



STATE BAR OF MICHIGAN

Michigan IT Lawyer

A Publication of the State Bar of Michigan Information Technology Law Section

<http://www.michbar.org/it>

Bits and Bytes from the Section

By Michael Gallo, 2014-2015 IT Law Section Chairperson

Autumn has come to Michigan and brings changes that may be familiar to members of the Information Technology Law Section, including colorful foliage, cooler weather, and the annual Information Technology Law Seminar!

On Wednesday, September 24, 2014, the Section hosted the **7th Annual Information Technology Law Seminar**. Due to a new direction taken by ICLE, this was the first year ICLE did not participate in the IT Law seminar, but Council and Ex-Officio Members believed the Section should proceed with the event regardless, and as was true of previous seminars, this year's presentations were interesting, informative and enlightening.

This year's seminar was moderated by **Ronald S. Nixon**, Section Chair for 2013-2014, from *Kemp Klein Law Firm*. Mr. Nixon kept the presenters on or ahead of schedule, and ensured the day ran smoothly.

The first speaker was **H. Ward Classen**, *Accenture LLP*, and author of the ABA best seller, *A Practical Guide to Software Licensing for Licensees and Licensors, 5th Edition*. Mr. Classen's presentation, titled 'A few Nuances of Software Contracting', covered topics such as source code escrow, the validity of web based contract terms, ownership of developed IP, and mobile apps.

Next, **Richard E. Kruger**, *Jaffe Raitt Heuer & Weiss*, discussed 'Intellectual Property Agreements and Bankruptcy', focusing on Section 365(n) of the Bankruptcy Code, the debtor as Licensor, and the debtor as Licensee. After a brief break, **Professor Kathleen E. White**, *Wayne State University*, overviewed *Alice Corp. V. CLS Bank*, and how the case impacts patent eligibility analysis.

During lunch, the IT Law Section's Annual Section Meeting was held, and a slate of Council members was approved, including **Issac T. Slutsky**, **Keith A. Cheresko**, and **Jeanne Marie Whalen (Moloney)**. Next, the IT Law Section Council meeting was held to approve 2014/2015 Section Leaders: **Michael Gallo**, Chair; **Susanna C. Brennan**, Chair-Elect; **Christopher J. Mourad**, Secretary. At the next Council meeting, members will approve a Treasurer, with an eye on convincing **Donna K. Mallonee** to accept the role!

Next, **Kathy Ossian**, Founder and CEO of *Ossian Law, P.C.*, presented an 'Update on the Computer Fraud and Abuse Act', which included numerous recent procedural decisions, criminal prosecutions, and civil actions and

Table of Contents

October 2014 ■ Vol. 31, Issue 5

- Bits and Bytes from the Section1
- State Bar of Michigan Information Technology Law Section Mission Statement..... 2
- Recent Developments in Information Technology Law 3
- 2015 Edward F. Langs Writing Award 14

Michigan IT Lawyer is published every other month. Previously published issues of the Michigan IT Lawyer, and its predecessor the Michigan Computer Lawyer, are available at <http://www.michbar.org/it/newsletters.cfm>. If you have an article you would like considered for publication, send a copy to:

Michael Gallo
2700 Renshaw Drive
Troy, Michigan 48085
e-mail: michael@gallo.us.com





2014-2015

Information Technology Section Council

Chair ▪ Michael Gallo
 Chair-Elect ▪ Susanna C. Brennan
 Secretary ▪ Christopher J. Mourad
 Treasurer ▪ Donna K. Mallonee

COUNCIL MEMBERS

Steven D. Balagna
 Susanna C. Brennan
 Keith A. Cheresko
 William Henry Hartwell
 Daniel John Henry
 Donna K. Mallonee
 Jeanne Marie Moloney
 Christopher J. Mourad
 Ronald S. Nixon
 Carla M. Perrota
 Robert L. Rothman
 Dalpreet Singh Saluja
 Clara Lauren Seymour
 Isaac T. Slutsky
 Nathan William Steed
 David R. Syrowik

IMMEDIATE PAST CHAIR

Ronald S. Nixon

EX-OFFICIO

Claudia V. Babiarz
 Charles A. Bieneman
 Jeremy D. Bisdorf
 Thomas Costello, Jr.
 Kathy H. Damian
 Christopher J. Falkowski
 Robert A. Feldman
 Sandra Jo Franklin
 Mitchell A. Goodkin
 Karl A. Hochkammer
 William H. Horton
 Lawrence R. Jordan
 Charles P. Kaltenbach
 Michael S. Khoury
 J. Michael Kinney
 Edward F. Langs*
 Thomas L. Lockhart
 Mark G. Malven
 Janet L. Neary
 Ronald S. Nixon
 Kimberly A. Paulson
 Paul J. Raine*
 Jeffrey G. Raphelson
 Frederick E. Schuchman III
 Steven L. Schwartz
 Carol R. Shepard
 David Sinclair*
 Anthony A. Targan
 Stephen L. Tupper

Commissioner Liaison

Hope Shovein

NEWSLETTER EDITOR

Michael Gallo

*denotes deceased member

Bits and Bytes . . .

