



*Analysis of Recent U.S.
Supreme Court Intellectual
Property Decisions from
Copyrights and Patents to
Civil Liability and Attorney
Fees*





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She has worked continuously and exclusively as an attorney since she graduated from law school. Ms. Naumann established her own practice in 1996 which is exclusively intellectual property law. Ms. Naumann's practice includes individual entrepreneurs and start-up companies, as well as small and medium sized businesses. Her issued patents include a broad range of technologies including: a razor handle, board game, agricultural method, pneumatically driven trench shoring device, floral containers, electromechanical lock, laminar flow nozzle, portable exercise devices, mechanical bag holder and shelving. When necessary, she has filed successful patent application appeals in the Patent & Trademark Office on behalf of clients.

Ms. Naumann has obtained trademark registrations, copyright registrations and design patents on behalf of artists, writers and companies. In addition to obtaining intellectual property protection through government agencies, She advises and drafts documents for ownership, shop rights, works for hire, transfers of rights, licenses, permissions, rescission, consents, distribution agreements, non-disclosure agreements, releases, trade secrets, proprietary information and web sites.



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Course Description

Course Presentation

- II. U.S. Supreme Court cases and issues reviewed
 - A. Application of issue preclusion and res judicata in trademark infringement litigation;
 - B. Copyright eligibility for software;
 - C. Statutory interpretation regarding whether there is a willful requirement for an award of trademark infringement profits;
 - D. Proper characterization of generic vs. descriptive marks when an asserted mark is a combination of two generic terms;
 - E. Whether state sovereign immunity is a defense to disputed copyright infringement of a private work;
 - F. Whether the patent office is entitled to an award of attorney fees pursuant to a 35 U.S.C. section 145 proceeding;
 - G. Whether a party is civilly liable for trademark infringement of a licensor's mark outside the United States;
 - H. Whether the inter parte review statute authorizes judicial review of the timeliness of the submission of the initial statutory petition.

This course provides an in-depth examination in intellectual property for any attorney.

Course Material

This material is intended to be a guide in general and is not legal advice. If you have any specific question regarding the state of the law in any particular jurisdiction, we recommend that you seek legal guidance relating to your particular fact situation.

The course materials will provide the attendee with the knowledge and tools necessary to identify the current legal trends with respect to these issues. The course materials are designed to provide the attendee with current law, impending issues and future trends that can be applied in practical situations.



Course Learning Objectives and Outcomes

Participants will gain the ability to understand the duties, roles and responsibilities of counsel in situations involving interpretation of U.S. Supreme Court Opinions;

Participants will become aware of the most recent U.S. Supreme Court intellectual property decisions which primarily address statutory interpretation;

Participants will learn to advise their clients whether profits from infringement litigation are worth risking if the courts award large damages to intellectual property owners and trademark statute provisions awarding infringement damages;

Participants will learn the scope of generic and descriptive trademarks and service marks;

Participants will learn possible exceptions to state sovereign immunity for copyright infringement and;

Participants will gain practical skills in the area of: writing briefs and presenting oral arguments in the patent office or Federal Circuit would be greatly facilitated with knowledge of the Supreme Courts (i) most recent intellectual property decision and (ii) the most significant Defends Secret Act judicial decisions.

Participants will gain practical skills to advise clients on which procedural steps to take depending upon their individual circumstances and their business circumstances.

Upon completion of the course, participants should be able to apply the course material; improve their ability to research, plan, synthesize a variety of sources from authentic materials, draw conclusions; and demonstrate an understanding of the theme and concepts of the course by applying them in their professional lives.

Timed Agenda:

Presenter Name: Adrienne B. Naumann

CLE Course Title: Analysis of Recent U.S. Supreme Court Intellectual Property Decisions from Copyrights and Patents to Civil Liability and Attorney Fees

