


Changes to the IP Landscape

General Practice Review
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Intellectual Property Updates



Copyrights Trademarks Patents

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Copyrights - In the News

Davidson v. United States

No. 13-9422 (Fed. Cl. June 29, 2018).



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Classification: Public



Copyrights - In the News

Davidson v. United States

No. 13-9422 (Fed. Cl. June 29, 2018).



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Classification: Public



Copyrights - In the News

Davidson v. United States

No. 13-9422 (Fed. Cl. June 29, 2018).

- Robert Davidson created the sculpture "of" the Statue of Liberty, "Lady Liberty," for the New York New York Hotel and casino in 1996. He was paid \$385,000 for his work.
 - Fun Fact: the original Statue of Liberty was built in 1875 for \$250,000 (converted from francs).
- USPS needed an image for a Forever Stamp. They utilized an image of what they thought was the original Statue of Liberty which they procured from Getty Images.

Source: United States Patent And Trademark Office, Examination Guide D-17 (Jun. 26, 2007) ("Examination Guide D-17")

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Classification: Public



Copyrights - In the News

Davidson v. United States

No. 13-9422 (Fed. Cl. June 29, 2018).

- The image was taken by photographer Raimund Linke and, despite having taken a licensing fee from the USPS, Getty Images did not have the appropriate rights to Davidson's sculptural work.
- Between December 2010 and January of 2014, the stamp sold over 4.9 Billion copies and generated \$2 billion in revenue.

https://ecf.ca9.uscourts.gov/cgi-bin/show_public_doc?703540942-08-0

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Classification: Public



Copyrights - In the News

Davidson v. United States

No. 13-9422 (Fed. Cl. June 29, 2018).

- 28 U.S.C. § 1498(b): Waiver of sovereign immunity for copyright infringement.
- 17 U.S.C. § 102(a)(5): Protects *sculptural* works...
- 17 U.S.C. § 102(b): ...so long as they are original.
- 17 U.S.C. § 120: No protection for an *architectural* work that is located or ordinarily visible from a public space.
- 17 U.S.C. § 107: Fair use defense.

https://ecf.ca9.uscourts.gov/cgi-bin/show_public_doc?703540942-08-0

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Classification: Public



Copyrights - In the News

Davidson v. United States

No. 13-9422 (Fed. Cl. June 29, 2018).

- 28 U.S.C. § 1498(b):
 - Accepted. It's the government. Immunity is waived.
- 17 U.S.C. § 102(a)(5):
 - Accepted. It's a sculpture.*
- 17 U.S.C. § 102(b):
 - Original because he used a photo of his mother as inspiration.
- 17 U.S.C. § 120:
 - Summary Judgment for Plaintiff. *Simply because the work is near the Casino does not necessarily indicate that it is architectural in nature or, in the event it is, that it is *solely* architectural in nature.

https://ecf.ca9.uscourts.gov/cgi-bin/show_public_doc?703540942-08-0

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Classification: Public



Copyrights - In the News

Davidson v. United States

No. 13-9422 (Fed. Cl. June 29, 2018).

- 17 U.S.C. § 107:
 - Fair use: (i) "the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes"; (ii) "the nature of the copyrighted work"; (iii) "the amount and substantiality of the portion used in relation to the copyrighted work as a whole"; and (iv) "the effect of the use upon the potential market for or value of the copyrighted work."
 - **Rejected:** All four factors weigh in favor of Plaintiff.
- Award: \$3.5 million.

https://ecfs.uscourts.gov/cgi-bin/show_public_doc?703544942-08-0

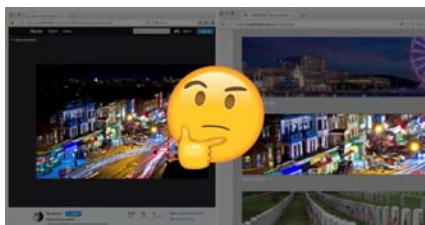
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Classification: Public



Copyrights - In the News

Brammer v. Violent Hues Productions, LLC

(E.D.N.Y. 2018).



<http://www.workshoppingpocket.com/court-rules-copping-photos-found-on-internet-is-fair-use/>

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Classification: Public



Copyrights - In the News

Brammer v. Violent Hues Productions, LLC

(E.D.N.Y. 2018).

- In 2011, photog Russell Brammer took a time-lapse image of a neighborhood in Washington D.C. which he uploaded on his Flickr account, reserving all rights and including a copyright notice.
- Violent Hues runs a film festival in Virginia and used a cropped version of the photo on their website. Violent Hues claimed they never saw any indication the photo was copyrighted and claimed fair use.

<https://law.justia.com/cases/federal/district-courts/virginia/1201/cv-00009/37354/05/>

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Classification: Public



Copyrights - Practical

Cease and Desist Letters

Best Practices:

- Take the letter seriously.
 - Statutory damages can range from \$750 to \$30,000 per act of infringement.
 - Recent jury awards are significant.
- Gather facts.
 - Where did your client get the photo? Is it licensed?
 - How long has the content been used? In what manner?

