

**WINTER
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IP & TECHNOLOGY NEWSLETTER



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Edited by: Amanda Rosenfield Lippes and Erin S. Phillips





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A Copyright Lesson Learned, Dr. Seuss is not to be Spurned!

By: George McGuire¹

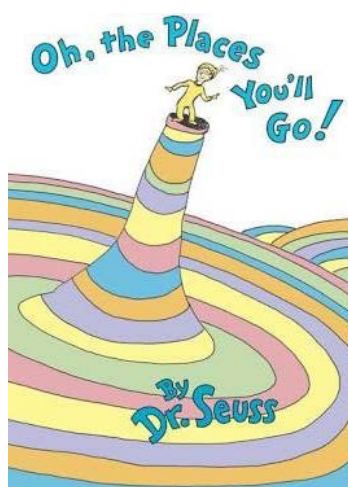
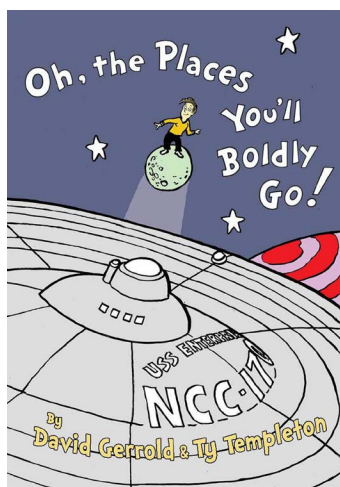
Fair Use a Mash-Up Pleaded;
a License, though, is Needed

The Court found infringement,
a mash-up insufficient

Comment on the original one,
or fair use will be done

Do not use my work, please,
unless willing to pay me fees

This admittedly imperfect anapestic tetrameter is a summary of the recent Ninth Circuit opinion in *Dr. Seuss Enterprises, L.P. v. ComicMix LLC* which involved a Star Trek mash-up of the famous Dr. Seuss book *Oh the Places We Will Go* (the mash-up called *Oh, the places You'll Boldly Go*).



Fair-use has been called the most ad hoc legal doctrine in all of the law. A balancing test of four factors any one of which, or none of which, or some combination of which may be deemed critical in any given fact pattern, provides for difficult reliance upon precedent by those who create works that draw upon a pre-existing work.

The four factors are:

1. the purpose and character of the use;
2. the nature of the copyrighted work;
3. the amount and substantiality of the portion used; and
4. the effect of the use on the market for the original.

The purpose and character of the use is where this case largely turned, and at least since the Supreme Court decision in *Campbell v. Acuff-Rose Music*, 510 U.S. 569 (1994) where 2 Live Crew's parody of Roy Orbison's *Pretty Woman* was held to be a fair use, where most fair use cases turn.

In *Campbell*, the Court explained, the purpose and character of the use looks to the extent to which the defendant has used the plaintiff's work in a new or different manner or for a different purpose than the original, altering it with a "new expression, meaning or message." In essence, how transformative is the use. A transformative work "adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message." On the other hand, a work that "merely supersedes the objects of the original creation" is not transformative. Thus, the new work must also comment upon, ridicule, criticize, or otherwise parody the original work (i.e., "altering it with new expression, meaning or message"). If transformation is all that is needed, the Ninth Circuit held, copyright owners would have little to no recourse against anyone who draws upon their original works and creates something new. The right to create derivative works would, in essence, wither and die if transformation without more was all that was needed for fair use to succeed.

In essence, the new work must comment upon the original in some way. This could entail critiquing it, ridiculing it, as is done with parody, or otherwise commenting upon it. In *Campbell*, this was done with 2 Live Crew's commenting upon Roy Orbison's *Pretty Woman* by using the same melody while providing poetic lyrics about growing up poor in a ghetto versus the white, middle class, suburban upbringing that was the subject of Roy Orbison's

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song. If the commentary has no critical bearing on the substance or style of the original composition, which the alleged infringer merely uses to get attention or to avoid the drudgery in working up something fresh, the claim to fairness in borrowing from another's work diminishes accordingly (if it does not vanish), and other factors, like the extent of its commerciality, looms larger.

