INTELLECTUAL PROPERTY LAW
AMERICAN BAR ASSOCIATION YOUNG LAWYERS DIVISION

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MESSAGE FROM THE COMMITTEE

Welcome to the first quarterly installment of the YLD Intellectual Property and Internet Law Committee Newsletter for the 2016-2017 bar year! Our Committee is dedicated to providing resources, opportunities, and knowledge to help young lawyers build their IP and Internet Law practices.

The leadership of the Committee is here to serve you and your fellow committee members!

Co-Chairs: Alex Chan and Amanda Katzenstein
Vice-Chairs: Ben Hodges, Ukeme Jeter, Debolina Kowshik, Michelle Miu, and Donielle Robinson

Visit our webpage to take advantage of the Committee's resources. If you are interested in writing a practice article, creating or presenting a CLE program, or becoming more involved with the Committee, please contact Alex Chan at Alex@datanovo.com or Amanda Katzenstein at AKatzenstein@polsinelli.com.

NEWS AND ANNOUNCEMENTS

ABA Midyear Meeting

From February 2nd – 5th, 2017, join your fellow committee and YLD members for three fun-filled days of CLEs and networking in Miami, FL! Register online at the http://www.americanbar.org/calendar/midyear2017.html to plan your trip. If you plan to attend the ABA Midyear Meeting, please considering taking some notes and preparing a summary of the meeting and/or your experience for our Committee's next newsletter.

Upcoming Teleconference

"Comparative IP Law: Attorneys' Fee Awards in Patent Litigation in the US, UK, Germany, and Canada"
November 15, 2016 at 10:30 a.m. EST

Attorneys' fee awards in US patent litigation are highly debated. While Octane Fitness and Highmark have set the standard for attorneys' fee awards in the US, it is helpful to contrast the US approach with so called "loser pays" jurisdictions. We will look to patent litigation in Canada, the UK, and Germany to discuss (1) the proper venues for patent disputes; (2) starting assumptions for attorneys' fee awards in patent cases; (3) factors considered in awarding attorneys' fees and quantum of awards; and (4) the process for obtaining an attorneys' fee award.

Free CLE Events

Using Social Media to Brand and Grow Your Practice
November 1, 2016 1 p.m. - 2 p.m. EST.
FREE Webinar

Student Loan Best Practices in the Face of Political Change
November 3, 2016 1 p.m. - 2 p.m. EST.
FREE Webinar

ARTICLES

Tech Giants Take Design Patent Case to Supreme Court

By: Debolina Kowshik

How did you decide on your last smartphone? Was it based purely on the aesthetic design? Or were functionality and user experience equally important factors? These are some of the questions that were considered by our eight justices earlier this week as Apple and Samsung presented oral arguments in the first design patent case to reach the Supreme Court since 1885. The companies have been involved in patent litigation since 2011 and just debated a small piece of the overall lawsuit in their oral arguments: what is the appropriate amount of damages to be awarded when a design patent is infringed?

A design patent protects the ornamental features of an invention. Samsung was found to have infringed three of Apple's design patents covering: (1) the black rounded rectangular shape on the front of the device; (2) the front face of the device along with its bezel frame; and (3) the icon layout on the home screen.[1] As a result, the South Korean giant was required to pay damages equaling total profits from the sale of all infringing devices, amounting to $399 million, as required under Section 289 of the Patent Act, 35 U.S.C. §289. Not ready to give up that easily, Samsung argued there is much more to a smartphone than just the external design and each patented phone component should play a part in determining damages.

Design-heavy brands such as Tiffany & Co. and Adidas have shown their support for Apple by filing amicus briefs arguing that the Section 289 total profits rule deters "design pirates" and any decision to amend the Act should be left to Congress.[2] On the other side, Samsung received backing from tech companies such as Facebook and Google. They argued that the "article of manufacture" in Section 289 should take into account the numerous components that go into a smartphone, such as the camera, operating system, and synchronization across devices, and the damages should be scaled accordingly.[3]

No matter which way you lean, one thing is clear: the realm of design patents continues to take on new shapes and forms as technology advances. The Supreme Court is expected to issue a ruling before the end of its term in June 2017.

