Bright Ideas

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I. Introduction: Recent Growth of AI and AI Patenting

Artificial intelligence (AI) technology has been around for decades. Patent filings covering AI-related inventions have also been around for decades. However, it is only in the past 15 to 20 years that AI has exploded in the technology world generally. And it is only in the past 10 years that AI has exploded in the world of patent filings.

Last year, the World Intellectual Property Organization (WIPO) initiated a new series of reports, *WIPO Technology Trends*, with a 154-page report entitled *Artificial Intelligence* (the “WIPO report”). The report looks at AI patenting trends across industries and around the world. The mere fact that WIPO chose to make AI the focus of its first *Technology Trends* report suggests that AI patenting has become particularly significant. Notably, of the roughly 340,000 AI patent filings published since 1960, more than half have published since 2013.1 (The statistics and charts below are either directly from or based on statistics in the WIPO report.)

AI is an umbrella term covering many different categories of specific techniques. The “machine learning” category has dominated AI patent filings in recent years and now appears in nearly 90% of AI-related patent filings.2 As the chart below shows, new machine learning patent families grew steadily but modestly from 1990 to 2010. After 2010, growth accelerated dramatically.3

The recent AI patent filing boom is driven mainly by filings originating in China and in the United States. Although Japan led the world in AI patent filings until the late 1990s, and Korean filings have grown steadily since the early 1990s, filings in the United States and in China over the past 10 years have significantly outpaced those in other countries. Furthermore, China’s AI-filing growth is now much greater than that of the United States, as shown below.4

Telecommunications and transportation are the industries most often targeted in AI patent families. Each is targeted in 24 percent of AI patent families.5 Given recent growth in autonomous vehicle technology, the prominence of the transportation industry in AI patenting is not surprising. Notably, however, the life science/medical industry area is not far behind and is targeted in 19 percent of all AI patent families.6 AI patenting now spreads across many diverse industries. For example, some of the industry areas with the biggest recent AI patenting growth are agriculture and banking/finance.7

II. AI in Context

AI inventions should not be thought of as divorced from the specific context of their application. As discussed further below, although the heart of an AI system is typically realized in computer hardware and software, the particular design of such an AI system can vary significantly depending on the application to which it is applied. An AI invention is often intertwined with the context of the things it seeks to control and/or analyze data from such as a car, a scientific instrument, or a medical device. In some contexts, such as driving and medical diagnosis, the use of machine learning raises not only interesting patent questions but also important ethical and regulatory issues.

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III. Elements of an AI Invention

To gain insight into the kinds of things that go into AI patent applications and some of the unresolved legal issues related to AI patenting, it helps to get a feel for how AI actually works. As stated above, in the technology world and in the patent world, machine learning is far and away the most prominent AI technology category. Therefore, although there are other categories of AI technology, we focus here on machine learning.

A. Machine Learning Generally

The WIPO report defines “machine learning” as:

[A]n AI process that uses algorithms and statistical models to allow computers to make decisions without having to explicitly program it to perform the task. Machine learning algorithms build a model on sample data used as training data in order to identify and extract patterns from data, and therefore acquire their own knowledge.8

To put it more succinctly, machine learning technology allows a computer to “learn” from examples. The quotation marks remind us that when we speak of a computer “learning,” it is really shorthand for “appearing to learn” or “learning-like” activity.

Many things we observe and learn about in the real world can be represented as a mathematical function that maps inputs to outputs. For example, a baseball pop-fly can be represented by inputs such as velocity, height, mass, flight angle, air velocity, etc. To the extent those inputs impact an output of interest, e.g., where the ball will land, there is a probably a discoverable mathematical function that can be used to predict the output based on the set of inputs. In the pop-fly example, classical mechanics provides rules describing such a function and can, with sufficient accuracy, predict the ball’s landing spot given correct inputs. Thanks to Newton and various equations derived from his laws of motion, we already know rules describing such a function. But before discovering his laws of motion, Newton needed to make many observations of objects in motion and figure out what those laws were.

Machine learning’s goal (at least in the context of what is known as “supervised” learning) is to allow a computer to carry out at least part of the scientific method. The first step (the hard one) is to use real-world known examples of something—i.e., instances of that something for which relevant conditions and results are already known—to discover a mathematical function that maps those real world conditions (function inputs) to real-world results (function outputs). The second step is to apply that newly discovered function to untested examples of that something by measuring or otherwise obtaining conditions associated with those untested examples and then using those conditions as inputs to the function to predict a real-world result based on the function’s output.

Below are just a few illustrative examples of useful real-world applications and “inputs” and “outputs” that might be associated with a machine learning implementation for those applications:

<table>
<thead>
<tr>
<th>Application</th>
<th>Inputs</th>
<th>Math function (mapping inputs to outputs)</th>
<th>Outputs</th>
</tr>
</thead>
<tbody>
<tr>
<td>Object recognition</td>
<td>Pixel values from a digital image (and/or features values computed using those pixel values)</td>
<td>?</td>
<td>Object identity (e.g., word or phrase selected from a set of thousands of words or phrases corresponding to various objects)</td>
</tr>
<tr>
<td>Tissue pathology slide analysis</td>
<td>Pixel values from a digital image (and/or features values computed using those pixel values)</td>
<td>?</td>
<td>Tissue classification as positive (e.g. for cancer) or negative</td>
</tr>
<tr>
<td>Speech recognition</td>
<td>Digital audio data (and/or feature values computed using that data)</td>
<td>?</td>
<td>Recognized words</td>
</tr>
<tr>
<td>Autonomous driving</td>
<td>Lidar data, image data, car velocity data, weather data, time of day data, etc.</td>
<td>?</td>
<td>Driving control instructions (e.g., for steering, accelerating, braking, etc.) and/or intermediate outputs for determining such instructions (e.g., indication that object 30 feet away is another car)</td>
</tr>
<tr>
<td>Cardiac diagnosis</td>
<td>EKG data</td>
<td>?</td>
<td>Arrhythmia identification / classification</td>
</tr>
</tbody>
</table>
In sum, machine learning strives to fill in the “function” column above by analyzing training data derived from real-world examples in which the values for the inputs and outputs are already known. Once a sufficiently accurate function is discovered, then the trained machine learning system applies that function to determine outputs for new, untested examples, assuming the inputs of the new examples can be measured and provided to the trained machine learning system.

B. How Neural Networks Find a Function From Examples

We now dip a toe in the water of some neural network details—without pretense of completeness or technical precision—to provide a feel for the technology on a small, simplified scale to give some sense of what is involved on a larger scale. Machine learning techniques, such as neural networks, essentially use a “template” function that has a structure but also has many unknown parameters. The machine learning system then uses training data and a training algorithm to try to “learn” the optimal parameter values so that the function’s output can be calculated accurately for new examples given a new set of inputs.

The underlying principle is more familiar than it might seem. Consider a very simple “template” function, the basic linear equation from junior high math:

\[ y = ax + b \]

In the language of machine learning, \( y \) is an output value corresponding to some real-world thing; \( x \) is an input value corresponding to some real-world thing; and \( a \) and \( b \) are unknown parameter values. If you know that the relationship between \( x \) and \( y \) is linear, then you can discover the value of parameters \( a \) and \( b \) with just two known examples, each of which is represented by an input value \( x \) and an output value \( y \).

For example, assume:

- \( a \) is the speed someone travels directly away from home from a given starting point;
- \( b \) is the distance from home of the given starting point;
- \( x \) is the time the person spends traveling directly away from home; and
- \( y \) is the person’s final distance from home.

If we assume \( a \) and \( b \) are fixed values that do not change from one example to another, then we can determine those fixed values with two different “training” examples in which \( x \) and \( y \) are known. Once we know the fixed values for the parameters \( a \) (speed) and \( b \) (initial distance), we can determine the value of \( y \) (final distance from home) for any value of \( x \) (time spent traveling) using the above equation.

Of course, if all real-world relationships of interest were simple linear ones, then we could get by with basic algebra and avoid the need for sophisticated machine learning techniques such as neural networks. But many important real-world relationships are very non-linear.

Neural networks provide intricate template functions to model complicated, non-linear relationships between measurable conditions (inputs) related to a real-world thing of interest and particular outcomes of that real-world thing of interest. Those template functions might have several thousand (or more) unknown parameters. A very simple “feed forward” type neural network is shown below by way of illustration.

A neural network typically is arranged in “layers” of nodes known as artificial neurons. For example, in the above illustration, nodes N11 and N12 are in a first layer, and nodes N21 and N22 are in a second layer. Each node of the above neural network implements what is known as an “activation” function, which typically is a fairly simple non-linear function. For example, a commonly used activation function in recent years is known as the “ReLU” function (ReLU refers to “rectified linear units”). The rule for that function is simple: If the input is greater than 0, then the output equals the input. If the input is less than or equal to 0, then the output equals 0. The activation function determines a node’s output value by applying the function’s rule to a weighted sum of inputs from nodes in a prior layer. The “weights” shown above \((w1, w2 \ldots w10)\) are the parameters to be learned during training.

The above network’s computations would proceed as follows: The input to node N11 is equal to \((\text{Input1})(w1) + (\text{Input2})(w3)\). The input to node N12 is \((\text{Input1})(w2) + (\text{Input2})(w4)\). In similar fashion, the input to node N21 is a weighted sum of the output of nodes in the prior layer, i.e., \((N11 output)(w5) + (N12 output)(w7)\), as is the input to node N22, i.e., \((N11 output)(w6) + (N12 output)(w8)\), and the input to node N31, i.e., \((N21 output)(w9) + (N22 output)(w10)\). The output of each node is determined by applying the activation function to the input.

The above network would be “trained” for a particular real-world prediction problem by running training data with known output values through the network and making incremental adjustments to weight values to reduce the network’s prediction error until it cannot be reduced any further. A simplified overview of that process is as follows:
A neural network invention typically involves selecting and arranging a particular mix and configuration of neural network layer types, sizes, and depths that work well for a particular real-world problem. Neural network inventiveness can also reside in identifying the optimal input data, input pre-processing techniques, and/or training techniques that work best given the particular real-world problem to which the neural network is applied.

The possible elements of a neural network invention listed below could arguably all be characterized as mathematical, thus raising a question of whether such inventions are simply “abstract ideas” and therefore not eligible subject matter under 35 U.S.C. § 101. However, the choices made regarding the elements in a neural network invention can dramatically and concretely impact the ability of a computer to efficiently solve problems existing in the physical world. And, in some fields, that efficiency can be a matter of life and death. Cancer research, for example, is a race against time for those who have or will get diagnosed with the disease. One neural network design might help analyze genetic sequences an order of magnitude faster than another. To the extent significant improvements in processing time and/or accuracy in analysis of physical phenomena result from a neural network invention, we believe that invention is more than simply an abstract idea. However, as discussed near the end of this article, the law does not yet appear to have clearly reached that conclusion.

1. **Architecture**

The type and arrangement of neural network or other machine learning structures and techniques that work best for allowing a computer to use image data of biopsied tissue to predict whether the tissue contains malignant cells might be very different from the particular type and arrangement of structures and techniques that allow a computer to recognize spoken words based on captured audio data. In both cases, the individual techniques/processing elements are likely well known, but their particular arrangement and configuration in the invented AI system for performing the particular task is not well known. Thus, the types of layers, arrangement of different layers, size (width) of various layers, number of layers (network depth) and, in sum, the overall architecture of a neural network tailored to a particular problem is often at the heart of an AI invention.

2. **Input Data Determination, Pre-Processing, and Feature Extraction**

AI inventors distinguish between “raw” data (or processed raw data such as normalized, weighted, or encoded data), on the one hand, and “features,” on the other.

