property and the Question of Who Creates”

Prof. Ned Snow, University of South Carolina School of Law
“Against Protecting Harmful Creations of the Mind”

Dr. Wang Runhua, Intellectual Property Fellow, Chicago-Kent College of Law
“New Private Law? Intellectual Property ‘Common-Law Precedents’ in China”

1:00 Lunch

1:45 Panel 6: Copyright Law (I)

Moderator: Prof. Ann Bartow, University of New Hampshire School of Law

Presenters: Prof. Christine S. Davik, University of Maine School of Law
“Unregistered Complaints”

Prof. Liam S. O’Melinn, Pettit College of Law, Ohio Northern University
“American ‘Degeneracy’ and the Cultural Background of Early American Copyright”

Prof. Amanda Reid, UNC School of Media and Journalism
“Meta-Analysis of Therapeutic Benefits of Music”

3:15 Coffee Break

3:30 Panel 7: Copyright Law (II)

Moderator: Prof. Marshall Leaffer, Indiana University Maurer School of Law

Presenters: Dr. Cheryl Foong, Curtin Law School (Australia)
“A Purposive Approach to Defining and Analyzing Copyright Markets”

Prof. Doris E. Long, UIC John Marshall Law School
“Can Copyright Cope with the Challenges of New Technology in the Twenty-first Century?”

Prof. Timothy J. McFarlin, University of La Verne College of Law
“Killing Classic Copyrights”

5:00 Closing Remarks

Prof. Peter K. Yu, Texas A&M University School of Law

7:00 Dinner for Roundtable Participants

Wild Salsa
300 Throckmorton Street, Fort Worth

Commentators

- Prof. John T. Cross, University of Louisville School of Law
- Prof. H. Brian Holland, Texas A&M University School of Law
- Prof. Marshall Leaffer, Indiana University Maurer School of Law
- Prof. Elizabeth A. Rowe, University of Florida Levin College of Law
- Prof. Jeff W. Slattery, Texas A&M University School of Law
- Prof. Lars S. Smith, University of Louisville School of Law
- Prof. Saurabh Vishnubhakat, Texas A&M University School of Law
- Prof. Peter K. Yu, Texas A&M University School of Law
- Prof. Zhu Yifei, Law School, China Jiliang University (China)

ABSTRACTS

Prof. Jeremy Bock, Tulane University School of Law

“Compartmentalizing Patent Law”

Is patent law specialized enough? For most casual observers, this may seem like an unusual question because many of the concerns expressed by commentators lie in the perception that patent law is allegedly too specialized. But greater specialization may have benefits where the patent system’s ailments have proven difficult to diagnose and treat, as illustrated by the patent system’s resilience to changes in the law. It may be the case that reforms and changes in the law have been futile because we do not know exactly what is wrong and have difficulty predicting how the patent system will react because it has too many moving parts. I argue that some form of compartmentalization in the patent system—as achieved through greater specialization—can enhance its diagnosability. And, once a diagnosis is obtained, compartmentalization may facilitate experimentation in case law and the adoption of reforms because the impact of any modification and the risk of failure may remain localized, rather than spread to or entangle other parts of the patent system and beyond.

Dr. Dhanay Cadillo Chandler, Faculty of Law, University of Turku (Finland)

“Creating Incentives and Regulation for New Health Technologies”

This paper stems from the on-going controversy between the needs for innovation, access to new life saving drugs, the constant push for higher standards of IPRs of protection that are lobbied at the international level (i.e. existing EU-third country trade and investment treaties), and the regulatory challenges faced by new technologies. The controversy has a twofold connotation: 1) the potential failure of the patent system to foster innovation in all fields of technology; and 2) the need to provide a set of incentives in addition to the patent system to foster innovation in needed medical fields. The general hypothesis: Innovation in the field of neglected and communicable diseases is falling behind or simply lacking. Thus, it may be necessary to develop a side system of incentives that while is based in the patent system it will benefit from the inclusion of human rights principles to achieve a well will potentially boost access to medicines, national growth, transfer of technology and improvements within the public health care sector as the final price could be delinked from the cost of R&D.

