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Seminars

Intellectual Property Review—Updates and Changes from 2022



*Cosponsored by the
Intellectual Property Section*

Friday, February 24, 2023
9 a.m.—1:20 p.m.

4 General CLE credits (ID 97235)

SECTION PLANNERS

Planning Chair: **Kimberly Fisher**, *Kolitch Romano Dascenzo Gates LLC, Portland*
Christopher Erickson, *Tonkon Torp LLP, Portland*
Leigh Gill, *Immix Law Group PC, Portland*
Melissa Jaffe, *Law Offices of Melissa B. Jaffe PC, Portland*

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— Karen Sandrik, <i>Willamette University College of Law, Salem, Oregon</i>	
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Lined area for notes or content.

SCHEDULE

9:00 Trademark Law Update

- ◆ Federal cases
- ◆ Trademark Trial and Appeal Board (TTAB) cases
- ◆ Developments at the Trademark Office

Venkat Balasubramani, *Focal PLLC, Seattle*

10:00 Transition

10:05 Patent Law Update

- ◆ Relevant patent decisions from the Federal Circuit
- ◆ Pending Supreme Court decisions
- ◆ Developments at the Patent Office

Karen Sandrik, *Willamette University College of Law, Salem*

11:05 Break

11:15 Copyright Law Update

- ◆ Updates to the Copyright Office
- ◆ SMART Copyright Act of 2022
- ◆ US vs. EU copyright changes
- ◆ Cases of note and of interest

Leigh Gill, *Immix Law Group PC, Portland*

Melissa Jaffe, *Law Offices of Melissa B. Jaffe PC, Portland*

12:15 Transition

12:20 The Leahy-Smith America Invents Act (AIA)—The First Ten Years of Post-Grant Review Practice at the Patent Trial and Appeal Board (PTAB)

- ◆ Significant cases from the Supreme Court and Federal Circuit that helped shape post-grant review practice before the PTAB
- ◆ PTAB rules and decisions governing IPR practice
- ◆ Impact of PTO Director guidance and review in AIA proceedings

Peter Ayers, *US Patent and Trademark Office—Office of the Solicitor, Alexandria, Virginia*

1:20 Adjourn

Lined area for notes or content.

FACULTY

Peter Ayers, *US Patent and Trademark Office—Office of the Solicitor, Alexandria, Virginia*. Mr. Ayers is Senior Counsel for Patent Law and Litigation at the USPTO. He oversees the Solicitor's Office decisions on whether to intervene in appeals from PTAB decisions in AIA post-issuance proceedings and advises the USPTO regarding the rules governing post-issuance proceedings. He also supervises the inter partes appellate litigation case load, handles Federal Circuit appeals in patent cases, and renders legal and policy advice on patent matters through the General Counsel to the Under Secretary and Director of the USPTO, the Solicitor, Deputy Solicitor, and other members of the USPTO's senior staff. Mr. Ayers manages the preparation of intervention and amicus memoranda in patent law cases, interfaces with the PTAB and the Patents organization on recurring issues in inter partes cases, and helps supervise the preparation of briefs and arguments in inter partes cases.

Venkat Balasubramani, *Focal PLLC, Seattle*. Mr. Balasubramani is a founder of Focal PLLC, a boutique firm focused on technology and internet clients. He has handled a range of cases involving the First Amendment, content regulation, and copyright and trademark. He is also a guest blogger at the Technology and Marketing Law Blog. While he does not tweet much recently, you can find him on Twitter @Vbalasubramani.

Leigh Gill, *Immix Law Group PC, Portland*. Mr. Gill is a technology law attorney who guides clients through software licensing, digital rights licensing, artistic rights licensing, and intellectual property. His practice includes technology and intellectual property law, business law, and employment matters. He is a member of the American Bar Association and the Oregon State Bar Technology Law Section. Mr. Gill is a regular CLE presenter, and he is admitted to practice in Oregon and Washington.

Melissa Jaffe, *Law Offices of Melissa B. Jaffe PC, Portland*. Ms. Jaffe is the owner and principal attorney of the boutique transactional and IP firm for creative businesses. She works with international companies, start-up businesses, entrepreneurs, and artists through the international IP and business legal terrain. Ms. Jaffe is an executive committee member of the Oregon State Bar Intellectual Property Section and Business Law Section and a board member of Washington Women Lawyers and King County [Washington] Women Lawyers. She is licensed in Oregon, California, and Washington.

Karen Sandrik, *Willamette University College of Law, Salem*. Professor Sandrik's research focuses on the intersection of commercial law and intellectual property law. Most recently, her writing seeks to address problems within patent law, specifically patent licensing, patent damages, and innovation incentives, by employing the lens of contract law and the Uniform Commercial Code. Her teaching reflects this research interest. Professor Sandrik teaches contracts, secured transactions, sales, deals, IP law, patent law, and IP transfer and commercialization. In addition to her teaching and research, Professor Sandrik is codirector of the Business Lawyering Institute and director of the Certificate Program in Law and Business.

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Chapter 1

Presentation Slides: Trademark Law Update (2022 Year in Review)

VENKAT BALASUBRAMANI

Focal PLLC

Seattle, Washington

Trademark Law Update (2022 Year in Review) OSB – IP Section (2/24/23)

Presented by Venkat Balasubramani (Focal PLLC)

focal
PLLC

Jack Daniel's Properties, Inc. v. VIP Products LLC (U.S.)

- Set for argument
March 22, 2023



focal
PLLC

2

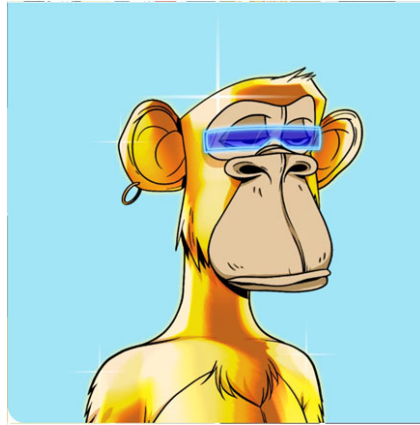
In re Elster, 26 F.4th 1328 (Fed. Cir. 2022)



Hermès v. Rothschild (S.D.N.Y.)

- “MetaBirkin” NFTs
 - Judge Rakoff denied Summary Judgment
 - Trial ongoing

Yuga Labs, Inc. v. Ryder Ripps (C.D. Cal.)



San Antonio Winery, Inc. v. Jiaxing Micarose Trade Co. (9th Cir. 2022)

- Service of process allowed through PTO
 - 15 U.S.C. § 1051(e) foreign applicants designate a U.S. resident for service
 - If none designated, service may be made through director of PTO

Deadlines for Office Actions

- 3 months (from 6 months)
- One 3-month extension available (\$125 fee)

Abitron Austria GmbH v. Hetronic International, Inc. (U.S.)