Both types of data are potential candidates for inputting into a neural network. “Features” are typically some values derived from the raw data. For example, in processing digital image data for input into a neural network for object recognition, the pixel values might be the “raw” data. It is possible to input all the pixel values into a neural network. However, it is also possible to extract image “features” from the pixel data and input those “features” into the neural network rather than, or in addition to, the raw pixel data. For example, a “feature” might be computed based on a change in pixel values over a portion of the image. It is also possible to use a neural network to learn what “features” are most useful to derive from a given type of raw data for a particular classification or prediction task.

The choice of what raw data to collect and use, how to pre-process it, and what features to extract from that data, if any, for input to a neural network can significantly impact how well the neural network performs a particu-
lar learning task. Significant thought and experiment go into making these choices, and they are an appropriate subject of AI inventions.

3. Training Methods

Neural networks are trained by iteratively passing training data through the network, measuring the “error” (sometimes called “loss”) in the outputs relative to known values of what the output should be, and updating weight values to gradually reduce that error. Currently, many neural networks are trained using some variation of the back-propagation algorithm previously mentioned. For many neural network applications, standard training techniques are used in a routine way, and those techniques are not elements of the invention.

However, standard training techniques can be modified and/or combined with other known training techniques for specific training tasks in a manner deserving of protection. For example, known training techniques can be modified to prioritize certain training performance goals appropriate for a particular application. Such goals might include learning weights quickly that produce acceptable, but not spectacularly low, error levels or, by contrast, more finely tuning weights over a longer time period to increase predictive precision. We think such training techniques and/or the selection thereof in a particular context can be appropriate elements of an AI invention.

IV. Challenging Patent Law Issues for AI Inventions

AI inventions are everywhere these days. And many areas of AI innovation are consequential to advancing particularly high-stakes endeavors. For example, these inventions provide cutting-edge tools that promise to improve the efficiency and effectiveness of medical research and, ultimately, diagnoses and treatments. However, despite the potential criticality of AI inventions to advances in medical and life sciences, current U.S. patent law leaves an undesirable level of uncertainty regarding section 112 written description and enablement requirements and section 101 subject matter eligibility requirements for AI inventions. This uncertainty risks incentivizing leading companies to keep the inner workings of important AI inventions secret rather than seek patent protection. Such decisions by those on the cutting edge of applying AI to medicine and other fields risk reducing the protection. Such decisions by those on the cutting edge of applying AI to medicine and other fields risk reducing the

A. Written Description and Enablement: Is AI an “Unpredictable Art?”

The law regarding both written description and enablement under section 112 distinguishes between so-called “predictable arts” and “unpredictable arts.” The former typically requires less detailed disclosure in order to support relatively broad claim scope, while the latter typically requires greater disclosure detail. Traditionally, many mechanical, electrical, and computer-related inventions are treated as “predictable arts” for section 112 purposes, whereas many chemical, life science, and medical treatment-related inventions are treated as “unpredictable arts.”

As discussed further below, AI inventions present potential challenges to this traditional division between “predictable” and “unpredictable.” Notably, the USPTO’s 2019 Request for Comments on Patenting Artificial Intelligence Inventions9 raises the question of whether AI inventions should be treated as unpredictable arts for purposes of section 112.

1. Written Description

To meet the written description requirement under section 112, a patent specification must describe the claimed invention in sufficient detail that a person of ordinary skill in the art can reasonably conclude that the inventor had possession of the claimed invention. Generally, disclosures for relatively new, complex, and/or unpredictable arts require a heightened level of detail to satisfy the written description requirement.10 As a new field evolves, the balance between what is known and what is added by each inventive contribution also evolves.11

The level of detail required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology.12 Computer-related inventions have traditionally been treated as “predictable” in the sense that it has been assumed that one skilled in the art would understand what the inventor has invented if the specification provides at least high-level disclosure of the underlying processing. In other words, the inventor does not need to spell out in detail all variations on how a particular solution might be implemented in order to claim the solution with reasonably broad scope.

However, in the context of deep-learning technology, the reasons why one neural network design performs better than another is not necessarily clear to one skilled in the art or even to the inventor. Whether a particular solution will work can, in some cases, be as much a matter of trial and error as it is a matter of discovering principles that underly the efficacy of that solution. Therefore, assessing whether undisclosed variations on the primary embodiments were in the possession of the inventor at the time of the application’s filing might be more challenging in the context of AI inventions than in the context
of other computer-related inventions. Notably, the USPTO has raised the question of whether AI inventions might, under the written description requirement, require more detail in the specification’s disclosure than other inventions require.15

2. Enablement

In order to meet the enablement requirement, an invention must be disclosed in sufficient detail to allow one of ordinary skill in the art to both make and use the invention without undue experimentation.14 In re Wands sets forth several factors for determining whether undue experimentation is required: (1) the breadth of the claims; (2) the nature of the invention; (3) the state of the prior art; (4) the level of one of ordinary skill; (5) the level of predictability in the art; (6) the amount of direction provided by the inventor; (7) the existence of working examples; and (8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure.15

For “predictable arts” a person of ordinary skill in the art is generally assumed to have reasonably high mastery of the basic tools and techniques disclosed in the specification for making and using the invention. Such an assumption allows for a relatively high-level description of subject matter, e.g., generic computer components, network connections, etc., which are considered to be well-known by a person of ordinary skill.16 Therefore, an inventor might satisfy the enablement requirement by describing only limited or incrementally inventive portions of a computer-implemented application in greater detail.

However, for AI inventions, the USPTO has asked whether the unpredictability of certain AI systems raises challenges for applicants to provide sufficient detail to avoid “undue experimentation.”17 While no special considerations apply to AI for enablement at this point, we note that AI inventions share some characteristics with inventions in the traditionally “unpredictable arts” category, i.e., chemical, pharmaceutical, biotech, and other life-sciences related inventions. AI inventions, like chemical and life-science inventions, often require significant research and trial and error over a long period of time to discover solutions that work for a particular problem. Just as it might be difficult to understand exactly why a particular chemical formulation leads to effective results when trying to apply section 101 law to AI. In 2019, the USPTO further revised its section101 guidance with a January revision (the “2019 PEG”) and request for comments and provided a further update in October21 (the “October Update”).

The 2019 updates added a new “integrated into a practical application” prong to Step 2A of the existing USPTO framework for evaluating subject matter eligibility. This new prong makes clear that even if a claim recites a judicial exception (abstract idea, law of nature, or natural phenomenon) the claim is not considered to be “directed” to that judicial exception if “the claim as a whole integrates a judicial exception into a practical application.”22

In general, the judicial exception is integrated into a practical application if it does something concrete with the exception’s output. The October Update, at least in the medical science context, clearly distinguishes between data input gathering activity and data output utilization activity. The latter appears to satisfy this new “integrated into” prong, while the former, by itself, does not. For example, according to the October Update, a claim reciting

It is too early to know whether AI inventions will ultimately be treated as within the “predictable” or “unpredictable” arts for purposes of the written description and enablement requirements. But, at the very least, patent practitioners who draft patent applications for AI inventions should keep in mind the current uncertainty regarding written description and enablement requirements for AI inventions and be prepared to defend the sufficiency of their disclosures during prosecution. 

3. Subject Matter Eligibility

USPTO guidance for subject matter eligibility under section 101 does not yet include AI-specific examples, and a robust body of section 101 jurisprudence on AI-specific questions does not yet exist. However, the USPTO’s 2019 Request for Comments suggests that the USPTO is actively considering how to best treat AI inventions under section 101.20

In the meantime, the USPTO has continued to update its section 101 eligibility guidance and examples, which provide something, at least, for practitioners to go on when trying to apply section 101 law to AI. In 2019, the USPTO further revised its section101 guidance with a January revision (the “2019 PEG”) and request for comments and provided a further update in October21 (the “October Update”).
vaccinating cats using different vaccination schedules and then analyzing results to determine a lowest risk schedule would not integrate the judicial exception into a practical application.\textsuperscript{23} The vaccinating step in that example is merely “in order to gather data.”\textsuperscript{24} However, if the relevant claim goes on to recite using the identified lower risk schedule to then vaccinate other cats, that would integrate the judicial exception into a practical application, and the claim would be subject-matter eligible.\textsuperscript{25}

It is important not to confuse the “integrated into” analysis under the new prong of Step 2A with the “significantly more” analysis of Step 2B of the USPTO guidelines. In contrast to additional elements under the “significantly more” analysis of Step 2B, the additional elements relied on for the “integrated into” analysis can be “routine and conventional.” The October Update’s Example 46, regarding a livestock management invention, makes this particularly clear.\textsuperscript{26} Claim 1 recites gathering livestock data via monitors (e.g., video cameras), analyzing the data to determine whether an animal’s data appears to be aberrant, and displaying the results on a display.\textsuperscript{27} The USPTO considers this claim not eligible.\textsuperscript{28} By contrast, Claim 3 of the same example adds the step of controlling a sorting gate to separate animals with aberrant behavior from those with normal behavior.\textsuperscript{29} This additional step renders the claim eligible.\textsuperscript{30} Note that although controlling a sorting gate, by itself, is presumably “routine and conventional,” that is okay because, in context, it integrates the alleged exception into the “practical application” of separating the livestock based on behavior, which goes beyond simply identifying the behavior.

In the context of AI inventions, this answers some questions but not others. For example, a claim to an AI invention for an autonomous vehicle would presumably be eligible if the claim recited using the AI data output to control the vehicle in some way. However, we still lack official guidance that tells us whether or when an intricately designed neural network processing system, tailored to a specific real-world problem, can be patent-eligible if it produces a useful data output but that output does not trigger some further concrete action. Because machine-learning applications often make predictions or accurately identify things without necessarily taking further actions based on those predictions or identifications, further AI-specific guidance is needed. Such further guidance would help AI innovators and patent practitioners make more effective decisions regarding patenting AI.

\textbf{Endnotes}

1. WIPO report at 13.
2. \textit{Id.} at 31.
3. Chart based on WIPO report at 42, Fig. 3.4.
4. Chart based on WIPO report at 90, Fig. 5.6.
5. WIPO report at 49
6. \textit{Id.}
7. \textit{Id.} at 51
8. \textit{Id.} at 146.
9. 84 FR 44889 (Aug. 27, 2019).
11. \textit{Id.} at 1358.
13. See Request for Comments on Patenting Artificial Intelligence Inventions, 84 FR 44889 (Aug. 27, 2019, question #6: “Does there need to be a change in the level of detail an applicant must provide in order to comply with the written description requirement, particularly for deep learning systems that may have a large number of hidden layers with weights that evolve during the learning/training process without human intervention or knowledge?”)
16. In re Fisher, 427 F.2d 833, 839 (C.C.P.A. 1970) (“In cases involving predictable factors, such as mechanical or electrical elements, a single embodiment provides broad enablement in the sense that, once imagined, other embodiments can be made without difficulty and their performance characteristics predicted by resort to known scientific laws. In cases involving unpredictable factors, such as most chemical reactions and physiological activity, the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved.”).
17. See Request for Comments on Patenting Artificial Intelligence Inventions, 84 FR 44889 (Aug. 27, 2019, question #7: “How can patent applications for AI inventions best comply with the enablement requirement, particularly given the degree of unpredictability of certain AI systems?”
18. In re Fisher, 427 F.2d. at 839.
19. In re Wands, 858 F.2d at 737.
20. Request for Comments on Patenting Artificial Intelligence Inventions, 84 FR 44889 (Aug. 27, 2019, question #5: “Are there any patent eligibility considerations unique to AI inventions?”
22. 2019 PEG at 54.
23. October Update at 14.
24. \textit{Id.}
25. \textit{Id.} at 15.
26. Appendix 1 to October Update at 30.
27. \textit{Id.} at 31.
28. \textit{Id.} at 33.
29. \textit{Id.} at 32-33.
30. \textit{Id.} at 40.
Patentability of Method of Treatment Claims: Recent Federal Circuit Rulings