At the international level, the discussion comes down to balancing IP incentives, protecting and promoting IPRs while also taking into consideration health concerns. A cornerstone aspect in this regard, are the very definitions of “invention” and “incentives.” Defining what a pharmaceutical innovation is or reaching a common definition would possibly lead to the implementation of better regulatory incentives. At the moment, inventions are defined on basis of the patentability requirements –novelty, inventive step, and industrial applicability. Innovation is seemingly driven by incentives coming from either the patent system, or outside this, such is the case provided by the Orphan drug legislation in the EU. Access to innovation and sustainable funding is also part of this two-way street approach embodying solutions and challenges given by the same regulatory framework. Thus, this paper, as part of the overall project, will focus in finding connecting points in terms of defining the term “invention” as an “incentive” at the EU level the Orphan Drug Scheme, PRIME; at the international level e.g. India, the Patent Act. The analysis of the aforementioned intends to shed light on the possibility to use the policy space to define “innovation” on basis of public health concerns. In doing so, implementing TRIPS of higher standards of protection is believed to achieve a balance amongst different stakeholders’ interests without breaching international obligations.

Prof. Christine S. Davik, University of Maine School of Law
“Unregistered Complaints”

In March, the U.S. Supreme Court handed down its highly-anticipated decision in *Fourth Estate Public Benefit Corporation v. Wall-Street.com, LLC* which resolved a split among U.S. Court of Appeals concerning the point in time when a copyright owner is first able to file suit against an alleged infringer. While at first glance this case may merely appear to be a simple issue of statutory interpretation, namely whether it is upon application for registration or once a determination has been made on registration by the U.S. Copyright Office, I argue this decision is a clarion call for a much-needed amendment to the Copyright Act. Although the Court may have correctly construed the registration prerequisite in Section 411(a) of the Copyright Act, I argue that neither of the two approaches before the Court was a truly appropriate option. Alternatively, I proffer the requirement of infringement must be removed entirely in order to properly account for technological changes in the methods and speed by which copyrightable works are now created, reproduced, and distributed. This will ensure that all copyright owners are able to access the courthouse without delay in accord with virtually every other area of law.

Unfortunately, as it currently stands post-*Fourth Estate*, most U.S. copyright owners cannot seek relief immediately upon detecting infringement of their work. Instead, they must wait the months and in some cases years for the Copyright Office to complete its review, despite the existence of federal copyright protection that attaches automatically upon creation of the work. As such, the author of an unregistered work is essentially left with a right to prevent copyright infringement, but an inability to do so. Adding to the inequities of this situation is the fact that due to treaty obligations prohibiting formalities that stand in the way of enforcing one’s copyright rights, owners of foreign works do not have to comply with this registration prerequisite. Instead, these owners can proceed directly to federal court to protect their works.

Accordingly, I advocate for complete removal of the registration prerequisite. In doing so, this Article stands in stark contrast to the recent scholarly trend in the field of copyright law advocating for more, not less, formalities associated with one’s copyright rights. This includes calls by many legal scholars for the “re-incentivization” of federal registration by taking away certain rights and the availability of particular defenses as a consequence for failing to seek an earlier copyright registration. While many of these proposals are an understandable reaction to the significant increase in both the breadth and depth of copyright rights over the past several decades, emphasizing registration is not an appropriate way to achieve balance in light of the numerous barriers to registration in its current form, especially for individual artists or smaller entities. Consequently, after examining the various arguments in support of and in opposition to the repeal of the registration requirement, this article ultimately concludes the overwhelming advantages to eliminating the Section 411(a) prerequisite outweigh any perceived or actual drawbacks.

