

**GRADUATE INSTITUTE OF INTELLECTUAL PROPERTY  
MBA PROGRAM  
COLLEGE OF COMMERCE  
NATIONAL CHENGCHI UNIVERSITY**

**INTELLECTUAL PROPERTY LAW**

**FALL 2009**

A. Basic Information

Instructor: Professor Jerry G. Fong  
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Class Hours: Tuesday, 14:00 - 17:00  
Office Hours: By appointment.

C. Administrative details: My office hours are available by advance appointment. My office is Room 260919, 9F in the building of College of Commerce. My e-mail is [jf8888@nccu.edu](mailto:jf8888@nccu.edu). You can also reach me via my research assistant, Tzu-Yuan Lin. He is available at 0921-304-193 or by his email [hsnu926alvis@hotmail.com](mailto:hsnu926alvis@hotmail.com)

C. Suggested Books and Reading Materials

- I. *Fong, Jerry G.* ∙ The Basic Legal Issues and Development Trend in Intellectual Property Law, Angel Publishing Co. (2003)
- II. *Fong, Jerry G.* ∙ Strategic Legal Planning for High Technology Industry, Angel Publishing Co. (2003)
- III. *Hiroiyuki Watanabe*, Intellectual Property as Securitized Assets (2004)
- IV. *F. Scott Kieff*, An Approach to Intellectual Property, Bankruptcy, and Corporate Control (June 2005)
- V. *Anna S. Nilsson, Henrik Friden, and Sylvia Schwaag Serger*, Commercialization of Life-Science Research at Universities in the United States, Japan and China (2006)
- VI. *John Wiley*, Making Innovation Pay People Who Turn IP Into Shareholder Value (March 2006)

- VII. *Kenan Patrick Jarboe & Roland Furrow, Intangible Asset Monetization – The Promise and The Reality* (April 2008)
- VIII. *Current and Emerging Intellectual Property Issues for Business – A Roadmap for Business and Policy Makers* (9<sup>th</sup> Edition, 2008)
- IX. *Intellectual Property in the New Technological Age* by Robert Merges, Peter Menell & Mark Lemley, revised 4th edition
- X. U.S. Supreme Court and Court of Appeal cases as indicated in the schedule of each class meeting
- XI. Gary P. Pisano, *Organizational Strategies and Business Models – Better Biotechnology*, Harvard Business Press, 2006
- XII. Additional materials, e.g. Harvard Case Study, may be assigned in class if necessary
- XIII. **Please note that item No. I on the list is required for every student.**

#### D. Course Objectives

Intellectual property (“IP”) law turns intangible information into a commodity that can be produced and exchanged in the market. Intellectual capital is the most valuable asset of many corporations and enterprises today and will play an important role behind future economic growth. Specifically, with the rapid development of technology and increasing diversity of financial commodities in the market in 21<sup>st</sup> century, the IP system is evolving not only to respond to the complexity of technology development, but also address how to get adequately financed by intellectual capital within the global network.

This course will give students a general understanding of pertinent issues in IP regimes today in the beginning through case study. Then I will introduce the new trend about how to use IP to enhance innovation and the financing of product development by allowing IP right-holders to put their property on the market for valuation and trading. Many of the issues discussed in this course will reflect the on-going development in the IP-related financial market.

#### E. Grading Policy

Your grade for this course will be based on you class participation (10%), assigned case brief (10%), final written assignment (40%) and final oral presentation (40%). Every student must decide the topic for your written assignment no later than December 1st. Your initial assignment must be handed in on your presentation date for my comment. For your final revised assignment, the due date is January 20th, and may NOT be accepted if they are late. Both of your initial assignment and final revised assignment MUST meet the

following format: **12 font, Single Space and Times New Roma**. All the citation or footnote must follow **The Bluebook (18<sup>th</sup> Edition)** standard. Any assignment not following the standard format will be returned without grading.

Your final oral presentation can be done individually, or joined together by two students as a group. You **MUST** use power point as the main device for the whole presentation. The final grade for some students will also be affected by class participation. Each student will be assigned to a panel, which shall all together do the case brief to facilitate classroom discussion each week. Students who are consistently unprepared or absent from their scheduled case brief presentation days will be penalized. Students who make consistently excellent presentations will be rewarded. The form of the reward or penalty is a change of your final grade by five points increment, for example, a reward raises a 80 to a 85. I expect to reward from 5 - 10% of the class, and I hope not to penalize anyone.