By Natalie Kennedy

I. Introduction
The Supreme Court’s 2012 decision in Mayo Collaborative Servs. v. Prometheus Labs., Inc.,1 which found the claims at issue unpatentable under section 101 of the Patent Act as directed to a natural law, has been the subject of extensive debate concerning its application to the patentability of diagnostic methods.2 In 2014, the Supreme Court followed Mayo with Alice Corp. Pty. Ltd. v. CLS Bank Int’l,3 which addressed the patentability of claims to computer-implemented business methods and which confirmed and officially established the prevailing two-part test for evaluating patent subject matter eligibility based on the test articulated in Mayo.4

Since Mayo, a number of Federal Circuit decisions have found diagnostic method claims to be patent ineligible under section 101 on the ground that they were directed to “natural laws.”5 However, the Federal Circuit has in several recent cases upheld the patentability of claims to methods of medical treatment, distinguishing the claims at issue from those found unpatentable in Mayo, in which the exemplary claim was the following:

A method of optimizing therapeutic efficacy for treatment of an immune-mediated gastrointestinal disorder, comprising:

(a) administering a drug providing 6-thioguanine to a subject having said immune-mediated gastrointestinal disorder; and

(b) determining the level of 6-thioguanine in said subject having said immune-mediated gastrointestinal disorder,

wherein the level of 6-thioguanine less than about 230 pmol per 8x10^8 red blood cells indicates a need to increase the amount of said drug subsequently administered to said subject and

wherein the level of 6-thioguanine greater than about 400 pmol per 8x10^8 red blood cells indicates a need to decrease the amount of said drug subsequently administered to said subject.6

Patent claims to methods of treatment, like diagnostic claims, inevitably involve relationships that the Supreme Court has termed “natural laws.” The Court in Mayo found the claims unpatentable as directed to a natural law despite reciting a step of administering a drug to a subject, a type of step common to many method of treatment claims. As the Court explained its reasoning:

While it takes a human action (the administration of a thiopurine drug) to trigger a manifestation of this relation [between concentrations of certain metabolites in the blood and the likelihood that a dosage of a thiopurine drug will prove ineffective or cause harm] in a particular person, the relation itself exists in principle apart from any human action. The relation is a consequence of the ways in which thiopurine compounds are metabolized by the body—entirely natural processes. And so a patent that simply describes that relation sets forth a natural law.7

The Court also stated that the administering step of the representative claim “simply refer[red] to the relevant audience, namely doctors who treat patients with certain diseases with thiopurine drugs.”8 On the other hand, the Court suggested that “a typical patent on a new drug or a new way of using an existing drug” would confine its reach to particular applications of natural laws, unlike the claims at issue.9 This guidance left open the question of whether patent claims to particular methods of medical treatment were patent ineligible as directed to natural laws.

The Federal Circuit has since answered that question, in part, by distinguishing certain claims to methods of medical treatment from those at issue in Mayo. In Vanda Pharms. Inc. v. West-Ward Pharms. Int’l Ltd.,10 as well as in Natural Alternatives Int’l, Inc. v. Creative Compounds, LLC11 and Endo Pharms. Inc. v. Teva Pharms. USA, Inc.,12 for example, the Federal Circuit upheld claims to methods of medical treatment, which entailed “a specific method of treatment for specific patients using a specific compound at specific doses to achieve a specific outcome.”13 Conversely, in a non-precedential case, INO Therapeutics LLC v. Praxair Distrib. Inc.,14 the court held the claims at issue

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to be patent ineligible, despite an argument from the patent owner that the claims were directed to patent-eligible methods of treatment.

In order to orient the reader to the framework for the Federal Circuit’s reasoning in section 101 patent eligibility cases, I begin with a quick review of the Supreme Court’s Alice test before discussing Vanda and the other recent Federal Circuit method-of-treatment cases.

II. The Alice Test

Following Mayo, in Alice Corp. Pty. Ltd. v. CLS Bank Int’l, which involved claims directed to a “computerized scheme for mediating settlement risk,” the Supreme Court articulated a two-part test for subject matter eligibility, based on the test first developed in Mayo. In Alice Step 1, the Court held that one must “first determine whether the claims at issue are directed to a patent-ineligible concept.” If the claims are directed to a patent-ineligible concept, then, in Alice Step 2, one must “examine the elements of the claims to determine whether it contains an ‘inventive concept’ sufficient to ‘transform’ the claimed [patent-ineligible concept] into a patent-eligible application.”

III. Vanda v. West-Ward

In Vanda v. West-Ward West-Ward sought to overturn a Delaware district court ruling that the claims at issue were not patent ineligible under section 101. The claims at issue (all from Orange Book-listed patents) were directed to methods of treating patients with schizophrenia, wherein the dosage of the treatment is determined by the results of genetic testing for the presence of an enzyme that metabolizes the drug.

Claim 1 of U.S. Patent No. 8,586,610 (the “610 patent”) was considered representative:

1. A method for treating a patient with iloperidone, wherein the patient is suffering from schizophrenia, the method comprising the steps of:

   determining whether the patient is a CYP2D6 poor metabolizer by:

   obtaining or having obtained a biological sample from the patient; and

   performing or having performed a genotyping assay on the biological sample to determine if the patient has a CYP2D6 poor metabolizer genotype; and

   if the patient has a CYP2D6 poor metabolizer genotype, then internally administering iloperidone to the patient in an amount of 12 mg/day or less, and

   if the patient does not have a CYP2D6 poor metabolizer genotype, then internally administering iloperidone to the patient in an amount that is greater than 12 mg/day, up to 24 mg/day,

   wherein a risk of QTc prolongation for a patient having a CYP2D6 poor metabolizer genotype is lower following the internal administration of 12 mg/day or less than it would be if the iloperidone were administered in an amount of greater than 12 mg/day, up to 24 mg/day.

The district court held that, while the claims to a method of treatment were directed to a patent ineligible concept (namely, “the relationship between iloperidone, CYP2D6 metabolism, and QTc prolongation”) and thus failed Alice Step 1, they passed Alice Step 2, since “[West-Ward] ha[d] not proven by clear and convincing evidence that the precise test and the discovered results were routine or conventional.”

On appeal, Judge Alan D. Lourie, joined by Judge Todd M. Hughes, writing for the Federal Circuit panel, agreed with the district court’s conclusion as to patent eligibility but disagreed with the court’s reasoning. The Federal Circuit held that the method of treatment claims were patent eligible under both steps of Alice. The court reasoned that claim 1 “require[d] specific steps” of “(1) determining the patient’s CYP2D6 metabolizer genotype by (a) obtaining a biological sample and (b) performing a genotyping assay; and (2) administering specific dose ranges of iloperidone depending on the patient’s CYP2D6 genotype.” In contrast, the representative claim in Mayo recited a method of “optimizing” a dosage of thiopurine drugs, wherein the drugs were administered first and a level of certain metabolites measured, “wherein the level of metabolites indicate[d] whether to adjust the dosage.”

The Federal Circuit noted that while the claim in Mayo recited a drug administration step, the claim “as a whole” was not directed to the use of the drug to treat a disease.

The Federal Circuit regarded the method of using iloperidone to treat schizophrenia, as claimed in the ‘610 patent, as an application of the relationship between iloperidone, CYP2D6 metabolism, and QTc prolongation, as opposed to merely a claim to the natural law itself. Furthermore, the court stated, the ‘610 claims at issue did not “tie up the doctor’s subsequent treatment decision,” unlike the claims in Mayo, which could be violated whether or not the doctor altered his or her treatment.

The court likened the claims of the ‘610 patent to those at issue in Rapid Litigation Mgmt. Ltd. v. CellzDirect, Inc., wherein the end result of the claimed process was “not simply an observation or detection of the ability of hepatocytes to survive multiple free-thaw cycles” but a
method of preserving the cells. The claims in CellzDirect were found to be patent-eligible despite the “natural ability of the subject matter to undergo the process.” As the Federal Circuit pointed out in CellzDirect, if it were otherwise, “claims directed to actually ‘treating cancer with chemotherapy’ or ‘treating headaches with aspirin’ would be patent ineligible,” thus previewing the court’s decision in Vanda that the method of treatment claims were patent eligible because they were “directed to a specific method of treatment for specific patients using a specific compound at specific doses to achieve a specific outcome.”

Chief Judge Sharon Prost dissented on the ground that the claims should have been held to be patent ineligible because they were directed to a natural law. In her view the majority “conflated[d] the inquiry at Alice” step one with the search for an inventive concept at step two. Judge Prost further stated that the ‘610 claims “set[] forth a natural relationship—namely, the relationship between the CYP2D6 genotype and the likelihood that a dosage of iloperidone will cause QTc prolongation” and that the claims stated nothing more than “apply it.” She reasoned that, as with the Mayo claims, the administering step of the Vanda claim did nothing more than indicate the relevant audience for the claims and that “requiring a dosage instead of indicating a dosage is not sufficient at step two” to confer patent eligibility. Unlike the claims in CellzDirect, which were not a mere observation or detection, Judge Prost opined that the ‘610 claims were “no more than the conclusion of a natural law” and that the “fact that a reduction of iloperidone dosage in poor metabolizers may reduce QTc prolongation” was “both the means and the ends” of the claim at issue.

West-Ward (which became Hikma), filed a petition for a writ of certiorari with the Supreme Court. The Supreme Court invited the Solicitor General to file a brief, but, ultimately, the petition was denied.

### IV. Methods of Treatment after Vanda

Since Vanda, the Federal Circuit has upheld claims in two precedential cases involving methods of treatment. In Natural Alternatives, one set of claims at issue was directed to the administration of beta-alanine via a dietary supplement to increase the anaerobic working capacity of muscle and other tissue. The Federal Circuit held that the claims do “not only embody this discovery” but also “require that an infringer actually administer the dosage form claimed in the manner claimed, altering the athlete’s physiology to provide the described benefits,” making the claims treatment claims, which are patent eligible under Step 1 of Alice. Once again, the court pointed out that, unlike the claims in Mayo, the claims at issue required an affirmative act of administration even though they relied on the relationships between the administration of beta-alanine and beta-alanyl-histidine dipeptide synthesis. As the court described it, the method claims in Natural Alternatives “require[d] specific steps be taken in order to bring about a change in a subject, altering the subject’s natural state.”

In Endo, the claims were directed to using oxymorphone to treat pain in patients with impaired kidney func-

“The court noted that the method claims at issue in Endo, like those of Vanda, ‘require[d] specific steps’ including providing the pharmaceutical at a certain dose, testing the patient for kidney function, and administering a lower dose based on the measure of kidney function, in order to achieve a certain amount of drug in the body over a 12-hour period.”
More recently the Federal Circuit addressed the patent eligibility of method of treatment claims in INO Therapeutics LLC v. Praxair Distrib. Inc. 58 The claims in INO Therapeutics were directed to methods for providing inhaled nitric oxide (iNO) gas to neonatal patients via gas cylinders, wherein if certain patients did not have left ventricular dysfunction (LVD), those patients would be treated with a certain dose of iNO, but for certain patients that had LVD, those patients were not to be treated. 59 The claims in INO Therapeutics, unlike those in Vanda, Natural Alternatives, and Endo, were held to be patent ineligible. The Federal Circuit held that the claims failed Alice Step 1 as being directed to a natural law (namely, that a “neonate patient’s body will react to iNO gas in a certain way depending on whether or not the patient has a congenital heart condition called LVD”). 60 The court further focused on the fact that the claim did not direct doctors to take any action: “The claimed method here recites an old use of an old drug. Then it proposes no use.” 61 The court pointed out that no authority had been cited for the proposition that such claims “constitute an eligible new ‘use’ as contemplated by Mayo and its progeny.” 62

As for Alice Step 2, the court held that the claims did not add enough to the natural law beyond routine and conventional steps. The district court found administration of iNO at the claimed dosages to be a routine practice, 63 and the Federal Circuit noted evidence that the idea of withholding treatment from patients with LVD was itself conventional. 64

The Federal Circuit designated its opinion in INO Therapeutics as non-precedential, and the court denied en banc rehearing. INO Therapeutics’ petition for a writ of certiorari, filed March 6, 2020, was denied.