Dr. Cheryl Foong, Curtin Law School (Australia)
“A Purposive Approach to Defining and Analyzing Copyright Markets”

This paper poses the question: Can a more critical approach to copyright markets advance our understanding of the scope of exclusive rights? The scope of these rights as interpreted by courts has an impact on the state of copyright markets, and the development of such markets. By explicitly tying the question of infringement to the markets impacted by these decisions, perhaps we can bring greater clarity to judicial reasoning on the scope of exclusive rights. Using the Australian approach to market definition in competition law as a starting point, this paper seeks to develop a clearer perspective on copyright market definition and analysis. It further explores notions of expressive competition and disseminative competition as applied to different elements of infringement.

Prof. Stefania Fusco, Notre Dame Law School

“Monetization Strategies of University Patents and Their Impact on Technology Diffusion” (with Francesco Lissoni, Catalina Martínez and Valerio Sterzi)

The pressure to extract rents from academic research results has led many universities to file more patents and to utilize a growing range of monetization strategies including selling patents to Patent Assertion Entities (PAEs). We build a database on the first sales of university patents granted by the USPTO as well as to the citations that these patents received year after year. Next, we conduct an econometric analysis on a panel data framework to demonstrate that the university patents acquired by PAEs receive, on average, significantly fewer citations after the transfer than other university patents, indicating a post-transfer “isolation” of the relative technology. Our study provides novel evidence on the limits that the transfer of ownership of university patents to PAEs may impose on the diffusion and use of patented technologies that are derived from academic research. We believe that our research has produced sufficient evidence to argue that universities’ monetization strategies should be subject to full scrutiny by legislators in various jurisdictions, particularly when they involve selling knowledge to PAEs.

Prof. Roberto Garza Barbosa, Tecnológico de Monterrey (Mexico)

“Mexican Patent Litigation, International Intellectual Property Treaties and the Extension of Patent Term of Protection”

This article analyzes how the provisions on patent term adjustments contained in the new United States-Mexico-Canada Trade Agreement (USMCA) will be problematic for Mexico. To illustrate this point, the article revisits a patent litigation in Mexico. The plaintiff was a Japanese company who was suing over the infringement of its rights by a Mexican Lab. In this case, Transitory Article Twelve of the Mexican Industrial Property Act was applied to recognize a priority filing date seven years later than its original filing in Japan. The litigation involved several issues like the extension of the term of protection, and the alleged infringement by the defendant after authorities had extended the term of the patent. There are several principles and concerns discussed, such as the principle of patent independence, national treatment, and minimum term of protection, all of which are contained in the Paris Convention, Agreement on Trade-Related Aspects of Intellectual Property Rights and in the Patent Cooperation Treaty.

Prof. Eric E. Johnson, University of Oklahoma College of Law

“The Macroeconomics of Intellectual Property”

This Article argues for a reorientation of intellectual property theory away from a microeconomic mode of analysis and toward a macroeconomic perspective, and this Article provides a set of principles for thinking about intellectual property in macroeconomic terms.

Economic justifications have long been the core of intellectual property theory. Yet economic thinking about intellectual property has generally kept to a microeconomic perspective. Microeconomic analysis concentrates on individuals—consumers, producers, workers, investors, etc.—and the economic interactions among them. Correspondingly, the microeconomic objective is economic efficiency—ensuring the optimal production of goods and services and their optimal distribution to those people and firms who can make the best use of them. Macroeconomic analysis, on the other hand, concentrates on a society-wide view. And correspondingly, the macroeconomic yardstick is economic growth and the avoidance of economic stagnation. A macroeconomic perspective implies that inefficiencies should be tolerated if doing so means advancing people’s standard of living on a society-wide basis.

This Article takes the position that law-and-economics analysis should, as a general matter, be reoriented toward macroeconomic goals and perspectives. This need is particularly acute for intellectual property law,

which is fundamentally tied into notions of progress and innovation—things that have long been the preoccupation of macroeconomic analysis.

After making the general claim for a need for a macroeconomic perspective in intellectual property theory, this paper provides a set of principles for putting this into practice, points out fallacies to avoid, and sets out initial policy prescriptions.

