Supreme Court Roundup: A Review of the October 2019 Term's Key Intellectual Property Law Cases: NantKwest, Thryv, Romag, Lucky Brand Dungarees, Booking.com (I and II), Allen, and Public.Resource.Org

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During its October 2019 Term, the Supreme Court issued a number of significant intellectual property decisions. These include decisions in two patent cases, *Peter v. NantKwest, Inc.* and *Thryv, Inc. v. Click-to-Call Technologies, LP*, four trademark cases, *Romag Fasteners, Inc. v. Fossil Group, Lucky Brand Dungarees Inc. v. Marcel Fashions Group, U.S. Patent & Trademark Office v. Booking.com B.V., and Booking.com B.V. v. U.S. Patent & Trademark Office*, and two copyright cases, *Allen v. Cooper and Georgia v. Public.Resource.Org Inc.*

With respect to patent law, in *NantKwest*, the Supreme Court held that the U.S. Patent & Trademark Office ("USPTO") could not recover its legal personnel's salaries as "expenses" in appeals to U.S. district courts under § 145 of the Patent Act for the review of patent application rejections. In *Thryv*, the Court reversed a Federal Circuit decision and established a clear rule precluding judicial review of time-bar challenges of USPTO Patent Trial and Appeal Board ("PTAB") inter partes patent challenges.

In trademark law, the *Romag* decision clarified that willfulness is not required for an award of profits in federal trademark infringement cases brought under 15 U.S.C. § 1125(a). While an infringer's mindset is an essential consideration in awarding the infringer's profits, it is not a precondition to the award. In *Lucky Brand Dungarees*, the Court rejected the Second Circuit's defense preclusion doctrine for certain trademark cases. The Court in *Booking.com* held that a "generic.com" term may be eligible for federal trademark registration but noted that there is no rule that adding ".com" to a generic term does not automatically render it registrable. And in a second *Booking.com* case, the Court effectively extended its ruling in *NantKwest* to also cover trademark appeals brought under 15 U.S.C. § 1071(b)(3).

With regard to copyright law, the Court held in *Allen* that U.S. states and territories are immune from federal copyright infringement, ruling that Congress lacked the constitutional power to strip away the states' sovereign immunity. Finally, in *Public.Resource.Org*, the Court clarified that the government edicts doctrine, which specifies that materials created by courts in the performance of their official duties belong to the public domain, is also applicable to "non-binding, explanatory legal material" that is created and published by a legislative body – essentially preventing states from claiming copyright in their annotated codes.

The NYIPLA submitted amicus briefs in the *NantKwest* and *Thryv* patent cases, and in both *Booking.com* trademark cases, all of which briefs are available at https://www.nyipla.org/nyipla/AmicusBriefsNews.asp.

I. PATENT DECISIONS

A. *Peter v. NantKwest, Inc.*

Peter v. NantKwest, Inc.			
No. – 18-801	**Granted** – Mar. 4, 2019	**Argued** – Oct. 7, 2019	**Decided** – Dec. 11, 2019

- The Court ruled that the USPTO cannot recover the salaries of its legal personnel as "expenses" when a patent applicant files a district court action to appeal a decision denying patent protection.

The Supreme Court of the United States unanimously held in *Peter v. NantKwest, Inc.* that the term "expenses" in 35 U.S.C. § 145 does not include attorney's fees, and that the USPTO cannot recover the salaries of its attorneys and paralegals in appeals brought under that section of the Patent Act. *NantKwest* clarifies that the phrase "[a]ll expenses" does not mean that parties appealing patent rulings under this provision must also pay pro-rata portions of the salaries of the USPTO attorneys and paralegals involved in such appeals. Accordingly, such appeals will now be considerably more affordable to those having to pay for them.

i. Question Presented

The Court was asked to address whether the USPTO is entitled to its attorney's fees when a patent applicant files a district court action to appeal a decision denying patent protection.

ii. Background

In 2001, the USPTO rejected Dr. Hans Klingerman and NantKwest, Inc.'s patent application. The PTAB affirmed this decision. The lower courts affirmed the USPTO's rejection of their patent. Subsequently, the USPTO filed a motion for reimbursement of its attorney's fees under § 145, which the district court denied. The Federal Circuit reversed this decision on appeal. The USPTO requested certiorari to the Supreme Court, which was granted.

When a patent application is filed, it is first reviewed by a Patent Examiner. If the applicant is not satisfied with the final conclusion of the Patent Examiner, the applicant can then file an appeal with the Patent Trial and Appeal Board. If the applicant is still dissatisfied after this appeal, it has two options: it can either file an appeal to the Court of Appeals for the Federal Circuit or file a lawsuit in federal court to overturn the application's rejection. The patent statute authorizing the federal court action's filing provides that the Patent Office is entitled to recoup from the applicant the expenses incurred in that action. The Patent Office recently began asserting that the expenses it is to be awarded include its attorney's fees. The Supreme Court disagreed with the Patent Office and ruled that it cannot recover its legal personnel's salaries as "expenses" for district court reviews of patent application rejections.

An adverse decision of the USPTO may be challenged via mutually exclusive pathways created by the Patent Act. "Unlike § 141, § 145 permits the application to present new evidence . . . not presented to the P.T.O.'" *NantKwest*, 589 U.S., at ___ (slip op. at 2). A challenge under § 145 may result in a drawn-out litigation, as there is no limit on an applicant's ability to introduce new evidence. Thus, the Patent Act "requires applicants who avail themselves of § 145 to pay '[a]ll the expenses of the proceedings.'" *Id.*

Further, when considering the award of attorney's fees, a fundamental principle, known as the "American Rule," states that "each litigant pays his own attorney's fees, win or lose, unless a statute or contract provides otherwise." *Id.* at 3-4. The Government argued that "[b]ecause the American Rule presumption is most often overcome when a statute awards fees to a 'prevailing party,' . . . the presumption applies only to prevailing-party statutes." *Id.* Thus, the Government reasoned that

because Section 145 requires a party to pay all expenses, the presumption does not apply, regardless of the outcome.

iii. Analysis

In determining that the American Rule did, apply to Section 145, the Court examined whether Congress intended to depart from the American Rule. There must be a sufficient "specific and explicit" indication of Congress' intent in order to overcome the presumption; the absence of a specific reference to attorney's fees is not enough. *Id.*

First, the Court looked to the statute's text, specifically analyzing the meaning of the term "expenses." *Id.* "Reading the term 'expenses' alongside neighboring words in the statute . . . supports a conclusion excluding legal fees from the scope of § 145." *Id.* at 7. Traditionally, attorney's fees have not been included in the class of expenses referred to in the phrase "expenses of the proceeding," suggesting that the use of "expenses" would not have been understood to include attorney's fees at the time of the statute's enactment. *Id.* Thus, the Court held, Section 145's plain text does not overcome the American Rule's presumption against fee-shifting to permit the USPTO to recover attorney's fees.