V. Conclusion: The Future of Patent Eligibility of Medical Treatment Claims

Proper application of section 101 will likely continue to be disputed. There have been congressional overtures toward statutory amendments of section 101 to clarify the conditions for patent eligibility, and the U.S. Senate held hearings in 2019. 65 But the effort to reform section 101 reform is on hold for the time being. 66

While the recent Federal Circuit rulings addressing method of treatment claims provide much for practitioners to consider, the law of patent eligibility for medical treatments will almost certainly continue to evolve with technology.
37. Id. at 1140 (J. Prost, dissenting).
38. Id.
39. Id. at 1142 (J. Prost, dissenting).
40. Id. at 1143 (J. Prost, dissenting).
41. Hikma Pharms. USA Inc. v. Vanda Pharmns. Inc., 139 S. Ct. 1368 (2019). The Solicitor General argued that the Federal Circuit’s decision was correct, and therefore that the case was not the “optimal vehicle for bringing greater clarity because the court of appeals majority arrived at the correct result.” See Brief for the United States as Amicus Curiae, Hikma Pharmns. USA Inc. v. Vanda Pharmns. Inc., No. 18-1317 (Dec. 6, 2019).
44. Natural Alternatives Int’l, Inc. v. Creative Compounds, LLC, 918 F.3d 1338 (Fed. Cir. 2019). The decision in Natural Alternatives was written by Judge Kimberly A. Moore, who was joined by Judge Evan J. Wallach. Judge Jimmie V. Reyna, concurring in part and dissenting in part, would have remanded the case and stated that the majority used an improper claim construction.
45. Id., at 1344.
46. Id., at 1344-45.
47. Id., at 1345.
48. Endo Pharmns. Inc. v. Teva Pharmns. USA, Inc., 919 F.3d 1347 (Fed. Cir. 2019). The opinion was written by Judge Kara F. Stoll for a unanimous panel, which included Judges Wallach and Raymond C. Clevenger, III.
49. Id., at 1350-51.
50. In Endo, this is a “providing” step.
51. The district court equated the claims to those in Mayo, holding that the claims were ineligible. See Endo, 919 F.3d at 1352.
52. Endo, 919 F.3d at 1353 (emphasis added).
53. Id., at 1355.
54. Id. (citing Mayo, 566 U.S. at 75).
55. Id. at 1354.
56. Order Granting Joint Motion to Dismiss, Natural Alternatives Int’l, Inc. v. Creative Compounds, LLC, No. 3-16-cv-02146 (S. D. Cal. May 3, 2019).
58. 782 F. App’x 1001 (Fed. Cir. 2019) (non-precedential). The panel consisted of Chief Judge Prost, Judge Pauline Newman, and Judge Timothy B. Dyk, with Chief Judge Prost authoring the majority opinion and Judge Newman dissenting.
59. INO Therapeutics, 782 F. App’x at 1003.
60. Id., at 1005.
61. Id., at 1009.
62. Id.
63. Id. at 1010.
64. Id. at 1011-12.
66. In a recent interview with the Intellectual Property Owners Association, Senator Thom Tillis (R-N.C.), a co-drafter of the proposed bill text and the Chairman of the Senate Judiciary Committee’s Subcommittee on Intellectual Property, suggested that the legislation is unlikely to move forward in the near future: “Given the reasonable concerns that have been expressed about the draft as well as the practical realities of the difficulty of passing legislation, absent stakeholder consensus I don’t see a path forward for producing a bill—much less steering it to passage—in this Congress.” Intellectual Property Owners Association. Daily News Special Feature: Q&A with Senator Thom Tillis, https://ipo.org/index.php/exclusive-qa-with-sen-thom-tillis/.

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Google v. Oracle: An Overview
By Jacob Baldinger and Mariam Morshedi

I. Introduction
Google and Oracle will soon argue before the Supreme Court over the scope of copyright protection in an important area of software development. Oracle sued Google for its use of Java application programming interfaces (APIs) in the Android operating system. APIs are computer code that allow different software programs to communicate with each other. After two separate appeals in the lower courts, Oracle obtained a ruling that Google infringed its copyrights in the Java platform. Google is asking the Supreme Court to overturn the infringement ruling. This article provides an overview of the case, including a summary of the large number of amicus briefs filed in the Supreme Court on both sides.

II. The Facts
In 2005, Google began negotiating a license to adapt the entire Java SE platform for smartphones and other mobile devices. Oracle, which owns the Java platform, insisted that any Google product incorporating Java maintain compatibility with other Java programs. Google and Oracle were unable to reach an agreement, and Google wrote the Android operating system instead. Unlike Java, Android is optimized for the constraints of mobile devices such as limited battery life and limited computing power.

Android did, however, reuse aspects of the Java platform. Specifically, Android replicated the syntax and structure of declaration codes associated with 37 Java API libraries. Reusing these Java APIs allowed third-party developers to use familiar Java declarations and commands to write applications that Android would recognize.

In total, Google copied 11,330 lines of Java code, including the structure and arrangement of the copied code. Despite reusing the Java code, it took almost one hundred Google engineers over three years to build Android. The copied Java APIs represents less than 0.1% of the more than 15 million relevant lines of code in Android.

Using Java code, Android developers have created millions of applications used by more than a billion people. Between 2007 and 2016, Android generated over $42 billion for Google. However, Android applications are incompatible with Oracle’s Java platform, and Java applications are incompatible with Android devices.

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In 2010, Oracle sued Google for copyright and patent infringement in the Northern District of California. Oracle estimates its damages at $9 billion.

Due to complexity of the issues, the district court evaluated the case in two phases. The first phase covered copyright eligibility, infringement, and equitable defenses. The second phase covered patent infringement. In phase one, the district court entered judgment in favor of Google, concluding that the Java APIs and their associated structure, sequence, and organization (SSO) were not subject to copyright protection.\(^1\) In phase two, the district court also ruled in favor of Google, finding no patent infringement.\(^2\)

Oracle appealed the district court’s copyright ruling (but not the patent ruling) to the Court of Appeals for the Federal Circuit.\(^3\) The Federal Circuit reversed, holding that the Java APIs and their associated SSO were copyrightable, and remanded the case for further consideration of Google’s fair use defense.\(^4\) On remand, the district court conducted a jury trial on the fair use issue, and the jury concluded Google’s reuse of the Java APIs was fair use.\(^5\)

Oracle again appealed to the Federal Circuit. The Federal Circuit again reversed, holding that, as a matter of law, Google’s reuse of the Java API packages was not fair use.\(^6\)

Google petitioned the Supreme Court to review the Federal Circuit’s copyright eligibility and fair use holdings. On November 15, 2019, the Supreme Court granted the petition with respect to both issues. Oral argument was scheduled for March 24, 2020, but because of the recent COVID-19 outbreak, the argument was postponed until October 7.

The case thus presents two issues: whether the Java APIs copied by Google are eligible for copyright protection, and, if they are, whether Google’s use of the Java APIs was fair use.

III. Copyright Eligibility

The threshold question in the case is whether the API code that Google copied is copyrightable. Copyright law protects creative expression, not functions or methods of operation. Google argues the Java APIs it reused in Android were functional—they allowed its operating system to recognize commands written in Java, a computer language that many developers know (and that was created by Oracle). Oracle, on the other hand, claims that Google used Java’s creative expressions and elegant organizational framework. According to Oracle, Google could have taken a commercial license to reuse the Java APIs or created its own organizational framework for implementing the API functions. Instead, Google copied the Java APIs, including their copyrightable expression and organization.

Section 102(a) of the Copyright Act provides that copyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression . . . from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.

However, section 102(b) states that “in no case does copyright protection . . . extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery.”

Oracle argues that the expression and organization of Java APIs copied by Google are original expression eligible for copyright protection because the code is meant to be readable by humans. The code explains to app developers a function of the code, how the computer will use the code, and how the code relates to other parts of the Java platform. The copied code could have been written in countless other ways, and Oracle’s creative choices represent an expressive, copyrightable work.

Oracle also argues that aside from the expressiveness of the copied Java APIs, its copyright covers the SSO of the code. A computer would run perfectly fine if thousands of lines of code were all stored in single file, but such an arrangement would be difficult for humans to use. Java’s authors therefore determined relationships and built interdependencies between different Java modules. Oracle argues that the SSO itself reflects creative choices that were critical to Java’s widespread adoption and are therefore independently copyrightable.

Google responds by focusing on the distinction between a “method of operation”—which is not protectable under section 102—and expression. Whereas Oracle characterizes everything in the Java system including the Java APIs as “expression,” Google contends that the Java APIs are non-copyrightable “methods of operation.” If the APIs are simply functional, they are not copyrightable, and Google therefore did not commit infringement by using them. In any case, Google argues, the copied Java APIs are mere instructions that do not contain enough creative expression to be copyrightable.

Google also contends the Java APIs and its SSO are not eligible for copyright protection under the merger doctrine. As noted, copyright protection does not extend to “any idea, procedure, process, system, method of operation, concept, principle, or discovery.” Under the merger doctrine, when “the expression is essential to the statement of the idea, the expression also will be unprotected, so as to insure free public access to the discussion of the idea.”\(^7\) Copyright law “distinguishes between ideas and expression and makes only the latter eligible for copyright protection.”\(^8\)
To utilize the Java APIs, code must strictly adhere to the Java syntax and SSO. No other code can perform the Java API functionality. Google utilized the Java APIs only to the extent necessary to achieve functionality of the APIs. Therefore, the merger doctrine would seem to dictate that any creative expression in the APIs merges with its functionality. If the merger doctrine were not applied, Oracle’s copyrights would convey an exclusive right to the functionality of the copied Java APIs, a right that should be properly secured by patent, not copyright.

IV. Fair Use

If the Court determines the Java APIs at issue are copyrightable (as Oracle argues), it will then evaluate whether Google made fair use of the code. Copyright law allows people to make limited use, or “fair use,” of copyrighted material without infringing the copyright. Google argues that even if the copied Java APIs are eligible for copyright protection, the jury correctly found that its use of the code was a non-infringing “fair use.”

Section 107 of the Copyright Act provides:

[F]air use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.

The statute lists the four factors that should be considered to determine whether use of copyrighted material is fair:

1. the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
2. the nature of the copyrighted work;
3. the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
4. the effect of the use upon the potential market for or value of the copyrighted work.

With respect to factor one, Google argues it “transformed” use of the Java APIs by implementing them in the constrained operating environment of mobile devices. This new implementation gave new expression and meaning to the copied code. Although creation of Android was a commercial endeavor, Google contends that any commercial advantage was due to the underlying code implemented by the copied Java APIs, which Google wrote on its own.

Oracle counters that to be transformative, a use must change the expression or meaning of the copied material. Google’s use was not transformative because every line of code copied by Google has the same meaning and serves the same purpose in Android as it did in Java. The copied material itself was not transformed. Transformative use of the copied Java APIs would include copying it to critique the code or to research how to make a program that does not infringe.

Under factor two, creative works are accorded greater protection than factual/informational ones; the latter are more susceptible to a fair use defense. Google argues that substantial evidence indicates that the copied Java APIs were primarily functional, not creative. Therefore, the jury reasonably concluded that the copied Java APIs were entitled to minimal copyright protection and reusing the code was a “fair use.”

Oracle argues that even minimally creative works like APIs are entitled to protection against copying of their expressive elements.

Factor three looks at (1) the amount of material that was copied relative to the entire copyrighted work and (2) accounts for the importance of the copied material relative to the entire copyrighted work. Google argues the copied Java APIs comprise less than 0.5 percent of the code in the Java SE libraries, which are themselves only a subset of the entire Java SE platform. Evidence was presented to the jury that although the copied Java APIs were necessary to allow code written in Java to work on Android, the copied code had no value independent of the underlying implementing code that Google independently wrote.