- Extraterritoriality
- Set for Argument March 21, 2023

Wreal, LLC v. Amazon.com, Inc. (11th Cir. 2022)

- Reverse confusion
- FyreTV v. Fire TV (Amazon)

Spotify AB v. U.S. Software, Inc. (TTAB 2022)

- Spotify v. Potify
- Dilution / Blurring
- Spotify = famous mark

Presumption of Irreparable Harm, 15 U.S. Code § 1116

- Nichino Am., Inc. v. Valent U.S.A. LLC (3d Cir. 2022)
- SoClean, Inc. v. Sunset Healthcare Sols., Inc. (Fed. Cir. 2022)

City of Chi. v. Doordash, Inc. (N.D. Ill. 2022)

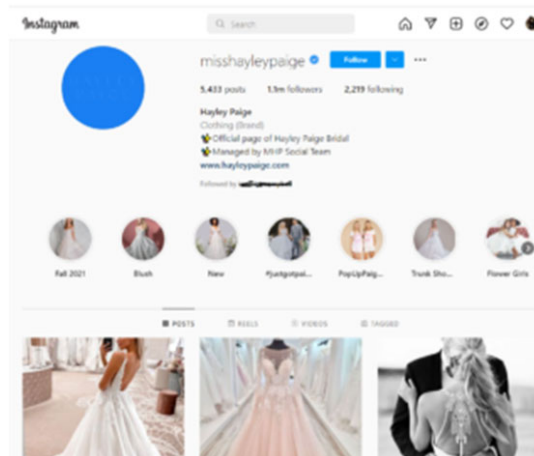
- Lawsuit against delivery services based on misrepresentation / unfair competition
- (815 ILCS 338/ Fair Food and Retail Delivery Act)

Identity Verification (USPTO)

- Identity verification is mandatory for all users (August 6, 2022)

Social Media Account Ownership Disputes

- JLM v. Gutman (S.D.N.Y. 2022)
- Big Thirst, Inc. v. Donoho (W.D. Tex. 2022)



Links and Resources

1. *Jack Daniel's Properties, Inc. v. VIP Products LLC* (U.S.) (set for argument on Mar. 22, 2023)
SCOTUSBlog page: <https://www.scotusblog.com/case-files/cases/jack-daniels-properties-inc-v-vip-products-llc-2/>
2. *In re Elster* (Fed. Cir. 2022) (petition for cert. filed on Jan. 27, 2023)
Supreme Court docket: <https://www.supremecourt.gov/search.aspx?filename=/docket/docketfiles/html/public/22-704.html>
3. *Hermès v. Rothschild* (S.D.N.Y.) (trial ongoing as of the date of these materials)
SJ Order: <https://www.documentcloud.org/documents/23596642-hermes-intl-v-rothschild-order-denying-motions-for-summary-judgment>
4. *Yuga Labs, Inc. v. Ryder Ripps* (C.D. Cal.) (ongoing)
The Fashion Law: <https://www.thefashionlaw.com/copyright-computer-generated-image-issues-come-up-in-yuga-labs-v-ryder-ripps/>

Links and Resources

5. *San Antonio Winery, Inc. v. Jiaxing Micarose Trade Co.* (9th Cir. 2022) (service of process)
Ruling: https://scholar.google.com/scholar_case?case=1602354654646484873&hl=en&as_sdt=6&as_vis=1&oi=scholar
6. *New deadline to respond to office actions for trademark applications* (USPTO) (3 vs. 6 mos)
USPTO Website Post: <https://www.uspto.gov/trademarks/laws/2020-modernization-act/new-response-deadline-applications>
7. *Abitron Austria GmbH v. Hetronic International* (U.S.)
SCOTUSBlog page: <https://www.scotusblog.com/case-files/cases/abitron-austria-gmbh-v-hetronic-international-inc/>
8. *Wreal, LLC v. Amazon.com, Inc.* (11th Cir. 2022)
Courthouse News: <https://www.courthousenews.com/amazon-must-face-porn-company-in-trademark-trial-11th-circuit-rules/>

Links and Resources

9. *Spotify AB v. U.S. Software, Inc.* (TTAB 2022)

Brand Protection Blog:

<https://www.thebrandprotectionblog.com/spotify-successfully-opposes-potify-applications-based-on-dilution-by-blurring/>

10. *Presumption of Irreparable Harm*, 15 U.S. Code § 1116

3d Cir. Ruling:

https://scholar.google.com/scholar_case?case=11001617681578702558&hl=en&as_sdt=6&as_vis=1&oi=scholar

Fed. Cir. Ruling:

https://scholar.google.com/scholar_case?case=7671090997356277332&hl=en&as_sdt=6&as_vis=1&oi=scholar

11. *City of Chi. v. Doordash, Inc.* (N.D. Ill. 2022), 2022 U.S. Dist. LEXIS 41635

12. *Identity Verification* (USPTO)

USPTO Website Post: <https://www.uspto.gov/blog/director/entry/safeguarding-the-trademark-community-against>

Links and Resources

13. *Social Media Account Ownership Disputes*

Blog post: <https://blog.ericgoldman.org/archives/2022/08/who-owns-a-disputed-social-media-account-jlm-v-gutman.htm>

Questions/
Comments?

venkat@focallaw.com
@VBalasubramani



Chapter 2

Presentation Slides: Patent Law

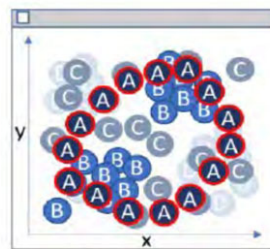
KAREN SANDRIK

Willamette University College of Law
Salem, Oregon

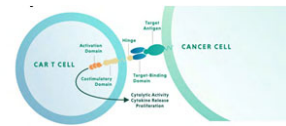
IP Review: 2022 Updates & Changes Patent Law

Presented by:
Karen Sandrik, Willamette University College of Law
February 24, 2023

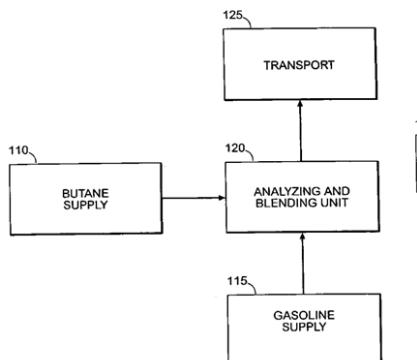
Top Ten in 2022



J.A. 20-21.



BLENDING ARCHITECTURE OVERVIEW



NETFLIX

Patent Eligibility

Patentable Subject Matter (§ 101)

IBM Corp. v. Zillow Grp., Inc.

50 F.4th 1371 (Fed. Cir. 2022)

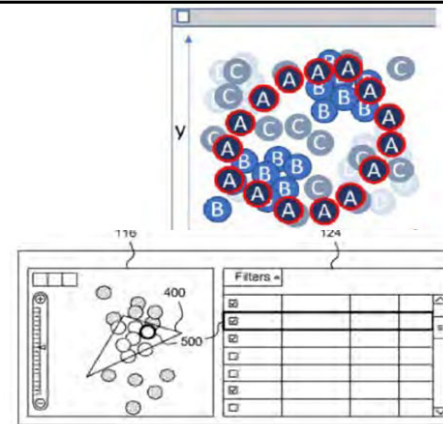


Granted JMOL –
patents claimed ineligible subject matter



Reyna, **Hughes**, Stoll: Affirmed

- A method for “coordinated geospatial, list-based and filter-based selection” and “methods of displays layered date on a spatially oriented displace (like a map), based on nonspatial display attributes.”
- Held: affirmed patents are directed to abstract ideas and lack an inventive step.
- “Identifying, analyzing, and presenting certain data to a user is not an improvement specific to computing . . . requiring the selection and manipulation of information—to provide a ‘humanly comprehensible’ amount of information useful for users . . . —by itself does not transform the otherwise-abstract processes of information collection and analysis.”



