

## RECENT DEVELOPMENTS IN INTELLECTUAL PROPERTY LAW

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I. Patent Law .....	492
II. U.S. Supreme Court .....	492
A. Judicial Review of PTAB’s Decision to Institute an IPR .....	492
B. Federal Court.....	494
1. Venue Under 28 U.S.C. § 1400(b).....	494
III. Trademark Law .....	496
A. Supreme Court Cases .....	496
1. Profit Award for Trademark Infringement Under the Lanham Act .....	496
2. Capability of a “Generic.com” to Function as a Protectable Mark .....	497
IV. Copyright Law .....	499
A. Supreme Court Copyright Cases .....	499
1. Sovereign Immunity of the States in Copyright Infringement Cases .....	499
2. Extent to Which Governmental Authorities Can Copyright Materials .....	501
V. Conclusion .....	503

The following is a review of selected opinions rendered over the past year on the intellectual property front having a particularly meaningful impact on U.S. patent, trademark and copyright laws. These opinions broadly implicate judicial review of certain aspects of patent proceedings, venue issues, trademark damages, the eligibility of certain “generic.com” terms for protection, and the ability of certain government actors to sue or be sued in copyright.

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## I. PATENT LAW

This year the Supreme Court addressed whether decisions of the Patent Trial and Appeal Board (PTAB) of the United States Patent and Trademark Office (USPTO) to institute *inter partes* review (IPR) proceedings are subject to judicial review. The Federal Circuit addressed whether the presence of a defendant's computer servers in the forum district created a "regular and established place of business" for purposes of establishing venue under 28 U.S.C. § 1400(b), the patent venue statute.

## II. U.S. SUPREME COURT

### A. *Judicial Review of PTAB's Decision to Institute an IPR*

In *Thryv, Inc. v. Click-to-Call Technologies, LP*,<sup>1</sup> the U.S. Supreme Court overruled the Federal Circuit in a 7-2 decision, holding that PTAB decisions about whether to apply the time bar of 35 U.S.C. § 315(b) of the America Invents Act of 2012 (AIA) to IPR proceedings are final and not appealable.

When the USPTO is presented with a request to institute IPR proceedings, it must decide whether to institute review.<sup>2</sup> 35 U.S.C. § 314, provides, among other things, that if the request comes more than one year after the filing of a suit against the requesting party for patent infringement, then "[a]n *inter partes* review may not be instituted."<sup>3</sup> "The determination by the [USPTO] Director whether to institute an *inter partes* review under this section shall be final and nonappealable."<sup>4</sup>

Thryv, Inc. (Thryv) filed a request for institution of IPR proceedings to reconsider the validity of the granted claims of a patent owned by Click-to-Call Technologies, LP (Click-to-Call).<sup>5</sup> Several years prior to Thryv's request, a predecessor of Click-to-Call asserted the same patent against a predecessor of Thryv in a complaint, which was ultimately dismissed without prejudice.<sup>6</sup> In response to Thryv, Click-to-Call argued that the USPTO could not institute IPR proceedings because the earlier filed complaint dismissed without prejudice triggered the one year time bar of 35 U.S.C. § 315(b).<sup>7</sup> The PTAB disagreed with Click-to-Call and instituted the IPR proceedings, reasoning that a complaint dismissed without prejudice does not trigger the time bar of 35 U.S.C. § 315(b).<sup>8</sup> As a result of

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1. *Thryv, Inc. v. Click-to-Call Techs., LP*, 140 S. Ct. 1367 (2020).

2. 35 U.S.C. § 314.

3. *Id.* § 315(b).

4. *Id.* § 314(d).

5. *Thryv*, 140 S. Ct. at 1371.

6. *Id.* at 1371.