Oracle argues that “statistics cannot trump quality” and that the copied code included “central” and “important” Java packages.

Courts consider factor four—potential market harm—to be the most important in the fair use analysis. Google argues that use of the copied code (including their SSO) caused no harm to the market for the Oracle’s copyrighted works. Evidence was presented that Android did not supplant or supersede the market for Java. Rather, Java was designed for servers and desktop computers and is not suitable for the smartphone market.

Oracle contends that its commercial customers leveraged the availability of Android for steep discounts on Java licenses and that Google’s copying harmed the potential market for Java. For example, the 2005 licensing negotiations with Google show that Oracle was attempting to license Java for the smartphones market.

V. Amicus Arguments

Over 50 amici filed briefs raising various policy and legal concerns. Below, we summarize arguments made by amici on both sides and on neither side.
The U.S. Government

The government filed a brief supporting Oracle and arguing that computer programs are copyrightable despite their functional character. The government contends that the merger doctrine does not apply because Oracle had “unlimited” expressive options when it designed Java. Regarding fair use, the government argues that copying to achieve interoperability can be fair use but that Android was a commercial endeavor designed to be incompatible with Java, and Google’s technical requirements did not require copying. In fact, the government states, other companies, including Apple and Microsoft, developed successful mobile operating systems without copying Oracle’s work.

Other Amicus Arguments Supporting Oracle

1. The “Choice in Expression” Argument. A number of Oracle supporters argue that Google’s functionality argument is invalid because Google did not have to copy the Java APIs to achieve their function; Google could have used a number of expressive choices. The Java APIs and their associated SSO were not dictated by the operational outcome they were intended to achieve. Google’s formulation of the merger doctrine suggests that computer programs protected by copyright lose that protection if those programs become the most popular and common way to express an idea. Furthermore, Google could have used code conversion apps to translate Java into its new Android language.

Amici also provide empirical evidence that there are a large number of expressive choices available to any individual programmer, even when coding a solution to an identical, known problem. They also cite examples of successful mobile operating systems (e.g., iOS) that are not compatible with Java and did not reuse Java APIs.

Even though the Java APIs are copyrightable, Google’s use was not fair. Lower courts have applied the doctrine of copyright fair use inconsistently by over-emphasizing one or two fair use factors, such as transformation. Court should require a holistic fair use analysis that includes an appropriate balance of all the statutory fair use factors. Some amici go further, arguing that a jury cannot engage in the same type of determinations. A jury cannot engage in the same type of thorough analysis and undertake the careful balancing contemplated by Congress or the courts.

2. The “Reliance on Copyright” Argument. Amici argue that the exception Google seeks (either for interoperability or for functionality or due to popularity of the expression) is not only hard to implement but also bad for innovation. Commercial entities would not innovate without being provided with strong copyright protection; they would not undertake the expensive and time-consuming effort to produce software or other innovative work product. Congress considered but declined to carve out a subset of computer programs as uncopyrightable, recognizing that such line-drawing would difficult. The copyright statute requires that all computer software be treated just like any other literary work and analyzed under traditional copyright principles.

Java’s popularity is not a legitimate reason to excuse Google’s copying; it does not make Google’s use fair. Secondary use of a copied work that results in a marketplace replacement for the original is impermissible because it undermines the incentive to create. Copying to avoid a business inconvenience undermines the constitutional goal of “promot[ing] the progress of science and the useful arts.”

Lowering the bar for copyright protection will make it harder to enforce copyright protection and will harm U.S. economic interests. U.S. intellectual property-intensive industries generate nearly $7.7 trillion in gross output and account for more than 60% of total U.S. exports.

Strong copyright protection is fundamental to a well-ordered legal system. The copyright exceptions Google advocates would place the United States in violation of its international agreements. The Court should apply copyright law as it stands and leave to Congress the task of deciding whether copyright law needs an upgrade.

3. The “Beautiful Expression” Argument. Other amici emphasize that Java is an “expressive” work; its language is chosen to invoke intuition among users, which is why it became so popular. The development of Java was the result of creative efforts by a team of highly trained developers. The Java API may read like gibberish to non-programmers, but it is an elegantly designed set of packages resulting from a creative exercise that is apparent to everyday professional programmers. The Java API comes intuitively to programmers, and is a huge part of what has made Java a success. Although a single method name like “max” may not itself be copyrightable, the names, selection, structure and taxonomy of thousands of methods is.

4. The “Google Doesn’t Play Fair” Argument. Several amici highlight Google’s commercial behavior and profit model to portray the company in an unsympathetic light. They contend out that Google behaves anti-competitively and is using Java anti-competitively. Google could have written the declaring code in many different ways but copied the Java APIs so it could attract Java programmers to Android and replace Java.

Reproduction and distribution of Android directly superseded the legitimate market for the Java. Google’s disregard for copyright in order to increase its profits compromises any argument that its use is non-commercial, transformative, or in any sense “fair.” Other industry players need copyright protection to fund research and development costs and continue to build new and sophisticated software. Google, on the other hand, makes
money by collecting and selling user data, not by licensing its software.

**Amici Arguments Supporting Google**

1. The “Network” or Monopoly Argument. Amici supporting Google note that smaller market players need to be able to copy software interfaces to be competitive. Copyright protection for Java APIs will allow Oracle and other top industry players to cement their position at the top, making it too costly for small businesses or startups or new innovators to compete efficiently. Oracle released its software to the public under an open source license in the hope that it would increase its use and distribution. Oracle can’t now complain just because a big company like Google is using it. Google’s use of Java provides Oracle the business benefit it hoped for—a boost to the Java system’s use and distribution.

These amici argue that Oracle is the one behaving anti-competitively by leveraging legitimate rights to gain illegitimate monopoly power outside the scope of its legitimate rights—extending copyright protection to the Java APIs represents a misuse of copyright law to obtain a monopoly over technology that could not have been patented. Software APIs become standards (and are copied) because of their functional, not expressive, value. New entrants seeking to introduce a rival system must overcome costs of on-boarding both consumers and software developers to a new system. Allowing reimplementations is critical to preventing lock-in and ensuring competition, not merely in the computer marketplace but also in other industries that are dependent on software, such as the consumer retail market.

2. The “Parts” Argument. Other amici argue that Oracle is trying to enforce copyright protection on a small segment of its entire Java platform. This segment, the Java APIs, is just one functional component of a larger system that may deserve protection as a whole but not for each component. Primarily functional programs receive “thin” copyright protection to ensure that subsequent programmers can freely reuse these unprotectable segments when developing their own programs. This principle has always been accepted—based on legal precedent dating back 140 years.

Oracle based its claims in this case on copyright registrations for the entire Java SE program—all 2.8 million lines of it (in the 166 Java SE packages). If Oracle had tried to register only the Java API segment, the Copyright Office likely would have rejected the application.

To determine whether a segment of a larger work is independently entitled to copyright protection requires evaluating the expressive aspects of the segments versus its ideas, systems, methods of operation, or the like. Any functionally required aspects—including any expression necessary to practice the idea—should be factored out of the analysis. The remaining expressive aspects should then be compared to what was copied. This approach recognizes that while entire software programs may be copyrightable, smaller segments of the program may not be.

Consider a car manufacturer that develops an ignition switch using a metal key that includes an original cut pattern on the blade. Although the cut pattern may be protected as a “modern sculpture,” the car manufacturer could not use copyright law to prevent others from utilizing the same expression for the purpose of starting the car. Copyright protects separable expressive features, such as surface ornamentation of an ignition key. It does not prevent the reuse of functional specifications. Only patent law can protect those features.

Amici analogize the reuse of Java APIs to the reuse of phrases in Supreme Court opinions. Looking at 15,942 opinions issued in 7,113 cases from 1946 to 2014, they broke the text of each opinion into individual words and two- and three-word phrases. On average, 64.6% of three-word phrases can be found in prior opinions. Removing these phrases (e.g., assuming they are copyrightable) renders the text of the opinion unintelligible or ambiguous.

The “structure, sequence and organization” (SSO) of the Java APIs are also not copyrightable. Amici suggest considering the SSO of an online form for entering payment and shipping information when buying a product online. A shopping site could come up with a totally new format for requesting this information. For example, instead of entering “First Name, Last Name,” users might be required to enter “Name as it appears on most recent 1040 fax form for U.S. taxpayers” or “Name that comes after your first name and middle name(s).” Common sense, technological standardization, and economic efficiency have driven the industry to adopt an almost ubiquitous SSO that every user expects, understands, and completes with ease.

Holding the Java APIs to be copyrightable runs contrary to a broad consensus of judicial and legislative evolution around the world that copyright does not protect software interfaces such as the Java APIs at issue in this case.

3. The “It Happens” Argument. In many industries, from software to the medical, legal and retail industries, copying of this nature happens. Several briefs offer examples to illustrate that copying of this nature is not only not problematic for innovation but helpful and functional.

Innovation today depends on collaborative development, interoperability, and reuse of computer code. For example, the reuse of APIs allows users to freely add, delete, and update apps without purchasing a new phone. To maintain, service, repair, customize, and refurbish OEM automotive products, suppliers of aftermarket parts must access the product software applications through a program interface. Holding Java APIs to be copyrightable

(continued on page 25)
disturbs settled industry expectations that programming interfaces are uncopyrightable functional elements. In cloud computing Oracle itself is reusing APIs. Historically, the software industry has developed through the reuse of APIs. Examples include Unix -> Linux -> Android/Apple iOS and IBM BIOS -> AWS -> Microsoft/Oracle/Google cloud computing systems. Rather than compete on the API design, software providers compete on business factors—like price and customer service—and on implementation factors—like latency, downtime, and redundancy.

Google was not “seeking to appropriate the advances” in the Java software interfaces, but rather “to give [Java programmers] an option to exploit their own prior investment in learning” the Java language. Subjecting APIs to copyright protections would force developers to constantly re-engineer something that already works, stymying creativity and innovation. Any program that exists today could conceptually be rewritten by removing all API declaration calls and replacing them with the entirety of the remote implementing code they represent.

Subjecting APIs to copyright protections would also be particularly harmful to startups small businesses and entrepreneurs. Requiring startups to pay royalties to perform rudimentary operations or engage in hundreds or thousands coding workarounds will exponentially increase the costs of developing software. The likely result will be that more startups fail.

Empirical research demonstrates that broader copyright protection is not correlated with more revenue for copyright owners or production of more creative works. This empirical research suggests the Court should favor narrower, rather than broader, copyright protection.

Aside from commercial benefits, copying of this nature is associated with important social benefits. Librarians and the patrons they serve are dependent on a robust and stable understanding that copying of this nature is fair use. The lower court erred in its fair use analysis, such as by dismissing as insignificant the functional nature of the Java APIs and conflating the market for the Java platform as a whole with the market for individual APIs. The jury got it right. Until the decision below, no appellate court had reversed a jury’s general verdict finding of fair use, and doing so violated the Seventh Amendment right to a jury trial.

Other Amicus Arguments

The Robert Rauschenberg and Andy Warhol Foundations argue that whatever the Court decides regarding fair use, the Court should be clear that the same analysis does not necessarily apply to other contexts such as art, literature, or music. In these contexts, fair use must account for the reality that expressive works often build on, and pay homage to, pre-existing works.

The American Intellectual Property Law Association filed a brief in support of neither party in which it argued that declaring code portions of the Java APIs are not protected by copyright (generally supporting Google). They also advocate respecting the jury’s fair use verdict.