Patentability

Anticipation (§ 102)

Mosaic Brands, Inc. v. Ridge Wallet LLC

55 F.4th 1354 (Fed. Cir. 2022)



Granted summary judgement of invalidity re:
'808 patent based on anticipation



Newman, Prost & **Stark**: Reversed & Remanded

- Both parties asserted patents directed to money-clip wallets.
- Dispute regarding inventor's credibility and authenticity of proffered 2010 design drawings and 2011 invoices (and the lack of any documented sales from 2012-2019).
- Held: SJ was inappropriate due to genuine issues of material fact regarding whether Mosaic's Smart Money Clip II is prior art to Ridge's patent.

Junker v. Medical Components, Inc.

25 F.4th 1027 (Fed. Cir. 2022)



Granted summary judgement of no invalidity under the on-sale bar



The piece part prices for this set will be as follows:

Size	ORDER QUANTITIES			
	5,000	10,000	25,000	50,000
4F-6F	\$4.45	\$4.25	\$4.05	\$3.95
7F-8F	4.70	4.50	4.30	4.20
11F	5.05	4.85	4.75	4.70

The above prices are for shipment in bulk, non-sterile, FOB Athens, Texas on a net 30-day basis.

Dyk, Reyna & Stoll: Reversed

- Design patent directed to an ornamental handle with “large, rounded Mickey-Mouse-shaped ears” for an introducer sheath used in a catheter kit.
- Held: Itr sent to Boston Scientific responding to a request for quotation constituted a commercial offer for sale.

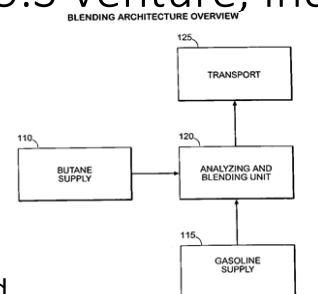


Sunoco Partners Mkt & Terminals L.P v. U.S Venture, Inc.

32 F.4th 1161 (Fed. Cir. 2022)



Bench: Rejected on-sale bar defense with respect to certain claims



Prost, Reyna & Stoll: Reversed & Remanded

- Claims directed to a system and method for adding butane to gasoline near the end of the distribution process to “blend the maximum allowable butane into each batch,” which varies depending on season and location.
- Two days before the critical date, the inventors offered to sell an automated butane-blending system to Equilon in exchange for Equilon’s commitment to purchase butane in the future (500,000 barrels over 5 or so years).
- Held: district court erred in determining that the experimental-use doctrine applies because the Equilon agreement expressly described the transaction as a sale without reference to any experimental purpose.



Patentability

Obviousness (§ 103)

Adapt Pharma Operations Ltd. V. Teva Pharms. USA, Inc.

25 F.4th 1354 (Fed. Cir. 2022)



Bench trial: found claims invalid as obvious

Newman, Prost & **Stoll**: Affirmed

- Claims directed to methods of treating opioid overdose via intranasal administration of a naloxone formulation (i.e. Narcan[®] Nasal Spray).
- Held: there was sufficient evidence of motivation to combine given known drawbacks of prior methods of administration, need to include pH-limiting, chelating, and preserving agents in an intranasal formulation, and FDA's guidance that a higher dose may be necessary for intranasal application.
- District Ct may have erred in its long-felt-need analysis but it was harmless error given "the strong case of obviousness as a matter of law."
- Judge Newman Dissent: (1) there was no expert testimony on motivation to combine; (2) no reasonable expectation of success because the prior art warned that the preservation used causes unacceptable naloxone degradation; and (3) "objective indicia are properly considered as part of the evaluation of the *prima facie* case."

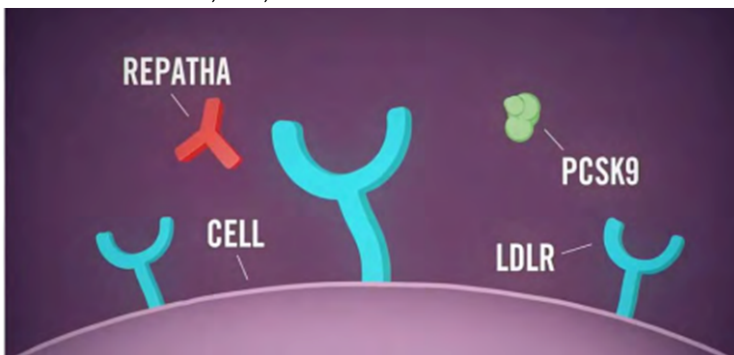


Patentability

Enablement (§ 112)

Amgen v. Sanofi

U.S. Patent No. 8,829,165



 **Repatha**
(evolocumab) injection
140 mg/mL

1. An isolated monoclonal antibody, wherein, when bound to PCSK9, the monoclonal antibody binds to at least one of the following residues: S153, I154, P155, R194, D238, A239, I369, S372, D374, C375, T377, C378, F379, V380, or S381 of SEQ ID NO:3, and wherein the monoclonal antibody blocks binding of PCSK9 to LDLR.

Amgen v. Sanofi (Amgen I)

872 F.3d 1367 (Fed. Cir. 2017)



Jury: Permanent inj. Enjoining sales of Praluent[®] (alirocumab) entered jury verdict of infringement and no invalidity



Prost, Taranto & Hughes: Vacated & remanded for new trial on written description and enablement

- Post-priority date evidence admissible to prove specification failed to disclose a “representative number of species.”
- Held: rejected jury instruction suggesting that a patentee may claim antibodies by describing the antigen.



Denied Amgen’s cert petition challenging Federal Circuit’s separate written description and enablement requirements.

Amgen v. Sanofi (Amgen II)

987 F.3d 10880 (Fed. Cir. 2021)



Granted JMOL of invalidity for lack of enablement



Hughes, **Lourie** & Prost : Affirmed

- “This invention is in an unpredictable field of science with respect to satisfying the full scope of the functional limitations.”
- Held: “The use of broad functional claim limitations raises the bar for enablement.”



Amgen’s petition for rehearing *en banc* denied on June 21, 2021

- “Amgen argues that we have created a new test for enablement. That is incorrect.”

Amgen v. Sanofi (Amgen II)

987 F.3d 10880 (Fed. Cir. 2021)



November 18, 2021: Amgen petition for *certiorari*

- 1: Whether enablement is a question of fact or a question of law.
- 2: Whether the statutory requirement to teach those skilled in the art to “make and use” the claimed invention means the specification must enable others “to reach the full scope of claimed embodiments” without undue experimentation—i.e., to cumulatively identify and make all or nearly all embodiments without substantial time and effort.

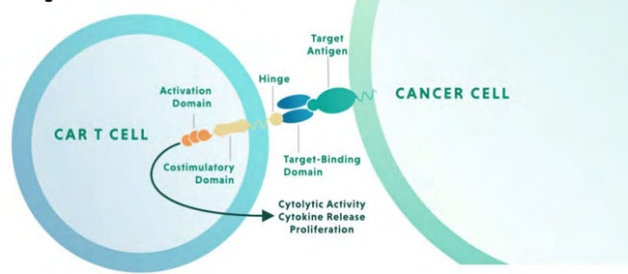
September 22, 2022: SG argued against granting *certiorari*

November 4, 2022: Petition granted with respect to Question 2

Patentability

Written Description (§ 112)

U.S. Patent No. 7,44,190



- 10 F.4th 1330 (Fed. Cir. 2022)



Jury: Valid and infringed, awarded about 1.2 B in damages
JMOL Denied



Moore, Prost, & O'Malley: Reversed

- 2-9

Juno Therapeutics, Inc. v. Kite Pharma, Inc.

