

MARK D. JANIS

Professor of Law

H. Blair & Joan V. White Chair in Intellectual Property Law

University of Iowa College of Law

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EDUCATION

J.D., Indiana University School of Law, Bloomington, IN (1989, *summa cum laude*; Order of the Coif)

B.S. Chemical Engineering, Purdue University, West Lafayette, IN (1986, with distinction)

EXPERIENCE

H. Blair & Joan V. White Chair in Intellectual Property Law, University of Iowa College of Law, Iowa City, Iowa (2006-)

H. Blair & Joan V. White Intellectual Property Law Scholar, University of Iowa College of Law, Iowa City, Iowa (2002-2006)

Professor of Law, University of Iowa College of Law, Iowa City, Iowa (1999-)

Associate Professor of Law, University of Iowa College of Law, Iowa City, Iowa (1995-1999)

Associate, Barnes & Thornburg, Indianapolis, IN (1989-1995)
specialization: patent law

Adjunct Professor of Law, Indiana University School of Law, Bloomington, Indiana (Spring 1994)

PUBLICATIONS

BOOKS

IP AND ANTITRUST LAW: AN ANALYSIS OF ANTITRUST PRINCIPLES APPLIED TO INTELLECTUAL PROPERTY LAW (2001) (with Hovenkamp and Lemley) (2 vols.) (with annual updates)

TRADEMARKS & UNFAIR COMPETITION: LAW & POLICY (1st ed. 2004) (with Dinwoodie) (supplements 2005, 2006) (2d. ed. 2007)

TRADEMARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH (edited book) (with Dinwoodie) (Edward Elgar Publishing, forthcoming 2008)

BOOK CHAPTERS

Patent Pools, in WAYNE DALE COLLISON (ED.), ISSUES IN COMPETITION LAW AND POLICY (forthcoming ABA 2008)

Unilateral Refusals to License in the US, in FRANCOIS LEVEQUE & HOWARD SHELANSKI (EDS.), ANTITRUST, PATENTS AND COPYRIGHT (Elgar 2005) (with Hovenkamp & Lemley)

"Minimal" Standards for Patent/Antitrust Under TRIPs, in KEITH MASKUS & JEROME H. REICHMAN (EDS.), INTERNATIONAL PUBLIC GOODS & TRANSFER OF TECHNOLOGY UNDER A GLOBALIZED INTELLECTUAL PROPERTY REGIME (Cambridge 2005)

Use, Constructive Use, and Registration in the United States, in JEREMY PHILLIPS & ILANAH SIMON (EDS.), TRADE MARK USE (Oxford 2005) (with Dinwoodie)

Themes in Federal Circuit Patent Jurisprudence, 2000-2001, in HUGH HANSEN (ED.), 7 INTERNATIONAL INTELLECTUAL PROPERTY LAW & POLICY (2002)

ARTICLES

Technological Change and the Design of Plant Variety Protection Regimes, 82 CHI.-KENT L. REV. 1557 (2007) (with Smith)

Confusion Over Use: Contextualism in Trademark Law, 92 IOWA L. REV. 1599 (2007) (with Dinwoodie)

Lessons from the Trademark Use Debate, 92 IOWA L. REV. 1703 (2007) (with Dinwoodie)

Rules v. Standards for Patent Law in the Plant Sciences, 24 LAW IN CONTEXT 54 (2006), also in JAY P. KESAN (ED.), SEEDS OF CHANGE (Oxford-CABI) (2007)

Unilateral Refusals to License, 2 J. COMPETITION L. & ECON. 1 (2006)(with Hovenkamp & Lemley)

Supplemental Forms of IP Protection for Plants, 1 MINNESOTA J. LAW SCI. TECH. 305 (2004), reprinted in 7 BIO-SCIENCE LAW REVIEW 32 (2005)

Reforming Patent Validity Litigation: The "Dubious Preponderance", 19 BERKELEY TECH. L.J. 923 (2004)

Equilibrium in a Technology-Specific Patent System, 54 CASE W. R. L. REV. 743 (2004) (commentary)

Balancing Ease and Accuracy in Assessing Pharmaceutical Exclusion Payments, 88 MINN. L. REV. 712 (2004) (with Hovenkamp and Lemley)

Anticompetitive Settlement of Intellectual Property Disputes, 87 MINN. L. REV. 1719 (2003) (with Hovenkamp and Lemley)