Endnotes

3. An interesting procedural note: Because the case was originally filed with patent claims, the appeal fell under the jurisdiction of the Federal Circuit instead of the Ninth Circuit. 28 U.S.C. § 1295(a)(1) However, on the copyright issue the Federal Circuit applied Ninth Circuit law (the law of the circuit in which the case originated), as it does when deciding non-patent issues. See Atari Games Corp. v. Nintendo of Am., Inc., 975 F.2d 832, 837 (Fed. Cir. 1992).
11. See, e.g., Briefs filed by Professor Arthur Miller; Ralph Oman (former Register of Copyrights); Brief of Former Congressmen; Copyright Thought Leaders; Hudson Institute; Consumer’s Research; Copyright Alliance; Center for Medicine in the Public Interest; American Conservative Union Foundation; Internet Accountability Project; Committee for Justice; American Legislative Exchange Council; 25 Professors of Journalism and Media Law; Nine Professors and Scholars of Intellectual Property Law; Synopsys, Inc.; USTelecom; The Recording Industry Association of America et al.
12. See, e.g., Briefs filed by Digital Justice Foundation; Former Sun Executive Scott McNealy.


14. See, e.g., Briefs filed by Center for Democracy and Technology et al; Electronic Frontier Foundation; American Antitrust Institute; The Retail Litigation Center, Inc.; Rimini Street, Inc.; Python Software Foundation et al.

15. See, e.g., Briefs filed by Electronic Frontier Foundation; Software Freedom Law Center; Michael Risch; Peter S. Menell, David Nimmer, and Shyamkrishna Balganesh; Empirical

16. See, e.g., Briefs filed by Auto Care Association and Static Control Components, Inc.; Developers Alliance; R Street Institute, Public Knowledge, and The Niskanen Center, Engine Advocacy; American Library Association et al.; Software and System Developers and Engineers for United States Government Agencies; Professor Glynn Lunney; Software Innovators, Startups, and Investors; 83 Computer Scientists; Copyright Scholars; Civ Pro, IP & Legal History Professors; Microsoft Corporation.

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UDRP’s Younger Sibling: Rapid Suspension of Cybersquatting Domain Names Under the URS

By Gerald M. Levine

I. Introduction

When the Internet Corporation for Assigned Names and Numbers (ICANN) was formed in 1998, there were three business extensions: .com, .net, and .org, and 2,154,634 registrations (led by .com with 1,879,501). The earliest registrations of generic top-level domains (gTLDs) date to 1985: a .net in January and a .com in March. Between 1998 and 2013, ICANN delegated several more extensions including .info and .biz. Before 2000, the first effective year of the Uniform Domain Name Dispute Resolution Policy (UDRP), rights holders had to litigate claims of unlawful registrations of domain names in national courts invoking trademark theories of liability. There was no ready-made jurisprudence tailored for the new tort of cybersquatting.

In the first full year of the UDRP, ICANN-certified providers administered approximately 3,500 domain name disputes involving around 5,000 domain names. By January 1, 2000, the number of registered domain names had increased by another six million. From that point on, the number of domain name registrations increased exponentially. Verisign Inc., the registry of .com and .net, reported that as of September 30, 2019, there were 198 million domain names in the gTLD space (of which 144 million are in the .com extension). Cybersquatting complaints have risen more slowly, and less dramatically, to around 6,000 annually involving 8,000 or 9,000 domain names.

In 2013, ICANN approved 1,800 new generic top-level domains (“new gTLDs”) for delegation to the Domain Name System (DNS). The new gTLDs have been introduced into the market on a rolling basis. Many, perhaps most, are currently available for registration, while others are yet to be launched. Even as ICANN was taking steps to approve the new gTLDs for delegation, the World Intellectual Property Organization (WIPO) was expressing concern on behalf of the trademark constituency that “[t]he unprecedented expansion of the Internet domain name space . . . is likely to disrupt existing strategies for trademark protection on the web.”

To counter this dire prediction, ICANN created three new protective mechanisms for rights holders, namely, (1) a registry-like body to verify marks and their commercial uses called the Trademark Clearinghouse (TMCH); (2) Sunrise (a 90-day period during which owners whose trademarks have been verified by the TMCH may preregister names corresponding to their trademarks); and (3) a new adjudicatory procedure, the Uniform Rapid Suspension System (URS).

When introduced, the URS was not intended for legacy gTLDs (.com, .net, etc.), and for new gTLDs it applies only to that class of dispute colloquially referred to as a “slam dunk.” By way of registrar contract revisions negotiated in 2019, ICANN opened the URS to two legacy extensions: .org and .info. To many, this move presages a future ICANN decision to make the URS a “consensus policy”—that is, to open it up to all legacy extensions. For reasons I will outline below, the URS as presently constituted has not proved particularly popular with mark owners, but it could improve in popularity if certain changes were made.

Regardless whether a claim could be brought in a URS proceeding, rights holders have a choice of mechanism to shut down cybersquatting domain names. There is no particular mystery about the lack of enthusiasm for URS: the URS remedy is limited to suspension for the life of the registration; for the UDRP, it is either cancellation or transfer of the domain name. The difference is temporary as opposed to permanent relief. It appears that for most complainants, the permanent relief offered by the UDRP is better than the temporary relief offered by the URS.

This moment is particularly opportune to take a bird’s-eye view of the URS (and its relation to the UDRP) because there is an ICANN “Working Group” currently examining “All Rights Protection Mechanisms” (RPMs) to determine whether they fulfill the purposes for which they were created and whether additional policy recommendations are needed to improve them (the RPM WG). Its mandate is divided into two parts: Phase 1 examines the 2013 RPMs; Phase 2 focuses on the UDRP. The proper understanding of the term “rights protection mechanisms” is that it applies equally to mark owners as it does to domain name holders to the extent they establish their rights.

ICANN posted Phase 1 Preliminary Recommendations and Individual Proposals for public comment on March 18, 2020. The Recommendations include revising the default provisions of the URS; the Individual Proposals mainly address substantive changes to the URS such as reducing some respondent protections and extending the URS to include all legacy gTLDs. At some point following the public comment on Phase 1, which

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ended on May 4, 2020, the RPM WG will issue a Final Recommendation.

The RPM WG will not get to Phase 2 (UDRP) until late 2020 or have any preliminary recommendations until 2021 (if that!).

II. Jurisdiction and Remedies

ICANN describes the URS as “complement[ing] the existing UDRP by offering a lower-cost, faster path to relief for rights holders experiencing the most clear-cut cases of infringement.” The words have been chosen carefully. By its terms, the scope of the URS is significantly narrower than the UDRP. It is only available to owners with word marks; figurative marks are outside the scope. It is also not available to mark owners claiming unregistered marks.

Current experience with the URS is slim because of its low usage. Since its introduction in 2014, there have been fewer than 2,000 cases. Rights holders prevail in approximately 98% of them. At the same time, at least twice as many rights holders use the UDRP for challenging domain names with new gTLD extensions. Why the preference?

On the surface, “lower cost” and “faster path” sound like sales pitches, encouraging rights holders to use the mechanism. Important though these two features are, the major discouragement appears to arise from the combination of differences between the URS and the UDRP. The URS demands a higher standard of proof and has only a single remedy. The third phrase, “clear-cut cases,” is a substantive statement about the subject matter jurisdiction of the URS, namely, that it is only available to a limited class of complainants.

I will return to the three phrases in a moment after developing some context. Mark owners pay less and have a heavier burden with the URS, but they get less. The question is, if mark owners had their druthers, what would they want? A partial answer is found in the RPM WG Preliminary Recommendations and Individual Proposals.

A. Higher Standard of Proof

To prevail under the URS, mark owners are required to support their claims of cybersquatting by clear and convincing evidence; while under the UDRP the burden is satisfied by a preponderance of the evidence. This higher standard has defeated parties who have submitted deficient pleadings. The URS tracks the UDRP in dismissing claims by mark owners whose rights postdate registrations of alleged infringing domain names. Other complainants are flummoxed by the conjunctive requirement that demands proof of both registration in bad faith and use in bad faith. And, of course, the complainant must be able to show a trademark right. In Best Reviews Guide, the Examiner noted that “[t]he lack of a

Trademark on the Principal Registry [is] dispositive of the matter in this forum.”

These bars to rapid suspension are repeated for emphasis in several different provisions: There must neither be “open questions of fact,” “genuine contestable issues,” nor “genuine issues of material fact.” For the avoidance of doubt as to the meaning of “clear and convincing evidence,” the URS includes the following instructions to Examiners (the name of decision-makers under the URS):

To restate in another way, if the Examiner finds that all three standards are satisfied by clear and convincing evidence and that there is no genuine contestable issue, then the Examiner shall issue a Determination in favor of the Complainant.

If the claim is not slam dunk, it either belongs in a UDRP proceeding or in an action in a court of competent jurisdiction.

B. Suspension

The second principal difference between the URS and the UDRP is the available remedy. Whereas the UDRP offers two remedies, cancellation or transfer of the domain name, the URS offers only suspension for the duration of the registration. The concern here is that the same domain name could be registered by another potential infringer once it is released following the expiration of the registration. This is not paranoiac: There have been instances of domain names returning to the URS under different respondent names. The URS has no provision for putting the domain name out of reach for further exploitation. Individual Proposal #13 therefore proposes that the losing respondent “cannot re-register the same domain name once it is no longer suspended.”

In the discussions by the World Intellectual Property Organization (WIPO) that ultimately led to ICANN implementing the UDRP, commentators considered three remedies to combat cybersquatting: suspending, cancelling, and transferring infringing domain names. Of the three, suspension appears to have been considered separately. Final Report Paragraph 189 states:

A number of commentators were in favor of the possibility of an expedited application under the administrative procedure, whereby a complainant could obtain a suspension of a domain name registration on short notice pending a final decision on the merits.

However, the Final Report concluded that “the scope of the administrative procedure to cases of abusive registration makes this possibility unnecessary.” While suspension did not make its way into the UDRP, ICANN nevertheless incorporated all three remedies in the Regis-
trar Accreditation Agreement (RAA), and it is a standard fixture in domain name service agreements.19

The unused remedy of suspension came in handy when ICANN began considering an expedited mechanism for rights holders challenging registrations of domain names in new gTLD extensions, and it found its place in the URS. While mark owners would like to enlarge the remedy and limit reopening of default suspensions, domain name holders would like to strengthen protections against overreaching and assure that respondents get a fair opportunity to defend their domain names.

III. Benefits and Burdens of the URS

Two principal features of the URS—lower cost and faster path—both implicate due process issues that the RPM WG focused on. Lower cost is a benefit to trademark owners but not to domain name holders. As for faster path, because, for the most part, respondents are likely to be unrepresented, it can affect their ability to gather sufficient information to defend themselves. The RPM WG found deficiencies in this area.

A. Lower Cost

The “lower cost” (Forum charges $375 for 1 to 14 domain names20 at against $1,300 for a sole Panel or $2,600 for a three-member Panel for the UDRP) buys “faster path to relief,” but a rush to judgment comes at a cost of error discussed further below. As there must be effective means of suspending infringers, there likewise must be effective protections.

Not surprisingly, there are different opinions on cost. It is mainly mark owners who incur them and who may wish to even the score by shifting some of it to respondents. So, for example, the RPM WG report asks for community input on the question of penalties for abusing the URS process (Question #10, referring to URS Article 11, which targets overreaching mark owners, similar to reverse domain name hijacking under the UDRP). Individual Proposal #22 suggests that the URS “should incorporate a ‘loser pays’ model.” This would be a radical departure from the UDRP, but such a provision in a contingent form is written into the Canada country code policy.21

B. Faster Path to Relief

Respondents have 14 days from service to file a response;22 and Examiners have a three-day turnaround to file decisions,23 as compared with 14 days for UDRP Panels. Given the speed for turning around the URS administrative review—the provider has to act within two business days of submission of the complaint,24 and the Examiner has, as noted, three days for the decision—the examination is unnecessarily hurried, resulting in a perfunctory analysis of the record (with exceptions). For this reason, the RPM WG recommends (Preliminary Rec-ommendation #7) that “all URS Providers require their examiners to document their rationale in sufficient detail to explain how the decision was reached in all issued Determinations.”