The Court then looked to "the record of statutory usage" to demonstrate that the term "expenses" alone does not include attorney's fees. *Id.* at 8. "That 'expenses' and 'attorney's fees' appear in tandem across various statutes shifting litigation costs indicates that Congress understands the two terms to be distinct and not inclusive of each other." *Id.* Thus, the common statutory usage of the term "expenses" alone has "never been considered to authorize an award of attorney's fees with sufficient clarity to overcome the American Rule presumption." *Id.*

Finally, the Court pointed to the history of the Patent Act. Citing several sections under Title 35, the Court reasoned that "when Congress intended to provide for attorney's fees in the Patent Act, it stated so explicitly." *Id.* at 9. Thus, since Congress did not make it is intent similarly clear in Section 145, the statute does not authorize the USPTO to recover its attorney's fees.

iv. NYIPLA Amicus Brief

The NYIPLA filed an amicus brief in this case urging the Court to uphold the American Rule. The brief is available at https://www.nyipla.org/nyipla/AmicusBriefsNews.asp.

v. Follow-On Cases

Booking.com B.V. v. U.S. Patent & Trademark Office, No. 18-1309, raises the same issues as *NantKwest* but in the trademark context. The Court disposed of the case by granting certiorari, vacating the decision below, and remanding the case for further proceedings in light of the *NantKwest* decision. The case is discussed in detail below as *Booking.com II*.

B. *Thryv, Inc. v. Click-to-Call Technologies, LP*

Thryv, Inc. v. Click-to-Call Technologies, LP

No. – 18-916 **Granted** – June 24, 2019 **Argued** – Dec. 9, 2019 **Decided** – Apr. 20, 2020

- The Court established a clear rule that preliminary decisions made by the PTAB cannot be appealed.

In a 7-2 Decision in *Thryv, Inc. v. Click-to-Call Technologies, LP*, authored by Justice Ginsburg, and joined by Chief Justice Roberts and Justices Breyer, Kagan, and Kavanaugh, and joined-in-part by Justices Thomas and Alito, the Court vacated the Federal Circuit's decision and remanded with instructions to dismiss for lack of jurisdiction.

i. Question Presented

The Supreme Court accepted certiorari on the question of whether 35 U.S.C. § 314(d) precludes judicial review of a decision by the PTAB to institute inter partes review ("IPR") even when there was purportedly a prior lawsuit that should have barred institution under 35 U.S.C. § 315(b)

ii. Background

In 2013, Thryv, Inc. petitioned the PTAB to institute an IPR to challenge several claims of Click-to-Call's patent. Click-to-Call opposed the challenge, arguing that the IPR was untimely under § 315(b) due to a 2001 infringement suit against Thryv, which suit ended in a voluntary dismissal without prejudice. The PTAB disagreed, concluding that "a complaint dismissed without prejudice does not trigger § 315(b)'s one-year limit."

The PTAB instituted review, and after proceedings on the merits, issued a final written decision canceling claims of Click-to-Call's patent. Click-to-Call appealed the decision to the Federal Circuit, challenging only the PTAB's determination that the petition was not time-barred under § 315(b).

The Federal Circuit initially dismissed the appeal for lack of jurisdiction, "agreeing with Thryv and the Director (who intervened on appeal) that § 314(d)'s bar on appeal of the institution decision precludes a judicial review of the agency's application of § 315(b)."

However, after the en banc Federal Circuit in *WiFi One, L.L.C. v. Broadcom Corp.*, 878 F.3d 1364 (2018), held that time-bar determinations under § 315(b) are appealable, the Federal Circuit granted rehearing and vacated the final written decision because Thryv's request to institute IPR was untimely under Section 315(b).

iii. Analysis

In *Thryv*, the Court found that under its precedent in *Cuozzo v. Speed Technologies, L.L.C. v. Lee*, No. 15-446 (2016), Click-to-Call's challenge to the PTAB's ability to institute an IPR as an alleged violation of the time-bar provisions under Section 315(b) is barred under Section 314(d). Cuozzo held that § 314(d) "bars review at least of matters 'closely tied to the application and interpretation of statutes related to' the institution decision."

The Thryv Court reasoned that Section 315(b) 's time limitation is integral to the institution, as it "sets forth a circumstance in which '[a]n inter partes review may not be instituted.'" Thus, because § 315(b) expressly governs institution, a challenge to a petition's timeliness under § 315(b) raises "'an ordinary dispute about the application of' an institution-related statute" and, therefore, "easily meets" the Cuozzo standard.

The Court also reasoned that the America Invent Act's ("AIA") "purpose and design strongly reinforce [its] conclusion." Allowing § 315(b) appeals would go against the objective of IPR: "to weed out bad patent claims efficiently."

In addition, "because a patent owner would need to appeal only if she could not prevail on patentability, § 315(b) appeals would operate to save patent claims." Further, "§ 315(b) appeals [are not] necessary to protect patent claims from wrongful invalidation, for patent owners remain free to appeal final decisions on the merits."

Ultimately, in holding that the PTAB's decision to institute IPR proceedings cannot be appealed even if based upon a timeliness objection, the Court vacated the Federal Circuit's judgment and remanded with instructions to dismiss for lack of appellate jurisdiction.

iv. Dissent

The dissenting opinion, authored by Justice Gorsuch, and joined-in-part by Justice Sotomayor, argued that the "Court takes a flawed premise—that the Constitution permits a politically guided agency to revoke an inventor's property right in an issued patent—and bends it further, allowing the agency's decision to stand immune from judicial review."

Further, Justice Gorsuch, in a section of the dissent not joined by Justice Sotomayor, expressed concern with the Court's reading of § 314(d) as it "takes us further down the road of handing over judicial powers involving the disposition of individual rights to executive agency officials."