#### F. Others

- I. Every student must prepare an information card, including your contacts, picture, and basic background, and submit in the 2<sup>nd</sup> week
- II. A seminar on international licensing of IPRs will be held at NCCU this semester and will put the contents of week 16 subject to change
- III. Every student will be assigned to a panel and each panel must discuss beforehand and integrate their opinions to facilitate class discussion

## **CLASS SCHEDULE**

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No. Week	Subjects and Assignments
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### I. Week 1 **Intangible Assets and Intellectual Property Right**

- A. Basic Introduction
- B. Application of Intellectual Properties

### II. Week 2 **Trademark & Business (1)**

- A. Introduction
- B. Requirements of registering a trademark
- C. Issues in similar trademarks
- D. Dilution of trademarks

E. Assignment

1. Issues of registering a trademark: ***HTC case***
2. ***Moseley v. V Secret Catalogue, Inc.*** (likelihood of dilution, 2003); 96 年度智字第 94 號 (Heinz 商標淡化案)
3. Additional materials (optional): 施振榮：全球品牌大戰略，天下出版

III. Week 3 **Trademark & Business (2)**

A. Brand and trademark strategy in merger and acquisition (M&A)

B. Assignment

1. ***HBS-Lenovo case*** (need to purchase from NCCU's PERDO Office)

IV. Week 4 **Copyright & Business (1)**

A. Introduction

B. Requirements of copyrights: Originality and Expression

C. Infringement

D. Assignment

1. ***Altai v. Computer Associates*** (substantial similarity, 1992); 臺灣高等法院 90 年度上字第 1252 號民事判決(幾米向左走向又走判決)

V. Week 5 **Copyright & Business (2)**

A. Fair Use

B. Assignment

1. ***Feist Publications v. Rural Telephone Service*** (Fair use, 1991) 最高法院 94 年度台上字第 7127 號刑事判決與高等法院 94 年度重上更(四)字第 227 號刑事判決(新世紀英漢辭典著作權案)
2. 馮震宇：新世紀的挑戰-從新世紀英漢辭典案的著作權爭議談起、月旦法學雜誌 2007 年 1 月

VI. Week 6 **Patent & Business (1)**

A. Introduction

B. Requirements of patentability

C. Assignment

1. From Invention to Commercialization (IPFront)
2. ***QUANTA COMPUTER, INC. v. LG ELECTRONICS, INC.*** (Doctrine of exhaustion, 2008)

VII. Week 7 **Patent & Business (2)**

A. Business method patent

B. Assignment

1. **State Street Bank v. Signature Financial Group** (business method patent, 1998)
2. **In re Bilski** (business method patent, 2008)

VIII. Week 8 **Patent & Business (3)**

A. Patent strategy and commercialization

B. Assignment

1. *John Wiley*, Making Innovation Pay People Who Turn IP Into Shareholder Value (March 2006), Chapter 2: *Marshall Phelps* - Turning a Patent Portfolio into a Profit Center

IX. Week 9 **Students Presentation**

X. Week 10 **Trademark & Business**

A. Introduction

B. Assignment

1. United States of America v. Kai-Lo Hsu(美國政府控告永豐紙業盜取 Bristo-Myers-Squibb 營業祕密案, 1997); 96 年度勞訴字第 6 號(鴻海精密離職員工被訴案); Harvard case study : Cadence v. Avant!

XI. Week 11 **New International Trends and Issues of Intellectual Property Rights**

A. Introduction

B. Assignment

1. *John Wiley*, Making Innovation Pay People Who Turn IP Into Shareholder Value (March 2006), Chapter 5: *Peter Detkin* - Roadblocks, Toll Roads, and Bridges: Using a Patent Portfolio Wisely

XII. Week 12 **Enterprise Mergers and Acquisition and Intellectual Property Rights**

A. Introduction

B. Assignment

1. R. Russ O'Haver, The Relevance of IP Analysis in Technology-Driven M&A Transactions
2. 明碁併購的 IP 策略與相關問題

XIII. Week 13 **The Strategy of Enforcement and Litigation of IPRs**

A. Introduction

B. Injunction practices and strategy

C. Assignment: **eBay Inc. v. MercExchange, L.L.C.** (Patent Troll, 2006); 94 年度智

上字第 46 號 (凹凸科技案)