Time Format (00:00:00 - Hours:Minutes:Sec onds)	Description
00:00:00	ApexCLE Company Credit Introduction
00:00:20	Recent U.S. Supreme court Intellectual Property Decisions
00:00:28	CLE Presenter Introduction
00:00:52	CLE Substantive Material Presentation Introduction
00:00:52	The Defend Trade Secrets Act of 2016 and misappropriation
00:02:39	U.S. Supreme Court Intellectual Property Decisions 2019 – 2020
00:03:04	Peter v. NantKwest, Inc., 589 U.S. ____ (2019)
00:10:27	Expenses and Attorney Fees
00:20:10	Lucky Brand Dungarees, Inc. v. Marcel Fashions Group, Inc., 590 U.S. ____ (2020)
00:32:00	Computer Software Protection
00:33:50	Google LLC v. Oracle America, Inc., ____ U.S. ____ (2020)
00:41:59	Congress's Constitutional Authority
00:42:08	Allen et al. v. Cooper et al., 589 U. S. ____ (2020)
00:51:59	The meaning of Generic Terms
00:55:40	United States Patent & Trademark Office v. Booking.com B.V., ____ U.S. ____ (2020)
00:59:59	The Lanham Act 15 U.S.C. 1117(a)
01:00:09	Romag Fasteners v. Fossil Inc. et al., 590 U. S. ____ (2020)
01:04:15	Presenter Closing Comments
01:04:33	ApexCLE Company Closing Credits
01:04:41	End of Video



Analysis of Recent U.S. Supreme Court Intellectual Property Decisions from Copyrights and Patents to Civil Liability and Attorney Fees

United States Supreme Court

I. Peter v. NantKwest, Inc., 589 U.S. (2019)

A. Issue for the Court: Whether the phrase “all the expenses of the proceedings” within 35 U.S.C. section 145 includes attorney fees of the United States patent office [hereinafter ‘patent office’] incurred during section 145 litigation.

B. Background

1. Section 145 provides an alternative to a direct appeal to the Federal Circuit from a patent applicant’s unsuccessful outcome at the Patent Trial and Appeal Board.
2. However, under section 145 the applicant is responsible for expenses of this proceeding without regard to which party prevails.
3. Background
 - a. After a section 145 proceeding the district court awarded expert witness fees to the patent office, but not attorney fees.
 - b. The Federal Circuit en banc affirmed the district court.

C. The patent office’s position before the Court

1. The American Rule is not applicable, because reimbursement of expenses per section 145 does not depend upon prevailing party status.
 - a. the American rule directs that each party pay their own litigation expenses including attorney fees, unless a statute or enforceable contract clearly states to the contrary.
1. The modifier ‘all’ in section 145 confirms that the applicant should reimburse more than a subset of the patent office’s expenses.
2. The common meaning of the term ‘expenses’ historically includes attorney fees.
3. The statutory phrase “all the expenses of the proceedings” is sufficiently specific for the award of attorney fees.

D. NantKwest's position before the Court

1. The American rule applies whenever there is fee shifting.
2. Under the American Rule, fee shifting is only possible if there are specific and explicit statutory provisions or enforceable contracts for doing so.
3. This Court has repeatedly applied the American Rule to statutes which do not require a prevailing party.
4. Section 145 does not explicitly authorize attorney fees but only "expenses."

E. The Supreme Court decision

1. The American Rule is not limited to statutes or contracts which require a prevailing party status.
 - a. under the American Rule, each litigant pays its own attorneys' fees, win or lose, unless a statute or contract clearly provides otherwise.
2. The terms 'expense' in section 145 does not include attorney fees, because there is insufficient clarity to justify departing from the American Rule.
 - a. the term "expenses" in section 145 was not commonly understood to include attorney fees at its enactment.
 - b. the modifier 'all' does not transform expenses to include fees that it would not otherwise include.

II. **Thryv Inc. v. Click-to-Call Technologies, LP et al** **., 590 U.S. (2020)**

A. Issue: Whether 35 U.S.C. 314(d) permits appeals of the timeliness of commencement for inter parties review [hereinafter IPR] under 35 U.S.C. 315(b).

B. Background

1. After an IPR Click-to-Call appealed to the Court of Appeals for the Federal Circuit [hereinafter 'Federal Circuit'].
2. Click-to-Call contended that the IPR should never have commenced, because



- a. Thryv did not submit its initial petition until after the statutory deadline to do so. 35 U.S.C. 315 (b).
- b. the Federal Circuit agreed with Click-to-Call, and
 - (1) vacated the Board's IPR decision and
 - (2) instructed the Board to dismiss the IPR.