In the present case, the Star Trek mash-up used the rhyming meter and illustrations of *Oh The Places You'll Go* (and other Seuss works) to simply superimpose the Star Trek world thereover. There was no commentary about the message being made in *Oh The Places You'll Go*, nor was there a poking of fun at the original work. It was a taking, according to the Court, that did not advance the spirit of the fair use doctrine.

The result is not surprising considering the Ninth Circuit had previously denied fair use to the retelling of the O.J. Simpson double murder trial in the world of the *The Cat in the Hat* – a book entitled *The Cat NOT in the Hat! A Parody by Dr. Juice (Not)*. In that case, the court held broadly mimicking Dr. Seuss' characteristic style is not the same as holding his style up to ridicule, and without a critique of *Cat*, all *Not* did was simply retell the Simpson tale using the expressive elements of *Cat* to get attention or maybe even avoid the drudgery in working up something fresh. See, *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1399 (9th Cir. 1997).

In the end, this mash-up of Star Trek with Dr. Seuss' works was not entitled to a fair use defense. As the mash-up did not critique, comment upon, ridicule, or otherwise poke fun at the original work, all it amounts to is the taking of a particular expression that is familiar to a large audience for purposes of enhancing the attractiveness of the new work. This is not in accord with the spirit of fair use, and a lesson to be learned is that when making a commercial use that draws upon pre-existing works, be sure to either have the license to do so, or create the new work as a criticism, commentary, or parody of the underlying work – do not use the underlying work merely as a means of enhancing the familiarity and attractiveness of the new work.



TRADEMARKS

Salient Points from the Trademark Modernization Act

By: Daniel Carosa²

On December 27, 2020, Congress passed The Trademark Modernization Act of 2020 ("TMA") as part of the COVID-19 relief bill known as the Consolidated Appropriations Act, 2021. As described below, the TMA impacts both litigation and prosecution aspects of trademark practice in the United States. While the litigation aspects are already in effect, the prosecution aspects will go into effect by December 27, 2021 after the administrative rulemaking process is carried out pertaining to the new provisions.



Three Ways the TMA Impacts Trademark Practice

1. Rebuttable Presumption Benefitting Trademark Owners

To obtain preliminary or permanent injunctive relief in a trademark litigation, the trademark owner must show that monetary damages are insufficient to correct the harm it has endured or will endure. In other words, the trademark owner

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must demonstrate that it would suffer “irreparable harm” if an injunction is not granted.

Prior to 2006, federal courts generally treated a showing of likelihood of confusion or trademark infringement as presumptive proof of irreparable harm. In other words, patent and trademark owners were given a presumption that monetary damages would be inadequate if they proved that their trademark or patent was infringed (or that infringement was likely). However, in the 2006 patent case, *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006), the U.S. Supreme Court unanimously decided that patent owners are only entitled to that presumption by weighing a four-prong test of equitable factors traditionally used to determine if an injunction should issue (rather than a showing of patent infringement). That case caused a divide among the circuit courts as to whether irreparable harm can be presumed when a showing of likelihood of confusion or trademark infringement has been established.



The TMA overcomes this divide by codifying the rule that a trademark owner seeking an injunction shall be entitled to a rebuttable presumption of irreparable harm upon a showing of likelihood of confusion or trademark infringement. Thus, the TMA can make it easier for trademark owners to obtain injunctive relief in trademark disputes.

2. New Procedures for Addressing Improper Claims of Use in Trademark Applications and Registrations

While the details for these new procedures still need to be delineated, the TMA announces that

these procedures are designed to be quicker and cheaper alternatives to cancellation proceedings that are filed with the Trademark Trial and Appeal Board (TTAB).

First, the TMA codifies procedures to allow third parties to challenge false and/or inaccurate claims of use during examination. Trademark applicants should consult with their attorneys to see if these procedures can be leveraged against one or more prior-filed pending applications cited against their mark.

Second, the TMA creates new *ex parte* procedures for cancelling trademark registrations for marks that have not been used. The new *ex parte* procedures are called expungement and reexamination. These procedures were created in part to combat the registrations that improperly clutter the trademark register. Data has shown an increase in registrations from China that fraudulently rely on photos that have been manipulated to prove use.