10 F.4th 1330 (Fed. Cir. 2022)



June 13, 2022: Juno's petition for *certiorari* filed

1. Is the adequacy of the written description of the invention" to be measured by the statutory standard of "in such full, clear, concise, and exact terms as to enable any person skilled in the art to make and use the same," or is to be evaluated under the Federal Circuit's test, which demands that the "written description of the invention" demonstrate the inventor's "possession" of the "full scope of the claimed invention," including all "known and unknown" variations of each component?

Nov 7, 2022: *Certiorari* denied

Nov 23, 2022: Petition for rehearing filed asking SCOTUS to hold case in abeyance pending resolution of *Amgen v. Sanofi*

Jan 9, 2023: Rehearing denied

Novartis Pharms. v. Accord Healthcare Inc.

21 F.4th 1362 (Fed. Cir. 2022)



Bench: Patent is not invalid for lack of written description



Moore, Linn & O'Malley: Affirmed

- Claims are directed to methods of treating relapsing remitting multiple sclerosis (RRMS) with Gilenya® (fingolimod) "at a daily dosage of 0.5mg, absent an immediately preceding loading dose regimen."
- Majority held disclosure of rat experiment and a prophetic human clinical trial was sufficient to support the 0.5mg daily dose.
- The no-loading-dose limitation was adequately supported because there was expert testimony that a skilled artisan would have expected any loading dose to be explicitly specified so the absence of one would have been understood as an exclusion.
- Dissent: Chief Judge Moore: "[s]ilence is not disclosure."



Novartis Pharms. v. Accord Healthcare Inc.

38 F.4th 1013 (Fed. Cir. 2022)



Bench: Patent is not invalid for lack of written description



Moore, Linn & Hughes: Reversed

- Vacated the prior panel decision [ruling on petition for rehearing after Judge O'Malley retired].
- New majority held the specification's silence regarding a loading dose was inadequate support for the no-loading-dose limitation.
- Dissent: Judge Linn argued that the majority applies a heightened written description standard for negative limitations by requiring that it is "necessarily excluded."



Sept 20, 2022: Novartis's petition for rehearing en banc denied in a per curiam opinion.

Novartis Pharms. v. Accord Healthcare Inc.

38 F.4th 1013 (Fed. Cir. 2022)



Jan 18, 2023: Novartis files petition for *certiorari*

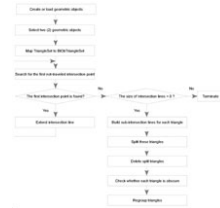
- 1: Can a court of appeals have a new panel re-decide a case?
- 2: Did the Federal Circuit properly apply a heightened written description standard for negative limitations?

Nature Simulation Sys. Inc. v. Autodesk, Inc.

23 F.4th 1334 (Fed. Cir. 2022), later modified and reissued as 50 F.4th 1358 (Fed. Cir. 2022)



Bench: Found claims invalid as indefinite after Markman hearing



Newman, Lourie & Dyk: Reversed & Remanded

- Claims are directed to computer-implemented methods of building three-dimensional objects using Boolean operations, specifically improvements on the known Watson and Delaunay methods.
- Majority held that the district court improperly applied a standard requiring “unanswered questions” to be answered in “the claim language, standing alone” rather than viewing the claims in light of the specification.
- Dissent: Judge Dyk agreed with the district court that “modified Watson method” renders the claims indefinite.

Panel modified and reissued its opinions following a petition for rehearing.



Patent Damages

Exceptional Case (§ 285)

Realtime Adaptive Streaming LLC v. Netflix, Inc.,

41 F.4th 1372 (Fed. Cir. 2022)



Bench: awarded attorneys' fees for both California actions pursuant to § 285 and, in the alternative, the court's inherent equitable powers.

NETFLIX



Chen, Newman, Reyna: Affirmed

- Original case filed in Delaware and Realtime opposed a transfer to the Northern District of California citing inconvenience and unfair burden.
- Magistrate judge then issues a report and recommendation regarding patent ineligibility and Plaintiff dismisses case, only to re-file in the Central District of California. Netflix moved for fees and to transfer the case to Delaware and, again, to avoid a decision on other motion, Plaintiff voluntarily dismissed.
- Held: No need for § 285 – the district court did not abuse its power in awarding fees pursuant to its inherent equitable powers.

Chapter 3A

Presentation Slides: Copyright Update—Year in Review

LEIGH GILL

Immix Law Group PC
Portland, Oregon



Presented } Leigh Gill, Immix Law Group

Themes and Trends

- 1 } Digital representations
- 2 } Economic substance and Fair Use
- 3 } Market power

Immix Law Group } Copyright Year in Review

Key cases

- *Unicolors v. H&M Hennes & Mauritz*, 142 S.Ct. 941 (Feb 24, 2022)
 - Errors in registration will not bar claims where there was no actual knowledge.
- *Starz Entertainment v. MGM*, 2022 WL 2733507 (9th Cir., July 14, 2022)
 - Discovery rule in copyright will permit damages measured on the 3 year Statue of Limitations from date of discovery, not date of infringement. Appears to establish a circuit split with 2nd Circuit.
- *Davis v. Pinterest*, 601 F.Supp.3d 514 (N.D. Ca., May 3, 2022)
 - DMCA safe harbor applies where defendant created a derivative work and distributed for commercial use.
- *Andy Warhol Found. v. Goldsmith*, 11 F.4th 26 (2nd Cir., Aug. 24, 2021)
 - Cert granted
- *ABKCO Music v. Sagan*, 2022 WL 5237636 (2nd Cir., Oct. 6, 2022)
 - Assessing the meaning of a phonorecord, AV works were not subject to compulsory licensing.

Immix Law Group } Copyright Year in Review

Tattoo cases

- Randy Orton Tattoo case - rejects de minimus defense as a matter of law.
- <https://news.bloomberglaw.com/ip-law/www-tattoo-verdict-fails-to-settle-complex-copyright-question>
- Hayden v. 2K Games – de minimus defense is a matter for the jury
- <https://lawstreetmedia.com/news/tech/no-summary-judgment-in-nba-2k-tattoo-case/>
- https://www.docketalarm.com/cases/Ohio_Northern_District_Court/1--17-cv-02635/Hayden_v._2K_Games_Inc._et_al/193/
- Kat Von D case – tattoo artist sued for infringement of photographer’s work
- <https://news.artnet.com/art-world/a-photographer-is-suing-tattoo-artist-kat-von-d-after-she-inked-his-portrait-of-miles-davis-on-a-friends-body-2135112?fbclid=IwAR0hJct9IVMVfOeQgvf3qXVIsX0VQXUaaSRacH6X4XHg8Y6RaPyR6IjFbs>

Immix Law Group } Copyright Year in Review

Solid Oak Sketches v. 2K Games
449 F.Supp.3d 333 (2020)