7. *Id.*

8. *Id.*

the IPR proceedings, thirteen claims of Click-to-Call's patent were held obvious or lacking novelty, and thus canceled.<sup>9</sup>

Click-to-Call appealed, and the Federal Circuit reversed, treating the PTAB's application of 35 U.S.C. § 315(b) as judicially reviewable, and concluding that the earlier complaint triggered the time bar of 35 U.S.C. § 315(b) thereby vacating the PTAB's decision.<sup>10</sup> Thryv then petitioned the Supreme Court for review of the Federal Circuit's decision, which the Supreme Court granted, on the question of whether the time determinations of the PTAB are subject to judicial review.<sup>11</sup>

The Supreme Court reversed the Federal Circuit's decision, holding that decisions by the PTAB about whether to apply the time bar of 35 U.S.C. § 315(b) are final and not appealable.<sup>12</sup> In doing so, the Court relied on its precedent in *Cuozzo Speed Technologies, LLC v. Lee*, 136 S. Ct. 2137, 2137 (2016), stating that “[w]e need not venture beyond *Cuozzo*'s holding that § 314(d) bars review at least of matters ‘closely tied to the application and interpretation of statutes related to’ the institution decision . . . for a § 315(b) challenge easily meets that measurement. . . . Because § 315(b) expressly governs institution and nothing more, a contention that a petition fails under § 315(b) is a contention that the agency should have refused ‘to institute an inter partes review’ [under § 314(d)].”<sup>13</sup> The majority further noted that allowing appeal of the decisions on the merits by the PTAB in IPR proceedings and vacating them based upon time bar issues may “wast[e] the resources spent resolving patentability and leav[e] bad patents enforceable.”<sup>14</sup>

The majority rejected Click-To-Call's argument that § 314(d)'s prohibition against appeals applied only to the PTAB's substantive determination of whether to institute an IPR proceeding under § 314(a). The majority explained that *Cuozzo* extended § 314(d) to appeals grounded in “statutes related to” decisions to institute proceedings.<sup>15</sup> The majority further noted that “every decision to institute is made ‘under’ § 314 but must take account of specifications in other provisions—such as the § 312(a)(3) particularity requirement at issue in *Cuozzo* and the § 315(b) timeliness requirement at issue here.”<sup>16</sup>

Justice Gorsuch, along with Justice Sotomayor in part, dissented, noting that the majority's view permits a politically guided agency's decisions

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9. *Id.*

10. *Id.* at 1372.

11. *Id.*

12. *Id.* at 1370.

13. *Id.* at 1373.

14. *Id.* at 1374.

15. *Id.* at 1375.

16. *Id.*

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“to stand immune from judicial review.”<sup>17</sup> The minority opinion further stated that “the *only* thing § 314(d) insulates from judicial review is ‘[t]he determination’ made ‘by the Director’ ‘under this section’—that is, a determination discussed *within* § 314. Nothing in the statute insulates agency interpretations of other provisions *outside* § 314, including those involving §315(b).”<sup>18</sup>

## B. Federal Court

### 1. Venue Under 28 U.S.C. § 1400(b)

In *In re: Google LLC*,<sup>19</sup> the Federal Circuit addressed whether the presence of a defendant’s computer servers in the forum district, located in leased space from local internet service providers, created a “regular and established place of business” for purposes of establishing venue under the patent venue statute, 28 U.S.C. § 1400(b).

Super Interconnect Technologies LLC (SIT) filed a patent infringement suit against Google LLC (Google) in the Eastern District of Texas. 28 U.S.C. § 1400(b) provides that “[a]ny civil action for patent infringement may be brought in the judicial district where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business.”<sup>20</sup> SIT alleged venue was proper because Google committed acts of infringement in the Eastern District of Texas and had a regular and established place of business there.<sup>21</sup> Google’s business in question included providing online advertising and video services to people residing in the Eastern District of Texas.<sup>22</sup>

SIT’s allegation of proper venue was based on the presence of several Google Global Cache (GGC) servers in the Eastern District, which serve as local caches for Google’s data.<sup>23</sup> The GGC servers were not hosted by datacenters owned by Google. Rather, Google contracted with certain internet service providers (ISPs) in the district, namely Cable One and Suddenlink, to host its GGC servers within the ISPs’ datacenters.<sup>24</sup> Both SIT and Google agreed that no Google employee performed installation of, performed maintenance on, or physically accessed any of the GGC servers hosted by either ISP.<sup>25</sup> Google moved to dismiss for improper venue,

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17. *Id.* at 1378.