Both new cancellation procedures will be initiated by a third party filing a petition with the Director of the USPTO (“Director”), along with evidence supporting their petition. The third party may be any party who wishes to challenge a registration; proof of standing is not required. The petition may challenge all or just a portion of the goods and/or services identified in the registration. After the initial petition is filed, the Director will determine if the petition has sufficient merit to proceed. The third party will not engage in the proceeding after the initial filing. Unlike cancellation proceedings with the TTAB, the Director of the USPTO may initiate either of these new procedures on their own initiative.

Expungement (Removal)

A registration may be challenged under the expungement procedure if the registrant has *never* used the mark in commerce in connection with the identified goods and/or services. In general, an expungement proceeding can only be brought between the third and tenth anniversaries of the registration. However, during the first three years of the enactment of the TMA, an expungement

proceeding can be brought against a registration any time after the third year following the registration date, even after the tenth year following the date of registration.

If a proceeding is instituted by the Director, a registrant can submit evidence showing that the mark was in use (or an excusable nonuse). Such a satisfactory showing prevents the registration from being expunged. If the registrant cannot submit evidence showing that the mark was in use (or an excusable nonuse), the Examiner will determine that the registration should be cancelled.



Reexamination

A registration may be challenged under the reexamination procedure if the mark was not used in connection with the identified goods and/or services at the time the trademark owner declared it was to the USPTO. A reexamination proceeding may be brought at any time within the first five years following the date of registration.

Note, the TMA provides limitations on later expungement and reexamination proceedings. Thus, once a registration is challenged, the same registration cannot be challenged again for the same goods and/or services where the registrant demonstrated use of the challenged goods and/or services (or an excusable nonuse).

Particularly with these new procedures, trademark owners should ensure that all of the goods and/or services listed in their applications and registrations are in use. Although only one specimen is required for each class to show use, applicants and owners

should obtain and store specimen for each and every good and/or service in the application or registration each time a specimen is required. Trademark owners should also pay extra attention to filing specimen that are difficult to challenge.

3. Shortened Response Time

While trademark applicants currently have a six month period of time to respond to office actions issued during examination, the TMA grants the USPTO the authority to shorten the response time to as short as 60 days. Thus, applicants should pay close attention to the response period set by the office to avoid abandonment of their applications. For those periods of time that are shortened, applicants will have the ability to request extensions of time to have the full six month response period, but such requests will likely have to be accompanied by government fees. We will know more details about the process for obtaining extensions of time following the administrative rulemaking process.



IP ASPECTS OF CANNABIS **High-Level Overview** **of Intellectual Property** **Protection for the** **Cannabis Industry**

By: Lacey Miller³

The cannabis industry is booming and as it continues to grow, new cannabis-related businesses are forming in various sectors of industry and new plant varieties, products, and techniques are developed daily. Protecting cannabis-related businesses and innovations as they emerge and develop is essential to industry success.

As the United States drifts toward the legalization of cannabis, the cannabis industry must be able to adapt to the rapidly changing laws and constantly

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increasing competition. The federal government divides the cannabis plant species into two categories – the hemp category and marijuana category. Hemp is distinguished as having a concentration of no more than 0.3 percent delta-9-tetrahydrocannabinol (THC). Federally, marijuana remains illegal under the Controlled Substances Act of 1970 whereas hemp was legalized under the 2018 Farm Bill. A majority of states have also decriminalized or legalized some form of medical or recreational usage of marijuana.

Intellectual property protection can be sought for brand names, logos, packaging, consumer products, cultivation methods, plant varieties, plant by-products, and more. Below is a brief overview of the different types of intellectual property protection available for businesses and individuals operating and innovating in the cannabis industry.

Trademarks

Trademarks provide protection for words, phrases, symbols, and designs that are source indicators of goods or services.

State trademark protection or common law protection may be sought in some states, but provide limited protection compared to federal trademarks. Federal trademarks are issued by the United States Patent and Trademark Office (USPTO) and provide national protection for a mark. Thousands of marks have already been

registered with the USPTO for cannabis-related brands and the USPTO even has a designated design code (05.13.09) for marijuana, cannabis, and hemp plants or leaves. One requirement to obtain a federal registration for a mark is lawful use of the mark in interstate commerce. This means federal trademark registration can only be obtained for federally legal products and services sold across state lines.