Intellectual Property Issues in Plant Breeding and Plant Biotechnology, in BIOTECHNOLOGY, GENE FLOW, AND INTELLECTUAL PROPERTY RIGHTS: AN AGRICULTURAL SUMMIT, Purdue Univ. Pub. RB-995 (2002)

Intellectual Property Protection for Plant Innovation: Unresolved Issues After J.E.M. v. Pioneer, 20 NATURE/BIOTECHNOLOGY 1161 (2002) (with Kesan)

U.S. Plant Variety Protection: Sound and Fury. . .?, 39 U. HOUSTON L. REV. 727 (2002) (with Kesan)

Transitions in IP and Antitrust, 47 ANTITRUST BULLETIN 253 (2002)

Patent Abolitionism, 17 BERKELEY HIGH TECH. L.J. 899 (2002)

Sustainable Agriculture, Patent Rights, and Plant Innovation, 9 IND. J. GLOBAL LEGAL STUDIES 91 (2001)

Designing an Optimal Intellectual Property System for Plants: A Supreme Court Debate, 19 NATURE/BIO TECHNOLOGY 981 (with Kesan) (October 2001)

Patent Law in the Age of the Invisible Supreme Court, 2001 ILLINOIS LAW REVIEW 387 (2001)

On Courts Herding Cats: Contending with the Written Description Requirement, 2 WASH. U. JOURNAL OF LAW & POLICY 55 (2000)

Inter Partes Reexamination, 10 FORDHAM INTELLECTUAL PROPERTY, MEDIA, AND ENTERTAINMENT LAW JOURNAL 481 (2000)

Who's Afraid of Functional Claims: Reforming the Federal Circuit's §112, ¶6 Jurisprudence, 15 SANTA CLARA COMP. & HIGH TECH. L. REV. 231 (1999)

A Tale of the Apocryphal Axe: Repair, Reconstruction, and the Implied License in Intellectual Property Law, 58 MD. L. REV. 423 (1999).

Second Tier Patent Protection, 40 HARVARD INTERNATIONAL LAW JOURNAL 151 (1999) (reprinted in 33 INTELLECTUAL PROPERTY REVIEW 17 (2001)).

Rethinking Reexamination: Towards a Viable Administrative Revocation System for U.S. Patent Law, 11 HARVARD JOURNAL OF LAW & TECHNOLOGY 1 (1997), excerpted in ROBERT P. MERGES & JANE GINSBURG, FOUNDATIONS OF INTELLECTUAL PROPERTY (2004).

Unmasking Structural Equivalency: The Intersection of §112, ¶6 Equivalents and the Doctrine of Equivalents, 4 ALBANY LAW JOURNAL OF SCIENCE & TECHNOLOGY 205 (1994).

Judge & Jury Roles in Equivalents Analysis: Commentary on Malta v. Schulmerich Carillons, 74 J. PATENT & TRADEMARK OFF. SOC'Y 621 (1992).

WORKS IN PROGRESS

TRADE DRESS AND DESIGN LAW (casebook) (with Dinwoodie) (Aspen, forthcoming 2008)

ESSENTIALS OF TRADEMARK AND UNFAIR COMPETITION LAW (student text) (with Dinwoodie) (Aspen, forthcoming 2009)

TRADEMARKS AND UNFAIR COMPETITION (student treatise) (with Dinwoodie and Austin) (Aspen, forthcoming 2009)

INTELLECTUAL PROPERTY RIGHTS IN PLANTS (treatise) (with Dinges and Jervis) (Oxford, forthcoming 2009-10)

Morse's Signals: Myth and Precedent in Patent Law (article, under preparation)

Trademark Dilution in Comparative Perspective, symposium volume of Transnational Law and Contemporary Problems (co-editor, with Yu)

AWARDS

University of Iowa Faculty Scholar Award, 2002-06 (to support research on intellectual property rights in plant biotechnology)

University of Iowa Collegiate Teaching Award, 2000-2001

University of Iowa Instructional Improvement Award, 2001 (to fund creation of a digital archive on image misappropriation in trademark and trade dress cases)

TEACHING ACTIVITIES

Courses Taught (University of Iowa College of Law)

Patent Law (Fall '95, Fall '96, Spring '98, Spring '99, Spring '00, Spring '01, Fall '01, Fall '02, Fall '03, Fall '04, Fall '05, Fall '06, Fall '07)

Patenting Complex Technologies (seminar) (Fall-Spring '01-'02)

Trademarks and Unfair Competition Law (Spring '97, Fall '97, Summer '99, Fall '99, Spring '01, Spring '02, Fall '02, Fall '03, Fall '04, Spring '07, Spring '08)