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[1] Apple Inc. v. Samsung Elecs. Co., 786 F.3d 983, 989, 114 U.S.P.Q.2d 1953, 1956 (Fed. Cir. 2015).
[2] Brief for Tiffany and Company, et al. as Amici Curiae Supporting Respondents, Samsung Elecs. Co., Ltd., et al. v. Apple Inc., 786 F.3d 983, 114 U.S.P.Q.2d 1953 (Aug. 5, 2016) (No. 15-777).
[3] Brief for the Internet Association, et al. as Amici Curiae Supporting Petitioners, Samsung Elecs. Co., Ltd., et al. v. Apple Inc., 786 F.3d 983, 114 U.S.P.Q.2d 1953 (Jun. 8, 2016) (No. 15-777).

Be Original in Briefs to Advance Your Argument and Avoid Copyright Infringement

By: Ben Hodges

At a very early stage in practice, every young lawyer should realize that there is no need to reinvent the wheel in his or her briefs. Very few truly original issues exist in any given case; therefore, it makes sense to look to past briefs for inspiration regarding the argument and the law. However, there is a difference between inspiration and copying. This difference has always been an issue of professional integrity, but now it is also one of legal liability.

The Court in Newegg Inc. v. Ezra Sutton, PA, CV 15-01395 TJH, Doc. # 64 (C.D. Cal. Sept. 2016) faced this issue when an attorney copied large portions of an appellate brief filed by another lawyer for another client (Newegg), and then filed those portions in a brief to support his client. Though the lawyer withdrew the brief and filed a different brief shortly thereafter, Newegg registered the brief and sued the attorney for copyright infringement. The Court in turn granted summary judgment for Newegg on liability and decided that the attorney's use was not fair use.

Fair use has four factors: (1) the "purpose and character of the use"; (2) the "nature of the copyrighted work"; (3) the "amount and substantiality" of the copying compared to the work as a whole; and (4) whether the copying has any effect on the "market or value of the copyrighted work."[4] Here, the Court found that making only "minor and cosmetic changes" to a brief used for the same purpose weighed against fair use for the first factor.[5] For the second factor, the Court found that legal briefs are "functional presentation[s] of fact and law" and that public policy should encourage dissemination of these through fair use, so the second factor weighed in favor of fair use.[6] The Court also found that since "most, if not all, of the substantive portions" of the brief were copied, the third factor weighed against fair use.[7] Finally, the Court found that with no identified market for the brief, the fourth factor weighed in favor of fair use.[8] Though the factors were split, the Court found that the first and third factors were stronger factors and thus found no fair use.[9] The Court also stated that Fed. R. App. P. 28(i) would have allowed joining the brief or adopting it by reference, but copying went beyond either of those two permissible options.[10]

[4] 17 U.S.C. § 107
[5] Newegg Inc. v. Ezra Sutton, PA, CV 15-01395 TJH, Doc. # 64, at 3.
[6] *Id*. at 3-4.
[7] *Id*. at 4.
[8] *Id*.
[9] *Id*.
[10] *Id*. at 5.

It is unclear whether this case will be appealed or settled. It is also unclear whether such a holding would survive appellate scrutiny. But what is clear is the warning this case sends to young (and old) lawyers: be original. A lawyer can look to past briefs for inspiration on what arguments to make, but the form of the argument should be original. Simply copying past arguments is now not only questionable professional integrity; it exposes a lawyer to copyright liability.

Ben Hodges is Vice-Chair of the ABA YLD IP Committee. Ben is a registered patent attorney and intellectual property litigation associate at Foster Pepper. Ben can be reached at ben.hodges@foster.com.