Figure 1 – 330 and Flames⁶



Figure 5 – Wizard¹⁴

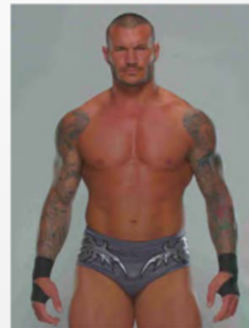


Immix Law Group } Copyright Year in Review

Catherine Alexander v. 2K Games
3:18-cv-00966-SMY (S.D. IL. 2022)

Comparison of Wrestler Randy Orton With His Video Game Counterpart

Mr. Orton in a Photograph



Mr. Orton in WWE 2K



Source: Court Filing

Bloomberg Law

Immix Law Group } Copyright Year in Review

Warhol Foundation v. Goldsmith, 11 F.4th 26 (2nd Cir., 2021)



Immix Law Group } Copyright Year in Review

Warhol Foundation v. Goldsmith, 11 F.4th 26 (2nd Cir., 2021)



Which brings us back to the Prince Series. The district court held that the Prince Series works are transformative because they “can reasonably be perceived to have transformed Prince from a vulnerable, uncomfortable person to an iconic, larger-than-life figure.” [Warhol, 382 F. Supp. 3d at 326](#). That was error.

...the Prince Series retains the essential elements of its source material, and Warhol's modifications serve chiefly to magnify some elements of that material and minimize others. While the cumulative effect of those alterations may change the Goldsmith Photograph in ways that give a different impression of its subject, the Goldsmith Photograph remains the recognizable foundation upon which the Prince Series is built. *Id.* at 42-43

Immix Law Group } Copyright Year in Review

END } *Thank you*

Immix Law Group } IP Issues for the Business Attorney

Chapter 3B

Presentation Slides: 2023 Intellectual Property Section Copyright Law Update

MELISSA B. JAFFE

Law Offices of Melissa B. Jaffe PC
Portland, Oregon



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MELISSA B. JAFFE, PC

2023 Intellectual Property Section Copyright Law Update

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LICENSED:

CA
OR
WA

FOCUS:

Intellectual Property (Copyright, Trademark, Licensing)
Strategy, Counsel, Negotiations, Drafting
Business Transactions
Franchise

BOARD SERVICE:

OSB, Business Law Executive Committee
OSB, Intellectual Property Executive Committee
WWL, Executive Committee
KCWWL, Executive Committee

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Digital Millennium Copyright Act of 1998 (DMCA)

- Criminalizes production and dissemination of technology, devices, or services intended to circumvent measures that control access to copyrighted works
- Notice-and-takedown
- Intended for Standard Technical Measures (STMs)
- Safe Harbor for Service Providers – unintended results

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“Nearly twenty-five years ago we enacted the Digital Millennium Copyright Act, a landmark update to the copyright laws for the internet age. Since then, the internet has significantly changed, and with it so has the world of copyright,” **said Senator Leahy**. “I’m excited to work, alongside Senator Tillis, with filmmakers, musicians, authors, and artists of all stripes, enlisting the help of online platforms, to address online copyright theft that robs these artists of the fruits of their creativity and hard work. The technology exists to protect against this theft; we just need online platforms to use the technology. I’m working hard to make sure our artists get paid, and we can enjoy legal access to their wonderful creations. I look forward to working with all realms of the copyright community to address the problem of copyright theft.”

-- Senator Patrick Leahy (D)-VT

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Strengthening Measures to Advance Rights Technologies (SMART) Copyright Act of 2022

-- [Senators Thom Tillis \(R-NC\) and Patrick Leahy \(D-VT\)](#)

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Strengthening Measures to Advance Rights Technologies (SMART) Copyright Act of 2022

- Hoping STM's will be adopted to fit the needs of particular industries
- Aims to encourage platforms to cooperate and work together
- Funding to the Copyright Office & support staff

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(SMART) Copyright Act of 2022

- EU = more restrictive
- No plans for moral rights
- Hopeful, not absolute

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Copyright Claims Board (CCB) of 2022

- alternative forum for resolving copyright disputes of low economic value (up to \$30k)
- no representation needed
- 3-member tribunal

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Copyright Claims Board (CCB) of 2022

- Proposed rules:
- File claim
- Opt out (60 days)
- “Discovery”

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Copyright Claims Board (CCB) of 2022

- **Accessible to anyone, with or without an attorney.** Designed to be clearly understood and usable by anyone, even without legal training. Users of the CCB are permitted to have an attorney but can also represent themselves.
- **Streamlined procedures conducted online.** Less money and time than federal court lawsuits. Participants are required to provide limited basic documents and information, as opposed to the more complicated and costly process of exchanging evidence in federal lawsuits & do not include the formal motions used in federal court.
- **Remote Hearings** via video conferences.

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Copyright Claims Board (CCB) of 2022

- **Participation is voluntary.** Both claimants (those that file claims with the CCB) and respondents (those against whom a claim is brought) can decide whether or not to participate in proceedings. No one is required to argue a dispute before the CCB; a party with a copyright claim can choose to go to federal court instead, and a respondent can opt out. If a respondent chooses to opt out, the claimant can still bring a lawsuit against that respondent in federal court.
- **Limited jurisdiction.** Only three types of claims can be brought:
 - [Infringement](#) of a copyright;
 - Claims [seeking declarations that specific activities](#) do not infringe copyright; and
 - [“Misrepresentation”](#) in notices sent under the Digital Millennium Copyright Act ([DMCA](#)).

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Copyright Claims Board (CCB) of 2022

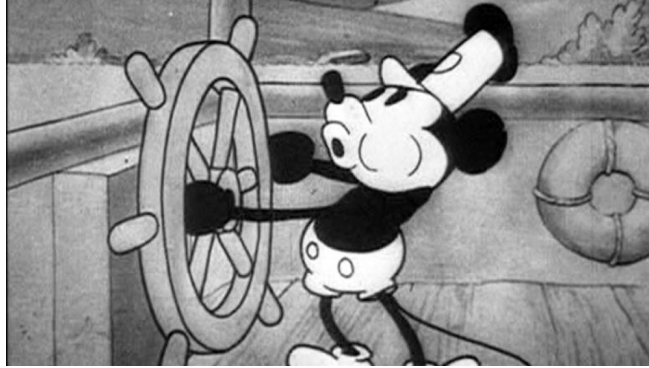
- **Counterclaims must be related to the original claim** Counterclaims (claims brought by a respondent against the claimant) are limited to the types of claims in the CCB’s jurisdiction, plus contract issues related to those claims, and must arise out of the same “transaction or occurrence” (that is, the same facts and circumstances) and involve the same copyrighted work as the original claim.
- **Monetary damages are capped at \$30,000.** Successful copyright infringement claims can choose to recover either statutory damages (in specific dollar ranges set by the law), or actual damages and the infringer’s profits (calculated based on the factual evidence. Because of these rules, in most cases, amounts the CCB would order respondents to pay successful claimants would be lower than those available in federal court. In federal court, actual damages are not capped, and statutory damages can reach \$150,000 for each work if the infringement was knowing or deliberate.