The dissenting opinion concluded that the majority's reading of the statute compounds the "error" made in *Oil States Energy Services, L.L.C. v. Green's Energy Group L.L.C.*, No. 16-712, by "not only requiring patent owners to try their disputes before employees of a political branch but limiting their ability to obtain judicial review when those same employees fail or refuse to comply with the law. Nothing in the statute commands this result, and nothing in the Constitution permits it."

v. NYIPLA Amicus Brief

The NYIPLA filed an amicus brief in this case arguing that judicial review of time-bar determinations should be permissible under relevant Supreme Court precedent. The brief is available at https://www.nyipla.org/nyipla/AmicusBriefsNews.asp.

vi. Follow-On Cases

The Supreme Court granted certiorari, vacated, and remanded the following three cases in view of its *Thryv* decision:

- *Emerson Electric v. SIPCO*, 207 L. Ed. 2d 1049 (U.S. June 15, 2020), where the Court was asked to consider whether the Federal Circuit improperly overturned the PTAB's determination that the patent was eligible for review under the covered business method ("CBM") program. This decision suggests that the Federal Circuit will no longer be able to review whether the PTAB properly determined if a patent is a CBM.
- *Atlanta Gas Light Co. v. Bennett Regulator Guard Inc.*, 140 S. Ct. 2711 (U.S. Apr. 27, 2020), where the Court was asked whether the Federal Circuit properly held that the PTAB should not have instituted an IPR of a patent where there was a civil complaint, later involuntarily dismissed, that was filed outside the one-year limitation. This decision reinforces that the Federal Circuit should not be addressing what constitutes a time bar under 35 U.S.C. § 315(b).
- *Superior Communications Inc. v. Voltstar Techs. Inc.*, 140 S. Ct. 2711 (U.S. Apr. 27, 2020), where the Court was asked whether the Federal Circuit had authority to review a PTAB decision to institute that was filed more than one year after a civil complaint, which complaint was dismissed without prejudice subject to a settlement agreement that later fell apart. This reinforces that *Thryv* controls even where a civil action was filed and settled voluntarily outside of the one-year period.

Furthermore, the Federal Circuit has applied *Thryv* and its progeny to limit its own jurisdiction to hear PTAB appeals in at least the following cases:

- In *ESIP Series 2 LLC v. Puzhen Life USA LLC*, 958 F.3d 1378 (Fed. Cir. May 19, 2020), cert. denied, 208 L. Ed. 2d 178 (U.S. Oct. 13, 2020), the Federal Circuit followed *Thryv* and extended preclusion of judicial review under Section 314(d) to a determination by the PTAB concerning the real parties in interest requirement of Section 312(a)(2). ESIP indicates that decisions on "real parties in interest" are related to institution such that judicial review is precluded under Section 314(d).

- In *Ruiz Food Prods Inc. v. MacroPoint LLC*, No. 19-2113 (Fed. Cir. June 24, 2020), the PTAB instituted an IPR after a declaratory judgment action was dismissed without prejudice but later granted MacroPoint's motion to terminate the proceedings without addressing patentability. The Federal Circuit denied Ruiz Food's appeal under *Thryv*, holding that the dispute was related to institution. Ruiz Food stands for the proposition that *Thryv* applies to motions to terminate in addition to institution decisions.
- In *BioDelivery Scis. Int'l v. Aquestive Therapeutics Inc.*, 935 F.3d 1362 (Fed. Cir. 2019), cert. denied, 208 L. Ed. 2d 26 (U.S. Oct. 5, 2020), the Federal Circuit remanded an IPR to the PTAB with instructions to review all challenged claims under *SAS v. Iancu*. The PTAB instead terminated the instituted IPRs. The Federal Circuit dismissed the appeal of the termination decisions, holding that it lacked the authority to review those decisions. *BioDelivery* stands for the proposition that *Thryv* controls even where the Federal Circuit has remanded an IPR with instruction to review the claims.
- In *Fitbit Inc. v. Valencell Inc.*, 964 F.3d 1112 (Fed. Cir. July 8, 2020), a Federal Circuit panel found that the patent owner's objection to petitioner's tardy filing of an IPR petition was not reviewable on appeal under *Thryv*.
- In *Facebook Inc. v. Windy City Innovations*, 819 Fed. App'x 936 (Fed. Cir. Sept. 4, 2020), a Federal Circuit panel found that the PTAB's joinder decisions are more like the reviewable challenges under SAS, which concern the manner in which instituted IPRs proceed, than non-reviewable challenges under *Thryv*, which concern decisions to institute.

It thus appears that *Thryv* is being applied to limit appeals not only where an issue is raised that is addressed in an institution decision, but also when issues are raised thereafter in motions to terminate or remands from appeals closely related to institution decisions.

II. TRADEMARK DECISIONS

A. *Romag Fasteners, Inc. v. Fossil Group*

Romag Fasteners, Inc. v. Fossil Group

No. – 18-1233 **Granted** – June 28, 2019 **Argued** – Jan. 14, 2020 **Decided** – Apr. 23, 2020

- The Court ruled that the mindset of the trademark infringer, although an important consideration, is not a precondition for an award of the infringer's profits.

The Supreme Court unanimously decided that trademark infringers may be liable for their profits in actions brought under 15 U.S.C. § 1125(a), even if they did not violate the law willfully. *Romag Fasteners, Inc. v. Fossil Group, Inc.*, No. 18-1233, Slip op. at 3, 7 (U.S. Apr. 23, 2020).

This Supreme Court decision reconciles differences in statutory interpretation among the judicial circuits. It holds that "willfulness" is no longer an "inflexible precondition" to an award of profits for trademark infringement under 15 U.S.C. § 1125(a), while acknowledging that "a trademark defendant's mental state is a highly important consideration."

This means that defendants in federal trademark infringement actions may face more severe monetary consequences if they are successfully accused of trademark infringement. As a result, this gives added incentive for plaintiffs to file more trademark infringement actions.

Thus, it may be even more prudent to conduct thorough trademark searches for potential conflicts before adopting new trademarks and to give extra scrutiny to possible conflicts discovered in those searches. Moreover, allegations of trademark infringement need to be taken even more seriously. A common view among accused infringers that they can simply stop using an accused trademark in the event of litigation without further consequence may no longer apply.

Although the Court did not discuss in detail, the other remedies set out in 15 U.S.C. § 1114, because the Court remarked that "no one suggests [that section] contain[s] the rule Fossil seeks," it would appear that the same logic concerning willfulness requirements (or the lack thereof) would apply there as well. *See* Slip op. at 3.

Justice Gorsuch delivered the Court's opinion, joined by Chief Justice Roberts and Justices Thomas, Ginsburg, Breyer, Alito, Kagan, and Kavanaugh. Justice Alito wrote a concurring opinion, joined by Justices Breyer and Kagan, and Justice Sotomayor, who wrote her own concurring opinion.

i. Question Presented

Because federal courts in different judicial circuits were split, the Supreme Court accepted certiorari on the question of whether willfulness was a precondition for an award of profits in trademark infringement cases brought under 15 U.S.C. § 1125(a).

ii. Background

In 2002, Fossil, Inc. signed an agreement to use Romag Fasteners, Inc.'s patented magnetic snaps in its handbags. Romag later discovered that Fossil's Chinese factories were using counterfeit Romag fasteners.

