INTRODUCTORY SURVEY

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I. PATENTS

1. Original Action for a Patent Under 35 U.S.C. § 145

In *Exceptional, After All and After Oil States: Judicial Review and the Patent System,* Professor Michael S. Greve traces the origins and the strange survival of § 145 of the Patent Act. Section 145 permits private parties to contest a denial of a patent application by the Patent and Trademark Office by means of an original action in a U.S. district court. This form of action was called a "bill in equity," in the nineteenth century, and is generally unknown and at great variance with administrative law today. Administrative law operates on the principles of agency adjudication and deferential, on-the-record, appellate review.

This article explains the legal tensions that the § 145 provisions cause between private right and public administration. Under the statutory patent regime of the nineteenth century, an invention patent, once issued, was a matter of private right and could only be revoked in a full-scale judicial infringement proceeding under a demanding standard of clear and convincing evidence. Over the last few decades, however, Congress has created mechanisms of administrative patent revocations.

In its 2018 decision in *Oil States Energy Services, LLC v. Green's Energy Group, LLC,* the Supreme Court rejected the plaintiff's position that invention patents are private rights that cannot be revoked administratively. The Courts said that Congress may create invention patents under its Article I powers, on its own, or can commit that task to an executive

agency. Congress may also commit the re-examination and cancellation of already-granted patents to Article III courts or to executive bodies.

However, the article states that the patent system not only provides for rival mechanisms of defeating a patent; it also provides for rival mechanisms of obtaining a patent. A final patent denial by the Patent and Trademark Office may be contested pursuant to § 141 of the Patent Act by way of an appellate action in the Federal Circuit. Alternatively, § 145 permits disappointed patent applicants to proceed by way of an original action in the U.S. District Court for the Eastern District of Virginia.

Section 141 actions conform to the familiar APA model of appellate review. That review pursuant to § 141 is a deferential, on-the-record, judicial review, with remand to the agency for further proceedings and when appropriate issuance of the patent by the Patent and Trademark Office. Section 145 actions are part and parcel of a patent law system that long predates the creation of the regulatory agencies. Section 145 actions belong to the world of private rights, where adjudication is de novo, and a prevailing plaintiff's patent issues as of right.

While some argue that § 145 should be repealed or assimilated to ordinary appellate review principles, the article argues that the Supreme Court has rejected such treatment. The article predicts that the Supreme Court will re-affirm the "exceptional" statutory nature of patent law and the private-right understanding of § 145 even and especially after the *Oil States* decision.

After describing judicial review under the Patent Act and the history of § 145, the article notes that the overarching theme of post-APA patent case law has been a judicial propensity to eviscerate the patent system's bifurcated judicial review scheme. Principally, the article states, such evisceration has been by treating § 145 as little more than an inconsequential oddity. However, the article states that

the Supreme Court's decision in *Kappos v. Hyatt* stopped that treatment. In that case, the Supreme Court rejected the Federal Circuit's and the government's efforts to assimilate § 145 proceedings to ordinary appellate review standards. Instead, the Court reaffirmed or resurrected the distinctive nature of § 145 proceedings.

The article examines the practical and legal implications of § 145, as interpreted in *Kappos v. Hyatt,* for administrative patent revocation under the America Invents Act. The article argues that patents obtained under § 145 cannot be later revoked by the Patent and Trademark Office or courts under § 141. In conclusion, the article states that one day the Supreme Court will decide this question. The article predicts the § 145 private rights model for patents will survive.

2. Patent Office Power and Politicization

In *Disguised Patent Policymaking,* Professor Saurabh Vishnubhakat discusses the Patent Office's growing power under the America Invents Act, a power relying on a claim to scientific expertise that has come at the expense of the courts. The article warns that the blinkered focus on Patent Office expertise has obscured until now the Patent Office's injection of politics and policy preference into patent law. The article provides an explanation and evaluation as well as a detailed critique of what the article calls "Patent Office aggrandizements to make policy in disguise."

First the article details the offending practices. The article describes the Patent Office's admitted stacking of administrative panels to obtain the outcome the Patent Office wants. The article also addresses the outcry that such stacking is contrary to due process. Next the article discusses the Patent Office's attempt to evade judicial review, first by colorably interpreting ambiguous nonappealability statutes and then by relying on early victories to stake out more implausible terrain.

The article evaluates the effects of these practices by the

Patent Office and identifies benefits of the practices to the Patent Office as well as systemic harms. The article explores alternatives to judicial review for policing Patent Office excesses and concludes such alternatives are inadequate.

The article explains how the Patent Office was able to engage in successful and attempted expansions of its own power described in the article. The article notes that scientific expertise has been a traditional reason given for Patent Office power over patent validity and a reason the power should be reallocated from courts to the Patent Office. However, the article considers this reason incomplete.

Next, the article discusses politics and policy preferences as an increasingly salient explanation for Patent Office power, including even legislative indications that these values should play a role in patent law, but within limits. The article then discusses the Patent Office's questionable choice to commingle the separate powers of screening and adjudication, which Congress delegated separately in the America Invents Act, in a single administrative decision-making body.

Lastly, the article provides focal points for reforming the current system of disguised patent policymaking so that the validity of patent rights is adjudicated more coherently, and the Patent Office exercises its power in a more principled and accountable way. The article lists three points for reform. First, the Federal Circuit should take an appropriate opportunity to interrogate the practice of patent stacking. Second, the Federal Circuit should continue to view with skepticism the expansive interpretation of important, but relatively narrow provisions for nonappealability of the PTAB's decisions. Third, the Federal Circuit should revisit the current Patent Office structure that commingles the Director's screening powers with the PTAB's adjudication powers.