18. *Id.* at 1380.

19. *In re: Google LLC*, 949 F.3d 1338 (Fed. Cir. 2020).

20. 28 U.S.C. § 1400(b).

21. *In re: Google*, 949 F.3d at 1340.

22. *Id.*

23. *Id.*

24. *Id.* at 1340.

25. *Id.* at 1341.

but the district court denied that motion.<sup>26</sup> Google then petitioned for a writ of mandamus ordering the district court to dismiss the case for lack of venue.<sup>27</sup>

The Federal Circuit granted Google's petition, holding that venue was improper in the Eastern District of Texas under the patent venue statute.<sup>28</sup> In reaching its decision, the Federal Circuit relied on its prior holding in *In re Cray, Inc.* where it held that a "regular and established place of business" under the patent venue statute must be: (1) "a physical place in the district;" (2) "regular and established;" and (3) "the place of the defendant."<sup>29</sup>

While the Federal Circuit found that the GCC servers met the physicality requirement of the first prong of the *Cray* test, it also found that the servers did not constitute a place of business because "a 'regular and established place of business' requires the regular, physical presence of an employee or other agent of the defendant conducting the defendant's business at the alleged 'place of business.'"<sup>30</sup>

Here, the parties agreed that there were no Google employees conducting business at the server facilities. Thus the court focused on whether the ISPs acted as Google's agents.<sup>31</sup> In determining that the ISPs did not qualify as Google's agents, the court found that the provision of internet services by the ISPs were not sufficient to establish an agency relationship, and that the ISPs one-time server installation services did not qualify as the conduct of a "regular and established" business.<sup>32</sup> The court also determined that the ISPs' obligation to perform occasional maintenance activities at Google's request did not give rise to an agency relationship for venue purposes because those types of activities "are merely connected to, but do not themselves constitute, the defendant's conduct of business in the sense of production, storage, transport, and exchange of goods or services."<sup>33</sup>

In reaching its holding, the court specifically noted that "we do not hold today that a 'regular and established place of business' will always require the regular presence of a human agent, that is, whether a machine could be an 'agent.'"<sup>34</sup> The court ultimately directed the district court to dismiss or transfer the suit.<sup>35</sup>

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26. *Id.*

27. *Id.*

28. *Id.* at 1347.

29. *Id.* at 1343 (citing *In re Cray, Inc.*, 871 F.3d 1355, 1360 (Fed. Cir. 2017)).

30. *Id.* at 1343–45.

31. *Id.* at 1345.

32. *Id.* at 1345–46.

33. *Id.* at 1346–47.

34. *Id.* at 1347.

35. *Id.*

## III. TRADEMARK LAW

This year, the Supreme Court was active on the trademark front addressing issues such as the showing necessary to award a defendant's profits for trademark infringement and whether the addition of a generic top-level domain (e.g., ".com") to a generic term couple creates a protectable trademark.

A. *Supreme Court Cases*

## 1. Profit Award for Trademark Infringement Under the Lanham Act

In *Romag Fasteners, Inc. v. Fossil, Inc.*,<sup>36</sup> the Supreme Court, in a unanimous decision, resolved a circuit split, holding that a plaintiff in a suit for trademark infringement does not have to show that a defendant willfully infringed the plaintiff's trademark as a precondition to a profits award.

Romag Fasteners, Inc. (Romag) sells certain magnetic fasteners that may be used in leather goods such as handbags.<sup>37</sup> Fossil, Inc. (Fossil) designs, markets, and distributes fashion accessories, including handbags.<sup>38</sup> Some years ago, the parties inked an agreement allowing Fossil to use Romag's magnetic fasteners in Fossil's handbags and other product offerings.<sup>39</sup> Romag found that certain Fossil handbags were being sold with counterfeit magnetic fasteners, and Fossil was doing little to prevent it, so Romag sued.<sup>40</sup> At trial, a jury agreed with Romag, finding that Fossil acted in "calious disregard" of Romag's rights, but rejected Romag's claims that Fossil acted "willfully."<sup>41</sup> Accordingly, the jury declined to award Fossil's profits to Romag, and the Second Circuit affirmed because it was one of a handful of circuit courts that only allowed an award of defendant's profits if infringement is willful.<sup>42</sup> Not all circuit courts require such a showing.<sup>43</sup>