C. Thryv's position before the Court

1. Untimely submission of the initial petition submission deadline under section 315(b) is not appealable under section 314(d), because
2. Under section 314(d), judicial review is precluded where
 - a. the grounds for challenging commencement or non-commencement of IPR
 - (1) are closely tied to statutes relating to the decision to commence IPR, and
 - (2) here, the timelines for submitting the IPR petition were closely tied to the statute related to the commencement decision, i.e., 35 U. S.C. section 315.
3. The American Invents Act (AIA) precludes judicial review of the section 315(b) deadline under section 314(d),
 - a. to achieve a shorter proceeding and greater cost-effectiveness than analogous proceedings in a trial court.

D. Click-to-Call's position before the Court

1. Not all appeals related to IPR commencement are barred by section 314(d), including those arising outside section 314 such as section 315(b).
2. "Under this section" in section 314(d) by its terms does not include the petition submission deadline of section 315(b).
3. In any event, courts may set aside Board decisions which exceed agency statutory authority.

E. The Court's decision

1. The Court reversed and remanded the Federal Circuit decision by relying in large part upon
2. *Cuozzo Speed Technologies, LLC v. Lee*, 136 S. Ct. 2131(2016) which held that
 - a. section 314(d) bars appeal of the patent office's decision to commence an IPR



- (1) where the grounds for attacking this decision are closely tied to the decision to initiate IPR.
 - b. an untimeliness attack under section 315(b) is closely tied because it describes a circumstance in which IPR may not be instituted.
- 3. section 314(d) does not limit the appeal prohibition to section 314(a).
- 4. SAS Institute, Inc. v. Iancu, 138 S. Ct. 1348 (2018) is distinguishable,
 - a. because it challenged the review process itself once instituted, but
 - b. not whether the agency should have initiated the review process in the first instance, and
 - c. the agency decision in SAS was therefore appealable.
- 5. any other interpretation would thwart the IPR statute's purpose
 - a. to provide a streamlined process that is
 - b. less costly and less time consuming than conventional litigation in courts.

III. Lucky Brand Dungarees, Inc. v. Marcel Fashions Group, Inc., 590 U.S. (2020)

A. Issue: Whether a party may raise defenses (i) which were not litigated during a prior related proceeding between the same parties, and (ii) where the claim for relief in the previous proceeding was different from the claim in the subsequent proceeding.

B. Background

- 1. In 2003 Lucky Brand and Marcel entered into a settlement agreement wherein Lucky Brand would refrain from using Marcel's federally registered mark "Get Lucky."
 - a. Marcel agreed to cease challenging Lucky Brand's marks comprising the word "Lucky."
- 2. After subsequent litigation, in 2005 a court entered judgment that Lucky Brand infringed Marcel's mark "Get Lucky."
 - a. Lucky Brand's remaining marks comprising the word "Lucky" were not fully addressed in this lawsuit, and
 - b. were absent from the final judgment.
- 2. In 2011 Marcel brought yet another lawsuit against Lucky Brand for trademark infringement occurring after the 2005 judgment,

- a. and directed against Lucky Brand's marks comprising the word 'Lucky,' but not for infringement of "Get Lucky."
- b. Lucky Brand then raised the defense that trademark infringement for marks comprising the word 'Lucky' was released by the 2003 settlement agreement.
- c. the district court dismissed Marcel's claims, but
- d. after a prior appeal, the Court of Appeals for the Second Circuit vacated the district court's decision and remanded.

C. Lucky Brand's position before the Court

- 1. The 2005 and 2011 lawsuits demonstrated different conduct, liability theories and time intervals.
 - a. claim preclusion only applies to
 - (1) claims actually resolved in the prior case, and
 - (2) does not bar claims arising from distinct albeit related transactions,
- 2. A claim relying upon events that postdate a prior case are not identical to the prior case's claims and circumstances
 - a. therefore claim preclusion or defense preclusion does not apply in the subsequent lawsuit.

D. Marcel Fashion's position before the Court

- 1. Res judicata precludes a subsequent claim where there is a common nucleus of operative facts, the same transaction or series of transactions as those of earlier litigation.
 - a. here Lucky Brand continues to willfully infringe with marks comprising the word "Lucky"
 - (1) in an identical manner, and
 - (2) for identical goods for which they were found liable in the 2005 judgment, and
 - c. furthermore, in the 2005 litigation Marcel had no opportunity to obtain damages from infringement which had not yet occurred.
 - d. defense preclusion also bars a defendant from converting a previously overlooked defense into a claim.
- 2. The Second Circuit correctly applied defense preclusion, because
 - a. the 2011 litigation and 2003 litigation comprise a common nucleus of operative facts, and
 - b. Lucky Brand could have pursued the settlement defense during the 2005 litigation, but chose not to do so.

