



2016 Texas A&M Intellectual Property Scholars Roundtable

FINAL PROGRAM

FRIDAY, OCTOBER 7, 2016

8:30 **Breakfast**

9:00 **Welcoming Remarks**

Dean Andrew P. Morriss, Anthony G. Buzbee Dean's Endowed Chair, Texas A&M University School of Law

Prof. Peter K. Yu, Co-Director, Center for Law and Intellectual Property, Texas A&M University School of Law

9:15 **Panel 1: Rethinking Intellectual Property Law**

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

Presenters: Prof. Glynn S. Lunney, Jr., Texas A&M University School of Law
"Copyright's Excess"

Prof. Eric E. Johnson, University of North Dakota School of Law
"Intellectual Property and Growth Economics"

Prof. Liam S. O'Melinn, Pettit College of Law, Ohio Northern University
"The Quasi-Constitutional Basis of the Intellectual Property Servitude"

11:00 **Coffee Break**

11:15 **Panel 2: International Intellectual Property Law**

Moderator: Prof. Doris E. Long, John Marshall Law School

Presenters: Dilan Thampapillai, Australian National University College of Law (Australia)
"Why Australia May Lose the Plain Packaging Debate in the WTO"

Prof. Srividhya Ragavan, Texas A&M University School of Law
"Trade, Intellectual Property and Compulsory Licenses"

Prof. Peter K. Yu, Texas A&M University School of Law
“The RCEP and Trans-Pacific Intellectual Property Norms”

1:00 Lunch

2:00 Panel 3: Patent Law

Moderator: Prof. H. Dennis Kelly, Texas A&M University School of Law

Presenters: Prof. Stefania Fusco, Notre Dame Law School
“The Customary and Statutory Patent Systems in the Venetian Republic Between the 15th and 18th Centuries” (with Ted Sichelman and Toni Veneri)

Prof. Joshua Sarnoff, DePaul University College of Law
“Reasonable Certainty?”

Prof. Saurabh Vishnubhakat, Texas A&M University School of Law
“Patent Error Correction: A Longitudinal Approach”

3:45 Coffee Break

4:00 Panel 4: Copyright Law

Moderator: Prof. Connie D. Nichols, Baylor Law School

Presenters: Prof. Oren Bracha, University of Texas School of Law
“Not De Minimis: Substantial Similarity in Music Copyright and Beyond”

Prof. Shubha Ghosh, Syracuse University College of Law
“Remapping Copyright Functionality: The Quixotic Search for a Unified Test for Severability for PGS Works”

Prof. Hannah Yee Fen Lim, Nanyang Business School (Singapore)
“The Problems of a Text and Data Mining Exception to Copyright Infringement”

Timothy J. McFarlin, Elon University School of Law
“Authorship and Audience Appeal”

6:00 Roundtable Adjourns for the Day

7:00 Dinner for Roundtable Participants

H3 Ranch
109 E. Exchange Ave, Fort Worth, TX 76164

SATURDAY, OCTOBER 8, 2016

9:00 Breakfast

9:30 Panel 5: Rethinking Intellectual Property and Cyberlaw

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

Presenters: Dr. Henry Biggs, Washington University School of Law
“Fan Friction: When Intrinsic and Extrinsic Motivators Collide”

Prof. Thomas C. Folsom, Regent University School of Law
“Intellectual [Anti-]Property Exceptionalism”

Prof. H. Brian Holland, Texas A&M University School of Law
“We Are All Cyborgs Now: A Cognitive Theory of the Third-Party Doctrine”

Prof. Betsy Rosenblatt, Whittier Law School
“Uncertainty Aversion and Intellectual Property”

11:15 Coffee Break

11:30 Panel 6: Patent Law and New Technology

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

Presenters: Prof. Sarah Burstein, University of Oklahoma College of Law
“The ‘Article of Manufacture’ in 1887”

Tabrez Y. Ebrahim, Esq., Bracewell LLP
“3D Bioprinting Patentable Subject Matter Boundaries”

Prof. Greg Reilly, IIT Chicago Kent College of Law
“Decoupling Patent Law”

1:00 Lunch

2:00 Panel 7: Intellectual Property and Scientific Research

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

Presenters: Prof. Emily Michiko Morris, University of Maine School of Law
“A Unified Theory of Pharmaceutical Regulatory Exclusivities”

Prof. Karen E. Sandrik, Willamette University College of Law
“Restitutionary Remedies for R&D Collaborative Agreements”