Unable to settle the dispute amicably, Romag sued Fossil in 2010 in the U.S. District Court for the District of Connecticut for trademark infringement under 15 U.S.C. § 1125(a). Following Second Circuit precedent, the District Court rejected Romag's request for an award of profits because the jury found that Fossil's behavior was "in callous disregard" of Romag's rights but was not willful. Slip op. at 2.

Romag appealed to the U.S. Court of Appeals for the Federal Circuit. The Federal Circuit, applying the Second Circuit's trademark precedent, affirmed the District Court's decision.

iii. Analysis

The Court began by noting that the critical issue, in this case, was whether a categorical rule that willfulness is required as a precondition for an award of profits "can be reconciled with the statute's plain language." Slip op. at 1. The relevant section of the Lanham Act governing remedies, 15 U.S.C. § 1117(a), states in pertinent part:

> When . . . a violation under section 1125(a) or (d) of this title, or a willful violation under section 1125(c) of this title, shall have been established . . . the plaintiff shall be entitled . . . subject to the principles of equity, to recover (1) defendant's profits . . . .

The Court clarified that this section of the statute explicitly requires a showing of willfulness in order for plaintiffs in actions brought under 15 U.S.C. § 1125(c), for trademark dilution, to recover a defendant's profits. However, the Court found that such a showing is clearly not required for plaintiffs in actions brought under 15 U.S.C. § 1125(a) such as for infringement of an unregistered trade dress, or for false or misleading use of trademarks.

The Court rejected Fossil's contention that the term "subject to the principles of equity" implicitly includes a willfulness requirement because "equity courts historically required a showing of

willfulness before authorizing a profits remedy in trademark disputes." Slip op. at 4. First, because the Lanham Act "speaks often and expressly about mental states," the Court disagreed that Congress would use coded language here to import a willfulness requirement that is expressly prescribed in other sections of the Act.

Second, the Court doubted that the "principles of equity" could be stretched to include "a narrow rule about a profits remedy within trademark law." Third, the Court did not find the evidence in the record supported that "trademark law historically required a showing of willfulness before allowing a profits remedy." Slip op. at 5.

That said, in language that many defendants will undoubtedly point to in the future to try to forestall an award of profits, the Court wrote: "We do not doubt that a trademark defendant's mental state is a highly important consideration in determining whether an award of profits is appropriate." Slip op. at 7.

The Court concluded its opinion with a curt dismissal of the policy arguments made by both sides, noting that the Court's "limited role is to read and apply the law."

iv. Concurrence

Justice Alito, joined by Justices Breyer and Kagan, noted that pre-Lanham Act cases "show that willfulness is a highly important consideration in awarding profits under 15 U.S.C. § 1117(a), but not an absolute precondition."

Justice Sotomayor wrote a concurring opinion disagreeing that courts of equity were just as likely to award profits for willful infringement as for innocent infringement but finding "that 15 U.S.C. § 1117(a) does not impose a 'willfulness' prerequisite for awarding profits in trademark infringement actions."

B. *Lucky Brand Dungarees, Inc. v. Marcel Fashions Group*

Lucky Brand Dungarees, Inc. v. Marcel Fashions Group

No. – 18-1086 **Granted** – June 28, 2019 **Argued** – Jan. 13, 2020 **Decided** – May 14, 2020

- The Court ruled that a defendant is not precluded from raising a defense it could have raised, but never litigated or resolved, in an earlier trademark action against the same party.

In a unanimous decision, the U.S. Supreme Court held that, in a later trademark action challenging different conduct and raising different claims from an earlier trademark action between the parties, Defendant Lucky Brand was not precluded from raising new defenses. *Lucky Brand Dungarees, Inc. v. Marcel Fashions Grp.*, No. 18–1086, slip op. at 1 (2020).

The decision reverses a Second Circuit decision that barred Lucky Brand from raising a defense that it allegedly "could have" raised in an earlier phase of the almost twenty-year dispute between the parties under the doctrine of res judicata. The Court stressed the importance of the decision in the trademark context, "where the enforceability of a mark and likelihood of confusion between marks often turns on extrinsic facts that change over time." *Id.* at 9.

Justice Sotomayor delivered the unanimous opinion of the Court in Lucky Brands that resolved a circuit split regarding the existence of the so-called "defense preclusion" principle. Instead, the Court has limited judicial preclusions to traditional claim and issue preclusion doctrines as the guideposts for barring certain defenses in trademark cases.

i. Question Presented

The Supreme Court accepted certiorari on the question of whether, when a plaintiff asserts new claims, federal preclusion principles can bar a defendant from raising defenses that were not litigated and resolved in any prior case between the parties.

ii. Background

Plaintiff Marcel and Defendant Lucky Brands both sell jeans and other apparel using the word "Lucky" in their trademarks on clothing. Marcel received a federal trademark registration for "Get Lucky" in 1986, while Lucky Brand began selling apparel using the trademark "Lucky Brand" (and other marks that include the word "Lucky") in 1990. These trademarks led to nearly twenty years of litigation between the parties, proceeding in three phases beginning in 2001.

In the initial conflict between the parties, Marcel sued Lucky Brand alleging trademark infringement and unfair competition by Lucky Brand's use of the phrase "Get Lucky." The parties settled in 2003 with Lucky Brand agreeing to "desist henceforth from the use of 'Get Lucky' as a trademark" and pay Marcel $650,000. In exchange, Marcel agreed to release any claims it had or might have arising out of or relating to Lucky's right to "use, license and/or register" the trademark "Lucky Brand" or any other marks that it "owned, registered, and/or used" at the time.

The next round of litigation began in 2005. Lucky Brand was on the offensive, alleging that Marcel and its licensee infringed its trademarks by copying its designs in a new clothing line. Marcel filed several counterclaims in response based on Lucky Brand's continued use of the "Get Lucky" phrase. Marcel also asserted counterclaims based on the Settlement Agreement's release of "any and all claims arising out of or in any way related to [Lucky's] right to use, license and/or register the trademark "Lucky Brand" and/or any other trademarks, trade names, brands, advertising slogans or tag lines owned, registered and/or used by [Lucky] as of the date of this Agreement." On the face of Marcel's counterclaims, it appeared that some of Lucky Brand's allegedly infringing marks were not registered until after the Settlement Agreement. The district court accordingly denied Lucky's motion to dismiss. Lucky Brand did not renew its "release" defense in the 2005 action, and the case proceeded to trial, which resulted in a final order and judgment under which Lucky Brand was permanently enjoined from using the "Get Lucky" mark. However, the final judgment did not address whether the Settlement Agreement barred some or all of Marcel's counterclaims in the 2005 action.