In conclusion, the article states that much of the Patent Office's recent political aggrandizement is a result of conflat-

ing large portions of its ordinarily reviewable adjudicatory process with the initial unreviewable screening process that it also happens to administer. Of particular concern are the stacking of adjudicatory panels until a majority emerges that can deliver politically palatable judgments and the push to expand ordinary nonappealability provisions to cover a wide range of adjudicatory activities over which the Federal Circuit would routinely exercise review. Since only six years have passed since the America Invents Act's post-grant trial proceedings went into effect, the article states that this relatively early stage at which the Patent Office decisions have come makes this an important moment in time in the evolution of patent law's power. Ignoring these problematic agency practices and allowing their underlying cause to persist would reinforce an already troubling status quo.

3. Amazon's New Patent Infringement Protection Program

In *From Amazon's Domination of E-Commerce to its Foray into Patent Litigation: Will Amazon Succeed as "The District of Amazon Federal Court?"* legal commentator Kaity Y. Emerson discusses Amazon's new anti-counterfeit enforcement protocol called the Utility Patent Neutral Evaluation Procedure (UPNEP).

The article begins by noting that Amazon is an e-commerce giant, with a consumer base of over 300 million active users. In a 2017 study, however, Amazon ranked fourth in sales of counterfeit merchandise. Courts don't find Amazon liable for selling counterfeit goods, because Amazon successfully argues that it is a platform for sellers rather than a seller itself. Amazon nevertheless profits from the sale of counterfeit merchandise and so it is under pressure from consumers and legitimate vendors to fix its counterfeit problem.

Amazon launched a Brand Registry program in 2017 to help protect brands that have a federally registered trademark. In 2019, Amazon added its Project Zero program to automatically take down counterfeit listings. Neither of these programs provides any remedy for patent infringement.

Amazon's new UPNEP program, still in the testing phase when this article was written, is Amazon's latest intellectual property protection effort and an attempt to combat utility patent infringement through a company quasi-judicial process rather than an internal quality-control approach used for trademark infringement with Project Zero and Brand Registry.

The UPNEP has some similarity to simplified International Trade Commission proceedings. After agreeing to the UPNEP, the parties participate in compact briefing over approximately a two-month period. The compact briefing is limited to fifteen pages and a neutral evaluator issues a decision shortly after receipt of the briefing. In all, the procedure takes about four months and initially costs each party $4000. The entire $4000 is ultimately refunded to the winning party, and if the parties settle, each party gets all but $1000 back. Products found to infringe a patent are removed from sale on Amazon.

The UPNEP does not foreclose either party from pursuing another form of relief and the UPENP will honor any subsequent court decision. There are no safeguards to prevent the same infringing seller from making another username and posting the same product. Amazon also excludes its own private label merchandise from UPNEP.

The article concludes that UPNEP should adopt a third party management structure to gain independence from Amazon and to encourage neutral decision-making from its evaluators. The article also indicates that the neutral evaluators should limit their decisions to clear-cut cases with a clear and convincing evidence standard.

4. Secret Sale Patentability Bar

In *A Tale of Two Sales: How a Secret Sale Remains a Bar to Patentability Under the AIA,* legal commentator Kris Schroder discusses the background of the on-sale bar within patent law, the relevant statutes before and after the Amer-

ica Invents Act, and the intent of Congress when writing the America Invents Act. The article then provides a case analysis of the Supreme Court's 2019 decision in *Helsinn Healthcare S.A. v. Teva Pharm, USA, Inc.*

Before the America Invents Act, the law provided that an invention on sale for more than a year before a patent application was filed was barred from patentability. The America Invents Act made a number of changes in American patent law. That Act moved the American system from a "first to invent" system to a "first to file" system. In a first to invent system, the law is more concerned with giving patent rights to the person who invented the subject matter first. In a first to file system, the law is more concerned with granting benefits to those inventors who disclose their invention first, allowing the public to benefit from the *quid pro quo* nature of the patent system faster. This change made the United States system more like that of most other patent systems in the world.

With respect to the on-sale bar, the America Invents Act inserted the words "or otherwise available to the public." This change gave rise to debate as to whether Congress intended this additional language to cover unforeseen circumstances by which the claimed invention became available to the public or if this was a clarification that the rest of the statute only applied when the claimed invention became available to the public. The question then became whether the Act implied that the on-sale bar should be for public sales only.

After considering remarks in Congress while considering the statute, the article discusses the history of the *Helsinn Healthcare S.A. v. Teva Pharm, USA, Inc.* case and the decision of the district court and the Federal Circuit. The article then considers the Supreme Court's decision that the America Invents Act did not change the on-sale bar.

The article argues that the Supreme Court misread the intent of Congress. The Court viewed the "otherwise avail-

able to the public" phrase as a "catch-all." The article views the phase to have been a narrowing phrase, to limit the on-sale bar to sales that are public. The article concludes that the Supreme Court erred in its conclusion and proposes that Congress can easily correct the Court's error with a simple Congressional amendment to the statute. The article proposes changing "on sale" to "on sale to the public."

5. Software and the Abstract-Ideas Doctrine

In *Abstraction in Software Patents (And How to Fix It)*, attorney Athul K. Acharya addresses the abstract nature of software technology and the abstract-ideas doctrine prohibiting patentability. The article first discusses the abstract-ideas doctrine itself and what it means for a patent claim to be considered impermissibly abstract. Next the article explores why software claims run afoul of the doctrine. Computer science is, the article notes, by its own description, a "science of abstraction."

The article then explores and rejects a common objection to software patents—that software consists of algorithms and algorithms are just math. The article argues that in fact, software patents that claimed actual algorithms rather than vague results would be an enormous improvement over most software patents today. Further, algorithms can be claimed concretely in pseudo code.

In conclusion, the article admits that software is challenging for patent law. However, there is innovation in software, the very kind of innovation that patent protection is intended to encourage. Thus, the article makes the case that software claims written in pseudocode would go a long way toward solving the problem of abstraction in software patents.

6. Disgorgement Remedy for Design Patent Infringement

In *The Disgorgement Remedy of Design Patent Law,* Professors Pamela Samuelson and Mark Gergen focus on the *Apple v. Samsung* case to revisit the origins and application of the disgorgement remedy in design patent law. The article

explains that Congress created the remedy in the late nineteenth century to overrule two Supreme Court decisions that awarded nominal damages as the sole compensatory remedy for infringements of design patents. Patented designs back then were generally or nearly co-extensive with the appearance of products sold in the marketplace and Congress viewed the product design as what sold the product.