Prof. Jacob S. Sherkow, New York Law School
“Cancer’s IP”

3:45

Closing Remarks

Prof. Peter K. Yu, Co-Director, Center for Law and Intellectual Property, Texas A&M University School of Law

6:15

Roundtable Adjourns for the Day

7:00

Dinner for Roundtable Participants

Del Frisco's Grille
154 E. 3rd St, Fort Worth, TX 76102

ABSTRACTS

Dr. Henry Biggs, Washington University School of Law

“Fan Friction: When Intrinsic and Extrinsic Motivators Collide”

Our understanding of what incentivizes creativity has evolved considerably in the past few decades. Where once cash was king as motivator, new research—and new opportunities for creativity—have shown that other motivators can play a significant role as well. Fan Fiction, or Fic, an area where the prospect of financial gain is remote, has stood as something of a beacon to this non-monetary revolution. However, this style of writing rather ironically has as its foundation heavily *extrinsically* rewarded works—and the authors of those original works have not always been happy about being borrowed from. Researchers have looked to psychology for a better understanding of the creative motivating landscape generally, but it would seem that the collisions and adverse reactions themselves are motivated more from a varied sense of fairness than anything else.

Prof. Oren Bracha, University of Texas School of Law

“Not De Minimis: Substantial Similarity in Music Copyright and Beyond”

The requirement of improper appropriation as a precondition for copyright infringement has been under attack recently. The most notorious example is the Sixth Circuit’s ruling in *Bridgeport Music v. Dimension Films* that the requirement does not apply to infringement of copyright in sound recordings. This summer in *VMG Salsoul, LLC v. Ciccone* the Ninth Circuit rejected this rule and explicitly created a circuit split. But a close look at this most recent decision reveals it to be a Pyrrhic victory. While insisting that the improper appropriation requirement equally applies across the law of copyright, it adopts and risks perpetuating an extremely frail version of this requirement. And unlike *Bridgeport’s* rule, this diluted reading is relevant for the entire realm of copyright. Sliding down the slippery slope created by earlier cases, the Ninth Circuit described improper appropriation as a de minimis exception to copyright infringement and strictly limited this “exception” to cases where the original, as used in the user’s work, would not be recognized at all by an ordinary member of the audience. In effect this rule says: “Get a license or never copy anything recognizable!” The paper explores the function of the improper appropriation requirement by analyzing its origin and underlying policy. It explains why the doubly narrow reading of the doctrine as a de minimis exception based on unrecognizability is inadequate for carrying out this function. The de minimis version of improper appropriation is based on a fundamental misunderstanding of the role played by this doctrine as a central copyright policy lever and of the way that cultural creativity works. The paper argues that to properly carry out its function of ensuring a lively, dynamic and just cultural sphere, there is a need for a much more robust improper appropriation doctrine than the de minimis version. It also explains why a strong improper appropriation limitation on copyright’s scope is not redundant in light of the fair use doctrine.

Prof. Sarah Burstein, University of Oklahoma College of Law

“The ‘Article of Manufacture’ in 1887”

Section 289 of the Patent Act provides that a person who, “without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than \$250” In two recent cases, the Federal Circuit held that this provision requires a court to award a successful design patent owner the total profit from the entire infringing product—even when the design patent claims only a small, immaterial, or otherwise unimportant fragment of that product’s design. This rule makes no sense and, if left in place, will invite abuse, chill competition, and hinder future design innovation. Defenders of this interpretation insist, however, that it is compelled by the plain meaning of the statute or that it is what

Congress intended when it passed the predecessor to § 289 in 1887. These arguments overlook the fact that, in 1887, “article of manufacture” was a term of art that did not mean “product” or “any item that is made by human labor.” Historical evidence examined in this Article undercuts the Federal Circuit’s “plain meaning” interpretation of § 289 and suggests that Congress did not intend the result created by the Federal Circuit’s interpretation—i.e., the massive overcompensation of the owners of design patents for partial designs. This Article does not argue that courts must adopt the original meaning of “article of manufacture.” But it does argue that courts should take this historical evidence into account in evaluating arguments about the statute’s “plain meaning” or about the original congressional intent.