Prof. Dmitry Karshedt, George Washington University Law School

“Obviousness: Before and After”

Nonobviousness, codified in 35 U.S.C. § 103, has been called “the ultimate condition of patentability” because of its crucial function of weeding out patents on trivial inventions. This requirement asks tribunals to decide if a patent claim would have been obvious to a person of ordinary skill in the art based on the state of knowledge in the invention’s field at the time the patent application was filed with the U.S. Patent and Trademark Office (PTO). Nonetheless, *Graham v. John Deere*, the Supreme Court opinion that lays the foundation for modern § 103 jurisprudence, says little about the timing of the obviousness. Instead, *Graham*’s central contribution is to divide evidence that bears on patent claim validity under § 103 into two general categories or tiers. In the first set of inquiries, sometimes referred to as the primary or “prima facie” case of obviousness, the PTO or a court determines the content of relevant pre-patent materials, such as journal publications and other disclosures collectively known as the “prior art,” and ascertains the differences between the prior art and the claim at issue. The second category, which the Supreme Court actually called “secondary considerations” and treated as a separate factor, includes real-world, and sometimes non-technical, facts such as commercial success of the product covered by the claims and the failure of others to address the problem ultimately solved by the patent. Although courts and commentators disagree vigorously over the relative weight and relevance of primary and secondary evidence, the *Graham* framework continues to play a central role in the law of § 103.

In this Article, I contend that *Graham*’s primary-secondary heuristic has led to significant errors, and should be rejected in favor of a different approach. Among other problems, the Court’s segmenting of the § 103 inquiry into technical and non-technical siloes is causing confusion and leading to incorrect assignments of probative value of certain evidence bearing on obviousness, in part by obscuring the significance of time for patent validity inquiries. I thus argue that *Graham* should be replaced with a framework that better accounts for the crucial role that the Patent Act attaches to the time of patent filing. I maintain that the logically salient way of organizing factual inquiries in § 103 cases is not the primary-secondary divide, but the distinction between evidence that comes into existence before the filing date of the patent application (ex ante) and evidence that appears after that date (ex post). I explain that the proposed categorization will facilitate the task of determining the relevance and weight of various pieces of obviousness evidence and result in more accurate validity judgments relative to the *Graham* regime. Lastly, I contend that, should we seek to modulate the nonobviousness requirement to increase incentives for post-filing experimentation and commercialization, this Article’s framework provides a ready lever for implementing this reform.

Prof. Daryl Lim, UIC John Marshall Law School

“Futurecasting”

Futurecasting explains why the current patent-antitrust framework breeds intractable ideological divisions that force courts into ultimately relying on “hunch, faith, and intuition,” usually deferring to patentees erroneously. The talk then explains how AI and behavioral economics synergistically provide the tools courts need to weigh competing narratives of innovation, and concludes by identifying promising avenues for future research.

Prof. Timothy J. McFarlin, University of La Verne College of Law
“Killing Classic Copyrights”

If a classic creative work has impermissibly copied another work, should a judge be allowed to kill it? In other words, should a judge be able to forbid the further distribution of a song like Led Zeppelin’s “Stairway to Heaven” or a film like Alfred Hitchcock’s *Rear Window*, and order that all existing copies be destroyed, if it’s found they’ve infringed someone else’s copyrighted work? If so, how should a judge properly decide which infringing classics should live or die?

Such cases, to be sure, have been relatively few and far between—it’s not every day that a classic work is accused of copyright infringement—but the gravity of each such claim, and its potentially dire consequences for our culture, should not be ignored. And the U.S. Supreme Court’s 2012 decision in *Petrella*—opening the doors to claims based on older (but still copyrighted) works as long as there’s been a recent act of infringement—has increased the chances we’ll see more claims against classic works in the future.