E. The Court's decision

- a. The appellate decision was reversed and remanded.
- b. Marcel's 2011 lawsuit addressed different conduct and different claims from the 2005 lawsuit, as well as at different times
 - 1. these two lawsuits did not share a common nucleus of operative facts,
 - 2. because the 2005 lawsuit depended exclusively upon use of the phrase 'Get Lucky' while
 - 3. the 2011 litigation addressed use of Lucky Brand's marks only comprising the word "lucky."
- c. so Lucky Brand was not precluded from raising this defense to Marcel's claim for trademark infringement by completely different marks.

IV. Georgia v. PublicResources.org, 590 U.S. (2020)

A. Issue: Whether annotations which are part of an official state statute code are copyright eligible.

B. Background

- 1. The State of Georgia [Georgia] contracted with a private company to initially draft annotations as part of the state official code comprising statutes.
 - 2. Georgia published this official state legislative code online without fees, but it did not publish the annotations.
 - 3. Public Resources published the annotations online without Georgia's permission.
- 1. The district court found that the annotations by themselves were copyright eligible.
 - 2. The Federal Court of Appeals for the Eleventh Circuit reversed, because
 - a. under the government edits doctrine, legislative works and judicial decisions are not copyright eligible
 - b. in this instance the state legislature incorporated the annotations as part of its official legislative code, and
 - (1) intermingling of annotations with the statutes created a unified work owned by Georgia's state government.

C. Georgia's position before the Court

1. while the statutes by themselves are not copyright eligible, works summarizing or discussing the statutes are copyright eligible.
 - a. the government edits doctrine requires force of law for government works to be copyright-ineligible, and
 - b. these annotations initially prepared by a private company do not comprise force of law.
2. Without copyright protection there is no financial incentive for private entities to provide annotations for Georgia.
3. Georgia's free online statutes satisfy due process.

D. Public Resources' position before the Court

1. Under this Court's government edits doctrine, any works created in the course of duties of government officials are not copyright eligible.
2. The government edits doctrine applies here, because
 - a. the annotations combined with the statutes are published under state authority,
 - b. this combined work is created through a legislative commission, and
 - c. force of law is not necessary for a government work to be copyright ineligible under this doctrine.

E. The Court's decision

1. The Court affirmed the Eleventh Circuit decision.
 - a. the commission which supervised the draft and inclusion of the annotations was part of the state legislature, and
 - b. the annotations are an integral part of the official state legislative code.
2. The correct question under the government edits doctrine is not
 - a. whether the annotations have force of law, but
 - b. whether they are prepared by a judge or a legislator as part of their official duties.
3. any other result would prevent citizens from learning which statutes were unenforceable by judicial decisions because of a "pay-wall."

V. Google LLC v. Oracle America, Inc., U.S. (2020)

A. Issues

1. Whether United States copyright protection extends to (i) software code comprising instructions within a computer program, and (ii) organization of this computer program; and
2. If so, does Google's incorporation of this same software code and organization into a commercially competing product comprise fair use.
 - a. fair use is a defense to copyright infringement where the factors for lawfully copying a portion of another's work without authorization include:
 - (1) a commercial purpose,
 - (2) critical significance of the copied portion,
 - (3) the quantitative extent of the copied portion, and
 - (4) the transformation of the copied portion

B. Background

1. Oracle and its predecessor Sun developed the computer program platform Java SE, and which included Java SE's organization and command hierarchy.
 - a. without Oracle's authorization, Google copied instruction code, known as declarations, into its own Android program for mobile devices.
2. The district court held that Oracle's declarations were not copyright eligible, although they were creative and original.
3. Upon a second appeal, the Federal Circuit reversed, because
 - a. Oracle's declarations and organization of Java SE were copyright-eligible, and
 - b. there was no fair use because Google copied for a commercial advantage.

C. Google's position before the Court

1. Oracle's declarations are not copyright eligible.
 - a. the declarations comprise methods of operation which are excluded from protection under section 102(b) of the copyright statute.