Tabrez Y. Ebrahim, Esq., Bracewell LLP
“3D Bioprinting Patentable Subject Matter Boundaries”

3D bioprinting combines emerging 3D printing technologies with synthetic biology. The promise of 3D bioprinting technology is to fabricate organs for transplantation, treat burn victims with *in vivo* skin repair, and create wearable microbiomes. 3D bioprinting can successively build, repair, or reproduce living human cells. This capability challenges eligible subject matter doctrine in U.S. patent law because it has no bright line standard for patent eligibility for nature-based products. As 3D bioprinting technologies mature, patent law will need to respond to situations where living and non-living worlds merge. This Article proposes a “Mixed-Scanned-Transformed” standard to supplement patent law’s “markedly different characteristics” examination of nature-based products. The markedly different standard arose from the *Chakrabarty* case in 1980 and is most recently informed by the *Myriad* case in 2013, but neither case involved merging living and non-living worlds. By applying this newly proposed standard, 3D bioprinted materials and potentially 3D bioprinting Computer-Aided Design files would likely be upheld as patentable subject matter. The proposed “Mixed-Scanned-Transformed” standard will allow patent law to become more bright-line towards 3D bioprinting inventions.

Prof. Thomas C. Folsom, Regent University School of Law
“Intellectual [Anti-]Property Exceptionalism”

The question has been asked: “Is intellectual property law exceptional, and if so why?”

The question has not only been asked but answered: “yes,” “no,” or “it depends.” Those who claim exceptionalism posit any number of reasons.

I will suggest a different and more fundamental reason, but first I will reframe the question by rejecting the premise. While “intellectual property” is a very nice name, a self-serving name, and a lovely turn of the phrase, it has one major drawback. It is misdescriptive and deceptively so. What we call “intellectual property” is actually an anti-property regime.

A first step is to justify my claim that patent and copyright (the two paradigmatically “property” fields) are not private property, but anti-property. Our statutory patent and copyright both have at least one and maybe two of the three characteristics of private property: a right of alienability and a right to exclude. But they lack the third: an unlimited temporal dimension. The failure of the third is more fundamental than often noticed.

A second step is to assert that pro-private property is the ordinary, non-exceptional state of our law. This follows if we grant the twin truisms that (i) private property is said to be either a guarantor of liberty or a coefficient of a free market economy and (ii) the United States is characterized as having embraced a free market economy with laws to match.

The third step is to apply the consequent to patent and copyright law—if pro-property is ordinary, then anti-property is extraordinary, exceptional. Because patent and copyright law is at least to some degree anti-property, then intellectual property law is, to that degree, exceptional.

If so-called intellectual property law is fairly characterized, instead, as anti-property law, it is exceptional at its very core. From this perspective, it is possible to draw some interesting and perhaps useful suggestions for making better sense of some of the routinely recurring contradictions in the laws of patent and copyright.

Prof. Stefania Fusco, Notre Dame Law School

“The Customary and Statutory Patent Systems in the Venetian Republic Between the 15th and 18th Centuries” (with Ted Sichelman and Toni Veneri)

In 1474, the Venetian Republic enacted what is widely recognized as being the world’s first Patent Act. Legal scholars have generally assumed that, subsequently, patents were exclusively granted in Venice based on the requirements set forth in this Act. This is because they relied on the writings of historians and political scientists who had no legal training and, therefore, overlooked many of the legal nuances of the Venetian patent protection. In fact, until now, only two other legal scholars have examined the *original* Venetian patents. In this Article, we use the original documents from the Venetian State Archives to demonstrate that, following the enactment of the 1474 Act, the Venetian Senate continued to grant patents based on customary law. Consequently, *two* forms of patent protection were present concurrently in Venice between the 15th and the 18th centuries—one customary and one statutory. An accurate description of these two parallel patent systems is essential to fully understand the extent of the world’s first form of patent protection and its remarkable impact on modern patent systems.

Prof. Shubha Ghosh, Syracuse University College of Law

“Remapping Copyright Functionality: The Quixotic Search for a Unified Test for Severability for PGS Works”

Intellectual property protection of design has been a vexing problem, perhaps more so in the United States than in Europe. Debates in the United States over design protection, whether conducted in the legislature or the courts, have centered on creating incentives for vexatious litigation among competitors and the adequacy of existing copyright, trademark, and patent laws in protecting the economic interests of designers. As the United States has not adopted a *sui generis* statute to protect designs, the debate continues within trademark, patent, and copyright laws as to the scope of protection for purely ornamental features of a work. This Article focuses on the debate within copyright, made particularly salient by the United States Supreme Court’s decision to review *Star Athletica v. Varsity Brands* in the 2016–2017 term.