Though it’s much harder (if not impossible) to fully keep a classic intangible work from the public than it is for a physical copy, this doesn’t mean that legal impediments are meaningless: they can impact access, price, and public confidence in the law. Joseph Sax’s 2001 book *Playing Darts with a Rembrandt: Public and Private Rights in Cultural Treasures* elegantly explored the public interest in the physical embodiments of such classics. This project is largely an effort to expand such thinking to the intangible works we might deem “classic” and, further, to those classics found to be infringing. Should we kill them?

Prof. Liam S. O’Melinn, Pettit College of Law, Ohio Northern University
“American ‘Degeneracy’ and the Cultural Background of Early American Copyright”

It is difficult to do a satisfactory history of the origins of American copyright law, in part because although copyright and patent were important enough to make it into the Constitution, they were not important enough to explain. Thus, direct evidence as to the precise motivations of the founding generation in adopting copyright law is sparse. In this project I examine the development of American literary enterprises after the Revolution, considered as responses to pointed European criticisms of America, as a plausible explanation of why Americans looked to copyright as a device for furthering the prospects of the new nation.

Since the seventeenth century British imperial thinkers and policy-makers had insisted that Americans were degenerates who were not entitled to the rights of true Englishmen. This belief, which was ultimately a constitutional view premised on the need for an imperial lower class, had a philosophical counterpart that endured beyond the Revolution. Famous European philosophers asserted without embarrassment that America was a degenerate land, and that this degeneracy extended to all things American, including plants, animals, and people. This critique is well-known in a general sense, but what is not fully appreciated is that to Americans the imputation of inferiority was devastating, not simply as a matter of pride, but also because the fledgling nation needed foreign recognition, support, and immigrants.

Thus Americans set themselves the task of refuting the degeneracy thesis via the creation of a national literature, following the call of Thomas Jefferson’s *Notes on the State of Virginia*. The book was a sustained defense of America aimed at France, and it was followed by an astonishing volume of books, essays, and poems with the same purpose. The result was the nearly instantaneous creation of a vast American literature. These writings spoke in one voice, praising American in virtually every regard. In 1776 American literature was to be found mainly in published sermons and political tracts, but beginning in the 1780s a more diversified literature came on the scene. There were political histories, natural histories, novels, poems, and essays published in books and in newly created journals of Americanism.

In addition to championing American causes, this literature began to fill a long-felt need for books in general and for works published in America rather than in Britain. An examination of this need and the manner in which it was filled help to explain, both directly and indirectly, why Americans looked to copyright law as an instrument to further the Americanization of their literature.

Prof. Amanda Reid, UNC School of Media and Journalism

“Meta-Analysis of Therapeutic Benefits of Music”

I conduct a meta-analysis of the social science literature documenting the therapeutic uses of music. The documented benefits of music therapy range from aiding individuals with autism spectrum disorders to helping the body manage pain and heal after trauma. Copyright has exemptions for favored uses. I argue that therapeutic use of copyrighted works should qualify as a preferred use. In light of the social utility of music therapy, I make the case for a copyright exemption for therapeutic uses of music.

Prof. W. Keith Robinson, Dedman School of Law, Southern Methodist University

“Access to the Patent System”

There is a perception that women and certain minorities underutilize the patent system. To combat this perception the United States Patent and Trademark Office (USPTO) has several initiatives and programs designed to assist underrepresented inventors. The USPTO has opened several regional offices across the country to expand access to its resources. Applicants may file their applications with a reduction in fees if they meet certain requirements. Also, the USPTO offers a pro se assistance program to assist pro se applicants with the filing of their applications. However, access to the patent system means more than just offering an inventor assistance with what information to submit in their patent application. True access involves removing obstacles to the inventing and patenting cultures that have historically been closed to underrepresented inventors. This paper explains these historical barriers and suggests further initiatives that the USPTO may implement to improve access to the patent system.