The third round of litigation began in 2011 with Marcel suing Lucky Brand again for trademark infringement. This time Marcel sought a new injunction prohibiting Lucky from "using the Lucky Brand marks," which Marcel claimed Lucky Brand had continued to use after the final judgment in the 2005 action. Notably, the 2005 action did not involve any alleged use of the "Get Lucky" slogan. Lucky moved for summary judgment on the ground that the final judgment barred Marcel's new claims. The district court granted the motion, concluding that Marcel's claims in the 2011 action were essentially the same as its counterclaims in the 2005 action. However, the Second Circuit vacated and remanded the decision, holding that Marcel's counterclaims in the 2005 action were for "infringements that occurred 'after May 2003' but before" the 2011 action, which meant that they could not have been raised in the 2005 action.

On remand to the district court, Lucky Brand moved to dismiss Marcel's amended complaint, arguing—for the first time since its motion to dismiss and answer in the 2005 action—that all of the marks at issue in the current action were "registered and/or used by [Lucky] . . . as of the date of th[e Settlement] Agreement," and thus covered by the agreement's release. In response, Marcel argued that "the res judicata or collateral estoppel effect" of the final judgment in the 2005 action precluded Lucky

Brand from relying on the Settlement Agreement in the current action because the same defense could have been resolved in the 2005 action for different claims. The district court disagreed, stating that "[i]ssue preclusion does not apply, because the applicability of the Settlement Agreement's release provision was not litigated and resolved in the 2005 action." The district court also held that claim preclusion did not apply because Marcel's claims in the 2011 action differed from its claims in the 2005 action.

The Second Circuit vacated and remanded the decision, concluding that a doctrine called "defense preclusion" barred Lucky Brand from raising the release defense in 2011. The Second Circuit reasoned that a defendant should be precluded from raising a defense where: "(i) a previous action involved an adjudication on the merits"; "(ii) the previous action involved the same parties"; "(iii) the defense was either asserted or could have been asserted, in the prior action"; and "(iv) the district court, in its discretion, concludes that preclusion of the defense is appropriate." 898 F. 3d, at 241. The Supreme Court granted certiorari to resolve the differences among Circuits regarding "when, if ever, claim preclusion applies to defenses raised in a later suit."

iii. Analysis

The Court began by noting that it has never explicitly recognized "defense preclusion" as a standalone category of *res judicata*, "unmoored from the two guideposts of issue preclusion and claim preclusion." Slip op. at 7. Further, any preclusion of defenses must, at a minimum, meet the same requirements of issue preclusion or claim preclusion. *Id.*

The decision turned significantly on the finding that the 2005 action and the 2011 action were grounded in different conduct, involved different marks, and occurred at different times, and thus, did not share a "common nucleus of operative facts." *Id.* at 8. For example, the 2005 action alleged that Lucky Brand infringed Marcel's "Get Lucky" mark by using the phrase to create consumer confusion. However, the 2011 action did not involve any alleged use of the "Get Lucky" phrase. Instead, Marcel alleged in the 2011 action that Lucky Brand's infringement was based only on the use of Lucky Brand's own marks containing the word "Lucky."

The Court also wholly rejected Marcel's claim preclusion argument, stating that "[e]vents that occur after the plaintiff files suit often give rise to new '[m]aterial operative facts' that 'in themselves, or taken in conjunction with the antecedent facts,' create a new claim for relief." *Id.* at 9 (quotation omitted). Importantly, the Court agreed that this principle carries considerable weight in trademark context because "liability for trademark infringement turns on marketplace realities that can change dramatically from year to year." *Id.* at 9. The Court accordingly held that claim preclusion did not and could not bar Lucky Brand from asserting its settlement agreement defense in the 2011 action.

Marcel argued that a version of "defense preclusion" should apply to the facts of its case in its briefing. However, the Court dismissed the argument, finding that the authorities referenced by Marcel likely did not stand for anything other than traditional claim - or issue - preclusion principles that may bar defenses raised in a subsequent suit. The Court pointed to a hypothetical involving judgment enforcement, where a party takes action to enforce a prior judgment already issued against another. If a different outcome in the second action "would nullify the initial judgment or would impair rights established in the initial action," preclusion principles would apply. Id. at 10. However, a court would still simply apply claim or issue preclusion in that scenario to bar a claim or defense that would attack a previously decided claim.

Because the Court held that Lucky Brand's defense in the 2011 action did not threaten the judgment of the 2005 action, the judgment enforcement principles would not apply to the case, regardless.

C. *U.S. Patent and Trademark Office v. Booking.com B.V. ("Booking.com I")*

U.S. Patent and Trademark Office et al. v. Booking.com B.V.			
No. – 19-46	**Granted** – Nov. 8, 2019	**Argued** – May 4, 2020	**Decided** – June 30, 2020
• The Court ruled that adding ".com" to the end of a generic term can possibly transform the term into a federally registrable trademark.			

The Supreme Court held in an 8-1 decision that "[a] term styled 'generic.com 'is a generic name for a class of goods or series only if the term has that meaning to consumers." *U.S. Patent and Trademark Office et al. v. Booking.com B.V.*, No. 19-46, Slip op. at 1 (U.S. Jun. 30, 2020).

In *Booking.com*, the Court's decision rejects a nearly per se rule against trademark protection for a "generic.com" term. Under the "mark as a whole" test adopted by the Court, there will likely start to be a lot more applications for "generic.com," "generic.org," and the like trademarks. Once again, the Court's rejection of a *per se* rule in favor of a flexible approach will likely result in more disputes down the road to be resolved.

This decision upholds the Eastern District of Virginia's ruling, which was affirmed by the Fourth Circuit, that the primary significance of "Booking.com" to consumers was not as a generic term, but a term for a specific online hotel reservation site, and that the addition of ".com" could evolve an otherwise generic term into something distinctive. The Court did, however, highlight that regardless of this ruling, it would not embrace a bright-line rule that automatically classifies all "generic.com" terms as non-generic. Instead, the decision in any given case depends on whether consumers perceive that particular term as a source indicator. Slip op. at 11.

Justice Ginsberg delivered the Court's opinion, in which Chief Justice Roberts and Justices Thomas, Alito, Sotomayor, Kagan, Gorsuch, and Kavanaugh joined. Justice Breyer filed a dissenting opinion. Justice Sotomayor filed a concurring opinion

i. Question Presented

The Supreme Court accepted certiorari to resolve the issue of whether combining a generic term with ".com" yields a generic term as well. Slip op at 6.

ii. Background

In 2011 and 2012, Booking.com, an online travel and reservation company, filed federal trademark applications to register marks containing the term "Booking.com." However, both the examining attorney at the USPTO and the Trademark Trial and Appeal Board ("TTAB") refused registration, concluding that "Booking.com" was a generic term when applied to online hotel-reservation services and was not registrable. Slip op. at 4. The TTAB further noted that "customers would understand the term 'BOOKING.COM' primarily to refer to an online reservation service for travel." Slip op. at 5. The TTAB went further, stating that even if "Booking.com" were descriptive and not generic, it would still be unregistrable because it lacked the requisite distinctiveness. Slip op. at 5.