Continued from page 1

remedies for CFAA related claims. Following Ms. Ossian, was **Susan M. Kornfield**, Co-Chair of the Intellectual Property Practice Group at *Bodman PLC*. Ms. Kornfield, who teaches *'Intellectual Property Practice'* at *University of Michigan Law School*, discussed *'Software Copyright after Oracle v. Google'*.

Closing the seminar was **Steve Tupper**, who leads the Privacy, Data Security and E-Commerce practice at *Dykema*. Mr. Tupper's topic, *'The State of Electronic Contracting and Online Consent: UETA and E-Sign Turn 15'* walked through various topics, including electronic signatures, transferable records, and an overview of the Uniform Electronic Transactions Act (UETA) and the Electronic Signatures in Global and National Commerce Act (E-SIGN).

The extremely successful day closed with a truly 'happy' hour which allowed attendees and presenters to mix and mingle, catching up with friends, forming new relationships, and discussing information technology concerns of the day. Thanks to all who enabled this year's seminar to take place, with special thanks going to **Ron Nixon**, **Charles Bieneman** and **Steven Balagna**, who were instrumental in selecting the speakers, making venue arrangements, and coordinating efforts through the *State Bar of Michigan!*

We are already looking forward to next year's seminar! ▪



State Bar of Michigan Information Technology Law Section Mission Statement

The purposes of the Section are to review, comment upon, and appraise members of the State Bar of Michigan and others of developments in the law relating to information technology, including:

- (a) the protection of intellectual and other proprietary rights;
- (b) sale, leasing, distribution, provision, and use of, hardware, software, services, and technology, including computer and data processing equipment, computer software and services, games and gaming, information processing, programming, and computer networks;
- (c) electronic commerce
- (d) electronic implementation of governmental and other non-commercial functions;
- (e) the Internet and other networks; and
- (f) associated contract and tort liabilities, and related civil and criminal legal consequences.

The Information Technology Law Section's bylaws can be viewed by accessing <http://www.michbar.org/it/councilinfo.cfm> and clicking the 'Bylaws' link.

Recent Developments in Information Technology Law

By David R. Syrowik, Brooks Kushman PC

Introduction

The 2013-2014 term of the Supreme Court ended with multiple decisions on intellectual property issues.

Over the past few months, the Court issued a number of patent law-related opinions covering ground from claim definiteness (*Nautilus*) to the exceptional case standard in Section 285 (*Octane, Highmark*) to multi actor infringement (*Limelight*) to the ever-present patentable subject matter case (*Alice*). Three of these opinions (*Alice, Highmark, and Limelight*) resolved deep intra-circuit splits at the Federal Circuit. Altogether, this term profoundly altered the landscape of patent law jurisprudence.

One of the most high-profile decisions was *Alice*. In that decision, the high court held that a banking-related business method is drawn to a patent-ineligible abstract idea, and it cannot be made patent eligible simply by adding implementation on a general purpose computer.

The other high-profile decision was *Aereo*, a copyright decision. In a 6-3 decision, the court held that *Aereo* publicly performs television programs when it transmits those programs.

PATENTS – Case Law – U.S. Supreme Court

Alice Corp. Pty. Ltd. v. CLS Bank Int'l, 88 BNA's PTCJ 513

As reported at 88 BNA's PTCJ 513, on June 19, 2014, a unanimous Supreme Court ruled that the method, system and readable media claims of a patent directed to a computerized trading platform were drawn to patent ineligible subject matter under 35 U.S.C. § 101. Justice Thomas followed the analysis set out in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, asking: (1) whether the claims at issue are directed to a patent-ineligible concept; and (2) whether the claims' elements, considered both individually and as an ordered combination, transform the nature of the claim into a patent-eligible application. On the first question, the Court concluded that the claims in this case for a method of mitigating settlement risk with an intermediary is just as ineligible as the method claims to the abstract idea of hedging risks struck down in *Bilski v. Kappos*. On the second question, the Court found that the abstract idea claim does not contain an inventive concept that transforms it into a patent eligible claim. Viewed as a whole, the method claims simply recite the concept of intermediated settlement as performed by a generic computer. They do not, for example,

purport to improve the functioning of the computer itself or effect an improvement in any other technology or technical field.

Limelight Networks, Inc. v. Akamai Technologies, Inc., 88 BNA's PTCJ 371

The Supreme Court on June 2, 2014 ruled that there can be no liability for induced patent infringement when there is no underlying direct infringement. The high court says that allowing liability for induced infringement when there has been no underlying direct infringement "would deprive 35 U.S.C. § 271(b) of ascertainable standards" and "require the courts to develop two parallel bodies of infringement law; one for liability for direct infringement, and one for liability for inducement."