In resolving the split among the circuit courts, the Supreme Court ruled that a plaintiff in a suit for trademark infringement does not have to show that a defendant willfully infringed the plaintiff's trademark as a precondition to a profits award.<sup>44</sup> In reaching this conclusion, the Court looked to the section of the Lanham Act governing remedies for trademark infringement and dilution.<sup>45</sup> The Court noted that § 1117(a) requires a showing of willfulness as a precondition to an award of profits under § 1125(c) for

36. *Romag Fasteners, Inc. v. Fossil, Inc.*, 140 S. Ct. 1492 (2020).

37. *Id.* at 1494.

38. *Id.*

39. *Id.*

40. *Id.*

41. *Id.*

42. *Id.*

43. *Id.*

44. *Id.* at 1497.

45. *Id.* at 1494-95.

trademark dilution.<sup>46</sup> But, the Court stated, similar language was missing from the text of § 117(a) with respect to trademark infringement under § 1125(a).<sup>47</sup>

The Court noted that its usual practice of not reading into statutes words that are not there was particularly relevant here where other parts of the Lanham Act included express language about a defendant's mental state, but the sections relevant to Romag's claim did not.<sup>48</sup> Therefore, the court ruled that willfulness is not a precondition to recovering profits from a party that engaged in trademark infringement.<sup>49</sup> However, the Court also stated that "willfulness" remains an important factor for courts to consider when weighing an award of profits, stating "a trademark defendant's mental state is a highly important consideration in determining whether an award of profits is appropriate."<sup>50</sup> In other words, courts can award profits as trademark infringement damages without a showing of willfulness, but such an award is within the discretion of the court to which the defendant's mental state is a "highly important consideration."

## 2. Capability of a "Generic.com" to Function as a Protectable Mark

In *USPTO v. Booking.com B.V.*,<sup>51</sup> the Supreme Court in an 8-1 decision rejected the USPTO's per se rule that "generic.com" terms are always generic, holding that (1) "Booking.com" was not generic for federal registration purposes, and (2) whether such a term functions as a mark, "depends on whether consumers in fact perceive that term as the name of a class or, instead, as a term capable of distinguishing among members of the class."

Booking.com B.V. (Booking), the operator of a website that allows customers to book hotel accommodations, filed a civil action against the USPTO challenging the Trademark Trial and Appeal Board's (TTAB) decision denying its applications to register "Booking.com" as a trademark.<sup>52</sup> The USPTO refused to register "Booking.com" because it is a generic name for online hotel-reservation services, and thus incapable of serving as a mark.<sup>53</sup> The USPTO's view was that when a generic term is combined with a generic top-level domain like ".com," the combination that results is generic.<sup>54</sup> Put differently, the Court interpreted the USPTO's position to

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46. *Id.* at 1495.

47. *Id.*

48. *Id.*

49. *Id.*

50. *Id.* at 1497.

51. U.S. Pat. & Trademark Off. v. Booking.com B.V., 140 S. Ct. 2298, 2307 (2020).

52. *Id.* at 2303.

53. *Id.*

54. *Id.*

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mean that every “generic.com” term is generic according to the USPTO, absent extraordinary circumstances.<sup>55</sup>

The district court found that while the term “booking” alone is generic, “Booking.com” is not generic.<sup>56</sup> The United States Court of Appeals for the Fourth Circuit affirmed the district court’s decision that “Booking.com” was eligible for registration.<sup>57</sup> The USPTO petitioned the Supreme Court for certiorari.<sup>58</sup>