<http://philtdonnell.com/2016/05/01/why-any-old-image-just-wont-do/>

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Classification: Public



Copyrights - Practical

Cease and Desist Letters

Remember:

- Most companies don't want to litigate, but they will.
- Resolution often requires payment of the licensing or subscription fee that would have been required to purchase the content.

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Copyrights - Update

Star Athletica v. Varsity brands

580 U.S. ____ (2017).

"The key takeaway is confirmation that designs featured on useful articles are protectable under copyright law if they can be perceived independently as a 2-D or 3-D work of art and if they otherwise would qualify for copyright protection."



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Copyrights - Update

Athleisure

"Athleisure involves designing fashionable sport and fitness apparel that allows consumers to easily transition from athletic activities to casual-dress occasions—such as meeting friends for lunch."

<https://www.sportstech.com/status-athleisure-copyright-law-protection-fitness-clothing-star-athleisure-legal/>

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Classification: Public



Copyrights - Update

Athleisure

Puma v. Forever 21

Silvertop Associates, Inc. v. Kangaroo Manufacturing



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<https://www.sportstech.com/status-athleisure-copyright-law-protection-fitness-clothing-star-athleisure-legal/>

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Classification: Public



Copyrights - Update

Athleisure

Silvertop Associates, Inc. v. Kangaroo Manufacturing

"The Court finds the Banana Costume is a useful article..."

"The Court must view the Banana Costume as a whole, as opposed to inspecting the individual components that come together to create the Banana Costume."




<https://www.sportstech.com/status-athleisure-copyright-law-protection-fitness-clothing-star-athleisure-legal/>
<https://casetext.com/case/silvertop-associates-inc-v-kangaroo-manufacturing>

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Classification: Public



Trademarks - Update


Creative Corporate Messaging



Source: <https://www.today.com/money/velcro-creates-song-get-people-stop-using-name-velcro-wrongly-1H6707>

Trademarks - Update


Creative Corporate Messaging



- We heard you. Our first Don't Say Velcro video received thousands of comments from over 150 countries. Some people loved it, some gave us new names for hook & loop fasteners, and some had other colorful feedback. Nevertheless, please remember that when you use VELCRO® as a noun you diminish the importance of our trademark. We're counting on you to call it by its name. [#hookandloopforever](#)

Source: <https://www.youtube.com/watch?v=2WVQ3M17k>

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Classification: Public



Trademarks - Update

Matal v. Tam

582 U.S. ____ (2017) (previously Lee v. Tam)



Source: <http://www.the-slants.com/>

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Classification: Public



Trademarks - Update

Matal v. Tam

582 U.S. ____ (2017) (previously Lee v. Tam)

- Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a) bars the registration of marks "which may disparage . . . persons . . . , institutions, beliefs, or national symbols, or bring them into contempt or disrepute . . ." or consist of or comprise, immoral, or scandalous matter.
- Challenge: The "disparagement clause" was challenged in *Matal* as unconstitutional under the First Amendment.

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Classification: Public
Source: <http://www.ipwatchdog.com/2017/03/17/caspe-earrings-matal-v-tam/id-8659/>



Trademarks - Update

Matal v. Tam

582 U.S. ____ (2017) (previously Lee v. Tam)

- Holding:
 1. By denying trademarks that allegedly disparage certain groups, the Lanham Act discriminates based on viewpoint.
 2. While the government may discriminate on viewpoint as related to government speech, trademarks are private speech.
 3. Even if trademarks are commercial speech – which the Court indicates they might not be – such speech still can't be restricted because of alleged offensiveness.

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Classification: Public
Source: https://www.supremecourt.gov/opinions/16pdf/15-035_lul3.pdf



Trademarks - Update

Matal v. Tam

582 U.S. ____ (2017) (previously Lee v. Tam)

- USPTO: June 26, 2017; Examination Guidance for Section 2(a)'s Disparagement Provision after *Matal v. Tam* and Examination for Compliance with Section 2(a)'s Scandalousness Provision While Constitutionality Remains in Question
- "The portions of [the] Trademark Manual of Examining Procedure (TMEP) §1203 that relate specifically to examination under the disparagement provision no longer apply."

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Classification: Public
Source: United States Patent And Trademark Office, Examination Guide D-17 (Jun. 26, 2017) ("Examination Guide D-17")



Trademarks - Update

In re Brunetti

877 F.3d 1330 (Fed. Cir. Dec. 15, 2017)

- Fed Circuit: Section 2(a) of the Lanham Act allows refusal of registration for a mark “[c]onsists of or comprises immoral . . . or scandalous matter.”
- The case involves Eric Brunetti’s clothing brand, FUUCT, and the application for trademark registration over the brand name.
- Application was rejected by the Examiner as “disparaging” and “vulgar.”

<http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/15-1083.Opinion.12-15-2017.1.PDF>

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Classification: Public



Trademarks - Update

In re Brunetti

877 F.3d 1330 (Fed. Cir. Dec. 15, 2017)

- The Federal Circuit Court of Appeals, relying in part on *Matal v. Tam*, held, “[i]ndependent of whether the immoral or scandalous provision is viewpoint discriminatory, we conclude that the provision impermissibly discriminates based on the content in violation of the First Amendment.”
- On September 7, 2018, the government filed petition for a writ of certiorari.
 - *In re Brunetti*, U.S. Supreme Court Case No. 18-302.