Nautilus, Inc. v. Biosig Instruments, Inc., 88 BNA's PTCJ 373

The Supreme Court on June 2, 2014 ruled that the phrases "amenable to construction" and "insolubly ambiguous" for purposes of identifying an indefinite patent claim "lack the precision" demanded by 35 U.S.C. § 112. The decision eliminates the standard used by the Federal Circuit and vacates a ruling that had been in favor of patentee Biosig.

Octane Fitness, LLC v. Icon Health & Fitness, Inc., 88 BNA's PTCJ 28

The Supreme Court on April 29, 2014 ruled that the current standard for finding an "exceptional" patent case for purposes of awarding attorneys' fees to the winner, "is unduly rigid, and it impermissibly encumbers the statutory grant of discretion to district courts." The court overturns the Federal Circuit's two-pronged test that required a showing of both objective baselessness and subjective bad faith.

Highmark Inc. v. Allcare Health Mgmt. Sys., Inc., 110 USPQ2d 1343

The Supreme Court on April 29, 2014 ruled that determination of whether a case is "exceptional," one warranting award of attorneys' fees under 35 U.S.C. § 285, is reviewed for abuse of discretion on appeal, and is not subject to *de novo* review, since 35 U.S.C. § 285 commits determination of whether case is "exceptional" to discretion of district court; all aspects of district court's "exceptional case" determination are subject to abuse-of-discretion standard.

PATENTS – Case Law – U.S. Courts of Appeals

***SmartGene, Inc. v. Advanced Biological Labs., SA,*
87 BNA's PTCJ 680**

The U.S. Court of Appeals for the Federal Circuit on January 24, 2014 ruled that claims to a computer expert system for use by medical professionals are not eligible for patenting under 35 U.S.C. § 101.

***Motorola Mobility, LLC v. Int'l Trade Comm'n.,*
87 BNA's PTCJ 385**

The U.S. Court of Appeals for the Federal Circuit on December 16, 2013 affirmed the ITC's judgments that should lead to an import ban on devices that infringe Microsoft's patent on applications such as Microsoft Outlook.

***Motorola Mobility LLC v. Int'l Trade Comm'n.,*
87 BNA's PTCJ 546**

The U.S. Court of Appeals for the Federal Circuit on December 16, 2013 affirmed Apple's non-infringement of Motorola's patent covering application-push technology.

***In re Enhanced Sec. Research, LLC,* 109 USPQ2d 1265**

The U.S. Court of Appeals for the Federal Circuit on January 13, 2014 ruled that a manual for software product, even though it was missing pages, qualified as "printed publication" that was "available to the public" within meaning of 35 U.S.C. § 102(a)(1), and thus was valid prior art for reexamination of claims directed to computer security device and method.

***Apple Inc. v. Samsung Elecs. Co.,* 87 BNA's PTCJ 169**

The U.S. Court of Appeals for the Federal Circuit on November 18, 2013 ruled that Apple cannot enjoin Samsung's smartphones and tablets based on design patent or trade dress protection, but Samsung may be forced to address certain features covered by utility patents. The court remands for the district court to reconsider whether Samsung should be enjoined from selling phones with certain features, including "pinch-to-zoom."

***Nazomi Commc'ns, Inc. v. Nokia Corp.,* 87 BNA's PTCJ 542**

The U.S. Court of Appeals for the Federal Circuit on January 14, 2014 ruled that computing devices do not infringe patent requiring hardware-software combination.

***Elcommerce.com, Inc. v. SAP AG,* 87 BNA PTCJ 942**

The U.S. Court of Appeals for the Federal Circuit on February 24, 2014 failed to provide an expert witness to invalidate elcommerce.com's means-plus function patent claims. The court accuses the high tech firm of persuading the district court of a Federal Circuit standard that is incorrect.

***Ancora Techs., Inc. v. Apple, Inc.,* 87 BNA's PTCJ 1001**

The U.S. Court of Appeals for the Federal Circuit on March 3, 2014 reversed a claim construction judgment, rejecting Apple's argument that the patentee had overridden the plain meaning of computer-related terms. Term "program," in claims for method of verifying that software program on computer is licensed, is properly given its ordinary meaning as "set of instructions" for computer, and term thus encompasses both operating systems and applications that run on them, since "program," to computer programmer, means "set of instructions," since claim language points against narrow interpretation that would limit term to applications programs, and since nothing in specification or prosecution history clearly narrows term "program."