Following this ruling, Booking.com sought review in the U.S. District Court for the Eastern District of Virginia, which reversed the TTAB. Slip op. at 5. Booking.com introduced in the District Court new evidence in the form of a "Teflon" consumer survey, which concluded that roughly 75% of participants viewed "Booking.com" as a brand name and not as a generic term for online hotel reservation services.

Based on this evidence, the District Court concluded that "Booking.com" was not a generic term for online hotel reservations to the relevant consumers. Slip op. at 5. Additionally, the District Court found that "Booking.com" had acquired secondary meaning regarding hotel-reservation services, and thus met the distinctiveness requirement for trademark registration. Slip op. at 5.

The USPTO appealed to the U.S. Court of Appeals for the Fourth Circuit ("the Fourth Circuit") but disputed only the District Court's classification of "Booking.com" as not generic. Slip op. at 5. The Fourth Circuit affirmed, rejecting the USPTO's argument that the combination of ".com" with a generic term like "booking" is necessarily generic. *Booking.com B.V. v. United States Patent & Trademark Office*, 915 F.3d 171 (4th Cir. 2019).

iii. Analysis

The Court began by noting that whether "Boooking.com" is generic turns on whether that term, taken as a whole, signifies to consumers a class of online hotel-reservation services. Slip op. at 7. It concluded that because consumers do not perceive "Booking.com" in that manner, "Booking.com" is not generic. Slip op. at 7.

The Court also rejected the USPTO's proposal of a nearly *per se* rule that when a generic term is combined with a generic top-level domain like ".com" the resulting combination is generic as well. Slip op. at 7. If accepted, this rule would have rendered "Booking.com" ineligible for registration, regardless of any surveys or other evidence of consumer perception. Slip op. at 7. The Court additionally found the USPTO's argument inconsistent with the USPTO's past practices, which registered both "ART.COM" and "DATING.COM." Slip op. at 8.

Although the USPTO warned that a ruling in favor of Booking.com would grant the company and others like it a monopoly, the Court stated that those fears were exaggerated, emphasizing that trademark law had its inherent safeguards to address such concerns. Slip op. at 12.

Further, in reaching its decision, the Court rejected the USPTO's reliance on the hundred and thirty-year-old *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U. S. 598, 602 (1888) case. That decision held that adding a generic corporate designation like "Company" to a generic term does not confer trademark eligibility. The Court found the analogy faulty because only one entity can occupy a particular internet domain name at a time, so a "generic.com" term could convey to consumers an association with a particular website. Slip op. at 9. Moreover, "an unyielding legal rule that entirely disregards consumer perception" is incompatible with a bedrock principle of the Lanham Act. Slip op. at 10. It is questionable if Goodyear would be decided the same way today.

iv. Concurrence

Justice Sotomayor filed a concurring opinion focusing on the nature of the evidence required to demonstrate that a term may be generic. She noted that even though finding value in the dissent's point that consumer-survey evidence "may be an unreliable indicator of genericness," she also grasps that the Court was correct in its assessment that sources like dictionaries and consumer and competitor usage reports have value in evaluating genericness.

She further stressed that had the USPTO used such sources as evidence, the Court may have rightfully found that "booking.com" was generic. This, however, was not the question before the Court.

v. Dissent

Justice Breyer filed the only dissenting opinion which gave more credence to the USPTO's concerns about monopolization. He concluded that although the Lanham Act altered the common law in certain respects, "it did not disturb the basic principle that generic terms are ineligible for trademark protection." *U.S. Patent and Trademark Office et al. v. Booking.com B.V.*, No. 19-46, slip op. at 4 (U.S. Jun. 30, 2020) (Breyer, J., dissenting).

He also emphasized his fears that the majority "decision will lead to a proliferation of 'generic.com' marks, granting their owners a monopoly," and that "[t]his result would tend to inhibit, rather than to promote, free competition in online commerce." Slip op. at 13 (Breyer, J., dissenting).

vi. NYIPLA Amicus Brief

The NYIPLA filed an amicus brief in this case, addressing the proper role of survey evidence in assessing whether a proposed ".com" trademark is federally registrable, which brief is available at https://www.nyipla.org/nyipla/AmicusBriefsNews.asp.

D. *Booking.com B.V. v. U.S. Patent and Trademark Office ("Booking.com II")*

Booking.com B.V. v. U.S. Patent and Trademark Office

No. – 18-1309 **Granted, Vacated, and Remanded** – July 2, 2020

- The Court effectively extended its ruling in *NantKwest*, that the USPTO cannot recover the salaries of its legal personnel as "expenses" in appeals to U.S. district courts, to trademark actions brought under 15 U.S.C. § 1071(b)(3).

In this second Booking.com case, the Court granted certiorari, vacated the judgment below, and remanded the case to the United States Court of Appeals for the Federal Circuit for further consideration in light of *Peter v. NantKwest*, 589 U.S. ___, 140 S. Ct. 365 (2019).

When Booking.com filed its petition regarding the issue of whether the USPTO could recover the salaries of its attorneys and paralegals in trademark appeals brought in district courts under 15 U.S.C. § 1071(b)(3), the above discussed case *Peter v. NantKwest*, which posed the same question in the patent context, was already pending. Nevertheless, the Court did not consolidate the two actions. Instead, the Court held in *Peter v. NantKwest, Inc.* that the term "expenses" in Section 145 of the Patent Act does not include attorney's fees, and that the USPTO cannot recover the salaries of its attorneys and paralegals in appeals brought under that section of the Patent Act, and subsequently granted certiorari, vacated the Federal Circuit's judgment, and remanded Booking.com for further proceedings in light of the *NantKwest* decision.

In effect, this decision means that the USPTO will no longer be able to recover the salaries of its attorneys and paralegals in trademark appeals brought under 15 U.S.C. § 1071(b)(3).

i. NYIPLA Amicus Brief

The NYIPLA filed an amicus brief in this case, advocating that the Court should reach the same decision here as it did in NantKwest, which brief is available at https://www.nyipla.org/nyipla/AmicusBriefsNews.asp.

III. COPYRIGHT DECISIONS

A. *Allen v. Cooper*

Allen v. Cooper			
No. – 18-877	**Granted** – June 3, 2019	**Argued** – Nov. 5, 2019	**Decided** – Mar. 23, 2020
• The Court ruled that state governments have sovereign immunity from copyright lawsuits notwithstanding a federal statute authorizing copyright lawsuits against states.			