In reaching its decision, the Supreme Court outlined three guiding principles for generic determinations: (1) a “generic” term names a “class” of goods or services, rather than any particular feature or exemplification of the class, (2) the distinctiveness inquiry of a compound word is based on the meaning as a whole and not its parts in isolation, and (3) the relevant meaning of a term is its meaning to consumers.<sup>59</sup>

Under the above principles, the Court stated that the determination of whether “Booking.com” is generic turns on whether that term, when viewed as a whole, “signifies to consumers the class of online hotel-reservation services.”<sup>60</sup> For example, the Court explained that if “Booking.com” were generic, it might “expect that a consumer, searching for a trusted source of online hotel-reservation services, could ask a frequent traveler to name her favorite ‘Booking.com’ provider.”<sup>61</sup>

Here, based on the evidence provided by Booking in support of its claim of acquired distinctiveness of this mark, which the USPTO no longer disputed, the Court found that “Booking.com” is not generic and affirmed the judgement of the Court of Appeals for the Fourth Circuit.<sup>62</sup> The Court rejected the USPTO’s argument that “no matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise . . . , it cannot deprive competing manufacturers of the product of the right to call an article by its name.”<sup>63</sup> The Court stated that such an argument was in error because it assumed that “generic.com” terms must always be generic.<sup>64</sup>

In reaching its holding, the Court noted that it was not automatically classifying “generic.com” terms as non-generic. Rather, whether such a term functions as a mark “depends on whether consumers in fact perceive

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55. *Id.* at 2305.

56. *Id.* at 2304.

57. *Id.*

58. *Id.*

59. *Id.*

60. *Id.*

61. *Id.* at 2304–05.

62. *Id.* at 2305.

63. *Id.* at 2306.

64. *Id.* at 2307.

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that term as the name of a class or, instead, as a term capable of distinguishing among members of the class.”<sup>65</sup>

In a dissenting opinion, Justice Breyer noted that “Booking.com” is simply an internet booking service, which is the generic product that Booking and its competitors sell in the marketplace.<sup>66</sup> The dissent stated that making such terms eligible for trademark protection would “lead to a proliferation of ‘generic.com’ marks, granting their owners a monopoly over a zone of useful, easy-to-remember domains,” which would tend to inhibit free competition in the relevant market.<sup>67</sup> The Court in the main opinion addressed the dissent’s concern, noting that infringement doctrines such as likelihood of confusion and fair use would restrict the scope of protection accorded to “generic.com” marks and thus protect such effects.<sup>68</sup>

#### IV. COPYRIGHT LAW

The Supreme Court addressed some interesting copyright issues this year focused on copyright law’s implications for the government itself, such as whether the States have sovereign immunity from copyright infringement suits, and whether governmental authorities can themselves copyright the materials that they create.

##### A. *Supreme Court Copyright Cases*

###### 1. Sovereign Immunity of the States in Copyright Infringement Cases

In *Allen v. Cooper*,<sup>69</sup> the Supreme Court in a unanimous decision affirmed the judgment of the Court of Appeals for the Fourth Circuit, holding that Congress lacked authority to repeal the states’ sovereign immunity from copyright infringement suits in the Copyright Remedy Clarification Act (CRCA) of 1990, and thus individuals are precluded from suing states for copyright infringement.<sup>70</sup>

The dispute in *Allen* arose when, in 1996, a marine salvage company discovered the wreckage of the Queen Anne’s Revenge, Blackbeard’s famous ship, which had sat undisturbed for nearly 300 years.<sup>71</sup> The salvage company hired a videographer named Frederick Allen (Allen) to document the salvage operation.<sup>72</sup> For over ten years, Allen took videos and photos of divers’ efforts to salvage the ship’s various parts including its

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65. *Id.*

66. *Id.* at 2309.

67. *Id.* at 2315–16.

68. *Id.* at 2307–08.

69. *Allen v. Cooper*, 140 S. Ct. 994 (2020).

70. *Id.* at 998–1000.

71. *Id.* at 999.