***Vederi, LLC v. Google, Inc.,* 87 BNA's PTCJ 1149**

The U.S. Court of Appeals for the Federal Court on March 14, 2014 overturned a district court's claim construction and gave broader scope that would cover the images presented to Street View users. Asserted claims directed to methods for creating synthesized images of geographic areas, which require images depicting views of objects in geographic area to be "substantially elevations" of objects, do not exclude curved or spherical images depicting views that are substantially front or side views of objects.

***Apple Inc. v. Motorola Inc.,* 88 BNA's PTCJ 12**

The U.S. Court of Appeals for the Federal Circuit on April 25, 2014 overturned Judge Posner's dismissal of the mobile phone patent battle between Apple and Motorola, with the result largely in Apple's favor. A fractured decision criticizes the lower court's rulings on claim construction, damages evidence, handling of the reasonable royalty analysis, injunctions when a patent is on a component and injunctions when the patent infringed is standard-essential.

***Suffolk Techs., LLC v. AOL Inc.,* 88 BNA's PTCJ 308**

The U.S. Court of Appeals for the Federal Circuit on May 27, 2014 ruled that Google wins an appeal challenging a patent for basic web page communication in an invalidity affirmance. The patent claims priority to the early days of the World Wide Web, but it is defeated by an even earlier posting on the "Usenet" bulletin board system that preceded the web and was used by programmers to discuss early web application development.

***Chi. Bd. Options Exchange, Inc. v. Int'l Sec. Exchange, LLC,*
110 USPQ2d 1451**

The U.S. Court of Appeals for the Federal Circuit on April 7, 2014 ruled that computer-based, means-plus function claim, in declaratory defendant's patent directed to automated exchange for trading financial instruments, is not invalid for failing to disclose

step-by-step algorithm for performing recited function of “matching” professional orders “on a pro rata basis”; person of ordinary skill in art would understand algorithmic structure for performing claimed function using size-based, pro rata matching.

***Broadcom Corp. v. Emulex Corp.*, 86 BNA's PTCJ 1182**

The U.S. Court of Appeals for the Federal Circuit on October 7, 2013 upheld Broadcom Corp.'s injunction preventing competitor Emulex Corp. from offering certain wireless data transceivers. As to the appropriateness of an injunction, the court distinguishes this case based on its market characteristics from the mobile phone market, where the court in 2012 refused to support an injunction sought by Apple.

***Microsoft Corp. v. Int'l Trade Comm'n.*, 86 BNA's PTCJ 1186**

The U.S. Court of Appeals for the Federal Circuit on October 3, 2013 upheld an ITC determination that Motorola did not infringe Microsoft phone patents due to a menu design change.

***Iborneith IP, LLC v. Mercedes-Benz USA, LLC*, 86 BNA's PTCJ 1280**

The U.S. Court of Appeals for the Federal Circuit on October 22, 2013 ruled that an algorithm relating to a means-plus-function claim that merely lists a number of relevant factors but fails to disclose how to weigh or calculate those factors to achieve a claimed result is indefinite, under 35 U.S.C. § 112. The court affirms the invalidation of all claims of a patent aimed at detecting and alerting drivers that become sleepy at the wheel.

***Soverain Software LLC v. Newegg Inc.*, 86 BNA's PTCJ 839**

The U.S. Court of Appeals for the Federal Circuit on September 4, 2013 ruled on rehearing, asserted dependent claim of patent directed to electronic commerce software system, as well as representative independent claim, is held invalid for obviousness over prior art pre-internet system for computer-based shopping.

***Apple Inc. v. Samsung Elecs. Co.*, 86 BNA's PTCJ 886**

The U.S. Court of Appeals for the Federal Circuit on August 23, 2013 ruled that the *Apple v. Samsung* trial should not have been as open to the press as the district court was prepared to allow. The court determines that the lower court's order to seal only a small number of trial exhibits in the “smartphone patent war” between Apple and Samsung was an abuse of discretion.

***Apple Inc. v. Int'l Trade eComm'n.*, 86 BNA's PTCJ 743**

The U.S. Court of Appeals for the Federal Circuit on August 7, 2013 ruled that Apple will get another chance to bar Motorola Droid and other smartphone model imports after the court overturns elements of an International Trade Commission decision. The court faults the ITC in particular for an obviousness analysis

that gave inadequate weight to the commercial success and copying of Apple's iPhone and iPad touchscreen interface.

***Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 108 USPQ2d 1173**

The U.S. Court of Appeals for the Federal Circuit on September 5, 2013 ruled that claims directed to computer-implemented system for generating tasks to be performed by insurance organization do not offer “meaningful limitation” to abstract method claims of same patent, which have been held invalid under 35 U.S.C. § 101 as drawn to patent-ineligible subject matter, and system claims are therefore invalid as well.

***In re Jasinski*, 107 USPQ2d 2082**

The U.S. Court of Appeals for the Federal Circuit on February 15, 2013 ruled that recitation of method for “verifying the accuracy of logical-to-physical mapping software” designed for testing memory devices, in preamble of claims in application, should be considered limitation rather than mere statement of intended purpose, since language refers to “essence of the invention”.