Thus Congress created the statutory design patent disgorgement remedy, now codified in § 289, for a patent owner to ask for a disgorgement of the "total profit" that an infringer made from sales of articles of manufacture to which an infringing design had been applied. There is no evidence, the article states, that Congress intended to change the fundamental and well-established character of a disgorgement remedy—stripping profit attributable to the wrong and no more. Anyone who wanted to impose a penalty on willful infringers would have to look to the treble damages remedy available under a different provision of patent law, such as § 264 today.

However, in the modern era, it has become common for design patents to issue on small parts, features, or components of complex products and on designs that are more functional than ornamental. Such changes in the nature of the design patent entitlement have precipitated a crisis about how to interpret the "total profit" remedy of § 289.

The design entitlement has been fragmented. What was once an entitlement to the distinctive overall appearance of a product of novel design has become an entitlement to the distinctive appearance of novel partial design elements embodied in a product. This fragmentation has significantly changed the nature of the entitlement by broadening its scope. The entitlement now reaches products that may be similar as to a particular element covered by a design patent, even if quite dissimilar in overall appearance.

Further, the article indicates that the fragmentation problem is exacerbated by a functionality problem. Patent

officials and courts have become willing to issue and uphold patents for designs that on their face are more functional than ornamental. Consequently, design patent law today is sometimes used to grant exclusive rights in functional designs that should be protected, if at all, under utility patent law, which subjects inventions to more rigorous examination for novelty, unobviousness, and specific claiming.

Fragmentation of the design patent entitlement and greater allowance for functionality in designs have put pressure on the § 289 disgorgement remedy and total profit rule. The fragmentation of the entitlement increases the likelihood that the total profit rule will capture profits that are not causally attributable to the infringing design.

The Supreme Court in *Apple v. Samsung* was made aware of concerns about the risk of grossly disproportionate awards in partial design cases. The Court qualified the § 289 total profit remedy by holding that a design patent owner could recover the total profit on a product in some cases, while in other cases the patent owner could recover only profit attributable to the infringing partial design element. Which measure of damages could be recovered would depend on what adjudicators determined was the relevant "article of manufacture" for § 289 damages.

The article reviews the Supreme Court's ruling in *Apple v. Samsung*, and explains why the Court's decision was historically ill-informed and normatively unpersuasive. The article states that the Court failed to consider fundamental principles that underlie the disgorgement remedy in tort and other substantive fields of law and how those principles should inform both the normative goals of disgorgement awards in design patent cases as well as the methodology for making such awards.

The article notes that the Court said nothing about how to calculate disgorgement damages when the relevant article of manufacture was not the end product. The article states that the Court did not mention the nuanced purpose of the

disgorgement remedy (which is to deter but not to punish), and the Court did not indicate what if any weight should be given to the scope of a design patent in assessing profits disgorgement.

After explaining how the *Apple v. Samsung* decision made things worse for defendants in design patent cases, the article proposes some ways to address the problems perceived with § 289 awards in partial design patent cases. The article concludes that causation and apportionment can and should be taken into account in § 289 awards in partial design patent cases.

II. TRADEMARKS AND TRADE DRESS

1. Disparity in Trademark Rights

In *The Likelihood of Exclusion: Economic Disparity in the United States Trademark System,* attorney Michael J. Choi discusses the expansion of trademark rights and how such expansion has contributed to suppression of small businesses. The article reports that as of 2014, 99.9% of the United States' 28.2 million businesses were small businesses, that is, businesses generally having fewer than 500 employees. Of these, 78% were sole proprietorships. Such small businesses generally do not focus their resources on registering and protecting trademarks. And these small businesses are vulnerable to trademark bullying by large businesses.

The article first provides an overview of the developments in statutory trademark law and the trademark registration process. Next, the article discusses the expansion of trademark rights and the lack of legal recourse available for accused infringers. The article posits that trademark protection's inherent flaw is that it grants more protection to some while denying recourse for others. This flaw, the article states, follows the expansion of rights afforded by trademark law, the scope of which has shifted from consumer protection

to personal property interest. The resulting imbalances enable many trademark holders to abuse their rights.

The article states that current trademark law expands what might be considered "confusing," so rather than considering the harms trademark law historically seeks to prevent (fraud and counterfeit of goods), litigation stems from confusion of the mark itself. Expanded trademark protection—for descriptive marks, famous marks, and a mark's foreseeably related markets—demonstrates the growing property interests in trademarks.

The article notes that trademark law depends heavily on the likelihood of confusion analysis, so parties caught in a trademark infringement suit have a limited arsenal with which to defend themselves. Trademark examiners lack a standard of review and are not required to follow other registration decisions when considering whether or not to register a mark. Further, the existing case law for trademark infringement is equally unreliable. Attorneys commonly advise their clients based on their experience rather than the merits of the case because of the lack of value in precedential cases. Statutory and common law defenses are few and unhelpful. And unlike copyright law, trademark law does not recognize trademark misuse claims.

The article states that increasing trademark protections for tangential goods and markets and famous marks encourages large companies to aggressively police their marks. Large companies, like all rights holders, must diligently police their marks but unnecessary and aggressive policing can cross into trademark bullying if their infringement claims are unmeritorious.

Trademark bullying has four aspects: (1) an unreasonable interpretation of trademark rights; (2) intimidation tactics; (3) the trademark enforcer is a large company; and (4) the accused infringer is a small business. A large company unreasonably interprets its trademark rights when it fails to conduct a complete and objective trademark assessment of

the alleged infringer's mark, exaggerates the strength of its own mark, or exaggerates the extent to which confusion is likely.