At issue in the *Star Athletica* case is the copyrightability of pictorial, graphic, or sculptural (PGS) works that constitute a “useful article.” While cheerleader uniforms are the subject of the dispute between Varsity Brands and Star Athletic, jewelry, belt buckles, mannequins, decorative lamps, and other tchotchkes are other examples of useful articles. Also included are maps and charts, the specific focus of this Article. These various types of works are accorded special treatment under the United States Copyright Act because they are a hybrid of functional and aesthetic works. Copyright law protects only aesthetic features of work, leaving coverage of functional features to patent law, trade secret law, or the public domain.

The question confronting the Court in *Star Athletica* is identifying the proper legal test for separating functional from aesthetic features of a work so that copyright law protects only the latter and not the former. This Article explores the dilemmas confronting the Court in identifying the appropriate test for

separability. The United States Court of Appeals for the Sixth Circuit, the intermediate appeals court whose decision in *Star Athletica* the Supreme Court is reviewing, identified nine distinct tests adopted by the intermediate appellate courts to separate copyrightable aesthetics from noncopyrightable function in a given work. The Sixth Circuit also announced its own hybrid test. These tests are the product of nearly forty years of jurisprudence, at least since the current Copyright Act of 1976. It is difficult to imagine how the Court will identify the one correct test from all these options. Most likely, it will distill some general principles to help guide the lower courts in reviewing cases, drawing on its foundational decision in *Mazer v. Stein*. Perhaps these principles will evolve into some clear rules and applicable standards. Most likely, litigation will continue and jurisprudence on separability will continue to proliferate.

The case of maps and charts, although seemingly far removed from cheerleader outfits, fashion design, and accessorizing, provides a window into the dilemma of creating a coherent doctrine of copyright functionality. This Article casts attention on maps and charts, in part, because they comprised, along with books, the original subject matter of copyright in the first United States statute enacted in 1790. But there are two salient reasons for considering the subject matter of maps (use collectively from hereon to include charts) in greater detail.

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

“We Are All Cyborgs Now: A Cognitive Theory of the Third-Party Doctrine”

The Fourth Amendment’s third-party doctrine provides that “a person has no legitimate expectation of privacy in information he voluntarily turns over to third parties.” But this virtually *per se* rule, born of another era, can no longer be justified in the information age. Applied in an environment in which pervasive personal data is distributed by third-party intermediaries and stored by third-party custodians, the current rule significantly undermines traditional conceptions and reasonable expectations of privacy. On this much, the many critics of the third-party doctrine agree. It has proven difficult, however, to articulate a limiting principle that both fits comfortably within existing privacy doctrine and is workable in practice.

This article constructs what I refer to as a “cognitive” theory of the third-party doctrine, from which limiting principles and workable rules are derived. Pulling from literature on cognitive augmentation and hybridization, particularly as applied to memory systems, I argue for a broader conception of the “person” protected by the Fourth Amendment—a conception in which automated, third-party communications and storage systems are recognized as part of the functionally integrated individual. It is an approach that draws structure and support from traditional protections of bodily integrity, as well as papers and places, but adapted to more accurately effectuate society’s privacy expectations. It is also in harmony with many of the more recent proposals for limiting the third-party doctrine; *e.g.*, interpersonal privacy (Bedi), the human observer-automation distinction (Tokson), and technosocial continuity (Strandburg). Finally, I suggest that leveraging traditional privacy concepts makes it possible to incorporate and apply cognitive theory principles within the existing privacy framework.

Prof. Eric E. Johnson, University of North Dakota School of Law

“Intellectual Property and Growth Economics”

The traditional economic account of copyrights and patents is that external incentives are needed to incentivize innovation and thus overcome the public goods problem. A critical line of scholarship accepts the incentive theory as a generally correct but focuses on drawbacks, arguing that social welfare losses may offset intellectual property’s welfare gains. A deeper criticism has emerged more recently, arguing that advances in behavioral economics, psychology, and business management studies show the incentive theory to be incorrect as a general matter, since natural and intrinsic motivations will propel innovation in the absence of intellectual property law.

Now comes a challenge to all three theoretical tacks—the traditional incentive theory, its drawbacks critique, and its claimed general debunking: Economist and legal scholar Robert Cooter argues for the transcendent importance of economic growth through the lens of what he calls the “overtaking principle.” He argues that where economic growth can cause rapid, exponential increases in welfare, wealth inequalities and static inefficiencies are unimportant and can be ignored. In essence, Cooter argues for a re-framing of questions about innovation-affecting law in terms of dynamic inefficiency rather than static inefficiency.