***Ultramercial Inc. v. Hulu LLC*, 107 USPQ2d 1193**

The U.S. Court of Appeals for the Federal Circuit on June 21, 2013 ruled that asserted claim for method of monetizing and distributing copyrighted products over internet is meaningfully limited to something less than abstract idea that advertising can be used as form of currency, and thus is directed to patentable process.

PATENTS – Case Law – U.S. District Courts

***In re Innovatio IP Ventures, LLC Patent Litig.*, 86 BNA's PTCJ 1185**

The U.S. District Court for the Northern District of Illinois on October 3, 2013 ruled that patent assertion entity Innovatio IP Ventures, stands to win an award of 9.56 cents per infringing chip if it succeeds on the merits. The infringing chips are sold in laptops, tablets, servers, and similar end products.

***Apple Inc. v. Samsung Electronics Co.*, 87 BNA's PTCJ 620**

The U.S. District Court for the Northern District of California on January 21, 2014 granted Apple a summary judgment against Samsung with respect to two patents.

***Apple Inc. v. Samsung Electronics Co.*, 87 BNA's PTCJ 219**

The U.S. District Court for the Northern District of California on November 21, 2013 has a second jury put back \$290 million in a patent infringement award to Apple from the \$450 million that Judge Lucy H. Koh had stricken eight months earlier. The first trial resulted in an award of \$1.05 billion for infringement by 23 different models of Samsung's Android-based smart phones and tablets, but Judge Koh had found errors in the jury's calculations.

PATENTS – Case Law – International Trade Commission (ITC)

***Certain Electronic Digital Media Devices and Components Thereof*, 86 BNA's PTCJ 792**

The International Trade Commission on August 6, 2013 announced that smartphones and tablets made by Samsung infringe valid Apple patents and an exclusion order barring imports of the devices is warranted.

PATENTS – Case Law – U.S. Patent and Trademark Office

***Ex parte Smith*, 108 USPQ2d 1198**

The Patent Trial and Appeal Board on March 14, 2013 ruled that means-plus-function claim directed to computer system for updating user reviews of product, which recites “processor” that is programmed to “receive” and “store” reviews of asset, and to “generate an opinion timeline for the asset for the user,” is unpatentable as indefinite.

***Ex parte Erol*, 107 USPQ2d 1963**

The Patent Trial and Appeal Board on March 13, 2013 ruled that the term “processor adapted to” perform several steps, recited in claim directed to technique for identifying one or more objects from digital media content and comparing them to objects specified by machine readable identifier, is verbal construct devoid of structure that is used as substitute for term “means for”; limitation is unpatentable for indefiniteness, since specification does not disclose sequence of steps of particular algorithm required to meet definiteness requirement for structure corresponding to limitation for computer-implemented function.

***Liberty Mutual Ins. Co. v. Progressive Cas. Ins. Co.*, 87 BNA's PTCJ 1159**

The Patent Trial and Appeal Board on March 13, 2014 cancelled claims of five patents asserted in an Ohio district court through the “covered business method” proceeding enabled in September 2012 by the America Invents Act.

***Apple Inc. v. Achates Reference Publ'g. Inc.*, 88 BNA's PTCJ 381**

The Patent Trial and Appeal Board on June 2, 2014 in two decisions ruled that Apple succeeded in its challenge to Achates patents on encrypted app store distribution.

***CRS Advanced Techs., Inc. v. Frontline Techs., Inc.*, 109 USPQ2d 1495**

The Patent Trial and Appeal Board on January 21, 2014 ruled that the challenged claims for computerized methods of “substitute fulfillment,” generally involving assignment of substitute teachers or bank tellers to available temporary openings, are directed to abstract, and therefore unpatentable, methods, and ad-

dition of “database comprising worker records” in two challenged system claims does not result in meaningful limitation that distinguishes them from patent-ineligible method claims.

PATENTS/DECLARATORY JUDGMENT – Case Law – U.S. Courts of Appeals

***Microsoft Corp. v. DataTern, Inc.*, 87 BNA's PTCJ 1358**

The U.S. Court of Appeals for the Federal Circuit on April 4, 2014 ruled that Microsoft did not have standing to file a declaratory judgment action against patent assertion entity DataTern as to one patent, based on DataTern's characterization of how the customer was using Microsoft's allegedly infringing product.

PATENTS/LICENSING – Case Law – U.S. Courts of Appeals

***Microsoft Corp. v. Motorola, Inc.*, 88 BNA's PTCJ 100**

The U.S. Court of Appeals for the Federal Circuit on May 5, 2014, in a battle over a prospective license for standard-essential patents owned by Motorola and used by Microsoft's Xbox gaming systems, finds that jurisdiction is properly before the Ninth Circuit instead, with the issue primarily being whether Motorola reached its agreement with the relevant standards bodies.