Copyright Law (Spring '96, Fall '99)

Advanced Issues in Intellectual Property (seminar) (Spring '97, Spring '99, Spring '00, Spring '04)

Innovation, Business and Law Colloquium (Spring '07)

International Intellectual Property Law (Spring '04)

Introduction to Intellectual Property Law (Fall '05, Spring '07, Spring '08)

Intellectual Property Reading Tutorial (Fall '05)

Arts & Entertainment Law (January '06 intersession)

Natural Resources Law (Spring '96, Fall '96)

Property II (small section) (Spring '97, Fall '97); (large section) (Spring '99, Spring '00)

Co-Curricular Activities (University of Iowa College of Law)

Host, Innovation Business and Law Practitioner-in-Residence Series (2007-08)

Convener, Trademark Scholars' Roundtable, Iowa City (Spring 2008)

Supervisor, Independent Research Projects (Spring '96 -- present)

Faculty Advisor and director of Intellectual Property Mentor Program, Intellectual Property Law Society (1995-present)

Faculty Advisor, Journal of Corporation Law (1997- present)

Advisor, Trademarks/Unfair Competition Moot Court Teams (Spring 1998)

Other Teaching Activities

Visiting Instructor, Munich Intellectual Property Center, teaching Design Protection, January 2008.

Visiting Instructor, Oxford University, teaching Trademarks & Unfair Competition Law, July 2003; July 2005; July 2007.

Visiting Instructor, University of Victoria (British Columbia) School of Law, teaching

Trademarks & Unfair Competition Law, July 2002, July 2004; July 2006.

Teaching Fellow, Summer Institute, Center for Advanced Study and Research in Intellectual Property (CASRIP), University of Washington School of Law, Seattle, WA, July 1999.

Instructor, University of Iowa Executive MBA Program, teaching Patents and Trademarks, December 2004; November 2005, December 2006, December 2007.

SERVICE AND PROFESSIONAL ACTIVITIES

Government Testimony

Federal Trade Commission, Spring 2002 Hearings on Intellectual Property and Antitrust (April 2002)

Department of Justice, Spring 2002 Hearings on Intellectual Property and Antitrust (May 2002)

Presentations

Presentation on Patent Law, UI Chemical Engineering Lecture Series, November, 1995.

Presentation on Patent Law, UI Biomedical Engineering Lecture Series, March, 1996.

Facilitator, Proposed Legislation Working Group, CIC Copyright Conference, May, 1996, Iowa City.

Presentations on Patent Law and Copyright Law, Iowa Intellectual Property Law Association Annual Meeting, October, 1996, Galena, Illinois.

Presentation on Patent Law, UI Biomedical Engineering Lecture Series, Fall, 1996

Presentation on Patent Law, UI Biocatalysis Seminar, October, 1996

Presentation: Litigation Concerning the Planning Provisions of the National Forest Management Act, UI Graduate Seminar in Urban Planning, Fall, 1996

Presentation: Trademark Dilution and Trade Dress Inherent Distinctiveness, Iowa Intellectual Property Law Association Annual Meeting, October, 1997, Des Moines, Iowa.

Presentation: The Blood Substitute: Scientific, Legal, and Business Aspects of Innovation, March 1998, Iowa City (moderator/organizer).

Presentation: Means Plus Function Expressions in Patent Claims, September, 1998, Finnegan Lectures, George Washington University Law School, Washington, D.C.

Presentation: Recent Developments in the Law of §112, ¶6, October, 1998, Iowa Intellectual Property Law Association Annual Meeting, Des Moines, Iowa

Presentation: Software Patents, UI Electrical and Computer Engineering Graduate Colloquium, November, 1998

Presentation: Software Patents, UI Mechanical Engineering lectures, March 1999

Presentation: Internet Patent and Trademark Issues, UI graduate course in information science, April 1999

Presentation: Litigating Medical Device Patents, UI Biomedical Engineering graduate seminar, Fall 1999

Presentation: Recent Developments Concerning the Written Description Requirement, October, 1999, Iowa Intellectual Property Law Association Annual Meeting, Cedar Rapids, Iowa

Presentation: The Future of the Written Description Requirement, April 2000, Washington University, St. Louis, MO

Invited Discussant: Law and Economics of Intellectual Property, April 2000, Vanderbilt University Law School, Nashville, TN

Presentation: The Supreme Court's Role in Patent Cases, April 2000, Univ. of Illinois Law School, Champaign-Urbana, IL

Presentation: Recent Developments in Inequitable Conduct Law, September 2000, Merchant & Gould, Minneapolis, MN

Presentation: Securing Durable Patents, October 2000, Iowa Intellectual Property Law Association Annual Meeting, Des Moines, Iowa.