If accepted, Cooter’s argument radically lowers the bar the incentive theory and could be understood to imply that intellectual property laws are justified even if they offer only weak or uncertain prospects of incentivizing innovation. This paper thus re-evaluates the case for patents, copyrights, and other public-goods-incentivizing forms of intellectual property in light of Cooter’s arguments.

Prof. Hannah Yee Fen Lim, Nanyang Business School (Singapore)

“The Problems of a Text and Data Mining Exception to Copyright Infringement”

The Singapore government released a Copyright Reform Public Consultation in late August 2016. One of the suggested amendments is to create a new exception that allows the copying of copyrighted works for the purposes of data analytics, i.e. text and data mining. The proposed exception is conditional on the user of the work having legitimate access to the work in the first place, such as a subscription to an academic journal, or collating online articles which are not locked behind a pay-wall. The exception would not differentiate between commercial or non-commercial activities. The exception only allows the final analysis to be commercialised, not the actual copies of the original works. This paper will argue that such a proposed amendment raises serious conceptual and contextual problems, not only within copyright law but also in the realm of personal data protection law principles.

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

“Copyright’s Excess”

For most of its three hundred years, copyright has focused on encouraging the creation of new works. Over that time, a simple intuition has justified ever broader copyright protection: More copyright means more revenue; more revenue means more original works. This is the fundamental premise on which copyright was founded. It is the fundamental premise on which copyright has been built.

Copyright’s Excess uses the experience of the popular music industry over the last fifty years to test copyright’s fundamental premise. According to the Recording Industry Association of America, sales of recorded music in the United States increased from \$4 billion (in constant 2013 dollars) in 1961 to over \$20 billion in 1999 before declining to under \$7 billion in 2013. This sharp rise and fall provides a unique natural experiment against which we can test copyright’s fundamental premise. If copyright’s fundamental premise is true, then music output, both in terms of quantity and quality, should, all else equal, have risen steadily from the 1960s until the end of the 1990s, and then should have begun a steady fall.

Yet, when we look at various measures of the quantity and quality of new music released in the United States, we find that the exact opposite has been true. For the popular music industry, more and better songs were released during low revenue periods than during high revenue periods. Rather than support copyright’s fundamental premise, the empirical evidence finds the exact opposite relationship for popular music: more revenue led to fewer and lower quality hit songs.

In *Copyright’s Excess*, I explore possible explanations for this startling but undeniable result. Although a number of possibilities may contribute to the observed patterns, this forthcoming book suggests that the

primary factor is that copyright, as presently structured, is fundamentally ill-conceived. It does very little to increase the return for, and thus ensure the production of, additional works at the margins. Instead, it tends to maximize the returns for the most popular works, enabling our most popular artists to capture rents far in excess of their reservation price. The incentives copyright provides are thus fundamentally misdirected.

Timothy J. McFarlin, Elon University School of Law
“Authorship and Audience Appeal”

When at the dawn of the millennium the Ninth Circuit Court of Appeals informed us that audience appeal should help determine the authorship of a copyrighted work, a radical idea slipped silently into American copyright. Looking to a work’s audience to determine who authored it has no real precedent in the law. The court, in the case that announced the arrival of this concept, *Aalmuhammed v. Lee*, found it only in a more than half-century-old opinion by Judge Learned Hand, in which he seemingly divined it from the ether.

The Ninth Circuit, moreover, offered no guidance on how to examine audience appeal in future cases, nor have the courts in the fifteen years since *Lee* been able to effectively do so. Left to guess at what *Lee* really meant by “audience appeal,” courts attempting to apply it as a factor in authorship disputes have struggled mightily in the vacuum *Lee* left behind. Legal scholars, too, have thus far devoted scant attention to audience appeal in authorship. Despite this judicial confusion and dearth of commentary, the concept’s implications and potential impact on copyright are far-reaching.

In one sense, using audience appeal to judge authorship turns traditional notions of creativity on their head. Society has long lionized the identity and autonomy of the author, the person whose inspired spark of originality makes a creative work copyrightable. By judging authorship only after examining its effect on the audience, we risk stripping authors of this identity and autonomy.

But in another sense, audience appeal probes a deeper question that copyright has often missed—is a work with no audience worth protecting?—and so, by analyzing its merits, we can better understand what our society hopes to accomplish with copyright.

In this way, audience appeal, largely lying dormant since its introduction in 2000, could indeed be authorship’s sleeping giant.