COPYRIGHTS – Case Law – U.S. Supreme Court

***Petrella v. Metro-Goldwyn-Mayer, Inc.*, 88 BNA's PTCJ 233**

The Supreme Court on May 19, 2014 ruled that the common law doctrine of laches cannot bar a copyright claim that was brought within the congressionally prescribed statute of limitations. The court reverses the Ninth Circuit's dismissal of a copyright infringement claim brought by the daughter of the “Raging Bull” screenwriter. The high court finds “nothing untoward” about a plaintiff holding off on filing a claim until it sees that a defendant's exploitation of a copyright has been profitable.

***American Broad. Cos. v. Aereo, Inc.*, 88 BNA's PTCJ 579**

The Supreme Court on June 25, 2014 held in a 6-3 decision that Aereo publicly performs television programs when it transmits those programs to individual users over the Internet, reversing a Second Circuit decision that found the television streaming service noninfringing. Infringement defendant, which operates Internet-based broadcast television streaming service, “performs” copyrighted work publicly when subscriber watches program using defendant's system, which streams data to subscriber from subscriber's own personal copy, made from broadcast signals received by single antenna allotted to that subscriber.

COPYRIGHTS – Case Law – U.S. Courts of Appeals

***Fox Broad. Co. v. Dish Network, LLC*, 86 BNA's PTCJ 623**

The U.S. Court of Appeals for the Ninth Circuit on July 24, 2013 ruled that a federal district court did not abuse its discretion in finding that Fox TV was unlikely to succeed on its copyright infringement and breach of contract claims against Dish Network's program recording and ad-skipping services. The court emphasizes that because Fox has no copyright interest in the commercials, it cannot rest any infringement claim on ad-skipping services.

***WNET v. Aero*, 86 BNA's PTCJ 573**

The U.S. Court of Appeals for the Second Circuit on July 16, 2013 denies en banc review to a group of television networks claiming that Aereo Inc.'s streaming television service constitutes copyright infringement. A split panel held in April that Aereo's service allowing subscribers to watch television programs online at nearly the same time as they are being broadcast did not constitute a public performance.

***Authors Guild Inc. v. Google Inc.*, 86 BNA's PTCJ 505**

The U.S. Court of Appeals for the Second Circuit on July 1, 2013 vacated the certification of a class of authors that have objected to Google Book Search's unauthorized mass scanning of libraries of books. The appeals court says that Google's fair use defense should be dealt with before a final determination on class status can be reached.

***Sony BMG Music Entertainment v. Tenenbaum*,
86 BNA's PTCJ 445**

The U.S. Court of Appeals for the First Circuit on June 25, 2013 ruled that a jury's \$675,000 damages award, which was well within the Copyright Act's statutory allowance, did not violate the due process rights of an individual who was found liable for willfully infringing 30 songs.

***Metro Reg'l Inf. Sys. Inc. v. Am. Home Realty Network Inc.*,
107 USPQ2d 1487**

The U.S. Court of Appeals for the Fourth Circuit on July 17, 2013 ruled that plaintiff operator of online real estate multiple listing service properly registered its copyright interest in photographs in its database, even though plaintiff did not list names of creators and titles of individual photographs.

***Oracle Am., Inc. v. Google Inc.*, 88 BNA's PTCJ 159**

The U.S. Court of Appeals for the Federal Circuit on May 9, 2014 reversed a district court's determinations in a software battle, concluding that Oracle is entitled to copyright protection on portions of Java-compatible computer programming used

in all mobile phones based on Google's Android operating system. The opinion faults the lower court for importing issues related to infringement—the merger doctrine and fair use—into its analysis of copyrightability.

***Garcia v. Google, Inc.*, 109 USPQ2d 1799**

The U.S. Court of Appeals for the Ninth Circuit on February 26, 2014 ruled that plaintiff is likely to succeed on merits of her claim, and is entitled to preliminary injunction in infringement action based on defendant film producer's use of plaintiff's performance in anti-Islamic film, which was posted on Internet video site, and which defendant Internet video service refused to take down after numerous requests by plaintiff.

***Authors Guild Inc. v. HathiTrust*, 88 BNA's PTCJ 439**

The U.S. Court of Appeals for the Second Circuit on June 10, 2014 ruled that the fair use doctrine permits the unauthorized digitization of copyrighted works in order to create a full-text searchable database. Affirming summary judgment in favor of a consortium of university libraries, the court also rules that the fair use doctrine permits the unauthorized conversion of those works into accessible formats for use by persons with disabilities, such as the blind.

COPYRIGHTS – Case Law – U.S. District Courts

***Lewis v. Activision Blizzard, Inc.*, 86 BNA's PTCJ 1271**

The U.S. District Court for the Northern District of California on October 17, 2013 ruled that voiceover work for the popular *World of Warcraft* online video game was within the scope of employment of a game master and thus constituted works made for hire.