Currently, trademark registration can be sought for goods and services that do not directly implicate or touch the marijuana plant. For instance, hemp production, providing cannabis related information or education, and providing services to cannabis businesses, such as marketing, are all services eligible for trademark registration. Goods such as hemp products, non-cannabis-specific smoking accessories, and apparel are also eligible for registration. However, it is not uncommon for the USPTO to closely scrutinize trademarks applied for by businesses that directly touch the marijuana plant, such as dispensaries and growers.

If marijuana becomes federally legal, more trademark registrations could be obtained on marijuana-specific brand goods and services, such as logos, brand names, slogans, packaging, scents, sounds, and even colors. Early protection of some sort may prove to be extremely beneficial for the future as it can help to show prior use in the industry where a previously illegal use might not be accepted.



Copyright

Copyrights provide protection for creative works, such as logos, written materials, photographs, and software.

Copyrights are issued by the United States Copyright Office and may be used to protect logos or other marketing or business works. There is no legality requirement for obtaining a copyright; however, because U.S. federal district courts hold exclusive jurisdiction over copyright infringement cases, enforcement of cannabis-related copyrights in federal copyright actions may be complicated.

Trade Secrets

Trade Secrets provide protection for information that is not generally known, has value to others who cannot legitimately obtain the information, and is subject to reasonable efforts to maintain its secrecy for as long as the requirements are met.

Trade secrets only protect information that is not generally known or reasonably ascertainable by others. Trade secret protection does not prevent others from ascertaining the information in legitimate ways, such as experimenting or reverse engineering. Therefore, they should be used for certain aspects of a business, including formulas, recipes, processes or methods that have economic benefit and are not easily determined. There is no legal process to obtain a trade secret, but a business owner must take the necessary steps to protect a trade secret. These steps can include labeling, non-disclosure agreements, proper training for employees, and limiting exposure to a need-to-know basis.

Differing state laws may make trade secrets particularly beneficial for the cannabis industry. Those in the industry may choose to protect items, such as customer lists, soil compositions, cultivation methods, harvesting processes, extraction methods, drying methods, and marketing strategies. Recipes and formulas, such as those for oils, edibles, supplements, and cosmetics, would also be candidates for trade secret protection.

Patents

Patents are issued by the USPTO and, like copyrights, do not have a legality requirements. Patents provide a right to exclude others from making, using, or selling the patented invention. Enforcement of cannabis patents is untested and will likely prove to involve numerous legal issues.

One requirement for an invention to be patented is that the invention must be novel. This means that the applied-for invention cannot be the same as another invention or patent/application (i.e., prior art) and it cannot be previously available to the public. There is an exception for the applicant's own public disclosures within one-year prior to filing the application. For the cannabis industry, this is complicated for a few reasons. First, there is limited publicly-available research and information for the applicant and a Patent Examiner (at the USPTO) to compare to the filed application, which could result in the granting of patents even though the invention may already be publicly available. Second, the cannabis black market is as old as the laws prohibiting it; consequently, many products have already exceeded this one-year disclosure period and would not be eligible for patent protection. Finally, there may be some questions that arise as to what was publicly available.

A patent only provides owners with the right to exclude others; it does not give the owner the right to make, use, or sell the invention ... you would still need a license from that person to make, use, or sell the patented invention. The right to use or freedom to operate is another matter. If the invention involves a plant or product owned by another, the patent owner would still need a license from that person to use or sell the patented invention.

Additionally, an owner must be able to enforce the patent, which can involve litigation in federal court. Currently, the enforcement of cannabis plant patents is largely unknown and untested. Some issues that may arise are the validity of patents, the legality of the industry, prior art, if enforcement would require illegal activity, and the regulation of the black market. One of the most closely watched cases, *United Cannabis Corporation v Pure Hemp Collective Inc.*, No. 18-CV-1922-WJM-NYW, 2020 WL 376508 (D. Colo. Jan. 23, 2020), was dismissed on March 31, 2021 after United Cannabis Corporation's bankruptcy, without the court's ability to fully analyze the infringement claims.