It could reasonably be argued that this “rush to judgment” comes with unintended (although foreseeable) consequences. The lower cost means there is less money to pay Examiners for their services, and the faster path means Examiners have less time to consider the merits of a dispute. Speed can be the enemy of sound judgment. These combined shortcomings can diminish confidence in the process. For example, in the case involving Prudential.app,25 the domain name did not resolve to an active website, and, except for the second level domain being identical with the well-known PRUDENTIAL mark, the Examiner was unilluminating on how it arrived at its decision. It suspended the domain name because [t]he PRUDENTIAL mark is famous all around the world and has been used for year[s]. Therefore, the Respondent knew or should have known of the Complainant’s mark when registering [the domain name].

While PRUDENTIAL may be “famous all around the world,” it cannot own “prudential” any more than Entrepreneur Media, Inc. can own the word “entrepreneur.”26 Had the domain name resolved to an active website, the content of the site would have been a critical factor in assessing bad faith; passive holding without other evidence is inconsistent with the jurisdictional limitations of the URS. Indeed, examiners have found that passive holding cases in which the domain name is composed of dictionary words that there are triable issues of fact that preclude suspension.

The deficiency in the decision is illustrated in a later Prudential case. The examiner dismissed the complaint on the grounds that the policy “was not intended to permit a party who elects to register or use a common term, ‘rock solid’ in this case as a trademark to bar others from using the common term in a domain name, unless it is clear that there is the case of the bad faith use” (emphasis added).27

C. Mitigation of Initial Default

ICANN recognized that the rush to judgment favored the complainant and crafted some provisions to strengthen and balance due process by (1) allowing respondents to cure a default after the initial determination of suspension and (2) allowing for a de novo appeal from a final determination of suspension. De novo review is permissible if the defaulting respondent either files an answer within six months (for a modest fee) or makes a request for another six-month extension (Paragraph 6.4 and 6.5, for another less modest fee). Thus, respondents have up to 12 months after default to establish a defense. De novo reviews are rare, and if they occur, it is rarer still to file for
a de novo appeal, which is a separate level of review and further fees.28

To trademark owners, de novo review—essentially giving respondents a second and third chance—constitutes an existential threat in that it prolongs the process; time waiting for a remedy is also a cost. There is also the possibility that the URS will become a consensus mechanism. If the URS were extended to legacy gTLDs, it would create the potential for gaming the proceeding. Hence, there are several Individual Proposals to reduce the risks. De novo review should either be eliminated or revised to a single shorter period.29

De novo appeal30 (a step beyond de novo review) is an interesting and inventive concept. It is not offered under the UDRP, but it is not sui generis. It has been a feature of Australia, New Zealand, and UK country code policies from the beginning. Whether the RPM WG recommends it for the UDRP must await further discussion in Phase 2 of the RPM WG.

While changes to the URS may be warranted, they could come as a cost to domain name registrants who arguably have lawful registrations. This is less an issue at present, since there are so few URS cases, but it is likely to become an issue if the URS blossoms into a consensus policy.

RPM WG Individual Proposal #36 would significantly reduce respondents’ right to enter the fray after default. It seeks to “[e]liminate the existing post-default de novo review period and instead replace the current URS appeal as a filing period to 60 days, with the possibility of obtaining an additional 30 days to file a URS appeal as a matter of right, upon request within the initial 60 day filing period.”

D. Due Process

Well over 95% of respondents default. In most cases this is likely because (as in UDRP proceedings) they have no defensible rights to their choices, but a small number of undefended or even defended disputes could very likely raise the kinds of issues that may not be so obvious. In these cases—such as the Prudential case cited above—there is good cause to insist on reinforcing due process for two obvious reasons: first, the possibility that respondents did not receive actual notice of the proceedings (emails going into spam, for instance) or unable to respond within the stipulated 14 days; and second, that respondents may not understand what the proceedings are about (the default language of the proceedings is English).

It is essential that respondents receive Notice of Complaint in their own language (Preliminary Recommendation #3) and are advised of their right to respond and defend their domain names. It is not unlikely for a respondent to learn its domain name has been challenged when it sees it has been suspended. For 95+% of the cases—those involving marks of well known and famous brands—undue speed probably makes no difference because it would be implausible for the respondent to deny targeting. However, there are other cases in which a cursory examination is not sufficient, specifically those involving domain names identical or confusingly similar to marks composed of dictionary words or common phrases that could conceivably be used for other businesses without infringing third-party rights.

The RPM WG considered several fixes: (1) transmitting the complaint only after the Registrar has forwarded the relevant WHOIS/RDDS data (Preliminary Recommendation #2); (2) transmitting notice of complaint with translation in the predominant language of the respondent (Recommendation #3); (3) developing a uniform set of educational materials for parties, practitioners, and examiners (Preliminary Recommendation #6); and (4) developing clear, concise, easy-to-understand informational materials (Preliminary Recommendation #10). These fixes will have an impact on the service providers in terms of the costs associated with the changes they will have to make to their online filing systems.31

III. URS Jurisprudence as Applied

A. Clear-Cut Cases

As already noted, URS jurisdiction is more limited than that of the UDRP. “Rapid suspension” is only available to mark owners with registered rights and proof of actual commercial use.32 It is not, therefore, as previously mentioned, available to mark owners claiming unregistered (common law) rights or design marks. To qualify for standing, rights holders must prove a set of additional elements beyond those necessary to meet the “standing” requirement of the UDRP. The “identical or confusingly similar” element remains, but the complainant also “[m]ust hold[ ] a valid national or regional registration . . . that is in current use.”33 Proof of use can be shown “(a) by demonstrating that evidence of use—which can be a declaration and one specimen of current use in commerce—was submitted to, and validated by, the Trademark Clearinghouse; or (b) . . . submit[ing] [proof] directly with the URS Complaint.”

Recent clear-cut cases on the docket include lockheedmartin.ooo, kohls.cloud, bloomberg.page, and cleanmopc. It should be noted that the first three of these incorporate well known, perhaps famous marks. “Clean my PC”34 is more like “rock solid” in being a common expression, but as the Examiner explained: “While the Complainant’s mark appears to be weak as it comprises a combination of the words ‘clean,’ ‘my’ and the acronym ‘pc,’ the evidence provided clearly shows that the Respondent was targeting the Complainant.”

For marks on the lower end of the spectrum, the complainant has to work harder. In Principal Services,35 the Examiner held that “[h]olders of protected marks which are also commonly used, generic terms should
ensure prompt registration of their desired domains, as their trademarks, on their own accord, will not suffice to succeed on claims against legitimate registrants of such domain names.” This is aptly illustrated in Laz.org, in which the complainant argued that “laz.org” was confusingly similar to its marks, LA ZETA and THE Z.36 It came to this conclusion based on a “belief” that the string was truncated to “laz” from “la zeta” (omitting the “eta”) and that the “la” (a “the” in Romance languages) was confusingly similar to “LA Z.” The Examiner rejected this contention, thereby reinforcing another, and most important point, well established in UDRP jurisprudence, that it is not an actionable claim for investors to sell stock from inventory lawfully registered.

B. The Evidentiary Burden

As already explained, the URS demands that complaints prove their contentions of cybersquatting by clear and convincing evidence, and the meaning of this standard is prescribed in the Procedure provisions. The URS essentially demands specific and concrete evidence that the challenged domain name is infringing. If inferences are made, they must flow directly from solid proof.

The Examiner found cybersquatting in eos.blackfriday37 by inferring from the second-level domain identical to the mark that the only reason for attaching the “black-friday” extension to the mark was to attract consumers interested in purchasing the complainant’s products. The inference was drawn from the content of the website to which the domain name resolved.

The URS prescribes two sets of factors that support conjunctive bad faith, a general set shared with the UDRP and a specific set that is unique to it. The specific set reads:

5.9.1 Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves not indicia of bad faith under the URS. Such conduct, however, may be abusive in a given case depending on the circumstances of the dispute. The Examiner must review each case on its merits.

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5.9.2 Sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) does not in and of itself constitute bad faith under the URS. Such conduct, however, may be abusive in a given case depending on the circumstances of the dispute. The Examiner will take into account:

5.9.2.1. the nature of the domain name;

5.9.2.2. the nature of the advertising links on any parking page associated with the domain name; and

5.9.2.3. that the use of the domain name is ultimately the Registrant’s responsibility.

As noted above with respect to Laz.org, “belief” in the correctness of one’s position does not satisfy the evidentiary burden to show bad faith because it rests on conjecture. In Topsolid.xyz,38 the Examiner noted that “[t]he Complainant has not provided any information with regard to its scope of business activity, especially in Switzerland, where the Respondent is located. Furthermore, the disputed domain name is a combination of the generic words ‘top’ and ‘solid’ and the Complainant provided no evidence that the Respondent deliberately targets its trademark.”

A similar conclusion was reached in Grey.email.39 It is particularly difficult to prove bad faith use of generic terms, regardless how well-known a mark may be, if used “solely in a descriptive way and not in connection with the Complainant’s services.”

Respondents also have two sets of circumstances as defenses, general and specific. The general defenses are identical to the UDRP. The specific defenses, which are peculiar to the URS, are:

5.8.1 The domain name is generic or descriptive and the Registrant is making fair use of it…

5.8.2 The domain name sites are operated solely in tribute to or in criticism of a person or business that is found by the Examiner to be fair use.

5.8.3 Registrant’s holding of the domain name is consistent with an express term of a written agreement entered into by the disputing Parties and that is still in effect.

5.8.4 The domain name is not part of a wider pattern or series of abusive registrations because the domain name is of a significantly different type or character to other domain names registered by the Registrant.

Defenses are well illustrated in two cases that went all the way to appeal. The respondent succeeded in one and failed in the other. Both were defended by able counsel through the de novo appeal. In Grey.email,40 respondent relied on 5.8.1 and 5.8.4. This is true even though mark owners have not embraced the URS for the reasons mentioned, but the Final Recommendations from RPM WG are very likely to amend it in some of the ways indicated while maintaining a delicate balance among different in-
terests. Grey.email is counterbalanced by eos.blackfriday, discussed above.

C. From the Mark Owner’s Perspective

There is an ongoing tug of war between mark owners and domain name holders over domain names composed of generic and descriptive phrases. An observant reader will notice that the Preliminary Recommendations are essentially focused on due process deficiencies (I suspect the competing interests reached an accommodation). In contrast, the Individual Proposals (where they are not technical in nature) are mostly offered by mark owners to expand the remedies and reduce protections in preparation for the URS becoming a consensus policy, which they favor. There are two Individual Proposals of particular interest. Proposal #16 states:

The URS should allow for additional remedies such as a “right of first refusal” to register the domain name in question once the suspension period ends or the ability of the Complainant to obtain additional extensions of the suspension period.

Individual Proposals #31 proposes that ICANN declare the URS a consensus Policy because data developed by a sub-team “indicates that URS in practice has proven viable, efficacious, and fit-for-purpose as a rapid remedy for clear-cut instances of protected mark abuse.”

IV. Conclusion

The URS is similar to the UDRP in both the language and elements of its three-part structure and its evidentiary demand for proving conjunctive bad faith, but it is dissimilar in being heavily prescriptive, whereas the UDRP is only minimally so. What this means for the URS is that Examiners are not authorized to leave the track laid out for them in the URS Procedure and Rules. They may cite to UDRP decisions and even quote from the WIPO Overview, now in its Third Edition, for the purpose of citing core principles and applying factors long agreed upon by consensus, but they do not have the same license as UDRP Panels to construe the language of the URS.

Nevertheless, there is a discernible development of a set of views that Examiners draw upon. This does not add up to a true jurisprudence, but it does provide guidance for parties, practitioners, and Examiners, which itself would be the kind of educational material the RPM WG is aiming at.