According to the article, current trademark law ensures that small businesses are effectively excluded from the trademark system. Nevertheless, the article provides some avenues to equalize these imbalances. First, the article suggests trademark law reform. Adding a trademark misuse claim that parallels copyright misuse can help minimize trademark bullying. Reigning in the expansion of trademark rights would also be helpful, as would limiting the likelihood of confusion inquiry to confusion regarding the actual source of a product.

Next, the article suggests trademark shaming as a solution to ward off trademark bullies. To successfully shame a trademark bully, at least four mandatory conditions should be met: (1) the target is vulnerable to shaming; (2) the community shares in the norms transgressed by the target; (3) the community includes an overlap between the target's consumers and the shamer's consumers; and (4) the shamer has credibility in the community.

Lastly, the article advocates that large companies engage in corporate social responsibility. In conclusion, the article states that trademark law should apply equally to all businesses and rights holders because the law should protect intellectual property interests regardless of economic disposition. In our free-flowing marketplace, respect for other rights holders ensures trademark law returns to the basic concept of protecting consumers from fraud and counterfeit.

2. Unlawful Use

In *Unlawful Use in Commerce and the Affirmative Defense to Infringement: When Trademark Rights are Not What They Appear to Be,* attorney James B. Astrachan explores the requirement that a trademark must be lawfully used in commerce in order to meet the use in commerce requirement

imposed by the Lanham Act to permit registration of the mark with the U.S. Patent and Trademark Office. The article also discusses the affirmative defense that may exist where a mark's owner failed to lawfully use the mark in commerce, and as a result failed to legitimately obtain trademark rights in the designation.

The article begins with advice as to the enormous value trademarks can have to a business. Some famous marks such as GOOGLE, APPLE, and MICROSOFT, for example, are estimated to be worth literally billions of dollars. One reason the marks have value, the article explains, is because their distinctiveness allows marketers to employ them to brand and create interest in products that are otherwise uninteresting or merely commodities. Further, trademarks derive value from attributes that other forms of intellectual property do not enjoy. That is, the longevity of a trademark's life is not governed by any statutory expiration, but rather lasts so long as the mark remains in continuous use. The oldest known mark, STELLA ARTOIS, for beer, dates back to 1366, although it was not registered until 1981.

However, to obtain these valuable trademark rights, the mark must be used in commerce. Intent to use is not sufficient. And the use must be lawful.

The article first addresses the need for lawful use of a mark for federal registration. Unlawful use can also result in cancellation of a registration. However, there must be a nexus between use of the mark and the unlawful activity. A trademark owner's breaking a law apart from or merely collateral to use of the trademark is not material to use of the trademark for registration purposes.

Since use of a trademark is necessary to establish a trademark, that is, for a trademark to exist, a use that is unlawful can also prevent common law formation or rights in a trademark. A mark used unlawfully in commerce does not acquire trademark rights from such use.

The article also addresses assertion of lack of lawful use of

a mark in commerce as an affirmative defense in litigation. This defense is not one of the enumerated defenses to trademark infringement set forth in 15 U.S.C. § 1115(b). Unlawful use arose as a public policy defense created by the courts. When applied in an action for trademark infringement, that defense can prevent the enforcement of trademark rights even in the face of evidence of actual confusion between the plaintiff's goods and the defendant's goods. As an affirmative defense, a defendant generally has the burden of asserting it with the defendant's answer to the complaint. While courts have held that an affirmative defense is not waived absent unfair surprise or prejudice, a defendant risks the defense will be disallowed on procedural grounds if not timely presented.

Generally, courts have been slower to adopt unlawful use of a trademark as a defense to infringement than the Trademark Office has been to consider unlawful use a reason to deny or cancel a registration. This defense has its origin in the unclean hands defense. Thus, a connection is needed between the plaintiff's unlawful use and the defendant's requested remedy. That is, unclean hands applies only when there is a nexus between the bad acts of a party seeking relief and the activities that party seeks to be enjoined by the court. However, marks associated with their owners' unlawful use in commerce, whether in violation of a federal statute or of common law, may be left unprotected against infringement by competitors. This occurs when that competitor raises as an affirmative defense to infringement that because of the trademark owner's unlawful use of the mark, that owner did not have trademark rights—the rights either had not developed or the mark had become unenforceable due to the unlawful conduct.

3. The “Consumer” Label

In *Rethinking Trademark Law's “Consumer” Label,* Professor Dustin Marlan reflects on what he considers to be the problematic use of the term “consumer” in trademark law.

While fictional constructs are oftentimes used to describe people in other branches of the law (*e.g.,* "PHOSITA" in patent law, "author" in copyright law, and "reasonable person" in tort law), the article argues that use of the term "consumer" in trademark law is especially concerning due to its negative connotations and implicit biases. The article contends that the passive label "consumer" imposes an uneven power dynamic between trademark owners and the public. Instead, the article recommends that alternative words such as "individual," "citizen," "purchaser," or "the public," be incorporated into trademark documents instead of "consumer" to describe people. In this way, the article indicates that the public can duly reclaim a more active role in trademark law.

In any given trademark document from a case opinion to an appellate brief, the term "consumer" appears regularly. Rarely can one examine a trademark document without coming across all too familiar phrases like "consumer protection," "consumer search costs" or "consumer perception." However, the article states that historically, the term "consumer" has elicited negative connotations since its introduction into the English vocabulary in the 1500s. In fact, its literal translation from Latin means "one who squanders or wastes."

In the 1800s, the term "consumer" was repurposed by pioneering economists, Adam Smith and William Stanley Jevons to take on its more contemporary meaning "one who uses up goods and services." According to the article, the modern meaning is extremely disconcerting for many reasons including its: (1) reduction of human beings to "market-based objects"; (2) anti-ecological bent; and (3) singular focus on the "destruction of a product" instead of a product's "productive life cycle." The article states that using the objectifying term "consumer," trademark law demonizes rather than personalizes humans.

According to the article, use of "consumer" to describe people seems "to elicit from courts an offensive and humiliat-

ing view of the citizenry." The article argues that the term "consumer" reduces human beings to the mere function of purchasing preferences and hence, dehumanizes them. As described by the article "consumer sounds like nothing more than a mindless resource to be exhausted and discarded . . . a citizen, in contrast is a free-thinking, free willed individual with rights."