Design Patents

Design patents provide protection for ornamental designs of manufactured articles for 15 years from the issue date of the patent.

Design patents can be used to protect the unique shape or appearance of items, but they do not protect plants, methods, or the use of an item. Design patents may be sought for ornamental items, such as storage containers, product packaging, wrappers, displays, and any accessory products with a cannabis-related design.

Plant Patents

Plant patents provide protection for distinct and new varieties of plants - limited to those that can be propagated asexually - for 20 years from the filing date.

While plant patents may seem to be the obvious choice for patenting a cannabis plant, the protection they offer is limited. Plant patents only cover asexual reproduction and clonal varieties of plants, which means that seed cultivation would not infringe the patent.

A biological deposit of the plant is not required for plant patents, but the application must include a complete botanical description of the plant and the characteristics which distinguish that plant from other known plants. The description needs to be of the entire plant even if only part of the plant is useful or sold. The description should include details regarding growth habit, branching habit, shape, bark, buds, blossoms, leaves, fruit, fragrance, taste, disease resistance, productivity, precocity, and vigor, if relevant. For cannabis plants, a description and level of THC and cannabidiol is also important.

Utility Patents

Utility patents provide protection for processes, machines, manufactured goods, and chemical, biological, and other compositions of matter for 20 years from the filing of the patent application.

Utility patents are more expensive and harder to obtain than plant and design patents, but the protection they offer is more inclusive. Utility patents can be sought for both sexually and asexually reproduced plants, plant products, consumer goods, methods, or machines. To be eligible for patent protection the invention must be patent eligible subject matter, novel, non-obvious, and fully enabled by the description provided in the patent application.

The process for obtaining a cannabis plant or plant by-product utility patent has many unique challenges. The patent-eligible subject matter requirement eliminates naturally occurring

plants, and as previously mentioned, the novelty requirement places limitations on inventions that have been available to the public for more than one year from filing.

Finally, the enabling requirement means that the application must describe how to make and how to use the invention. Using words alone to describe how to make a plant or plant product is nearly impossible, and many applications are rejected for lack of enablement. If a specific cannabis plant is essential to the claimed invention, it must be obtainable by a repeatable method or readily available to the public. To overcome this, some applicants have chosen to use a biological material sample deposit under the Budapest Treaty. This process typically involves depositing a sample of 2,500 seeds at a U.S. depository. However, U.S. depositories will not accept federally illegal substances, including marijuana seeds. Some applicants have used international depositories, such as the National Collections of Industrial, Food and Marine Bacteria Ltd. in Scotland. In at least a few instances, the USPTO has allowed applicants to deposit a smaller number of seeds, partially to accommodate different state limitations of legal possession.

Utility patents may be sought for both sexually and asexually reproduced cannabis plants, specific genes or traits, and methods, such as breeding, cultivation, propagation, extraction, or sorting. Additionally, utility patents may be sought for products, such as lamps, harvesting equipment, accessories, sorting devices, smoking, and cannabis-infused products such as food, beverage, pharmaceuticals, and cosmetics.

Plant Variety Protection Act Certificates

Plant Variety Protection Act Certificates provide protection of new varieties of seeds, tubers, and asexually propagated plants for 20-25 years.

Certificates are issued by the U.S. Department of Agriculture Plant Variety Protection Office. Certificate owners have the right to exclude others from marketing and selling their varieties, manage

the use of their varieties by other breeders, and enjoy legal protection of their work. Plant Variety Protection does not protect reproduction of a protected variety for plant breeding, for research, or for bona-fide purchasers to save a limited amount of seed for replanting.

The process to obtain a certificate involves an applicant paying an application fee of \$5,150 and depositing 3,000 seeds at the National Laboratory for Genetic Resource Preservation in Fort Collins, Colorado. Currently only hemp seeds can be protected as the depository will not accept marijuana seeds.

Conclusion

A strong intellectual property portfolio involves multiple different types of protection. The above listed types of protection can be obtained individually or in combination with one another. For example, a trade secret may be used prior to applying for a utility patent or a logo could be trademarked and used in a design patent. Industry members should work with an intellectual property lawyer to develop a strategy that best suits the specific needs for their business. A proper strategy will take into consideration business size, timing, location, laws, and cost.