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2023 COPYRIGHT – LOOKING FORWARD



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Chapter 4

Presentation Slides: Leahy-Smith America Invents Act: 10 Years Later

PETER AYERS

US Patent and Trademark Office—Office of the Solicitor
Alexandria, Virginia

Leahy-Smith America Invents Act: 10 Years Later

Presented to the IP Section of the Oregon State Bar
February 24, 2023

<p>125 STAT. 284 PUBLIC LAW 112–29—SEPT. 16, 2011</p> <p>Public Law 112–29 112th Congress</p> <p>An Act</p> <p><small>Sept. 16, 2011 [H.R. 1249]</small></p> <p><small>Leahy-Smith America Invents Act.</small></p> <p><small>35 USC 1 note.</small></p> <p>To amend title 35, United States Code, to provide for patent reform.</p> <p><i>Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,</i></p> <p>SECTION 1. SHORT TITLE; TABLE OF CONTENTS.</p> <p>(a) SHORT TITLE.—This Act may be cited as the “Leahy-Smith America Invents Act”.</p> <p>(b) TABLE OF CONTENTS.—The table of contents for this Act is as follows:</p> <p>Sec. 1. Short title; table of contents. Sec. 2. Definitions. Sec. 3. First inventor to file. Sec. 4. Inventor’s oath or declaration. Sec. 5. Defense to infringement based on prior commercial use. Sec. 6. Post-grant review proceedings. Sec. 7. Patent Trial and Appeal Board.</p> <p>SEC. 2. DEFINITIONS.</p> <p>In this Act:</p> <p>(1) DIRECTOR.—The term “Director” means the Under Sec- retary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.</p>	<p>Public Law 112–29 112th Congress</p> <p>Sept. 16, 2011 [H.R. 1249]</p> <p>Leahy-Smith America Invents Act.</p> <p>35 USC 1 note.</p> <p>Sec. 3. First inventor to file. Sec. 4. Inventor’s oath or declaration. Sec. 5. Defense to infringement based on prior commercial use. Sec. 6. Post-grant review proceedings. Sec. 7. Patent Trial and Appeal Board. Sec. 8. Preissuance submissions by third parties. Sec. 9. Venue.</p>
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AIA: Post Grant Review Proceedings

1. Inter Partes Review

- Within 1 year of being served
- 102/103 challenges
- Based on patents and printed pubs

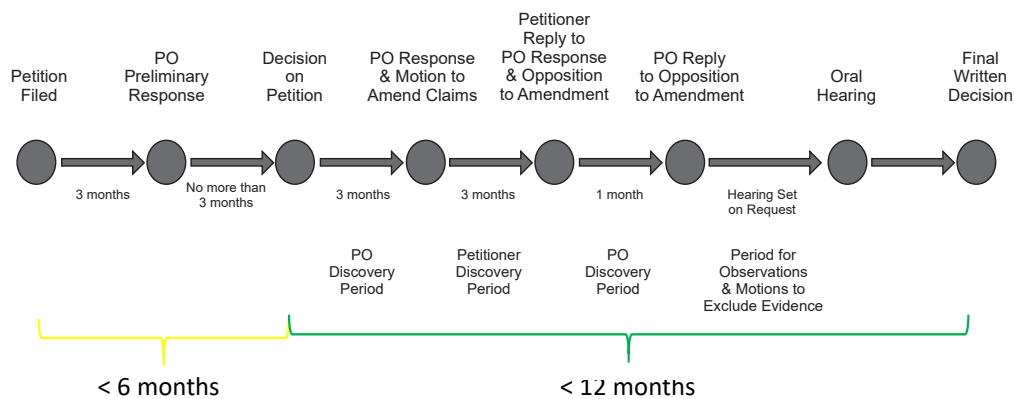
2. Post Grant Review

- 9 month post-issuance window
- 101/102/103/112 challenges

3. Covered Business Method Review

- Covered business method patents
- Not technological inventions
- Article III standing
- 101/102/103/112 challenges
- Now sunset

AIA: (Original) Trial Schedule

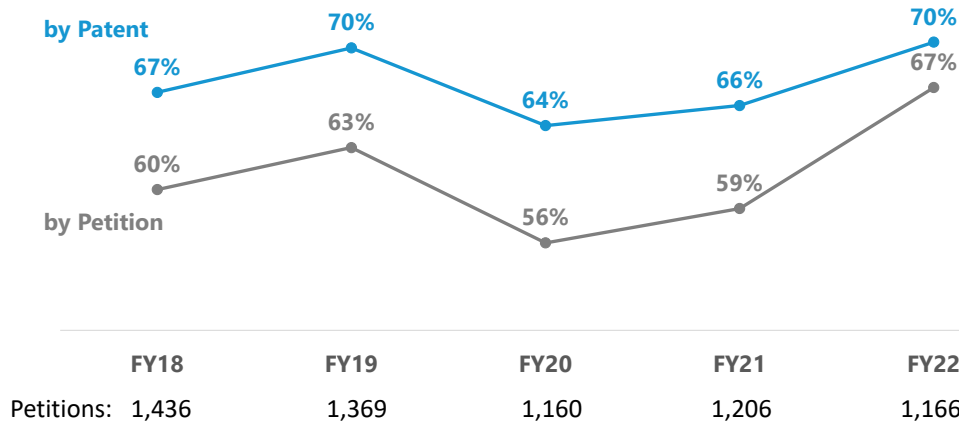


Total: 18 months from Petition to FWD!

AIA: Historical PTAB Institution

Institution rates by patent and by petition

(FY18 to FY22: Oct. 1, 2017 to Sept. 30, 2022)



AIA: Claim Construction

Broadest Reasonable Interpretation (BRI):

“the ***broadest reasonable meaning of the words*** ... as they would be understood by one of ordinary skill in the art, ***taking into account ... the applicant's specification.***” *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997) (emphasis added).

Federal Court Interpretation:

“construing the claim in accordance with ***the ordinary and customary meaning*** of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b) (emphasis added).

Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 FR 51,340 (Oct. 11, 2018).

AIA: Discretionary Denial

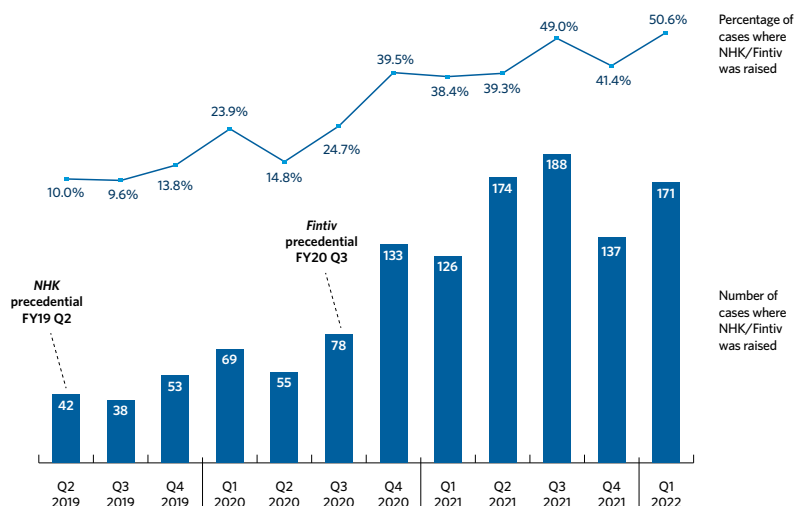
1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Apple Inc. v. Fintiv, Inc., Case No. IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential), available at <https://www.uspto.gov/patents/ptab/decisions-and-opinions/precedential>.