The article discusses consumerism's great conflict with sustainability and other ideals from which a large segment of the populace holds dear. As opposed to the term "consumer" that can evoke images of humans as "money-spending garbage disposals," perhaps "customer" is a more all-encompassing term to include these people. The article contends that it is simply illogical to describe people as consumers because consumption refers to the end of a product's life cycle. On the contrary, people are much more sensible and try to minimize consumption, because they possess a fundamental understanding that earth's resources are finite until and unless new technologies are developed to extract additional resources.

According to the article, linguistic biases are also possible through use of the term "consumer" in trademark law. In particular, labeling biases associated with the term result in negative stereotypes that trigger psychological responses, which divide rather than unite people. Additionally, the article argues that use of the term "consumer" creates unfair power dynamics between producers and consumers where producers have the power but consumers do not. Consequently, trademark law is viewed by the article to preferentially favor producers over consumers. The article states that the public's role in trademarks is minimized through use of the term "consumer" which portrays people as "passive" and "helpless." According to the article, "trademark law treats the public as unsophisticated, easily confused rubes . . . incapable of independent thinking." In fact, judges frequently use "extraordinary gullible consumer" to expand trademark ownership rights. For example, alleged consumer confusion

over similar names such as PROZAC and HERBROZAC (*Eli Lilly & Co. v. Natural Answers, Inc.,* 7th Cir. 2000) or parody ads such as "Michelob Oily" (*Anheuser-Busch Inc. v. Balducci Publications*, 8th Cir. 1994) served as the basis for rulings in favor of trademark owners.

Additionally, consumers are not granted use rights associated with expressive functions of trademarks. In fact, as a consequence of trademark doctrine's curious focus on rights of competitors instead of rights of citizens for use of a certain mark, consumers lack standing to sue (*Lexmark International v. Static Control Components*, SCOTUS 2014). Indeed, the article asserts that this characterization acts in sharp contrast to the wide range of social, legal, political, and cultural meanings people ascribe to trademarks.

In conclusion, the article details the numerous issues associated with use of the term "consumer" in trademark law. From negative connotations to implicit biases associated with the term, the article asserts that the term "consumer" must be phased out of trademark documents in order to level the playing field between producers and the public. This will, the article maintains, encourage the public to take a more active role in trademark law.

4. Consumer Surveys

In *An Empirical Examination of Consumer Survey Use in Trademark Litigation,* Professors Katie Brown, Natasha T. Brison, and Paul J. Batista provide a comprehensive examination of the use of consumer surveys in trademark litigation at the federal level. For the article, the authors examined 843 trademark infringement and dilution cases spanning a decade, from 2007 to 2017. The examination indicated that consumer surveys are not used in trademark litigation as often as research suggests they should be used.

The article's purpose is to provide guidance and advice to legal and marketing practitioners while contributing to the consumer survey literature. First the article provides a gen-

eral background of survey evidence and its inconsistent treatment in the courts. Next the article discusses trademarks and trademark law, outlining the differences between infringement and dilution and how best to protect brands from trademark infringement.

The article details the research on consumer survey use in marketing and legal literature, along with the types of surveys used in litigation and the admissibility of surveys. There are multiple types of trademark survey question formats that courts find acceptable when testing for likelihood of consumer confusion. The most notable are the Exxon format, the Eveready format, and the Squirt format. The article briefly discusses the advantages and disadvantages of each.

The article notes that the use of surveys in trademark infringement cases can be incredibly important, as these cases virtually demand survey research due to consumer perception being at the core of the claims.

The article discusses the use of survey evidence in trademark infringement litigation and in trademark dilution litigation. The article then evaluates the role of survey evidence between the years 2007 and 2017. The article reports the findings of the quantitative investigation of survey use for trademark infringement and trademark dilution cases and discusses the implications of this study for marketing and legal practitioners.

The article states that the probative value of a comprehensive trademark survey may not always justify the cost. The issue with courts interpreting survey data in legal cases is that there are no universal standards by which to make the interpretation. Nevertheless, the study the article discusses provides insight into the potential impact consumer surveys can have on the outcome of trademark infringement and dilution cases. Courts appear to display litigant-status preference, as plaintiffs are still more heavily favored when submitting surveys. Surveys can strengthen a plaintiff's

case, even when courts do not find confusion for each variable in the multi-factor tests.

In trademark infringement cases, it may be in the best interest of the plaintiff to provide the court with survey evidence. Defendants, however, may want to conduct further cost-benefit analyses to determine if the value of conducting the survey is worth more than providing an expert to dispute the plaintiff's survey methodology and admissibility.

In trademark dilution cases, the study findings showed that if both parties' surveys were credited, the courts may not give favorable weight to either. This is especially important to know in trademark dilution cases, as plaintiffs must prove their mark is famous.

In conclusion, the article states that trademark infringement and dilution surveys, conducted by marketing and legal experts, can provide direct evidence about consumer confusion or dilution that may be difficult to obtain by visual comparison or expert testimony alone. Defendants should not simply rely on their own perceptions of their marks when fighting against trademark infringement and dilution allegations.

III. COPYRIGHTS

1. Source Code Paradox

In *The Paradox of Source Code Secrecy,* Professor Sonia K. Katyal argues that the law of software has been willing to entertain a unique—and paradoxical—overlap between copyright, patent, and trade secrecy, even though the three regimes have somewhat opposing public goals. Copyright law and patent law are oriented toward dissemination and circulation of ideas. Trade secrecy in contrast is motivated by opacity and seclusion. Software has enabled developers to commit to all three simultaneously, even though their underlying values can be at cross purposes.

The article notes that many software scholars have focused

on issues regarding copyright and patent protection. However, the article indicates that focus on trade secrecy, and specifically source code secrecy, is overdue, especially now where the failure to incentivize source code disclosure has produced significant public law implications with which we are grappling due to the rise of artificial intelligence (AI).