Invited Commentary: E-Commerce and E-Quivalence: Defining the Scope of Internet Patents, George Washington U. Law School, October 2000, Washington D.C.

Presentation, Software and E-Commerce Patents, UI Electrical Engineering seminar, November, 2000.

Presentation: Introduction to Patent Law, UI Chemical Engineering Lecture Series, Spring 2001

Presentation: Sustainable Agriculture and Intellectual Property Rights in Plant Innovation, Conference on Sustainable Agriculture and GMO's, Indiana University School of Law, March 2001

Presentation: Federal Circuit Recent Developments, Fordham University School of Law, International Intellectual Property Law & Policy Conference, April 2001

Participant: Universal Odyssey: Discoveries in Genetics and Informatics, Grindavik, Iceland, May 2001

Presentation: Intellectual Property and Antitrust Law, National Contract Managers Association meeting, Cedar Rapids, IA, June 2001.

Presentations: Experimental Use and Plant Biotechnology; Litigating Patent Validity, High Technology Summit, University of Washington, Seattle, WA, July 2001

Presentation: On Sale Bar after *Pfaff*, October 2001, Iowa Intellectual Property Law Association Annual Meeting, Des Moines, Iowa.

Presentation: Patent Abolitionism, Berkeley Conference on Patent System Reform, Berkeley, California, March 2002

Panel Presentation, Bench, Bar, & Academia Panel on Patent Law Topics, ABA IP Section Spring Annual Meeting, Washington, D.C., April 2002.

Invited Commentary: Intellectual Property and Standards, Oracle Conference, George Washington U. Law School, Washington D.C., April 2002.

Presentation: Plant Variety Protection: Sound and Fury. . .?, IPIL (Univ. Of Houston) Conference, Santa Fe, New Mexico, May 2002.

Panel Presentation, Supreme Court's Role in Patent Cases (Festo Decision), Federal Circuit Bar Association Annual Meeting, San Diego, CA June 2002.

Presentation, IP Issues in Plant Innovation, Indiana Agricultural Summit, Indianapolis, Sept. 2002.

Presentation, Patent Law, UI Electrical Engineering Seminar, October 2002.

Panel Presentation, IP and Antitrust, ABA Annual Fall Forum, Washington, D.C., Nov. 2002.

Presentation, Patent Law, UI Chemical Engineering Seminar, November 2002.

Presentation, IP Issues in Informatics, UI Health Informatics Seminar, November 2002.

Presentation: The Federal Circuit's Benevolent Imperialism in Patent/Antitrust, Engelberg Innovation Colloquium, New York University School of Law, New York, February, 2003.

Presentation: Intellectual Property Rights in Plant Biotechnology and the Role of State Law, Legislative Agricultural Chairs Summit, Council of State Governments, Dallas, Texas, February 2003.

Presentation: Minimal Standards for Patent/Antitrust Under TRIPs, International Public Goods and Transfer of Technology Under a Globalized Intellectual Property Regime, Duke Law School, April, 2003.

Presentation: The Federal Circuit's Benevolent Imperialism, Chicago Intellectual Property Colloquium, Chicago-Kent Law School, April, 2003.

Presentation: Recent Supreme Court Trademark Cases, Iowa Intellectual Property Law Association, Des Moines, Iowa, September 2003.

Presentation: Patent Law, UI Biomedical Engineering Seminar, October 2003.

Panel Presentation: Technology-Specific Patent Law, Case Western Reserve Law School, Cleveland, Ohio, November 2003.

Panel Presentation: Experimental Use and Biotechnology Patents, Biotechnology and Law Symposium, University of Arizona College of Law, Tucson, Arizona, February 2004.

Presentation: Rules and Norms in Patent Law for Plant Biotechnology, Seeds of Change Symposium, University of Illinois College of Law, Champaign, Illinois, April 2004.

Panel Presentation: The FTC's Proposed Reforms to the Presumption of Patent Validity, Berkeley Technology Law Symposium, Boalt Hall School of Law, Berkeley, California, April 2004.

Presentation: Interface Measures in Intellectual Property Regimes for Plant Innovation, Symposium on Intellectual Property Rights for the Public Good, University of Minnesota School of Law, St. Paul, Minnesota, April 2004.