Prof. Zvi S. Rosen, George Washington University Law School

“Examining Copyright”

Various parts of the federal government have been engaging in substantive pre-registration examination of copyrights, and refusing to register material for copyright, for at least 170 years, from District Court Clerks in the 1850s to the U.S. Copyright Office today. However, this has not been subject to serious study before, and this piece will aim to change that. In particular, I will offer a history of copyright examination focused on the administrative development of the Copyright Office into a modern agency, anecdotal evidence of examination and rejection through history, and systematic statistics heretofore unavailable of applications and rejections from the 1950s through today, as well as limited statistics on rejection rationales at the dawn of the 20th century. Through this I will show that when we talk about copyright we are actually talking about several loosely connected types of creative works, which are in fact treated quite differently by the government entities which supervise their registration. I will also propose ways to make the examination process more efficient in light of the differences among types of works.

Prof. Elizabeth Rosenblatt, U.C. Davis School of Law

“Intellectual Property and the Question of Who Creates”

Many scholars have observed a substantial connection between the specifics of intellectual property doctrines, on one hand, and the sorts of inventions, works, and marks that people create, on the other. It is well established that intellectual property law inherently favors the creation of inventions and works with predictably high market value, by providing creators exclusive access to those markets. I suggest, however, that intellectual property law influences not only what sorts of things get made, but also who makes those

things, and who gains the sociocultural benefits of being identified as an inventor or creator. This project draws on social science, critical theory, and studies of intellectual property’s “negative spaces” to explore how intellectual property law and rhetoric may influence who creates, and how different sorts of creators (as distinct from their creations) are discursively valued by intellectual property law. While (as a general matter) law carries enormous potential to protect the less-privileged, legal systems often tend to favor large-scale players over individuals and small-scale players, rich over poor, majority over minority. The same can be said for intellectual property laws’ systems of mediating spaces between communities’ disparate norms surrounding innovation, creation, copying, and attribution.

Prof. Matthew Sipe, George Washington University Law School

“Headaches and Handbags: A Dissipation Theory of Trademark Functionality”

A group of test subjects are randomly assigned one of two treatments for their frequent headaches: either generic or brand-name ibuprofen. Subjects taking the branded ibuprofen, Nurofen®, report markedly greater pain relief and fewer side effects than the generic group. The experiment is repeated with new subjects, but this time the Nurofen pills are swapped for Nurofen-labeled placebos. The result: even a sugar pill with a trademark outperforms the genuine, but unbranded, pharmaceutical.

The traditional story of trademark law is one of indirect effects on the underlying product, via reductions in search costs and stronger reputation enforcement. Direct effects are, in theory, prohibited by the doctrine of functionality; a cost-saving shape or longer-lasting material cannot be trademarked. But despite a century of jurisprudence, the precise boundaries of this doctrine have proved nearly impossible to define in practice—and courts appear willfully blind to demonstrable psychological, sociological, and economic evidence that challenges the traditional story.

The culprit is a series of false dichotomies on which judges and administrators have variously relied rather than building a workable, unifying standard for trademark eligibility. Trade dress is treated differently than word and symbol marks. Aesthetic product features are distinguished from utilitarian ones. And effects on cost, quality, and use are conceptually separated from source-designating power.

This article suggests a novel approach to functionality, a unifying standard grounded in the traditional theories and core strengths of trademark law: protecting against welfare dissipation. The search-cost and quality-incentive enhancements associated with protecting trademarks have long been recognized; to allow unrestricted use of a given trademark would cause them to quickly dissipate. But from the placebo effect to status goods, there are a far greater variety of potentially dissipated enhancements than have been doctrinally recognized. Much as patent or copyright law seeks to incentivize creations that would not otherwise have been possible, the true test for trademark law lies in distinguishing between the enhancements that require protection in order to resist dissipation, and those that do not.