- b. the merger doctrine applies, because Oracle’s declarations cannot be written in any other manner and still properly respond to Java SE programs
 - (1) under the merger doctrine if there are only one if a few tangible expressions for an idea,
 - (2) then those tangible expressions merge with the idea and the tangible expressions are not copyright eligible.
 - c. Oracle’s declarations comprise short phrases without copyright eligibility
 - d. copyright protection does not extend to components of the entire JAVA SE platform
 - (1) such as declarations or the Java SE organization
 - 2. Even if the Java SE declarations and organization are copyright-eligible, there was fair use.
 - a. Google’s use of Oracle’s declarations was sufficiently transformative, and
 - b. where transformation requires the copied portion be significantly changed in appearance, content and/or purpose to qualify as fair use.
 - (1) Google created its own voluminous new code to include in Android, and
 - (2) Google also created entirely new code libraries including new instructions for functions necessary to operate modern smartphones
 - c. Google only incorporated a small percentage of Java SE

D. Oracle’s position before the Court

- 1. Copyright eligibility
 - a. the Copyright Act explicitly protects all computer programs if sufficiently original and creative
 - (1) Google previously conceded that Oracle’s works meet this requirement.
 - b. copyright only protects unique expression and not underlying ideas
 - (1) Oracle’s declaration code and organization are protected because they are tangible expression and not ideas
 - c. the merger doctrine is inapplicable,

- (1) because Oracle’s original software developers confronted limitless options for crafting the JAVA SE declarations and organization.
 - (1) Google could have independently created appropriate software programs, other than copying Oracle’s declarations and organization,
 - (2) for functions identical to those of JAVA SE.
- 2. Fair use
 - a. Google’s use of Oracle’s code is not transformative, because
 - (1) Google used the copied code for its original purpose without changing its expression, meaning or message.
 - b. Google’s product Android containing the copied code is now a strong competitor in Oracle’s market.
 - c. Oracle’s creative choices, including declaration and organization, were critical to JAVA SE’s success, and
 - (1) so the quantitative amount that Google copies is irrelevant under these circumstances.

VI. Allen et al. v. Cooper et al., 589 U. S. (2020)

A. Issue: Whether Congress possessed the constitutional authority to enact the Copyright Remedy Clarification Act [hereinafter the CRCA] under

- (i) the intellectual property clause of Article I, and/or
- (ii) section 5 of the Fourteenth Amendment

B. Background

- 1. In 1990 Congress passed the CRCA to provide private persons money damages for copyright infringement by the states.
- 2. Mr. Allen filmed a historic shipwreck in a venture with the State of North Carolina [hereinafter ‘North Carolina’]
 - a. he thereafter registered copyrights for his photography and films.
 - b. a North Carolina state agency subsequently displayed some of these works online without Allan’s permission.
- 3. The district court

- a. CRCA validly abrogates state sovereign immunity under section 5 of the Fourteenth Amendment [hereinafter 'section 5'] and,
 - (1) this abrogation is congruent and proportional to a clear pattern of abuse by the states, but
 - b. CRCA does not validly abrogate under the Constitution's intellectual property clause in Article 1.
- 4. The Federal Court of Appeals for the Fourth Circuit reversed, because
 - a. the record was unclear whether Congress relied upon section 5 when enacting CRCA, and
 - b. CRCA was not a congruent and proportional remedy for the asserted section 5 injury, i.e., deprivation of personal property(copyright) without due process.

C. Allen's position before the Court

- 1. The intellectual property clause authorizes Congress to abrogate state immunity from lawsuits of private parties.
 - a. in *Central Virginia Community College v. Katz*, 546 U.S. 356 (2006), this Court applied a clause by clause analysis of Article I for sovereign immunity abrogation, and
 - (1) held that the bankruptcy clause of Article 1 authorized Congress to abrogate this immunity
 - (2) analogously, the intellectual property clause of Article 1 is eligible for a clause by clause review.
- 2. CRCA is also a valid exercise of Congressional authority for abrogation of state sovereign immunity under section 5 of the Fourteenth Amendment.
 - a. copyright is property which requires due process for deprivation by the government, and
 - b. The CRCA is a congruent and proportional response to the states' record of copyright infringement.