Presentation: Recent Developments in Federal Circuit Patent Law, Los Angeles Intellectual Property Law Association Annual Meeting, Santa Barbara, California, May 2004.

Presentation: Supplemental IP Protection for Plants, International Seed Federation Symposium on Intellectual Property, Berlin, Germany, May 2004.

Presentation: Patent Law, UI Electrical & Computer Engineering Seminar, September 2004.

Presentation: The Intellectual Property Complex for Plants, ACIPA Lecture Series, Brisbane, Australia, November 2004.

Presentation: Is Plant Variety Protection Anachronistic?, ACIPA Conference on Intellectual Property and Farmer's Rights, Canberra, Australia, November 2004.

Presentation: Calibrating the Utility Patent System for Plants and Plant Biotechnology, Winter Bioethics Retreat, Iowa State University, Ames, Iowa, January 2005.

Presentation: Is Plant Variety Protection Anachronistic? Pioneer Hi-Bred Lecture Series, Des Moines, Iowa, May 2005.

Presentation: Intellectual Property for Plants: Questions and Answers, American Farm Bureau Biotechnology Conference, Indianapolis, Indiana, July 2005.

Presentation: Is Plant Variety Protection Anachronistic? Monsanto Legal Department Retreat, Des Moines, Iowa, September 2005.

Presentation: Patent Law Reform and the Standards Issue, Conference on Standardization and the Law, Stanford Law School, Palo Alto, California, September

2005.

Presentation: Trademark Use, Iowa Intellectual Property Law Association Annual Meeting, Cedar Rapids, Iowa, October 2005.

Presentation: The Supreme Court's Role in Patent Cases, University of Washington Law School, Seattle, Washington, January 2006.

Presentation: Obsolescence in Intellectual Property Regimes, Conference on Intellectual Property, Trade and Development, Chicago-Kent Law School, October 2006.

Presentation: Second-Window Post-Grant Patent Opposition, at Modest Proposals (intellectual property law symposium), Cardozo Law School, February 2007.

Presentation: Second-Window Post-Grant Patent Opposition, Patents and Progress Symposium, DePaul University Law School, March 2007.

Presentation: Trademark Use, Intellectual Property Workshop, University of Michigan Law School, April 2007.

Presentation: Debate on Trademark Use and Keyword-triggered Advertising, American Intellectual Property Law Association Spring Meeting, Boston, May 2007.

Presentation: Strategic Use of Patent Reexamination, American Intellectual Property Law Association, Minneapolis, June 2007.

Presentation: Patents and the Supreme Court, High Technology Summit, University of Washington Law School, July 2007.

Presentation: Recent Developments in Trademark and Unfair Competition Law, Iowa Intellectual Property Law Association Annual Meeting, Riverside, Iowa, October 2007.

Presentation, Patent Law, UI Chemical Engineering Seminar, January 2008.

Presentation, IP Scholarship, IP Works-in-Progress Conference, Drake University Law School, Des Moines, Iowa, March 2008.

Expert Testimony/Consultation

Vermeer Mfg. Co. v. Charles Machine Works, Inc. (S.D. Ia.) (patent infringement)

Kemin Foods v. Pigmentos Vegetales (S.D. Ia.) (patent infringement)

FTC v. Rambus (patent/antitrust)

Committee and Other Service

Member, UI Biological Materials Working Group, 1996.

Alternate Member, Board on Natural Resources, National Association of State Universities and Land-Grant Colleges, 1996.

Member, Board of Directors, University of Iowa Research Foundation (2000-)

Member, UI Committee on Intellectual Property Policy (2000-)

Member, Board of Directors, University of Iowa Law School Foundation (2002-)

Member, AALS Intellectual Property Section Executive Committee; AALS Organizing Committee, 2006 Mid-Year Meeting

Law College Committee service:

Academic Rules Committee (1995-1998); Placement Committee (1997-1999); Self-Study Committee (1999); Admissions Committee (1999-2001); Computer Committee (2000-2002); Teaching Improvement Committee (2000-2001, 2003-04); Faculty Appointments Committee (2001-03; 2004-05; chair 2006-07); Dean Search Committee (2003-04).

Professional Memberships

American Intellectual Property Law Association

American Bar Association, Intellectual Property Law Section, Antitrust Section

Iowa Intellectual Property Law Association

Association for Teaching and Research in Intellectual Property (ATRIP)

Federal Circuit Bar Association

International Trademark Association