***Battelle Energy Alliance, LLC v. Southfork Sec., Inc.*,
86 BNA's PTCJ 1272**

The U.S. District Court for the District of Idaho on October 15, 2013 issued a broad TRO in a copyright suit over software designed to protect energy systems.

***Disney Enters., Inc. v. Hotfile Corp.*, 86 BNA's PTCJ 1062**

The U.S. District Court for the District for the Southern District of Florida on September 20, 2013 ruled that the operator of a file-hosting service was not eligible for safe harbor protection for infringing content posted by its users. Granting summary judgment on the safe harbor question, the court also concludes that the service was liable for vicarious copyright infringement for its users' acts.

***Capitol Records, LLC v. Vimeo, LLC*, 86 BNA's PTCJ 1064**

The U.S. District Court for the Southern District of New York on September 18, 2013 ruled that whether the DMCA

safe harbors apply to infringing content posted on Vimeo could not be answered on summary judgment when complicated by involvement of Vimeo's employees.

United States v. Am. Soc'y of Composers, Authors, & Publishers, 86 BNA's PTCJ 1013

The U.S. District Court for the Southern District of New York on September 17, 2013 ruled that the country's largest performing rights organization must offer a "through-to-the-audience" license to an online music streaming service, even with respect to works whose copyright holders have withdrawn the authority to grant licenses to "new media" outlets.

Tuteur v. Crosley-Corcoran, 86 BNA's PTCJ 1019

The U.S. District Court for the District of Massachusetts on September 10, 2013 ruled that a copyright holder who allegedly conceded that she knew a blogger's online post was not infringing when she sent the blogger's hosting company a Digital Millennium Copyright Act takedown notice might be liable for making a misrepresentation in a DMCA notice.

Asher Worldwide Enters. LLC v. Housewaresonly.com Inc., 86 BNA's PTCJ 926

The U.S. District Court for the Northern District of Illinois on August 26, 2013 ruled that Website's operators may be personally liable for site's copyright, trademark infringement.

Am. Inst. of Physics v. Schwegman Lundberg & Woessner P.A., 86 BNA's PTCJ 736

A magistrate for the U.S. District Court for the District of Minnesota on July 30, 2013 dealt a blow to claims that downloading, copying, distributing, and storing technical journal articles in association with disclosure of prior art to the Patent and Trademark Office constitute copyright infringement.

Perfect 10 Inc. v. Yandex N.V., 86 BNA's PTCJ 577

The U.S. District Court for the Northern District of California on July 22, 2013 ruled that the hosting of allegedly infringing content on internet servers located in Russia cannot give rise to liability under U.S. copyright law.

Eyepartner Inc. v. Kor Media Group L.L.C., 86 BNA's PTCJ 578

The U.S. District Court for the Southern District of Florida on July 15, 2013 ruled that unauthorized use of copyrighted software code not fair use, results in preliminary injunction.

Clinical Insight Inc. v. Louisville Cardiology Medical Group PLC., 86 BNA's PTCJ 579

The U.S. District Court for the Western District of New York on July 12, 2013 ruled that software use following expiration of license constitutes breach, copyright infringement.

Electronic Creations Corp. v. Gigahertz Inc., 86 BNA's PTCJ 170

The U.S. District Court for the Northern District of New York on June 25, 2013 ruled that "fake hack" website copying service willfully infringed, liable for \$150K damages, fees.

Thale v. Apple Inc., 86 BNA's PTCJ 511

The U.S. District Court for the Northern District of California on June 26, 2013 ruled that photographer fails to show that alleged infringement by Apple was linked to profits.

Masck v. Sports Illustrated., 86 BNA's PTCJ 388

The U.S. District Court for the Eastern District of Michigan on June 11, 2013 ruled that plaintiff photographer's claim against defendant online retailer for contributory infringement, based on defendant's sales of allegedly infringing copies of photograph, will not be dismissed, since selling infringing merchandise is material contribution to infringement, asserted defense alleging that defendant's website is "capable of substantial noninfringing uses" is inapplicable in present case.

Davis v. Tampa Bay Arena, Ltd., 108 USPQ2d 1245

The U.S. District Court for the Northern District of Florida on June 27, 2013 ruled that defendant entertainment venue is granted summary judgment that it received implied nonexclusive license from plaintiff photographer to post copyrighted images on social networking Web site, since parties' agreements demonstrate that defendant requested plaintiff to "produce photographs" of defendant's events, since plaintiff took photographs and "delivered" them by giving defendant access to online photo server, and since plaintiff never threatened to sue if images were not removed from site.