<http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/15-1083.Opinion.12-15-2017.1.PDF>

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Classification: Public



Patents - In the News

Patents in the News

“Well, on second thought, let’s not go to [Patents]. It is a silly place.”

http://montpythons50webs.com/scripts/Phil_Email/2006e3.htm

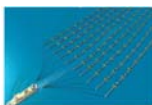
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Classification: Public



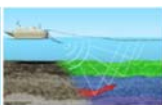
Patents - Update

WesternGeco LLC v. ION Geophysical Corp. 565 US __ (2018)

WesternGeco is a US company that performs various surveys of the ocean floor using patented "lateral steering technology."



ship towing streamer array



streamers detecting reflected sound waves

https://www.eflawg/files/2018/05/22/westerngeco_v_ion_opinion.pdf

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Classification: Public



Patents - Update

WesternGeco LLC v. ION Geophysical Corp. 565 US __ (2018)

- ION manufactured components in the US and then sold and shipped the components abroad.
- **Allegation:** Patent infringement with damages to be calculated based on the assemblies and lost profits from potential contracts.
- **Verdict:** The jury found infringement and awarded nearly \$100 million in damages.

https://www.eflawg/files/2018/05/22/westerngeco_v_ion_opinion.pdf

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Classification: Public



Patents - Update

WesternGeco LLC v. ION Geophysical Corp. 565 US __ (2018)

35 U.S.C. § 271(a):
Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

35 U.S. Code § 284:
Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court.

https://www.eflawg/files/2018/05/22/westerngeco_v_ion_opinion.pdf

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Classification: Public



Patents - Update

WesternGeco LLC v. ION Geophysical Corp.

585 US __ (2018)

35 U.S.C. § 271(f)(2):

Whoever without authority supplies or causes to be supplied in or from the United States any component of a patented invention that is especially made or especially adapted for use in the invention and not a staple article or commodity of commerce suitable for substantial noninfringing use, where such component is uncombined in whole or in part, knowing that such component is so made or adapted and intending that such component will be combined outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

https://www.eflawg/files/2018/05/22/westergco_v_ion_opinion.pdf

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Classification: Public



Patents - Update

WesternGeco LLC v. ION Geophysical Corp.

585 US __ (2018)

- WesternGeco argued that the award should be set aside as the Section 271 of the Patent Act should not be extended to include damages the occurred outside of the United States.
- The District Court disagreed and upheld the award.
- On appeal, the Federal Circuit agreed with ION and overturned the award holding that to enforce US patent rights for contracts that would have been performed overseas would be an impermissible extraterritorial application of patent law.

https://www.eflawg/files/2018/05/22/westergco_v_ion_opinion.pdf

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Classification: Public



Patents - Update

WesternGeco LLC v. ION Geophysical Corp.

585 US __ (2018)

SCOTUS:

- Presumption of domestic application of statutes.
- In order to overcome this presumption, typically there is a two-step process:
 - First you determine if the presumption applies at all.
 - If so, you then ask whether the case involves a domestic application of the statute and whether the relevant conduct occurred in the United States.

https://www.eflawg/files/2018/05/22/westergco_v_ion_opinion.pdf

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Classification: Public



Patents - Update

WesternGeco LLC v. ION Geophysical Corp.


565 U.S. (2018)

SCOTUS:

*Section 271(f)(2) focuses on domestic conduct. It provides that a company "shall be liable as an infringer" if it "supplies" certain components of a patented invention "in or from the United States" with the intent that they "will be combined outside of the United States in a manner that would infringe the patent if such combination occurred within the United States." The conduct that §271(f)(2) regulates—i.e., its focus—is the domestic act of "suppl[ying] in or from the United States." As this Court has acknowledged, §271(f) vindicates domestic interests: It "was a direct response to a gap in our patent law," *Microsoft Corp.*, 550 U. S. at 457, and "reach[es] components that are manufactured in the United States but assembled overseas," *Life Technologies*, 580 U. S. at ___ (slip op. at 11).*

https://www.eff.org/files/2018/05/22/westerngeco_v_ion_opinion.pdf

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Classification: Public




Patents - Update

Standard for IPR, PGR, and CBM

September 2012 – October 2018

- *Inter Partes* review (IPR), post-grant review (PGR), and covered business method (CBM) review proceedings before the Patent Trial and Appeal Board (PTAB):
 - Applied the "broadest reasonable interpretation" standard for the claims.
- District Court:
 - Applied the standard articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), the "Phillips" standard.

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Classification: Public



Patents - Update

Standard for IPR, PGR, CBM, and PTAB

September 2012 – October 2018

- "broadest reasonable interpretation" standard:
 - "broadest reasonable meaning of [a claim's] words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification."
- Phillips standard:
 - ordinary and customary meaning
 - "the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention."
 - Focuses on intrinsic evidence.

<http://www.ipwatchdog.com/wp-content/uploads/2018/10/2018-22005.pdf>

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