The Supreme Court unanimously decided in *Allen v. Cooper* that Congress lacked authority and invalidly abrogated states' sovereign immunity when it enacted the Copyright Remedy Clarification Act ("CRCA") of 1990. *Allen v. Cooper*, No. 18-877, 2020 U.S. LEXIS 1909 (U.S. Mar. 23, 2020). This ruling's practical effect is that copyright holders cannot sue states for federal copyright infringement damages.

The Court's opinion was authored by Justice Kagan and joined by Chief Justice Roberts and Justices Alito, Sotomayor, Gorsuch, Kavanaugh, and Thomas (in part). Justice Breyer also filed an opinion concurring in the judgment, joined by Justice Ginsburg.

i. Question Presented

The Supreme Court granted certiorari on the question of whether Congress validly abrogated states' sovereign immunity through the Copyright Remedy Clarification Act of 1990, which allows authors of original expression to sue states who infringe their federal copyrights.

ii. Background

The CRCA, 17 U.S.C. § 511(a), provides that any state (or state instrumentality, officer or employee in their official capacity) "shall not be immune, under the Eleventh Amendment of the Constitution or any other doctrine of sovereign immunity," from federal copyright infringement lawsuits by "any person." The statute was enacted at the same time as the Patent Remedy Act ("PRA") with "basically identical" language that eliminated the states' sovereign immunity from patent infringement suits. However, the Supreme Court struck down the PRA as lacking a valid constitutional basis in 1999 in *Florida Prepaid Postsecondary Ed. Expense Bd. v. College Savings Bank*, 527 U.S. 627 (1999).

As relevant here, petitioner Fredrick Allen documented the salvage of Blackbeard's flagship vessel Queen Anne's Revenge, which sank off the coast of North Carolina in the early 1700s. Allen brought suit against North Carolina when the state published some of Allen's photos and videos without his permission and payment. North Carolina moved to dismiss the lawsuit on the ground of state sovereign immunity. Allen argued that the CRCA removed the states' sovereign immunity in copyright infringement cases. The district court denied the motion to dismiss, agreeing with Mr. Allen that the CRCA clearly abrogated state sovereign immunity, and that such abrogation had a proper constitutional basis. 244 F. Supp. 3d 525, 533 (E.D.N.C. 2017). On interlocutory appeal, the Fourth Circuit reversed, relying on the Supreme Court's Florida Prepaid decision to find that the CRCA was unconstitutional because the abrogation of state sovereign immunity was not "congruent and proportional" to the injury it sought to remedy. 895 F.3d 337, 350 (4th Cir. 2018).

iii. Analysis

First, the Court rejected Mr. Allen's argument that the Intellectual Property Clause of the Constitution, Art. I, Sec. 8, Cl. 8 permits abrogation of sovereign immunity in connection with federal copyright suits. Significantly, the Court noted that it rejected that same theory in *Florida Prepaid*, and disagreed that any subsequent jurisprudence has modified that result. The Court noted that there was no "special justification" to overrule *Florida Prepaid*.

Then the Court addressed Allen's second argument that the CRCA was a valid exercise of Congressional power under Section 5 of the Fourteenth Amendment. The Court noted that Section 5 of the Fourteenth Amendment can authorize Congress to strip states of immunity but any abrogation statute "must be tailored to remedy or prevent conduct infringing" that amendment's substantive prohibitions.

For Congress to validly abrogate state sovereignty, "there must be a congruence and proportionality between the injury to be prevented or remedies and the means adopted to that end." However, the CRCA did not validly abrogate because it lacked the necessary "congruence and proportionality between the injury to be prevented or remedied and the means adopted to that end." The Court concluded that nothing in the legislative record or other relevant histories of the CRCA suggested any significant or widespread infringement of copyrights by states that warranted a broad abrogation of their sovereignty. Thus, the CRCA failed the "congruence and proportionality" test, as the PRA did in *Florida Prepaid*.

Ultimately, the Court left the door open to future legislation noting that Congress could pass a valid copyright abrogation statute in the future, provided that it does so in a congruent and proportional manner. The Court also recognized that a tailored statute could "effectively stop States from behaving as copyright pirates" and "bring digital Blackbeards to justice."

iv. Concurrences

Justice Thomas concurred in the judgment and concurred in the principal opinion in part. Significantly, Justice Thomas took issue with the majority's "special justification" standard for overruling the Court's precedent, its endorsement of future Fourteenth Amendment abrogation legislation, and its acknowledgment that copyrights could qualify as property deprived thereunder.

Justice Breyer also wrote a concurring opinion, joined by Justice Ginsburg. The opinion maintained that the Court "went astray" in *Seminole Tribe* and "erred again" in *Florida Prepaid*. In Justices Breyer's and Ginsburg's views, the Intellectual Property Clause provides a sufficient basis to abrogate state sovereign immunity. However, they ultimately joined the Court's judgment, recognizing that "their longstanding view has not carried the day" and that the precedent controls.

B. *Georgia v. Public.Resource.Org, Inc.*

Georgia v. Public.Resource.Org, Inc.

No. – 18-1150 **Granted** – June 24, 2019 **Argued** – Dec. 2, 2019 **Decided** – Apr. 27, 2020

- The Court clarified that the government edicts doctrine applies to "non-binding, explanatory legal material" that is created and published by a legislative body and may prevent states from claiming copyright in their annotated codes.

In a 5-4 decision, the Court found that the government edicts doctrine (which generally holds that works authored by certain federal public officials in the course of their official duties are in the copyright public domain) applies to the States, territories, and the District of Columbia. *Georgia v. Public.Resource.Org, Inc.*, No. 18-1150, slip op. at 1, 5 (U.S. Apr. 27, 2020).

This decision further clarified that the doctrine applied even to "annotated" versions of the law text to prevent a situation where there is "first class" versus "economy class" access to the law. To be clear, this decision will not stop those states and territories that currently charge for access to such materials from doing so. However, those states and territories will not now prevent third parties from providing free access to such materials by bringing copyright infringement actions.

This decision clarifies that under the government edicts doctrine, official statutes (and their annotations) promulgated by the U.S. States, territories, and the District of Columbia are in the public domain copyright-eligible, even if annotated. Accordingly, those states and territories currently charged for access to such materials may no longer do so. This decision will directly affect those states and territories that have negotiated contracts with legal publishers regarding the issuance of official annotated copies of their statues. Additionally, the Supreme Court's reasoning would seem to extend beyond annotated codes to more broadly reach and impact similar arrangements by the states to other public documents, such as state zoning or flood maps.

Of note was Justice Thomas' dissenting policy concern that states may stop producing annotated codes altogether, thus hindering quality judicial access to both rich and poor. Time will tell if such concerns are justified and whether high-quality annotated state codes continue to be written.