Endnotes
2. The first dot com, symbolics.com, was registered March 15, 1985; nordu.net was registered Jan. 1, 1985.
7. The URS is an ad hoc rather than a consensus policy which means that it cannot be upgraded to include legacy gTLDs without multi-stakeholder input and ultimate approval of ICANN’s Board.
8. ICAAN implemented the URS in June 2013.
11. URS 1.2.6.1: “the domain name is identical or confusingly similar to a word mark” (emphasis added).
12. See Dr. Seuss Enterprises, L.P. v. Contact Privacy Inc. Customer 0156025452, FA2003001868801 (Forum November 14, 2019) (gringe.store. Submitted the wrong screenshot of a web site resolving from the domain name to seussville.com).
14. URS Procedure 8.3: “For a URS matter to conclude in favor of the Complainant, the Examiner shall render a Determination that that there is no genuine issue of material fact.” URS Procedure 8.5: “Where there is any genuine contestable issue as to whether a domain name registration and use of a trademark are in bad faith, the Complaint will be denied. . . . The URS is not intended for use in any proceedings with open questions of fact, but only clear cases of trademark abuse.”
15. URS Procedure 8.6.
17. Cfa.business has come around twice within months of each other (same registrars); and also sks.science with different respondents and registrar.
19. RAA, 3.7.7.11.
21. Canada Internet Registration Authority (CIRA), Paragraph 4.6: “the Panel may order complainant to pay to the Provider in trust for the Registrant an amount of up to five thousand dollars ($5000) to defray the costs incurred by the Registrant in preparing for, and filing material in the Proceeding.”
22. URS Procedure 6.1.
23. URS Procedure 9.6: “A Determination shall be rendered on an expedited basis, with the stated goal that it be rendered within three (3) Business Days from when Examination began. Absent extraordinary circumstances, however, Determinations must be issued no later than five (5) days after the Response is filed.”

24. URS Procedure 3.2.


26. Entrepreneur Media, Inc. v. Smith, 279 F.3d 1135, 1147 (9th Cir. 2002) (“Although EMI has the exclusive right to use the trademark ‘ENTREPRENEUR’ to identify the products described in its registration, trademark law does not allow EMI to appropriate the word ‘entrepreneur’ for its exclusive use.”)

27. The Prudential Insurance Company of America v. Terrance McQuilkin et al., FA150500 1618256 (Forum May 29, 2015) (rocksolid.financial). This point is made again in a claim involving bnp-paribas.icu. The Examiner dismissed the complaint even though the second level domain is identical to complainant’s mark because “[while] [t]he evidence submitted by the Complainant show[s] a picture showing a parked page with pay-per-click links which appears to target the Complainant . . . the website under the disputed domain name does not resolve to a parked page.” Therefore, “[a]s noted by other Panels . . . [w]hen the evidence submitted by the Complainant is not in line with the actual use of the disputed domain name the case must fail,” BNP PARIBAS v. GDPR Masked, FA1810001810412 (Forum October 29, 2018) (bnp-paribas.icu).

28. Under URS Procedure Paragraph 12, either party can file for de novo appeal (Paragraph 12.1) within 14 days after a default or final determination (Paragraph 12.4). The Forum charges differential fees depending on whether the appellant uses the hearing record or elects to enlarge the record (Forum Supplemental Rules).

29. Individual Proposal #36.

30. URS Procedure 12.


32. URS Procedure 1.2.6.1: “The registered domain name(s) is/are identical or confusingly similar to a word mark: (i) for which the Complainant holds a valid national or regional registration and that is in current use.”

33. URS Procedure 1.2.6.1.


35. Principal Financial Services, Inv. v. T YS et al., FA1407001570598 (Forum Aug. 11, 2014)


40. Grey Global Group LLC v. i-content Ltd. et al., FA1606001681062 (Forum July 8, 2016).
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Enforcing the New Rule 34
By Bryan Wolin

I. Introduction
Federal Rule of Civil Procedure 34, which concerns documentary and electronic discovery, was substantially revised in 2015. Under the new rule, litigants may no longer rely on the usual boilerplate objections to discovery requests. Instead, they must be more precise, clearly articulating what they plan to produce and when. Many courts, recognizing the burden of this change, declined for some time to strictly enforce the new rule. But that time is drawing to an end, as courts around the country have begun to chastise, and in some cases penalize, litigants for failing to adapt to the new discovery regime.

II. The Rule and Committee Notes
In its pre-2015 incarnation, Rule 34 merely required that objections “must either state that inspection and related activities will be permitted as requested or state an objection to the request, including the reasons”1 and that “[a]n objection to part of a request must specify the part and permit inspection of the rest.”2

The revised rule makes several key changes. First, it expands upon the obligation to state “an objection,” requiring instead that responding parties must produce documents and things or “state with specificity the grounds for objecting.”3 Second, the rule codifies an alternative practice, allowing “[t]he responding party [to] state that it will produce copies of documents or of electronically stored information instead of permitting inspection.”4 Third, the rule adds a requirement to specify a time for production and provides that the production “must then be completed no later than the time for inspection specified in the request or another reasonable time specified in the response.”5 Finally, the rule now provides that an objection “must state whether any responsive materials are being withheld on the basis of that objection.”6

This new language overturned longstanding discovery practice, adding additional burdens and explicitly barring some well-worn formulaic objections. The accompanying Committee Notes make clear the purpose behind the changes and show that they are intended to have real teeth:

- “An objection that states the limits that have controlled the search for responsive and relevant materials qualifies as a statement that the materials have been ‘withheld.’”7
- Objections to Rule 34 requests must be stated “with specificity.”8
- “The production must be completed either by the time for inspection specified in the request or by another reasonable time specifically identified in the response. When it is necessary to make the production in stages, the response should specify the beginning and end dates of the production.”9

The Committee Notes leave no question that these rule revisions are substantive, not merely stylistic, and that they must be followed in order to reduce “unreasonable burdens” arising from imprecise discovery objections.10

III. Enforcement of a Revised Rule 34
To examine how courts have construed the new Rule 34 standards, we begin with a 2017 decision in the Southern District of New York, Fisher v. Forrest.11 This was a copyright and trademark dispute in which a licensor brought two related actions against his licensee, asserting that they used his likeness, as well as proprietary text and images, to promote a competing honey harvesting product. The plaintiff served discovery seeking, among other things, communications between the counterparties and product catalogs.12 In response, the defendants asserted 17 “general objections,” incorporated all of those objections into each of its specific responses, asserted a variety of standard-issue boilerplate objections to each of the disputed requests, and failed to explain when documents would be produced. Although not stated in the decision, the plaintiff no doubt took issue with these lackluster responses and moved for an order requiring production of the documents sought in the disputed requests.

The defendants violated Rule 34 in so many ways that the court found it necessary to begin its decision with the statement that it was time to “once again . . . issue a discovery wake-up call to the Bar in this District.”13 Notably, the defendants’ violations in Fisher were formerly standard practice: they asserted a variety of general objec-

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tions of limited applicability; they objected on the basis of relevance as the “subject matter of the litigation,” rather than using the language of revised Fed. R. Civ. P. 26 (“relevant to any party’s claim or defense”); they asserted that some requests were “overbroad and unduly burdensome” without further explanation; and they failed to indicate when their documents would be produced.16

After chastising the defendants, the court was ultimately merciful, ordering only that they revise their responses by: (i) using general objections “rarely” and only when they apply to all of the requests; (ii) dropping “overbroad and unduly burdensome” objections entirely, as the phrase is “meaningless boilerplate;” and (iii) specifically indicating when documents and electronically stored information would be produced.17

A 2019 ruling in Michael Kors, L.L.C. v. Su Yan Ye18 hits many of the same notes. This case arose when plaintiff Michael Kors alleged that that defendant’s patterned use of a “WK” mark was confusingly similar to Kors’s use of its famous MK mark. The defendant propounded a litany of discovery requests seeking information about Kors’s marketing plans, trademark enforcement strategy, and other typical areas of discovery. In response, Kors asserted a variety of objections and refused to specify adequately what documents it would produce or when. The parties attempted to meet and confer to resolve their differences but ultimately failed, leaving the defendant with no alternative but to file a motion to compel.

The court largely agreed with the defendant, finding that Kors’s objections were boilerplate, that its description of the documents it would produce vague,19 and that Kors “did not provide Defendant any information as to when it would produce documents to which it had no objection.”20 The court emphasized that Rule 34 “imposes the responsibility on a responding party to state what it is withholding or describe the scope of the production it is willing to make, including the parameters of the search to be made (i.e., custodians, sources, date ranges and search terms, or search methodology).”21 Fortunately for Kors, the court found that the requests were also improper, overbroad, and unreasonable. As in Fischer, the court did not issue any sanctions, instead giving the parties another bite at the apple—although it did suggest that it could find that Kors waived all of its objections by failing to adequately explain them pursuant to Rule 34.22 But the ruling nevertheless illustrates courts’ refusal to tolerate outdated, vague, boilerplate discovery objections that do not comport with the revised Rule 34.

Another recent example is Futreal v. Ringle—a negligence action in the Eastern District of North Carolina arising from a motor vehicle accident.23 In Futreal, the court addressed the propriety of a general “work product” objection where the objection was relevant to only some of the requests. The court stated that the use of general objections “finds scant support in the Federal Rules, which envision individualized, specific objections to requests for production of documents that inform the requesting party whether any documents have been withheld because of the objection.”24 Ultimately, the court found that an award of attorney’s fees was a more appropriate sanction than waiver of the work-product objection.25

Similarly, in Happy Place v. Hofesh26—a trademark dispute in the Central District of California arising from the use of the “HAPPY PLACE®” mark in the “experiential event” business—the court was confronted with objections to the adequacy of responses to a set of requests for documents concerning financial information, to use of the marks at issue, and related subject matter.27 The court found it necessary to quote the Committee Notes at length, and explained that new Rule 34(b)(2)(C) “was designed to ‘end the confusion that frequently arises when a producing party states several objections and still produces information, leaving the requesting party uncertain whether any relevant and responsive information has been withheld on the basis of the objections.’”28 That court further explained that “[b]oilerplate and general objections, with an open-ended promise to produce responsive documents if and when they may be found, are no longer allowed.”29

In Kilmon v Saulsbury,30 a 2018 decision from the Western District of Texas arising from alleged violations of the Fair Labor Standards Act, the court emphasized that “[t]he party resisting discovery must show specifically how each discovery request is not relevant or otherwise objectionable.”31 The court admonished the defendant for “stat[ing] which documents have been produced subject to its objections, but fail[ing] to provide whether it has withheld additional responsive materials.”32 However, going further than the rulings discussed above, the court not only required the additional specificity required by Rule 34 but also ordered that an objection to a discovery request on the ground that was overly broad, burdensome, or oppressive must be supported by affidavits or evidence “revealing the nature of the burden.”33

Kilmon appears to be an outlier, but such outliers may become more common as courts courts continue to work out how to enforce revised Rule 34.

IV. Conclusion

This sample of decisions applying Rule 34 as revised suggests that practitioners will be well advised to hew carefully to the text of the revised Rule by (1) stating objections with specificity; (2) only using general objections that apply to every request; (3) stating when documents will be produced; and (4) when objecting to part of a request, either clarifying what you intend to produce or identifying what documents are being withheld.
Endnotes
4. Id.
5. Id.
8. Id. (emphasis added).
9. Id. (emphasis added).
10. Id. (emphasis added).
11. Id. (emphasis added).
12. Id.
14. Id. at *2.
15. Id. at *1.
16. Id. [at passim].
17. Id.
19. Id. at *3.
20. Id.
21. Id.
22. Id. at *7.
24. Id. at *3.
25. Id. at *8.
27. Id.
29. Id.
31. Id. at *2.
32. Id. at *6.
33. Id. at *4.
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