The article warns that automated systems often implicate central issues of due process, criminal and civil justice, and equal protection. Their inner workings, however, are often protected as trade secrets and thus are entirely free from public scrutiny. Source code underlying government automated decision making is hidden from public view.

The first half of this article is directed to intellectual property law. The article describes the dominance of trade secrecy over source code. Patent and copyright protections have been treated as affording complimentary protection. The second half of the article examines implications of the shift toward mass market software for the public interest. Today, the article states, algorithms are pervasive throughout public law. Software is employed in predictive policing analysis, family court delinquency proceedings, tax audits, parole decisions, DNA and forensic science techniques, and matters involving Medicaid, other government benefits, and educator evaluations. The results are often inscrutable, even though the results can demonstrate significant risk of bias. Further, the article notes that a primary obstacle to greater transparency involves the increasing privatization of government functions.

The article makes a case for limiting source code secrecy in certain contexts and offers an architecture of "controlled disclosure." In conclusion, the article briefly discusses ways to offer greater transparency for source code and automated decision making through reforming areas of intellectual property law, contract law, and discovery. The article states that the particular significance of source code necessitates a more granular set of efforts by legislators and courts toward transparency. The article also provides a set of possibilities

to engage greater norms toward disclosure in cases of significant public interest.

2. "Substantial Similarity" Test

In *Substantial Similarity and Junk Science: Reconstructing the Test of Copyright Infringement,* Professor Robert F. Helfing discusses the numerous shortcomings of infringement tests based on the standard of "substantial similarity." The article argues that this standard is far too ambiguous and as a consequence, inhibits effective assessment of infringement claims brought forth by plaintiffs. To address these limitations, the article offers a new infringement test for evaluating whether or not a copyright protection has been violated.

According to the article, use of the term, "substantial similarity" has been a constant source of confusion due to the three different legal standard applied in infringement analyses. To prove infringement, the plaintiff must demonstrate "substantial similarity," which requires that the works be "so much alike that their similarity is more likely than not the result of copying." Most copyright cases are brought before the Second and Ninth Circuit Courts of Appeals. In the Ninth Circuit, an evaluation of the protectability of similar content occurs via an "extrinsic test," while the Second Circuit uses a "more discerning ordinary observer test" for the determination. For these tests, the plaintiff must first demonstrate that the similarity between the works meets an objective criteria of protection. Next, the plaintiff must demonstrate that the works are similar using a rather subjective method of "total concept and feel." Confusion emanates from the application of the different legal standards for infringement analyses and directly undermines the protection of copyrights. To address this issue, the article proposes a reconstructed test which the article calls more definite, focused, and predictive of outcome, while also truer to the constitutional premises of copyright law infringement analysis.

The article's reconstructed test has four objectives: (1) establish the protectability of the foundational work; (2) identify relevant duplication; (3) evaluate the originality of duplicate content; and (4) address the issue of copying. Regarding the first objective, the plaintiff must establish a foundation for the claim by showing that the alleged copying involves protected content. While the basis of the foundation may involve the copyrighted work as a whole or in parts, the proposed test seeks to identify the foundation as narrowly as possible so as to avoid unnecessary confusion and delay in the courts. With respect to the second objective, the plaintiff must identify the elements of relevant duplication between the foundational work and the work accused of infringement via "analytic dissection." The article uses "analytic dissection" for simplification and organization rather than for identification. For example, a musical work would be dissected into such categories as melody, harmony, pitch, rhythm, and lyrics when evaluating a plaintiff's infringement claim. Furthermore, "analytic dissection" would entail objective and subjective components. Objectively, an element can be included in both works or not, even if the duplication lies beneath the literal surface of the works. The subjective component would involve determining how far to mine beneath the literal surface for material duplication. Concerning the third objective, while the proposed test employs the doctrine of scènes à faire to determine whether the duplicate content meets the requirements of creativity, the test also compares the effect of the duplicate content to that of the foundational work where duplicate content is protected only where they evoke the same kind of aesthetic response. Regarding the last objective, the article's proposed test employs use of the term "strikingly similar" to eliminate the need to show access in proving copying.

In addition to circumventing issues associated with infringement analyses, the article claims the proposed test provides greater clarity to roles of the judge and jury in determining infringement. Under the proposed test, there is

no pretense that the sufficiency of inventiveness or expressive development is determined by cold objective analysis. Hence, the proposed test grants judges the discretion to make such determinations as a matter of law, and the direct and specific nature of the test adds clarity as to which issues can better be decided by summary resolution.

In conclusion, the article offers a novel infringement test to account for the many issues associated with current tests based on the standard of "substantial similarity." The article says the proposed test removes ambiguities plaguing modern tests that delay the progress of successful infringement claims in courts.

IV. TRADE SECRETS

1. Nonliteral Similarity

In *Similar Secrets,* Professors Joseph P. Fishman and Deepa Varadarajan discuss the treatment of "similarity" in a trade secret dispute. Recognizing that a foundational question in every dispute over intellectual property is whether the defendant's product is too similar to the plaintiff's, the article notes that in trade secrecy cases, trade secret law provides little guidance for assessing how much similarity is too much. The standard remains a secret.

The article takes a first close look at what that standard of too much similarity should be. The article posits that trade secrecy's similarity doctrine is currently asking an incomplete set of questions. Trade secrecy is inquiring almost exclusively into the defendant's innovation "means," instructing fact finders to determine whether the defendant has acquired any useful knowledge from familiarity with the secret. Trade secrecy is skipping over an inquiry into the defendant's "ends." The article states that a more sensible test would consider not only the defendant's benefit from knowing the secret, but also the exploitable asset, be it a product or a process, that the benefit ultimately translates into.

The article proposes that for liability, a defendant should be found both: (1) to have exploited an asset that incorporates material elements from an owner's secret; and (2) in doing so, to have been in a market that the plaintiff actually foresaw or could have reasonably foreseen given industry trends. The article states that it should be permissible for a defendant to have merely relied on a secret as a launching pad for developing a genuinely dissimilar good, or for operating in a remote and unanticipatable market. The article claims its approach protects trade secret owners against competition in their core markets while affording some freedom to others to pursue cumulative innovation.