D. North Carolina's position before the Court

- 1. Article 1 and the intellectual property clause
 - a. the *Katz* decision results from the unique history of the Article I Bankruptcy Clause, and
 - b. this history and decision is not relevant to the intellectual property clause question presented here.
- 2. CRCA is not a valid exercise of section 5 because in its enactment

- a. there was no Congressional record of widespread state unconstitutional conduct, and
- b. Congress did not address
 - (1) whether states intentionally infringed or otherwise created a due process problem, and
- c. therefore, the CRCA as a remedy is not proportional to any asserted constitutional grievance.
- d. copyright holders may pursue other currently available remedies in state courts such as unjust enrichment.

E. The Court's decision

- 1. Congress had no constitutional authority to pass the CRCA under the intellectual property clause of Article 1, because
 - a. The Katz holding resulted from the historical need to eliminate disparity in bankruptcy remedies among the states, and
 - (1) this history demonstrates that at the bankruptcy clause's inception, the federal government could subordinate state sovereignty.
 - b. instead, Florida Prepaid Postsecondary Education Expense Board v. College Savings Bank, 527 U. S. 627(1999) controls
 - (1) Florida Prepaid held that Congress had no constitutional authority to abrogate state sovereign immunity for patent infringement claims.
- 2. Congress had no authority under section 5 of the Fourteenth Amendment.
 - a. there must be congruence and proportionality between an injury and the statutory remedy therefore, and
 - b. there must be a pattern of intentional conduct for which there is no adequate state remedy to satisfy due process.
 - c. here, there is insufficient evidence of a pattern of intentional conduct by states to infringe, and
 - d. state law remedies are available.

VII. United States Patent & Trademark Office [hereinafter USPTO] v. Booking.com B.V. [hereinafter Booking.com], U.S. (2020)

A. Issue: Whether addition of an internet location entity identifier such as '.com' to a generic term such as 'Booking' may result in a protectable mark?

B. Background

1. The federal trademark examiner found the term 'Booking.com' to be generic for hotel reservation services.
 - a. where 'generic' indicates a word, phrase and/or design that everyone uses to designate a particular subject matter.
 - b. generic words, phrases or designs can never become protectable marks.

Example: Everyone uses the word 'pear' to designate a specific kind of edible fruit.

2. The Trademark Trial & Appeal Board affirmed, but
3. The federal district court found Booking.com to be protectable as a descriptive mark with sufficient evidence of secondary meaning.
 - a. a descriptive mark comprises features of the subject matter. Example, 'big and yellow' describes characteristics of a pear, but not the actual pear itself.
 - b. in contrast to generic terms, descriptive terms may become protectable trademarks
 - (1) if consumers recognize these terms as identifying a particular source for pears i.e., secondary meaning.
4. The Appellate Court of Appeals for the Fourth Circuit affirmed, because
 - a. Booking.com as a whole is not generic, and
 - b. the public perceived this phrase as Booking.com's brand.

C. The USPTO's position before the Court

1. The appellate decision is contrary to Goodyear India & Rubber Glove Manufacturing Co. v. Goodyear Rubber, 128 U. S. 598 (1888)
 - a. Goodyear held that a combination of a corporate entity designation with a generic term does not create a protectable mark.
 - (1) For example, 'Pear Company' can never be registered for a source which sells or grows apples, because



- (i) 'Pear' is a generic word in the English language designating a particular fruit, and
 - (ii) 'Company' is merely a business organization designation
 - (2) analogously, Booking.com could never be a trademark, because '.com' is merely a domain name designation and 'booking' is a generic term for hotel reservation services.
- b. treating 'Booking.com' as a protectable mark
 - (1) prevents competitors from using the word 'booking' in their own domain names and marks.
- 2. The Court of Appeals erred
 - a. in extending secondary meaning to generic terms, and
 - b. even if the public associates a generic term with a single source based upon a vigorous advertising campaign.
 - c. that some trademark examiners may have misinterpreted the law does not change the status and legal consequences of generic terms and phrases.

C. Booking.com's position before the Court

- 1. Whether a mark is generic is a question of fact
 - a. under the primary significance test of the Lanham Act, and
 - b. the inquiry should focus upon the combined terms as a whole, and
 - (1) not upon the individual terms or elements of the proposed mark
- 2. The USPTO improperly seeks a per se rule
 - a. that a class of marks are generic as a matter of law, but
 - b. the government has previously registered generic.com marks such as staples.com, weather.com, and ancestry.com
- 3. The USPTO relies upon Goodyear which is obsolete law since the effective date of the Lanham Act, because
 - a. the Lanham Act relies upon consumer perceptions as the basis for post-registration cancellation, and
 - b. during initial registration proceedings.