Prof. Emily Michiko Morris, University of Maine School of Law
“A Unified Theory of Pharmaceutical Regulatory Exclusivities”

The pharmaceutical industry is exceptional for a number of reasons. Pharmaceutical development is one of the most cost- and time-intensive areas of technology largely because it is one of the industries most subject to regulatory intervention. Indeed, the Food and Drug Administration (FDA) regulates the manufacture and marketing of pharmaceuticals more strictly than it regulates food, dietary supplements, or cosmetics. Because of these immense regulatory burdens, moreover, the pharmaceutical industry is also subject to intellectual property provisions as well as a growing list of non-patent regulatory exclusivities that apply to almost no other technology. Between regulatory burdens, intellectual property provisions, and regulatory exclusivities, innovation in the pharmaceutical industry has become incredibly complex, both from the viewpoint of the industry itself and the government that regulates it.

That being said, the use of regulatory exclusivities is growing apace with surprisingly little structured analysis, particularly across different types of regulatory exclusivities. For most of history, patents have been widely regarded as a highly effective means of incentivizing the large investments necessary for

creating and testing new drugs. In the last three decades, however, drugs in several different categories have become eligible for at least seven different types of regulatory exclusivities. These exclusivities come in a wide variety of shapes and sizes, but very little attention has been paid, at either the legislative or even academic level, to exactly why regulatory exclusivities differ and what the effects of those differences might be. Nor has there been much analysis of what roles these exclusivities might play that are not already being performed by patents or other intellectual property protections and how the two systems interact with one another.

A better understanding of exactly what these regulatory exclusivities are, how they function, and how they differ from one another and from patents has become particularly pertinent as the number of regulatory exclusivities grows. This Article therefore takes a close look at these exclusivities by dividing their various provisions into operational groups, or modules, based on their putative function. The analysis then looks at what functions the provisions in these modules actually perform well, as well as those functions that these provisions do not perform. The analysis also examines whether these modules complement or conflict with patent and other intellectual property schemes. Using these modules then to reconstruct the various regulatory exclusivities, the analysis considers whether these exclusivities are likely to achieve the objectives they were designed to serve and how the exclusivities might be modified better to perform these functions.

Prof. Liam S. O'Melinn, Pettit College of Law, Ohio Northern University
“The Quasi-Constitutional Basis of the Intellectual Property Servitude”

This paper continues my work on what I have termed the “intellectual property servitude” by examining the basis of rationales expressed in recent Supreme Court decisions. The Court has moved generally (although not uniformly) in the direction of more expansive rights for the holders of patent, trademark, and copyright, but has not always clearly expressed its grounds of decision. There appears to be a quasi-constitutional basis for at least some of the decisions, leading me to wonder whether the Court’s intellectual property jurisprudence actually has a quasi-constitutional basis—that is to say, whether this tendency toward silent constitutional adjudication is consistent enough to be express a constitutional ideology. Decisions that the Court claims to involve merely statutory interpretation clearly operate on the basis of principles outside the text of the relevant statute, but what is that basis? My hypothesis is that there is something more fundamental at work, something which if expressed clearly would be considered constitutional. Because it is expressed only tacitly I call it “quasiconstitutional.” An example, and the case that really started me thinking this way, is the famous *Sony* case. The decision purports to involve only statutory interpretation, but seems to be to make more sense considered as the functional equivalent of First Amendment overbreadth jurisprudence. More recent cases show a similar indeterminacy that shows itself in several ways. First, cases that are ostensibly precedential fail to offer clear enough guidance for parties, attorneys, and judges alike, as the Court’s ongoing battle with the Federal Circuit shows. Second, cases involving extremely controversial issues are sometimes decided by a strangely unanimous Court, raising the suspicion that the controversial issues themselves have been avoided. Third, some decisions involve a false unanimity, in which opinions that read like dissents are presented as concurrences. Is there an unexpressed (or very quietly expressed) set of constitutional principles that would unite and explain the indeterminacy? This paper will attempt to answer that question.

Prof. Srividhya Ragavan, Texas A&M University School of Law
“Trade, Intellectual Property and Compulsory Licenses”

Compulsory licensing of patents has been a product of much negotiations under the auspices of the trade regime both at the Uruguay round and thereafter. The negotiations have resulted in developing countries gaining the right to use such licenses to ensure access to medication especially when required to preserve public health. Yet, the use of such licenses in the recent past by India and Colombia have proved to be

controversial. The paper will address some of the raised questions about the limits of the negotiated rights, courses of action rightfully available for other countries to act and the limits of available unilateral versus multilateral dispute settlement actions.