72. *Id.*

guns, anchors, and other remains. Allen registered copyrights in all of the videos and photos.<sup>73</sup>

The state of North Carolina posted several of Allen's videos online and put one of Allen's photographs in a newsletter.<sup>74</sup> When North Carolina refused to admit any wrongdoing, Allen brought suit against North Carolina in federal court for copyright infringement.<sup>75</sup> North Carolina moved to dismiss the suit, arguing that under the doctrine of sovereign immunity it was not liable for copyright infringement.<sup>76</sup> In response, Allen argued that the CRCA was an exception to North Carolina's sovereign immunity, and, therefore, North Carolina could be held liable for copyright infringement.<sup>77</sup> The CRCA, 17 U.S.C. § 511(a), provides that a state "shall not be immune, under the Eleventh Amendment [or] any other doctrine of sovereign immunity, from suit in Federal court" for copyright infringement.<sup>78</sup>

The district court sided with Allen, holding that the CRCA properly abrogated North Carolina's immunity for suits for copyright infringement.<sup>79</sup> But, on interlocutory appeal, the Court of Appeals for the Fourth Circuit reversed, holding that under the logic of an earlier case, *Florida Prepaid Postsecondary Education Expense Board v. College Savings Bank*, 527 U.S. 627 (1999), the CRCA was unconstitutional.<sup>80</sup> Allen then appealed to the Supreme Court, which granted his petition for review because the Court of Appeals had held a federal statute invalid.<sup>81</sup>

The Supreme Court affirmed the Court of Appeals, holding that Congress lacked authority to repeal the states' sovereign immunity from copyright infringement suits through the CRCA, and thus individuals are precluded from suing states for copyright infringement.<sup>82</sup> In reaching its decision, the Court explained that there are two requirements that must be met before a federal court can hear a lawsuit against a non-consenting state.<sup>83</sup> First, "Congress must have enacted 'unequivocal statutory language' abrogating the States' immunity from the suit."<sup>84</sup> Second, "some constitutional provision must allow Congress to have thus encroached on the States' sovereignty."<sup>85</sup>

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73. *Id.*

74. *Id.* at 999.

75. *Id.*

76. *Id.*

77. *Id.*

78. *Id.*

79. *Id.* at 1000.

80. *Id.*

81. *Id.*

82. *Id.* at 998–99.

83. *Id.* at 1000–01.

84. *Id.* at 1000 (citing *Seminole Tribe of Fla. v. Florida*, 517 U.S. 44, 56 (1996)).

85. *Id.* at 1001 (citing *Kimel v. Fla. Bd. of Regents*, 120 S. Ct. 631 (2000)).

Although the CRCA easily met the first requirement, the Court stated that it did not meet the second requirement, relying heavily on *Florida Prepaid*, in which the Court held that the Patent Remedy Act did not validly strip the States of sovereign immunity with respect to patent infringement suits.<sup>86</sup> The Court noted that based on *Florida Prepaid*, together with *stare decisis*, the Intellectual Property Clause of Article I of the Constitution did not provide the authority to abrogate the sovereign immunity of the States.<sup>87</sup> Further, following a review of the legislative record of the CRCA, the Court held that the CRCA did not validly abrogate state sovereign immunity on the basis of due process under Section 5 of the Fourteenth Amendment, because it lacked the necessary congruence and proportionality between constitutional injury sought to be prevented or remedied and the statutory means adopted.<sup>88</sup> Thus, according to the Court, the CRCA suffered from the same deficiencies that doomed the Patent Remedy Act in *Florida Prepaid*, and as a result held that states retain their sovereign immunity against copyright infringement suits.<sup>89</sup>

## 2. Extent to Which Governmental Authorities Can Copyright Materials

In *Georgia v. Public.Resource.Org, Inc.*,<sup>90</sup> the Supreme Court, in a close 5-4 decision, affirmed the ruling of the Eleventh Circuit, holding that under the government edicts doctrine, the annotations beneath the statutory provisions in the Official Code of Georgia Annotated (OCGA) are ineligible for copyright protection.<sup>91</sup> By way of background, under 17 U.S.C. § 102(a), the Copyright Act grants protection for “original works of authorship.”<sup>92</sup> But, under the government edicts doctrine, officials empowered to speak with the force of law cannot be the authors of the works they create in the course of their official duties.<sup>93</sup>

The OCGA includes a set of annotations that appear below each statutory provision summarizing certain judicial decisions, opinions of the attorney general, and other related reference materials.<sup>94</sup> The OCGA is put together by the Code Revision Commission, which is a state entity of Georgia.<sup>95</sup> The Commission retained Matthew Bender & Co. to prepare

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86. *Id.*

87. *Id.* at 1003.