Chief Justice Roberts delivered the majority opinion of the Court, joined by Justices Sotomayor, Kagan, Gorsuch, and Kavanaugh. Justice Thomas filed a dissenting opinion, joined in full by Justice Alito, and joined in part by Justice Breyer. Justice Ginsburg issued a separate dissenting opinion, joined in full by Justice Breyer.

i. Question Presented

The Supreme Court granted certiorari on the question, does the government edict doctrine extend to—and thus render uncopyrightable— works that lack the force of law, including the annotations in the Official Code of Georgia?

ii. Background

The State of Georgia has one official code called the Official Code of Georgia Annotated ("OCGA"). The OCGA includes the text of all current Georgia statutes as well as annotations to the text. The annotations, which are not officially binding, typically include summaries of judicial opinions construing the provisions of the statutes. The annotations to the current OCGA were produced as a work for hire by Matthew Bender & Co., Inc., a third-party publisher of law books, for the Georgia Code Revision Commission ("CRC").

The CRC is a state-entity composed mostly of state legislators, funded by legislative branch appropriations, and staffed by Georgia's Office of Legislative Counsel.

In 2013, the non-profit organization Public.Resource.Org, Inc. ("PRO") purchased a full copy of the OCGA and posted it online, allowing free public access to the OCGA on various websites. After sending PRO several cease-and-desist letters, the CRC filed an action for infringement of its copyright in the OCGA annotations in the U.S. District Court for the Northern District of Georgia.

The Northern District ruled in favor of the CRC, reasoning that the annotations were eligible for copyright protection because the legislature did not enact them. The U.S. Court of Appeals for the Eleventh Circuit reversed, rejecting the CRC's argument under the government edicts doctrine, whose animating principle is that no one can own the law. The U.S. Supreme Court affirmed.

iii. Analysis

The Court found that the annotations in the OCGA were not eligible for copyright protection under the government edicts doctrine, which holds that "officials empowered to speak with the force of law cannot be the authors of—and therefore cannot copyright—the works they create in the course of their official duties." Slip op. at 1.

The doctrine, based on the Court's prior decisions in *Wheaton v. Peters*, 8 Pet. 591 (1834), *Banks v. Manchester*, 128 U.S. 244 (1888), and *Callaghan v. Myers*, 128 U.S. 617 (1888), derives from the basic principle that, in a democracy, the people are "the constructive authors" of the law and judges and legislators are merely draftsmen "exercising delegated authority." Slip op. at 5 (quoting *Georgia v. Public.Resource.Org, Inc.*, 906 F.3d 1229, 1239 (11th Cir. 2018)).

The Court here clarified that the appropriate test is "based on the identity of the author . . . judges—and, we now confirm, legislators—may not be considered the 'authors' of works that they produce in the course of their official duties as judges and legislators." Slip op. at 5-6. Just as judges who have the authority to interpret the law cannot claim copyright in their decisions under *Banks*, the same holds for legislative bodies who have the authority to make the law. In short, "copyright does not vest in works that are (1) created by judges and legislators (2) in the course of their judicial and legislative duties." Slip op. at 9.

Applying this two-step test to the case's facts, the Court found that Georgia's annotations are not copyrightable. First, the Court determined that the CRC "is not identical to the Georgia Legislature, but functions as an arm of it to produce the annotations." *Id.* This, thought the Court, was eminently clear from the membership, staffing, funding, and procedure followed by the CRC in approving the annotations, as well as from state law precedent that the CRC "is within the sphere of legislative authority." *Id.* at 10 (quoting *Harrison Co. v. CRC*, 24 Ga. 325, 330 (1979)).

Second, the Court found that, although the annotations are not enacted into law, their preparation is an act of "legislative authority" and they provide "commentary and resources that the legislature has deemed relevant to understanding its laws."

The Court rejected Georgia's argument that by listing "annotations" as copyrightable works in Section 101 of the Copyright Act, Congress exempted this type of work from the government edicts doctrine. The majority ruled that Section 101 only applied to "annotations . . . which . . . represent an original work of authorship."

The Court also rejected Georgia's argument that an adverse inference should be made because the Copyright Act explicitly precludes copyright protection for federal officials' works but not for state officials. Instead, the Court opined, "the federal rule does not suggest an intent to displace the much narrower government edicts doctrine with respect to the States." *Id.* at 12.

Finally, the Court noted its concern with Georgia's argument in favor of limiting the government edicts doctrine based on content and not authorship. Taken strictly, such an argument would exclude not just annotations but also consenting and dissenting opinions, headnotes, and syllabi prepared by judges, proposed bills and committee reports prepared by legislators, and other materials supplementary materials that "do not have the force of law, yet . . . are covered by the doctrine." *Id.* at 15. These materials, although they are without the force of law, are immensely important. "Imagine a Georgia citizen" reading an unannotated copy of Georgia's Code "criminalizing broad categories of consensual sexual conduct . . . with no hint [from annotations] that important aspects of those laws have been held unconstitutional by the Georgia Supreme Court." *Id.* at 17. Adopting Georgia's argument, the court concluded, might lead to an unfair justice system based on the ability to pay for copyrighted material.

iv. Dissents

Justice Thomas objected to the majority's interpretation of the 19th Century cases that form the basis of government edicts doctrine, due to the narrower understanding of authorship and copyright protection current at the time, and agreed with Georgia's arguments that the annotations should be eligible for copyright protection under the terms of the Copyright Act because the legislature did not enact them. In response to the majority's policy concerns, he noted that the practical effect of the majority's decision may well be that states would stop producing annotated codes altogether, which would render obtaining quality legal assistance even more expensive than it is now.

Justice Ginsburg agreed with the two-part test outlined in the Majority Opinion regarding whether the government edicts doctrine should apply. However, she disagreed with the majority's finding that the OCGA's annotations were drafted by legislators "in the course of their . . . legislative duties." She argued that since the annotations were not created contemporaneously with the statutes, are descriptive rather than prescriptive, and were drafted for the public's convenience, and they should not satisfy the second prong of the test.

IV. CONCLUSION

Due to the COVID-19 pandemic, the Supreme Court could not hear or decide all of the IP cases on last term's docket. Accordingly, there are some important IP cases from last term that are still pending. These include, for example, *Google L.L.C. v, Oracle America Inc.*, where the issues to be resolved involve copyright protection and fair use with respect to software interfaces. Additionally, the Court has recently granted certiorari to new IP cases with far reaching repercussions, such as *U.S. v. Arthrex, Inc.*, which regards the constitutionality of PTAB Administrative Patent Judges. Thus, we expect the Court's October 2020 Term to be just as significant for IP practitioners as its past term was.

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