D. The Court's decision

- 1. The Court affirmed the Fourth Circuit's decision.
- 2. Because Booking .com is not a generic name to consumers, it is not generic for federal trademark registration.

- a. a 'generic.com' term may convey to consumers a source-identifying characteristic associated with a particular website.
 - b. whether a 'generic.com' term is generic depends upon whether consumers actually perceive that term as (i) the name of a class, or (ii) as a term which distinguishes among members of this class.
3. All descriptive marks, and not exclusively Booking.com could inhibit competition
 - a. so trademark law requires that competitors' use of descriptive logos prevent likelihood of customer confusion.
 - b. Booking.com agrees that federal registration of 'booking.com' would not prevent competitors from using the work 'booking' for their own services.
4. There is no per se rule that combining a generic term with ".com" yields a generic composite.

VIII. Romag Fasteners [hereinafter 'Romag'] v. Fossil Inc. et al. [hereinafter 'Fossil], 590 U. S. (2020)

A. Issue: Whether 15 U.S.C. 1117(a) of the Lanham Act requires willful infringement for an award of an infringer's profits under 15 U.S.C. 1125(a).

B. Background

1. Fossil manufactures leather accessories in China and incorporated Romag's snap fasteners into these products.
 - a. Romag discovered that Fossil's Chinese manufacturer placed counterfeit snap fasteners displaying Romag's mark into Fossil's products.
 - b. Romag then commenced a lawsuit against Fossil for trademark infringement and counterfeiting.
2. The district court held that Romag was not entitled to infringer's profits, because Romag did not prove willful infringement.

C. after an initial appeal, a first certiorari petition and subsequent appeal, the U. S. Court of Appeals for the Federal Circuit affirmed the district court.

D. Fossil's position before the Court

1. The term “principles of equity” in section 1117(a) implicitly incorporates willfulness as a requirement for a profits award
 - a. willfulness was originally required at common law for a profit award, and
 - a. nothing in section 1117(a) supersedes this traditional willfulness requirement.
2. Romag's interpretation enables trademark owners to extort and improperly consolidate market power.

E. Romag's position before the Court

1. Section 1117(a) explicitly provides awards of the infringer's profits under section 1125(a), but an explicit willful violation is only necessary for a violation of 1125(c).
 - a. section 1125(a) does not explicitly include any mental state requirement for a profits award due to trademark infringement, and
 - b. section 1125(c) is clearly distinguishable, because this subsection exclusively addresses mark dilution and not trademark infringement.
2. The Lanham Act as a whole confirms a plain-text interpretation
 - a. if section 1117(a) superimposed an additional willfulness requirement for profits against all infringers,
 - a. then section 1114's diverse states of mind distinguishing among liabilities becomes inconsistent.
3. The ‘principles of equity’ clause of section 1117(a) does not justify an implicit willfulness requirement.
 - a. earlier common law
 - (1) does not supersede current statutory text, and
 - (2) in any event earlier decisions did not uniformly require willfulness for a profits award

F. The Court's decision

1. The Court vacated and remanded the appellate court decision
2. A trademark infringement plaintiff need not establish willful infringement for a profits award.
3. Section 1117(a) refers to section 1125(a), and
 - a. section 1125(a) also does not require willful infringement.

4. Section 1117(a)'s "subject to the principles of equity."
 - a. it is unlikely that Congress intended this phrase to comprise a narrow rule about a trademark infringement profits remedy.
5. Policies balancing market share and innocent infringement is property left to Congress.

Thank you for your attendance!



Resources

IX. Resources Specific to this Course

In addition, please see the resources cited within the material.

X. Resources for the Legal Professional

ABA Center for Professional Responsibility - www.abanet.org/cpr

Chicago Bar Association - www.chicagobar.org

Commission on Professionalism - www.2civility.org

Judicial Inquiry Board - <http://www.illinois.gov/jib>

Illinois Board of Admissions to the Bar - www.ilbaradmissions.org

Illinois Department of Financial and Professional Regulation -
www.idfpr.com/default.asp

Illinois Lawyers' Assistance Program, Inc - www.illinoislap.org

Illinois State Bar Association - www.isba.org

Illinois Supreme Court - www.state.il.us/court

Lawyers Trust Fund of Illinois - www.ltf.org

MCLE Program - www.mcleboard.org