88. *Id.* at 1003–04.

89. *Id.* at 1007.

90. *Georgia v. Public.Resource.Org, Inc.*, 140 S. Ct. 1498 (2020).

91. *Id.* at 1513.

92. 17 U.S.C. § 102(a).

93. *Public.Resource.Org*, 140 S. Ct. at 1505.

94. *Id.* at 1504.

95. *Id.*

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the set of annotations under a work-for-hire agreement, which placed the ownership of the copyright in the state of Georgia.<sup>96</sup>

Public.Resource.Org (PRO) placed the entire code, including annotations, on the Internet without permission.<sup>97</sup> The state of Georgia filed suit for copyright infringement against PRO, arguing that although the laws themselves were in the public domain, the annotations were not.<sup>98</sup> The district court ruled for the Commission, holding that because the annotations had not been enacted into law, they were eligible material for copyright protection.<sup>99</sup> However, the Eleventh Circuit reversed, rejecting the eligibility of the Commission's copyright under the government edicts doctrine.<sup>100</sup> The Supreme Court granted certiorari.<sup>101</sup>

The Supreme Court affirmed the Eleventh Circuit decision, holding that the annotations do not qualify as copyrightable material.<sup>102</sup> In arriving at its decision, the majority relied on three nineteenth century cases involving the copyright status of judicial opinions.<sup>103</sup> From those cases, the majority derived that the main principle behind the government edicts doctrine is that no person can own the law.<sup>104</sup> The majority explained that the doctrine gives effect to that principle in the copyright context through construction of the statutory term "author," and that under the Copyright Act judges cannot be the "author[s]" of "whatever work they perform in their capacity" as lawmakers.<sup>105</sup> The majority reasoned that legislators, like judges, have the authority to make law, and thus it naturally follows that legislator also cannot be "authors."<sup>106</sup> Moreover, just like judges, the majority explained that the doctrine applies to whatever work legislators perform in their capacity as legislators, including explanatory and procedural materials they create in the discharge of their legislative duties.<sup>107</sup>

The majority applied the above framework and determined that Georgia's annotations do not qualify as copyrightable material because (1) the author of the annotations qualifies as a legislator because under 17 U.S.C. § 201(b) the sole "author" of the annotations is the Commission, which serves as an arm of the legislature of the state of Georgia; and (2) the Commission creates the annotations in the discharge of its legislative duties.<sup>108</sup>

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96. *Id.* at 1505.

97. *Id.*

98. *Id.*

99. *Id.*

100. *Id.* at 1505–06.

101. *Id.* at 1506.

102. *Id.*

103. *Id.*

104. *Id.* at 1507.

105. *Id.*

106. *Id.*

107. *Id.* at 1508.

108. *Id.* at 1508–10.

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The majority further stated that the annotations provide important practical guidance to the public, which, if copyrightable, would be behind a paywall and only be available to those who can afford or are able to access the official annotated version.<sup>109</sup> Accordingly, the majority rejected certain arguments stated in the dissent that the annotations and other legislative commentary should be treated differently from state laws.<sup>110</sup>

#### V. CONCLUSION

As evidenced by the above cases, the U.S. Supreme Court and federal courts issued a variety of important decisions across a range of areas of intellectual property law over the past year. We will be monitoring with interest the extent to which courts around the country implement the decisions, particularly with respect to whether courts begin awarding profits as trademark infringement damages, and whether other certain “generic.com” type marks are deemed capable of functioning as a mark for federal registration purposes. We look forward to reporting on these and other significant developments in intellectual property law in next year’s article.

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109. *Id.* at 1512–13.

110. *Id.* at 1524.