**XIV. Week 14 IPRs and International Trade: International Market and Protection of Commodity**

- A. Introduction
- B. Section 337 of the Tariff Act of the United States and the TRIPs Agreement
- C. Assignment
  - 1. **Philips v. Pinco**

**XV. Week 15 Internet, Digital Contents and IPRs**

- A. Introduction
- B. Assignment
  - 1. BitTorrent- Cyberspace Copyrights (need to purchase from NCCU's PERDO Office)

**XVI. Week 16 Create the value of IPRs: Commercialization of IPRs**

- A. Introduction
- B. Strategy and Practices
- C. Assignment
  - 1. Gary P. Pisano, Organizational Strategies and Business Models – Better Biotechnology, Harvard Business Press, 2006 (need to purchase from NCCU's PERDO Office)

**XVII. Week 17 Students Presentation**

**XVIII. Week 18 Students Presentation**

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**學習成效檢核表 ASSURANCE OF LEARNING CHECK LIST**

## ■期初設計課程版本 Before the Semester Begins

請各位教師根據課程規劃，勾選出適合的選項

本課程與商學院願景的關連性 Adherence to Mission	
■ Globalization 訓練國際化的能力	■ Technology 訓練科技與應用的能力
■ Innovation 訓練創新的能力	■ Humanity 訓練人文素養
本課程與本系所學程學習目標的關連性 Adherence to Program Learning Goals	
* To create and foster human resources on the research, planning, management, operation, and utilization of intellectual property at the senior level. * To disseminate knowledge and experiences on how to provide adequate and effective protection over intellectual property rights while balancing with the public good.	
本課程所運用到的教學方法 Pedagogical Methodologies	
■ Lecture	<input type="checkbox"/> e-Learning
■ Study Group	■ Seminar
■ Case Study	<input type="checkbox"/> Internship
■ Project	<input type="checkbox"/> Independent Learning
<input type="checkbox"/> Role-Playing	<input type="checkbox"/> Theater Learning
<input type="checkbox"/> Others: _____	<input type="checkbox"/> Others: _____
本課程教授的核心能力 Student Skills, Knowledge and Attitude Enhancement	
■ Theory	<input type="checkbox"/> Action Planning
■ Analytics	<input type="checkbox"/> Listening
<input type="checkbox"/> Descriptive	<input type="checkbox"/> Persuading
■ Technical	■ Teamwork
<input type="checkbox"/> Decision-making	<input type="checkbox"/> World-view
<input type="checkbox"/> Others 其他能力: _____	<input type="checkbox"/> Others 其他能力: _____

**學習成效檢核表 ASSURANCE OF LEARNING CHECK LIST**

## ■ 期末檢核學生學習成效版本 After the Semester Ends

請各位教師根據課程規劃，勾選出適合的選項

本課程與商學院願景的關連性 Adherence to Mission	
■ Globalization 訓練國際化的能力	■ Technology 訓練科技與應用的能力
■ Innovation 訓練創新的能力	■ Humanity 訓練人文素養
本課程與本系所學程學習目標的關連性 Adherence to Program Learning Goals	
General MBA with special emphasis on Intellectual Assets Management & Intellectual Property Protection. Students will gain access to the following elements indispensable to the management of intellectual property-management skills from the College of Commerce, NCCU, and moreover, expertise on law and technology.	
本課程所運用到的教學方法 Pedagogical Methodologies	
■ Lecture	<input type="checkbox"/> e-Learning
■ Study Group	■ Seminar
■ Case Study	<input type="checkbox"/> Internship
■ Project	<input type="checkbox"/> Independent Learning
<input type="checkbox"/> Role-Playing	<input type="checkbox"/> Theater Learning
<input type="checkbox"/> Others: _____	<input type="checkbox"/> Others: _____
本課程教授的核心能力 Student Skills, Knowledge and Attitude Enhancement	
■ Theory	<input type="checkbox"/> Action Planning
■ Analytics	<input type="checkbox"/> Listening
<input type="checkbox"/> Descriptive	<input type="checkbox"/> Persuading
■ Technical	■ Teamwork
<input type="checkbox"/> Decision-making	<input type="checkbox"/> World-view
<input type="checkbox"/> Others 其他能力: _____	<input type="checkbox"/> Others 其他能力: _____