Prof. Greg Reilly, IIT Chicago Kent College of Law
“Decoupling Patent Law”

Patent law is applied in two distinct contexts: the Patent Office in determining an applicant’s entitlement to a patent and the courts in enforcing patent rights. These two contexts differ significantly in their functions, timing, structure, procedures, and decision makers. Despite these differences, identical patent law standards are generally applied in identical ways. This norm of coupled patent law is presumed, with little exploration of its theoretical justifications or whether and why the occasional departures that do occur are warranted. Yet, problems arising from the norm of coupled patent law may underlie current disagreement among Congress, the Supreme Court, the Federal Circuit, and commentators about the optimal design of patent law. Simply put, it may be impossible to develop a single, optimal set of standards to be applied uniformly in the very different contexts of patent acquisition in the Patent Office and patent enforcement in the courts.

This Article makes three contributions. First, it offers a descriptive account of the norm of coupled patent law and explores the limited departures that have occurred. Second, the Article provides the missing normative analysis of coupled patent law. Because of the significant differences between Patent Office and court proceedings, optimal implementation of patent law may, to some extent, require different legal standards (“decoupled patent law”) that properly account for the different functions, timing, structure, procedures, and decision makers in each context. Third, the Article provides an initial framework for implementing decoupled patent law, addressing statutory and practical concerns, as well as the difficult question of application of decoupled patent law in hybrid acquisition-enforcement procedures like post-issuance proceedings in the Patent Office. The Article concludes with examples of what decoupled patent law might look like in two key areas: obviousness and claim construction.

Prof. Betsy Rosenblatt, Whittier Law School
“Uncertainty Aversion and Intellectual Property”

Uncertainty aversion is the tendency to avoid situations in which the likelihood of success or failure is unknown. Uncertainty aversion is a widespread and dependable phenomenon that most people experience. It is distinct from risk aversion, and yet unlike risk aversion, few scholars have explored the impact of uncertainty aversion on decision-making in intellectual property fields, despite the fact that legal outcomes in several frameworks of intellectual property legal analysis, such as patent claim construction, trademark likelihood of confusion, and copyright fair use, create notoriously uncertain outcomes. This project will draw upon social science research regarding uncertainty aversion to explore how uncertainty aversion influences intellectual property decision-making and legal outcomes.

Prof. Karen E. Sandrik, Willamette University College of Law
“Restitutionary Remedies for R&D Collaborative Agreements”

Recent literature on contracting for innovation argues that parties in various science and technology sectors are “braiding” their contracts with formal and informal mechanisms to more effectively and cooperatively respond to uncertainty. The literature then opines that these braided contracts are correctly being enforced by the use of low-powered sanctions, and in particular, reliance damages. This Article agrees that parties are using braided contracts in part to help respond to exogenous shocks that are common in research and development (R&D) collaborations, yet it disagrees that these agreements are enforced through low-powered sanctions that protect “contractual ‘preliminaries.’” Instead, this Article

argues that adjudicators are turning to the law of restitution in determining the best remedial options of the disputed agreements. Further, this Article argues that the law of restitution and of unjust enrichment is well suited to the task and especially so in light of the prominence of intellectual property concerns in these often pre-patent R&D collaborative agreements.

Prof. Joshua Sarnoff, DePaul University College of Law
“Reasonable Certainty?”

Since the Supreme Court’s *Nautilus* decision, the Federal Circuit has embarked on resurrecting its earlier indefiniteness precedents within the parameters of the new “reasonable certainty” standard. We need something more. What would make claim interpretation reasonably certain? This paper is an initial effort that looks to linguistic theory, set theory, and interpretation theory to begin to attempt an answer.

Prof. Jacob S. Sherkow, New York Law School
“Cancer’s IP”

Recent efforts to cure cancer—in particular, the President’s 2016 announcement of a “Cancer Moonshot”—have focused on employing public-private partnerships, joint ventures between private industry and public agencies. Yet, the goal of public-private partnerships like the Cancer Moonshot centers on the production of public goods: scientific information. Using private incentives in this context presents numerous puzzles for both intellectual property law and information policy. This Article examines whether—and to what extent—intellectual property and information policy can be tailored to achieve the Cancer Moonshot’s goals. It shows that the success of the Cancer Moonshot, and other similar public-private partnerships, turn on data-sharing—the production, disclosure, and ultimate use of data. The Article also provides several concrete solutions for appropriately employing patents, trade secrets, and regulatory exclusivities to encourage different facets of data-sharing. Lastly, the Article concludes by using the Cancer Moonshot to draw broader lessons about public-private partnerships, generally, including considerations of data privacy, scientific reproducibility, and transaction costs.