Prof. Ned Snow, University of South Carolina School of Law

“Against Protecting Harmful Creations of the Mind”

Should considerations of morality play a role in defining intellectual property rights? In answering this question, I posit that morality means principles that dictate what is beneficial or harmful to society. Under that definition, the three theories of intellectual property suggest that morality should play a role: the utilitarian theory is based on increasing the public good, which is an inherently moral end; the labor-desert theory is premised on a natural-law principle that property must be used for moral ends; and the personality-autonomy theory subjects the moral claim of an individual to her intellectual creation to the moral claims of those whose autonomy is inhibited by that creation. Nevertheless, even if in theory morality is relevant to defining intellectual property, what about in practice? Why should the government impose a morality barrier to the free flow of ideas? There are three reasons. First, some intellectual creations are harmful to

society or inconsistent with the purposes of a specific intellectual-property regime. Second, government has a collective perspective in assessing an idea's value that laissez-faire market forces (which rely on individual assessments) may fail to realize. Third, the rule of law requires consistency in its treatment of unlawful conduct. Given these reasons, some considerations of morality should indeed be relevant in deciding whether to recognize intellectual-property rights. The boundaries for defining such considerations may be dictated by principles of speech law, which address government intervention in the creation and expression of ideas.

Prof. V.K. Unni, Indian Institute of Management Calcutta (India)

“Pharmaceutical Evergreening and ‘Enhanced Efficacy’ Under Indian Patent Law: Exploring the Scope for a Broader Interpretation”

Although pharmaceutical companies have tried to extend their monopoly through the practice of evergreening, this has led to a robust regulatory response in many countries including India. This paper explores whether the *Novartis* decision of the Indian Supreme Court, which instructs patent offices to follow a narrow interpretation of Section 3(d) of the Patents Act, is good for India in the long run. When Section 3(d) is given a narrow interpretation, it is eliminating potential improvements which can happen to a drug. These improvements can happen in many ways that can greatly augment the therapeutic efficacy of a medicine, such as increased shelf-life, increased heat stability and increased lipid solubility. A broader interpretation given to Section 3(d) might help some of the new Indian companies which are focused on the development of new molecules to safeguard their inventions.

Dr. Wang Runhua, Intellectual Property Fellow, Chicago-Kent College of Law

“New Private Law? Intellectual Property ‘Common-Law Precedents’ in China”

China has established a dynamic legal system by using guiding cases to improve adjudicative consistency. The guiding cases are de facto binding as “common-law precedents” and the only binding cases in China. The Supreme People’s Court (SPC) selects, compiles, and publishes guiding cases. In China’s dynamic legal system, the U.S. notably influences the intellectual property (IP) legal mechanism and the legal rationales for adjudicating IP disputes. Some amendments to the IP statutes of China are in response to actions and criticisms by developed countries, especially the U.S. The IP guiding cases reflect the voluntary development of the IP regime and the enforcement of the IP statutes in China. In the U.S., IP laws are mainly considered as private law, but they do involve some public law characteristics, as shown by the intervention of legislators and the development of statutory interpretation by the courts. These public law characteristics do not transform IP laws into public law, but they evoke the concept of New Private Law in modern IP laws.

This study reviews all twenty-two IP guiding cases (i.e., patent, copyright, trademark, anti-unfair competition, anti-monopoly) in China and compares them with corresponding judicial precedents in the U.S. I argue that Chinese IP guiding cases are not conventional private or public law, but instead can be explained under the theories of New Private Law. The IP guiding cases follow public policies to be part of governance and, as a result, show their influence on policymakers and legislators. Consistent with the concerns of U.S. IP holders, these guiding cases show that Chinese courts are instructed to be conservative in awarding both damages and injunctions. The courts function as a gatekeeper and consider IP quality to prevent over-rewarding IP holders either through the judicial system itself or the market when government agencies liberally or incautiously granted the IP rights. For trademark and unfair competition cases, the courts are instructed to give public apologies for substituting economic damages to IP holders. Moreover, the IP guiding cases suggest that the SPC and Chinese judges are inclined towards a utilitarian and realistic/pragmatic judicial philosophy rather than a formalistic approach in their statutory interpretation.