DATA PRIVACY

Where Do I Stand?: A Review of Recent Standing Decisions in Data Breach Class Actions

By: Jessica Copeland⁴ and Lacey Miller



As instances of successful cybersecurity breaches steadily increase across the country, so do the number of class action suits. However, in order to bring such a valid class action suit, Article III

of the U.S. Constitution states that a plaintiff must have standing. Thus, the question turns to when does a person go from being merely someone afflicted by a data breach to someone who can be a plaintiff with standing. Article III requires the plaintiff must personally have:

- suffered some actual or threatened injury;
- that injury can fairly be traced to the challenged action of the defendant; and
- that injury is likely to be redressed by a favorable decision.

Plaintiff Alleges Actual or Threatened Injury

The first element of standing is that the plaintiff must establish that they have an actual or threatened injury. Data breaches typically result in myriad unknown circumstances and unanswered questions regarding where the intrusion originated and the extent of exposure. Specifically, in response to a data incident the following questions arise, and several remain unanswered even after a thorough investigation: what data was stolen, who stole the data, what was their intent, and what was done with the data. This can put those inflicted by the breach in a precarious situation of not knowing if they are about to become a victim

of identity theft or not. For class action suits, the named plaintiff must be someone who has actually suffered the injury and cannot merely allege the injury of others. It is easy to establish actual injury in situations where there has been identity fraud or credit card fraud. However, not all plaintiffs wait until they have an actual injury to file a suit.

For those plaintiffs that merely allege threatened injury, courts have held that the injury needs to be more than the mere possibility of a future injury. It must rise to the level of being *certainly impending* or *have substantial risk of imminent injury*. What exactly rises to this level continues to be analyzed all over the country. While not all jurisdictions are aligned, the general trend is that in matters where the plaintiff has not alleged an actual injury, the allegations must set forth specific risks that raise the level of threat from possible to impending. In February, the Eleventh Circuit confirmed this analysis. *Tsao v. Captiva MVP Rest. Partners, LLC*, 986 F.3d 1332 (11th Cir. 2021).

While there is still inconsistency among the circuit courts, some factors that weigh in favor of finding standing where a plaintiff only pleads future injury are:

Type of Information

The sensitivity of the information is an important factor in determining risk of future harm. Most courts agree that the exposure of certain information, such as credit card numbers or social security numbers, presents a substantial risk of identity theft and/or financial harm. Whereas information that is publicly available or less sensitive, such as pure directory-type data including names and contact information, presents a lower risk of causing any future harm.

Other Injuries

Where the plaintiff alleges other affected individuals suffered an actual injury as a result of the same data breach, courts are more likely to find the plaintiff has standing. *McFarlane v. Altice USA, Inc.*, No. 20-CV-1297 (JMF), 2021 WL 860584 (S.D.N.Y. Mar. 8, 2021).

⁴ Jessica is co-chair of the firm's cybersecurity and data privacy practice. She advises her clients in all aspects of business counsel and disputes, with a particular focus on data privacy, cybersecurity and intellectual property.

Data Exposure

The extent of the exposure and what was done with the data, if known, may also be relevant. Data that may have been accessed but not sold or publicly exposed may be less likely to cause an injury.

Time Since the Breach

An extended period of time passing since the breach with no injury weighs in favor of dismissal.

Mitigation Efforts by the Plaintiff

In instances where credit card information was stolen and the plaintiff has since canceled that credit card, courts may find that there is no longer a future threat of credit card fraud.

After a data breach, many people will take steps to mitigate the risk of any actual injury, such as purchasing a credit monitoring service. Most courts view mitigation costs alone as self-inflicted injuries in attempt to manufacture standing. Yet, where the court has already deemed that there was a threatened injury or where there was a sufficient need for the mitigating measures, some courts will deem these costs an actual injury. Emotional distress, decreased economic value of information, and denial of the benefit of the bargain are additional injuries plaintiffs commonly argue in data breach lawsuits with varying but limited success. The Third, Fourth, and Eighth Circuits are more restrictive in finding standing where only future injury is alleged, whereas the Seventh and Ninth Circuits are more liberal, resulting in those districts being the preferred venue for class actions of this nature.