Dilan Thampapillai, Australian National University College of Law (Australia)
“Why Australia May Lose the Plain Packaging Debate in the WTO”

Australia has introduced laws on the plain packaging of tobacco (PPL). These laws restrict the use and display of the trademarks of tobacco companies. At present there is a dispute before the World Trade Organization’s Dispute Settlement System as to whether these laws comply with the rules contained in the TRIPS Agreement.

On a legal level, the question is whether the PPL is consistent with Articles 17, 20 and 15(4) of the TRIPS Agreement and Article 6 *quinquies* of the Paris Convention. Article 6 *quinquies* of the Paris Convention is incorporated into the TRIPS Agreement by virtue of Article 2(1). Similarly, Article 8(1) of TRIPS allows for measures necessary to protect public health.

The crucial issue in the context of Article 17 is whether the TRIPS Agreement confers only a negative right on trademark owners. That is, whether TRIPS offers trademark holders only the ability to restrain third parties from using their trademarks. This power is clearly not inhibited by the PPL. However, the PPL does limit the ability of rights-holders to use their marks in the course of trade. It is unclear as to whether the positive and negative rights must exist concurrently. Certainly, there is a textual reference in Article 20 to “the use of a trade mark in the course of trade”. Moreover, there is an argument that the positive right to use a mark is one of the fundamental assumptions underpinning the TRIPS Agreement as the whole point of setting up a system of registration was to allow rights-holders to use the mark in trade

free from interference by third parties. In this sense, the positive and negative aspects of trademarks rights seem rather inseparable.

If registration and use must operate concurrently then the limits imposed on denials of registration under Article 6 *quinquies* of the Paris Convention must be considered on the basis that those limits might also apply to measures that constrain the use of a mark. In this regard PPL measures fall clearly outside of the parameters of Article 6 *quinquies* and as such do seem to be impermissible.

Finally, there is an argument that the PPL measures promote public health and that as such are defensible under Article 8(1) of the TRIPS Agreement. However, Article 8(1) imposes a requirement of necessity which should not be confused with the general effectiveness of the measure.

On a normative level, the PPL measures raise the uncomfortable prospect of state intervention to regulate lifestyle choices. While tobacco may be injurious to human health, as are many other products such as sugar and alcohol, it is a lawful product. Measures that interfere with longstanding commercial rights so as to reduce consumption represent a moral choice about behavior. The question that must then be addressed is why PPL measures are appropriate in relation to tobacco, but not in relation to sugar-based products, alcohol or gambling?

Prof. Saurabh Vishnubhakat, Texas A&M University School of Law
“Patent Error Correction: A Longitudinal Approach”

In the five years since the America Invents Act was signed into law, the USPTO Patent Trial and Appeal Board has been an important fixture in patent error correction, attracting significant empirical investigation into its processes and effects. Beyond descriptive statistics of petition filings, technology-specific trends, and rates of institution and invalidation, the latest research has also begun to shed important light on important institutional features of PTAB practice, such as the strategic use by litigants of administrative review as a substitute for litigation in the federal courts, as a complement to impending litigation, and even as a preemptive strike against potential plaintiffs. Forthcoming research gives specific attention to joinder and serial petitioning in the PTAB and whether these practices represent socially useful collective action or constitute a form of harassment. These studies explore patent error correction as between competing forums for resolving the validity of issued patents. The present project offers a longitudinal view of error correction by comparing the fate of patents in the PTAB both to the origins of those same patents in USPTO examination and, more broadly, to the origins of similar patents that have not (yet) been subjected to *ex post* reevaluation in the PTAB.

Prof. Peter K. Yu, Texas A&M University School of Law
“The RCEP and Trans-Pacific Intellectual Property Norms”

This Article discusses the Regional Comprehensive Economic Partnership (RCEP), with a focus on intellectual property issues. The partnership is currently being negotiated among Australia, China, India, Japan, New Zealand, South Korea and the ten members of the Association of Southeast Asian Nations (ASEAN). This Article begins by briefly discussing the historical origins of the RCEP. It then examines the latest leaked draft of its intellectual property chapter. The Article concludes by examining three future scenarios concerning intellectual property norm-setting in the Asia-Pacific region as well as the intellectual property policy dilemma confronting the participating developing countries.