AIA: Discretionary Denial

FIGURE 2

NHK/Fintiv Issue Frequency

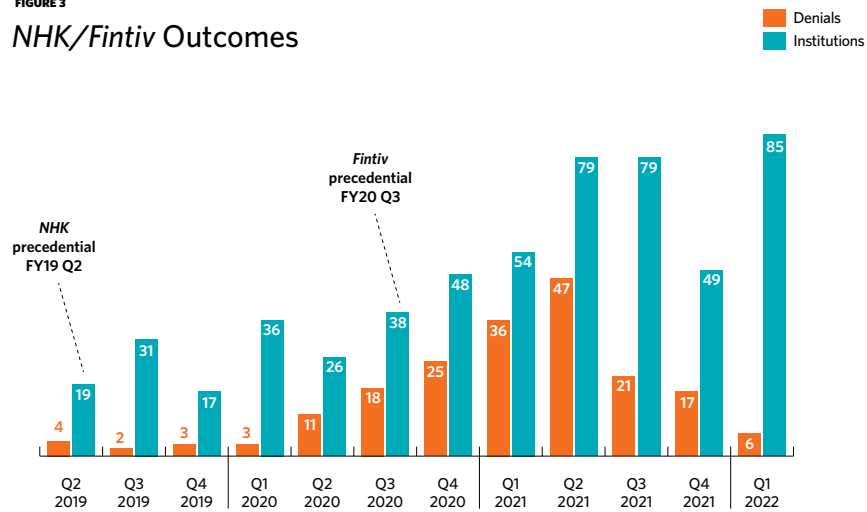


[PTAB parallel litigation summary executive report \(uspto.gov\)](#) (June 21, 2022).

AIA: Discretionary Denial

FIGURE 3

NHK/Fintiv Outcomes



Starting in the third quarter of fiscal year 2021, Fintiv denials dropped significantly.

[PTAB parallel litigation summary executive report \(uspto.gov\)](https://www.uspto.gov/patent/ptab/parallel-litigation-summary-executive-report) (June 21, 2022)

AIA: Discretionary Denial

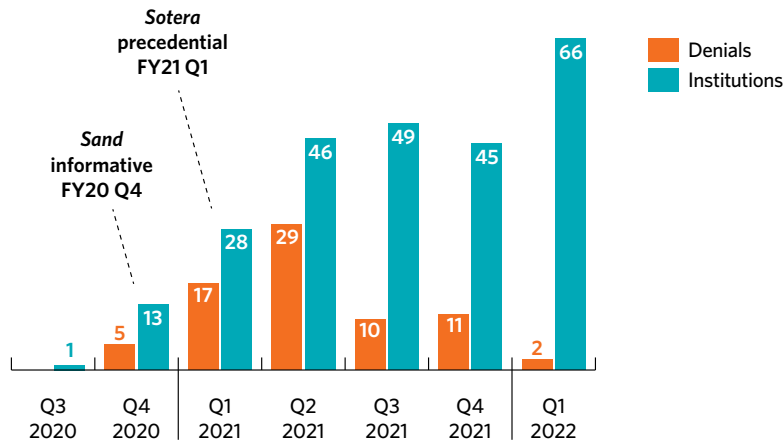
“Sand Revolution” Stipulation: “if the IPR is instituted, Petitioner will not pursue **the same grounds** in the district court litigation.” *Sand Revolution II, LLC v. Cont’l Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24 at 11-12 (PTAB June 16, 2020) (informative).

“Sotera” Stipulation: “Petitioner broadly stipulates to not pursue ‘any ground raised or that **could have been reasonably raised.**’” *Sotera Wireless, Inc. v. Masimo Corporation*, IPR2020-01019, Paper 12 at 18 (PTAB Dec. 1, 2020) (precedential § II.A)

AIA: Discretionary Denial

FIGURE 5

NHK/Fintiv Outcomes with Stipulations



[PTAB parallel litigation summary executive report \(uspto.gov\)](https://www.uspto.gov/parallel-litigation-summary-executive-report)

AIA: Discretionary Denial

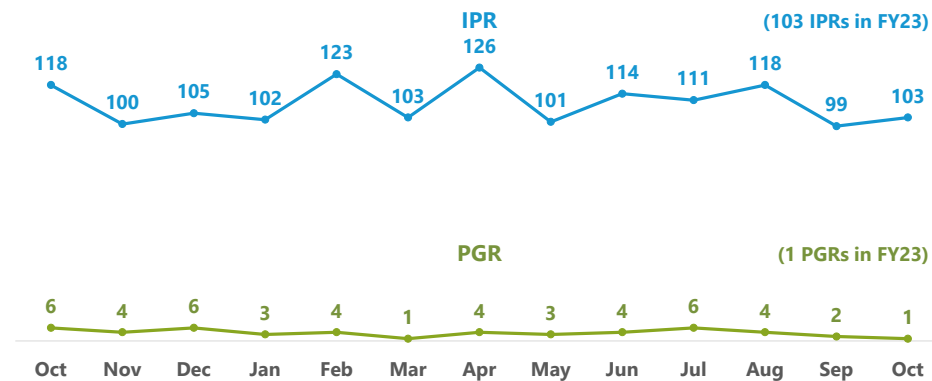
- Under new Interim Procedures, PTAB will not deny institution of an IPR or PGR under *Fintiv* when:
 - A request for denial under *Fintiv* is based on a parallel ITC proceeding
 - A petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition
 - A petition presents compelling evidence of unpatentability
- PTAB will consider the speed with which the district court case may come to trial based on recent time-to-trial statistics and other evidence
- PTAB may still deny under §§ 314(a), 324(a), and 325(d).

"INTERIM PROCEDURE FOR DISCRETIONARY DENIALS," (June 21, 2022), available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf

AIA: FY2022 PTAB Petitions

Petitions filed by month

(Oct. 2022 and Previous 12 Months: Oct. 1, 2021 to Oct. 31, 2022)



FY22 Total Petitions: 1,367

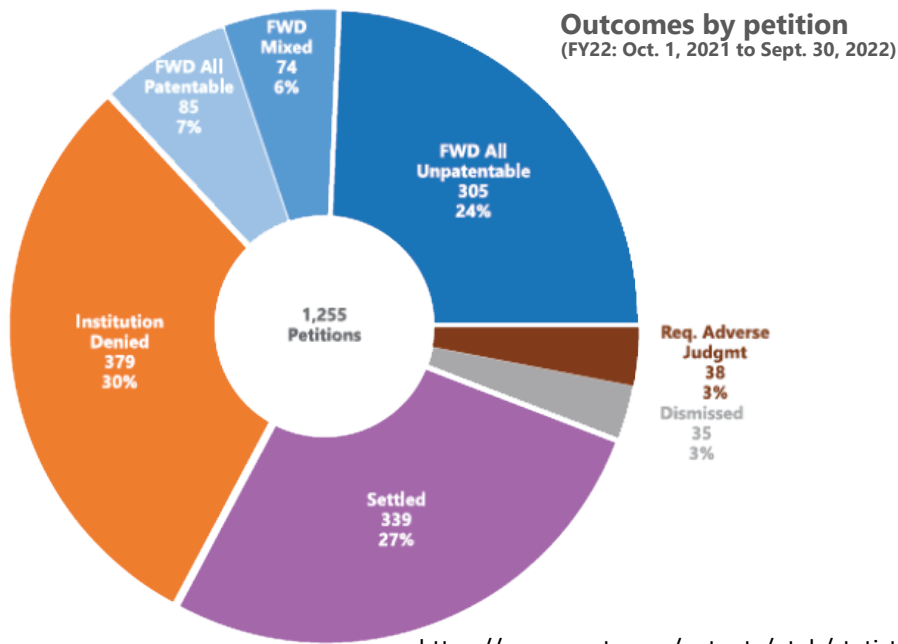
<https://www.uspto.gov/patents/ptab/statistics>