In discussion, the article first surveys how trade secrecy handles inexact similarity. Currently, trade secrecy gives owners much greater control over adaptive uses than do patents or copyrights. The article is concerned with freeing up use of a trade secret for innovation to produce something different. The article is not concerned with trade secret disputes where the defendant is trying to exploit relevant information in precisely the same way as the plaintiff trade secret owner does.

The article is also concerned with allowing use of a trade secret for exploitation in a very different market than the one of the plaintiff trade secret owner. The article refers to the common law of unfair competition, from which the particulars of trade secret law first evolved. The article indicates that recovery for misappropriation requires some direct competition. Outside the plaintiff's relevant markets, all competition is fair.

In conclusion, the article submits that the best place to reform substantial derivation doctrine is within the underlying definition of liability. A plaintiff should have to prove a material and foreseeable use as part of its case in chief. Alternatively, courts could themselves conduct inquiries as part of an affirmative defense or while calculating remedies after liability has been established. The article presents pros and cons of various approaches but notes that a solution can

be effected by the courts and statutory change is not necessary.

The substantial derivation concept presupposes that some derivations are actually insubstantial. Fact finders just need to be able to identify them. Fact finders should start by focusing on the product or process that the defendant is actually exploiting. Any derivation should be deemed insubstantial if there is no feature of that asset that materially contributed to the protectability of the trade secret in the first place. And when such a feature is present, the article states the defendant's use should still be excused if it is occurring solely in an unforeseeable market.

The article seeks to change the way courts think about nonliteral similarity in trade secrecy cases. The article states that using doctrinal tools the courts already have, a business environment can be built in which "not all R&D inspirations are uses," "[n]ot all derivations are substantial," and "not all similarities are wrong."

2. Extraterritoriality of Trade Secrets

In *Revisiting Trade Secret Extraterritoriality,* Professor Elizabeth A. Rowe and attorney Giulia C. Farrior provide a comprehensive analysis of the extraterritorial provision in the Defend Trade Secrets Act of 2016 (DTSA). The article first explores the numerous issues associated with the DTSA's extraterritorial reach provision and then offers strategies to effectively implement "domestic effect tests," which guide courts on the statute's reach in civil cases.

Theft of U.S. trade secrets is a growing problem for government and private businesses. To help address the issue of trade secret theft, the DTSA amended the Economic Espionage Act (EEA) to provide a private right of action: "[A]n owner of a trade secret that is misappropriated may bring a civil action under this subsection if the trade secret is related to a product or service used in, or intended for use in, interstate or foreign commerce" (18 U.S.C.A. § 1836(b)). By

referencing "foreign commerce," the DTSA established a reach beyond domestic commerce to include extraterritorial entities. Incidentally, both the EEA and the DTSA are listed under section 1837's chapter title: "[A]pplicability to conduct outside the United States." Unfortunately, the extraterritorial provision of the DTSA has been a constant source of confusion.

The article states that one question has been whether extraterritoriality addresses a jurisdictional question or a question on the merits. In *Trader Joe's Co. v. Hallatt*, the 9th Circuit said that the extraterritorial reach of the Lanham Act raises a question relating to the merits of a trademark claim, not to the federal courts' subject-matter jurisdiction. That court concluded on the merits that Trader Joe's alleged nexus between Hallatt's conduct and American commerce was sufficient to warrant extraterritorial application of the Lanham Act. The court established an "effects test" similar to those administered in domestic injury cases and found that the phrase "use in commerce" had a broad application and thus should apply extraterritorially.

Another question has been whether the DTSA can include conduct occurring entirely outside of the United States and not on United States soil. The language of section 1837 refers to an "act in furtherance," taking place in the United States. Hence, this insinuates that the DTSA would apply extraterritorially to conduct happening outside of the United States only if some of the conduct also took place in the United States.

The article suggests that either Congress should amend the statute to clarify the extent of the DTSA's extraterritorial reach or courts should interpret the phrase "act in furtherance of the offense" currently included in the statute. The article recommends adding language clearly indicating that the extraterritorial provision also applies to the DTSA. Additionally, the article suggests creating a "domestic effects" test that can be used to facilitate the application of United States law to conduct deemed harmful to trade secret

owners in the United States, including conduct occurring outside of the United States. The article states that such a test would provide uniformity and consistency among the circuits in interpreting the DTSA.

The article notes that a bill called the "Deterring Espionage by Foreign Entities through National Defense Act of 2018" has been introduced in Congress to address the shortcomings of the DTSA. That bill expands the extraterritorial scope of the EEA to include offenses occurring abroad that have a "substantial economic effect" in the United States. The article states that where the harm was caused or where the plaintiff was located when the harm was inflicted should be considered in trade secret and other intellectual property cases. For example, if Company X's trade secret has been misappropriated by Company Y, the injury would include the loss of the trade secret in addition to the resulting loss from the sales or value of the trade secret.

In conclusion, the article illustrates how changes to statute language and a "domestic effects test" can lead to successful future outcomes for domestic victims of extraterritorial misappropriation. According to the article, these actions will give trade secret owners experiencing trade secret theft by foreign entities more options at their disposal to take civil actions and obtain recourse against misappropriators in the future.

V. INTELLECTUAL PROPERTY

1. Intellectual Property as Procedure

In *The Procedural Foundations of ~~Intellectual Property~~ Information Regulation,* Professor Ira Steven Nathenson views intellectual property as a subset of information regulation rather than separate and apart from other information-regulation regimes—hence the title of the article shows a strike-through across the words "intellectual property." This article focuses on the often-ignored procedural foundations of intellectual property and suggests that procedure so

thoroughly pervades intellectual property that it's true foundations might be in procedure rather than substance.