Causal Connection of the Injury

The alleged injury must have been caused by the defendant's data breach. If the type of information used to cause an injury was not the same as the type of information exposed in the data breach, the causal connection is hindered. Also, if the information exposed was already publicly available, it can be harder to trace an injury to the breach. If the defendant used a third-party to store

or manage information and that party was hacked, the plaintiff has to allege that the defendant was responsible for the breach of another or did not do enough to prevent that breach and that the defendant owed the plaintiff a duty to do so. Recent trends show that courts are requiring more than mere conclusory allegations and that the plaintiff must plead sufficient facts relating to what the defendant did or did not do that led to the injuries. *Springmeyer Et Al. v. Marriott International, Inc.*, No. 20-CV-867-PWG, 2021 WL 809894 (D. Md. Mar. 3, 2021).

Redressable by Favorable Decision

Finally, the injury suffered must be able to be remedied by a favorable outcome in court. In most cases, alleging a monetary award is deemed sufficient to redress an actual injury.

Conclusion

Any class action plaintiff that fails to plead the above elements (injury, causation, and redressability) will have their case dismissed. A majority of U.S. District Courts have routinely dismissed complaints where the plaintiff has suffered no actual injury and only alleges the possibility of future injury. It is also becoming increasingly common for courts to closely scrutinize a class action plaintiff's allegation of a causal connection. And, while there remains a split of the circuits in terms of surviving a motion to dismiss, it is clear that plaintiffs in the Seventh and Ninth Circuits are more likely to withstand dismissal on the grounds of lack of standing.





CASE UPDATE

Supreme Court has Held Google's Copying of Oracle's JAVA APIs was Fair Use

By: George McGuire

In an article from our Summer/Fall Recap 2020 newsletter [here](#), we provided the background and summary of the oral arguments at the Supreme Court for this decade-long copyright battle between Google and Oracle. In short, Google used many of the JAVA APIs in writing the Android Operating System; this interface code was a convenient way to provide programmers with the location of the code that actually executes instructions and was all original code written by Google's programmers. In other words, Google copied the interfaces from JAVA that provided access to original Google code. In weighing the copying of the interface code, the Supreme Court held, in a decision issued April 5, 2021, that each of the four fair use factors weighed in favor of fair use, and then concluded, unsurprisingly, it was indeed fair use. The other question before the court – whether APIs were even a proper subject for copyright protection – was left undecided for another day. The Court presumed for sake of argument that such code is copyrightable, but in light of its determination that the copying was a fair use, the Court indicated there was no need to decide whether the code is actually copyrightable. Thus, one key takeaway from the decision appears to be that copying interface code (APIs) for functional reasons would quite likely be determined a fair use.



NEWS & HIGHLIGHTS



Bond Congratulates Lacey Miller on Passing the Patent Bar Exam!

The Patent Bar tests one's knowledge of patent laws, rules, and procedures and one's ability to analyze factual situations and properly apply these principles. In order to qualify to take the exam, one must establish they have the moral character and reputation, as well as the requisite scientific and technical background and competence to advise and assist patent applicants in the presentation and prosecution of their applications before the U.S. Patent Office. Although these requirements are needed to qualify to take the exam, the patent bar does not test scientific or technical knowledge. With an exam passage rate that is under 50%, Lacey's accomplishment is no small feat. Congratulations again!

Bond, Schoeneck & King and Putney, Twombly, Hall & Hirson Unite

Bond is pleased to announce that the law firm of Putney, Twombly, Hall & Hirson (Putney) became part of our firm on April 1, 2021. As the New York City region looks forward to business renewal and post-COVID recovery, two century-old New York state firms have joined forces to enhance the legal services they provide to their clients. Together, we offer even greater strength in our labor & employment, trusts & estates, litigation and corporate practice areas. Putney clients now have access to Bond's wide spectrum of practice areas outside of these four including intellectual property. With the combination and addition of an office in Red Bank, New Jersey, Bond now maintains 12 offices across New York, New Jersey, Massachusetts, Kansas and Florida. We extend our warm welcome to the lawyers and staff who are joining us!

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