AIA: MTA Pilot Program

- Provides patent owner (PO) with two options not previously available:
 - Option 1: PO may choose to receive preliminary guidance (PG) from Board on its motion to amend (MTA).
 - Option 2: PO may choose to file a revised MTA after receiving petitioner's opposition to initial MTA and/or after receiving Board's PG (if requested).
- Option 1 is not a predicate for Option 2.
- Applies to all AIA trials instituted on or after publication date of the notice (i.e., March 15, 2019)

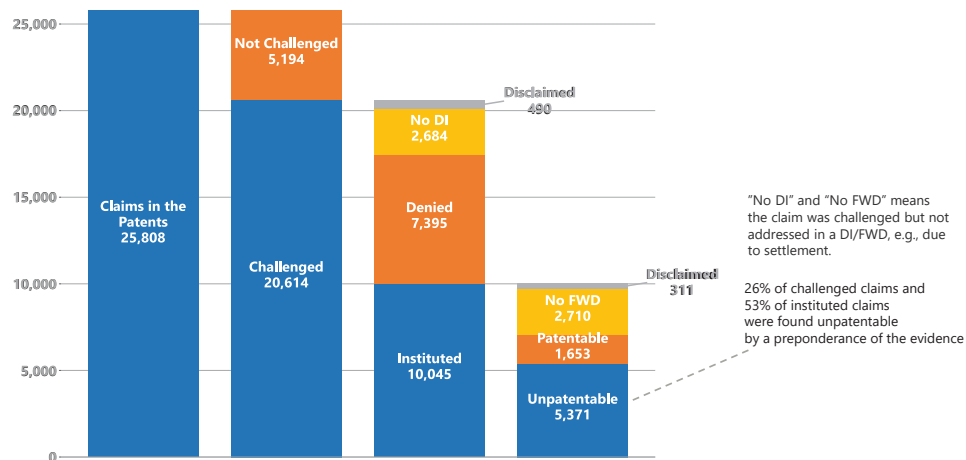
Notice Regarding a New Pilot Program, 84 FR 9497 (March 15, 2019); *see also* Extension of the Patent Trial and Appeal Board Motion To Amend Pilot Program, 87 FR 60134 (Oct. 4, 2022) (extending MTA Pilot Program until September 16, 2024)

AIA: FY2022 PTAB Outcomes



AIA: FY2022 PTAB Outcomes

Claim outcomes (FY22: Oct. 1, 2021 to Sept. 30, 2022)



<https://www.uspto.gov/patents/ptab/statistics>

AIA: Supreme Court Cases

- *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261* (2016)
- *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018)
- *Oil States Energy Services, LLC V. Green’s Energy Grp., LLC*, 138 S. Ct. 1365 (2018)
- *Return Mail, Inc. v. USPS*, 139 S. Ct. 1853 (2019)
- *Thryv, Inc. v. Click-to-Call Techs., LP*, 140 S. Ct. 1367 (2020)
- *United States v. Arthrex, Inc.*, 141 S. Ct. 1970 (2021)

AIA: ‘12 Federal Circuit Cases

	<u>Pending</u>	<u>Filed</u>
Total	884	1,356
Board of Contract Appeals	12	17
U.S. Court of International Trade	38	40
U.S. Court of Federal Claims	131	147
U.S. Court of Appeals for Veterans Claims	127	208
U.S. District Courts	354	473
Department of Justice ¹	0	1
Department of Veterans' Affairs	5	1
International Trade Commission	20	16
Merit Systems Protection Board	101	272
Office of Compliance	2	2
Patent & Trademark Office	81	138
Petitions for Writs ²	13	41

Federal Circuit Federal Judicial Caseload Statistics (March 31, 2012), available at https://www.uscourts.gov/sites/default/files/statistics_import_dir/B08Mar12.pdf.

AIA: '22 Federal Circuit Cases

Total	<u>Pending</u> 1,390	<u>Filed</u> 1,390
Army Board for Correction of Military Records	-	1
Board of Contract Appeals	17	17
U.S. Court of International Trade	54	62
U.S. Court of Federal Claims	280	158
U.S. Court of Appeals for Veterans Claims	98	125
U.S. District Courts	258	267
Department of Commerce	-	1
Department of Education	-	1
Department of Justice ¹	2	-
Department of Veterans Affairs	13	-
Equal Employment Opportunity Commission	1	-
International Trade Commission	24	20
Merit Systems Protection Board	94	121
Office of Compliance	-	1
Office of Personnel Management	-	1
Patent and Trademark Office	532	517
Social Security Administration	-	1
Petitions for Writ ²	17	97

Federal Circuit Federal Judicial Caseload Statistics (March 31, 2022), available at <https://www.uscourts.gov/statistics/table/b-8/federal-judicial-caseload-statistics/2022/03/31>.

AIA: Federal Circuit Cases

- *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017) (en banc)
- *Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364 (Fed. Cir. 2018) (en banc)
- *Click-to-Call Techs., LP v. Ingenio, Inc.*, 899 F.3d 1321 (Fed. Cir. 2018) (en banc)

AIA: PTO Rules

- 37 CFR § § 42.1 et seq.
- *PTAB Rules of Practice for Instituting on All Challenged Claims and All Grounds*, 85 FR 79,120 (Dec. 9, 2020), available at <https://www.uspto.gov/sites/default/files/documents/85FR79120.pdf>.
- *Rule to Allocate Burdens of Persuasion on Motions to Amend*, 85 FR 82,923 (Dec. 21, 2020), available at <https://www.uspto.gov/sites/default/files/documents/FinalRuleMTABurdens.pdf>.
- *Request for Comments on Director Review, et al.*, 87 FR 43,249 (July 20, 2022), available at <https://www.govinfo.gov/content/pkg/FR-2022-07-20/pdf/2022-15475.pdf>.

AIA: PTO Resources

- *Precedential and Informative Decision*, available <https://www.uspto.gov/patents/ptab/precedential-informative-decisions>.
- *Office Patent Trial Practice Guide*, 77 FR 48,756 (Aug. 14, 2012), available https://www.uspto.gov/sites/default/files/ip/boards/bpai/trial_practice_guide_74_fr_48756_081412.pdf.
 - August 2018 and July 2019 Updates to TPG, available at <https://www.uspto.gov/patents/ptab/trial-practice-guide-july-2019-update>.
- *Interim process for Director Review*, available <https://www.uspto.gov/patents/patent-trial-and-appeal-board/interim-process-director-review>; see also *Status of Director review requests*, available at <https://www.uspto.gov/patents/patent-trial-and-appeal-board/status-director-review-requests>.
- *Standard Operating Procedures*, available at <https://www.uspto.gov/patents/ptab/resources/board-procedures>.

Questions?