The article argues that intellectual property rights are at their foundation procedural rather than substantive. By "procedure," the article means any process used to achieve some sort of goal or result relating to intellectual property. Such a definition includes not just court procedure but also extralegal procedures such as cease and desist letters. The article says "procedure" means all kinds of procedures and processes, things we do, that are necessary predicates to the creation of intellectual property rights.

Intellectual property "as" procedure is the heart of the article. The article makes the claim that intellectual property is so heavily grounded in procedure (both in and out of court) that it makes little sense to talk about intellectual property in isolation from the procedures that are used to create, protect, and limit intellectual property rights. The connection between intellectual property and procedure is so foundational that minor changes to procedures can make huge impacts on real-world substantive rights.

Lastly, the article considers intellectual property as procedure from a more theoretical perspective and suggests that it may be better to start thinking of intellectual property in terms of information regulation procedures rather than as a discrete subject separate from other information-regulation regimes. The article states that intellectual property is not about the information, invention, and creations made by people; its about the acts they take that allow them to say: "that's mine." Actions matter, the article says, and without them there is no intellectual property. The article intends to shift focus away from intellectual property rights to intellectual property's attendant procedures.

2. Website Injunctions

In *Enjoining the Cloud: Equity, Irreparability, and Remedies,* Professor Hannibal Travis examines the tailoring of

remedies in cases involving online infringement. When websites communicate copyrighted works to members of the public without permission or use trademark unlawfully, domestic requirements of equitable relief come into tension with global enforcement cultures. Courts are sometimes persuaded to enjoin entire websites while at other times courts limit their injunctions to the adjudicated conduct and the parties before them. The article is devoted to Rule 65(d) and the framing of injunctions, especially those extending to intermediaries' conduct such as the provision of cloud services.

The article argues that the mere loss of control over an intellectual property right should not lead to an inference of irreparable injury, and the courts should be more precise about the mechanisms and actual impact of the illegal activity and injury. Every injunction should state in reasonable detail what is being prohibited or mandated, and should not frame the injunction by reference to another document. And as a general rule, injunctions should not issue against cloud technologies or other internet service providers unless applicable liability standards are clearly met.

In conclusion, the article argues that some of the worst disparities could be avoided by applying similar definitions and concepts across case types, primarily irreparable injury, adequate remedy, and the public interest. More rigorously analyzing the factual support for some proposed injunctive language could achieve the aims of substantive law while harming fewer innocent third parties.

3. Industry Structure

In *Reconceptualizing the Role of Intellectual Property Rights in Shaping Industry Structure,* Professor Peter Lee considers the impact of exclusive rights on the structure of technological and creative industries. These industries are considered critical to economic and social welfare and thus the forces that shape them are important subjects of legal and policy examination. Traditionally, scholars have argued

that intellectual property rights promote industry concentration by creating barriers to entry and enabling rights holders to grow large by internalizing the benefits of innovation. More recently, some scholars have argued that patents and copyrights promote industry fragmentation by facilitating new startup formation and market entry. This article enters this debate by more precisely delineating the myriad roles of intellectual property rights in shaping industry structure.

The article analyzes empirical and historical accounts of industry structure in six economically significant, IP-intensive fields: biopharmaceuticals; agricultural biotechnology, seeds, and agrochemicals; software; motion picture production and distribution; music recording; and book publishing. The structure of these industries, the article states, can determine the amount, variety, and quality of drugs, food, software, movies, music and books available to society.

The article first reviews the prevailing theoretical literature on intellectual property rights and industry structure, considering arguments that exclusive rights promote both industry concentration and fragmentation. The article next provides empirical profiles of the structural evolution of the six IP-intensive industries noted of interest. These accounts highlight the role of exclusive rights in helping to shape industry structure, but they also reveal a host of important non-IP factors that influence industry structure also.

The article argues that patents and copyrights most prominently promote fragmentation in upstream creative fields but that they tend to contribute to concentration in downstream fields focused on commercialization. The article observes that exclusive rights play multiple roles in shaping industry structure, from directly enabling fragmentation or concentration to indirectly motivating and facilitating such activity.

The article introduces two novel distinctions to more accurately characterize the influence of intellectual property

rights on industry structure. First, the article introduces the dimension of time, arguing that patents and copyrights promote initial entry by new firms (and thus industry fragmentation) but that over time exclusive rights contribute to industry concentration by erecting barriers to entry and serving as assets that incumbents seek to amass in mergers and acquisition. Thus, intellectual property rights contribute to initial entry and subsequent concentration.

Second, the article introduces the dimension of the value chain. That is, the article differentiates "upstream" creative endeavors, such as creating a biologic compound or producing a film, from "downstream" commercial endeavors within the same industry, such as further developing that biologic compound into a commercial drug or marketing and distributing that film. The article argues that patents and copyrights most prominently promote entry in upstream creation while tending to inhibit entry and contribute to concentration in downstream commercialization. In other words, again, intellectual property rights contribute to upstream fragmentation and downstream concentration.

The article is intended to provide legal and policy decision makers with a more robust understanding of how patents and copyrights contribute to both fragmentation and concentration, depending on context. In doing so, the article notes that the theoretical debate on the impact of exclusive rights on industry structure focuses on patents and copyrights as direct causes of either fragmentation or concentration. However, while exclusive rights can directly impact industry structure, the correlation of a particular configuration of exclusive rights with a particular industry does not necessarily imply causation. If other factors, such as high fixed costs or economies of scale, drive concentration, then the accumulation of large intellectual property estates by incumbents may not be a cause so much as a reflection of industry concentration. Broadly, the article highlights that the roles of exclusive rights in influencing industry structure can be rather complicated.

Lastly, the article explores the implications of the discussed findings. The article examines how antitrust law can address problematic concentration in IP-intensive industries. The article proposes reforms to intellectual property law that would condition the cost of obtaining and enforcing exclusive rights on an entity's size and market position. The article adds that caution is needed before attempting wholesale modifications to intellectual property rights given their varied and opposing effects on industry structure across time and the value chain. In conclusion, there is a broader array of economic and strategic forces that shape highly innovative fields that warrant further study.