Rosen v. Netfronts, Inc., 108 USPQ2d 1087

The U.S. District Court for the Central District of California on July 9, 2013 ruled that defendant's display of copyrighted photographs on internet, with offers to sell, violated plaintiff's exclusive rights to reproduce and distribute photographs, since defendant did not present evidence that photograph copies he sold were authorized, and thus first-sale doctrine is inapplicable, and since evidence shows that plaintiff did not unreasonably

delay in asserting his rights, given that he believed defendant had gone out of business when defendant suspended his online business for several years; however, statutory damages will be limited to \$800, based on innocence of defendant's infringement.

***Intercom Ventures LLC v. FasTV Inc.*, 107 USPQ2d 1780**

The U.S. District Court for the Northern District of Illinois on May 24, 2013 ruled that provider of Internet protocol television service has sufficiently stated claims for direct and contributory infringement of its distribution rights for television programs by alleging that primary infringer distributed copyrighted content and programming over Internet to subscribers via downloads from defendants' website to equipment provided by defendants, and by describing basis for each contributory infringer's knowledge of infringing activity, and their contributions to alleged infringement.

***Voltage Pictures LLC v. Does 1-43*, 107 USPQ2d 1614**

The U.S. District Court for the Northern District of Ohio on May 3, 2013 ruled that plaintiff alleging that 43 Doe defendants illegally reproduced and distributed copyrighted motion picture as participants in "BitTorrent swarm" is granted leave to conduct expedited discovery, from internet service providers, to identify and locate defendants.

***Antonick v. Elec. Arts. Inc.*, 87 BNA's PTCJ 672**

The U.S. District Court for the Northern District of California on January 22, 2014 ruled that when compared as a whole, there is no legal basis that would support a jury's determination that seven "Madden" football games created for the Sega Genesis console are virtually identical to the 1986 "John Madden Football" game that was developed for the Apple II computer.

***Authors Guild Inc. v. Google Inc.*, 87 BNA's PTCJ 101**

The U.S. District Court for the Southern District of New York on November 14, 2013 ruled that the use of the full text of tens of millions of books for its online search function is a transformative use, and thus Google's mass digitization of those books without authorization from copyright holders constitutes fair use.

***Schenck v. Orosz*, 109 USPQ2d 1099**

The U.S. District Court for the Middle District of Tennessee on November 17, 2013 ruled that "registration approach" to determining whether registration requirement of 17 U.S.C. § 411(a) has been satisfied, under which copyright is not considered registered until Copyright Office passes on application, will be followed in action in which plaintiffs filed "takedown" notifications under Digital Millennium Copyright Act, even though 17 U.S.C. § 512 requires copyright holder who receives counter-notification to file suit within 10-14 days after allegedly infringing material is removed from website.

***Battelle Energy Alliance, LLC v. Southfork Sec., Inc.*,
87 BNA's PTCJ 58**

The U.S. District Court for the District of Idaho on October 29, 2013 ruled that differences between open and closed software code fend off injunction in infringement suit.

***Beasley v. Commonwealth Edison Co.*, 108 USPQ2d 1478**

The U.S. District Court for the Northern District of Illinois on August 28, 2013 ruled that individual plaintiff who traced outline of drawing depicting handshake so that image could be reduced in size and scanned into computer is not joint author of image, since joint authorship requires that contribution of each author be independently copyrightable, and plaintiff did not exercise "considerable control" over drawing or make "significant contributions" by merely copyright and resizing existing work.

***Capitol Records, LLC v. Vimeo, LLC*, 87 BNA's PTCJ 491**

The U.S. District Court for the Southern District of New York on December 31, 2013 ruled that video-sharing website operator Vimeo LLC is entitled to summary judgment against copyright infringement claims involving user uploads, that employees did not view, granting in part the site's motion for reconsideration. The court previously held that a jury would need to decide whether Vimeo had red flag knowledge of infringement with respect to videos uploaded by premium members.

***Fox Television Stations, Inc. v. FilmOn X LLC*, 108 USPQ2d 1593**

The U.S. District Court for the District of Columbia on September 5, 2013 ruled that internet-based broadcast television subscription streaming service violates broadcast television plaintiffs' right to perform their copyrighted works publicly; allegedly "one-to-one relationship" between single mini-antenna and single viewer of video stream in defendants' system does not warrant finding that their retransmissions of broadcast channels are not public performances.

***Hearst Stations Inc. v. Aereo, Inc.*, 108 USPQ2d 1712**

The U.S. District Court for the District of Massachusetts on October 8, 2013 ruled that plaintiff owner of Boston television station failed to show that it is likely to succeed on merits of its claim that defendant internet streaming service, which retransmits plaintiff's programming for subscribers to watch and record on their computers and other internet devices, infringes plaintiff's exclusive public performance right.

***Computer Automation Sys., Inc. v. Intelutions, Inc.*,
108 USPQ2d 1805**

The U.S. District Court for the District of Puerto Rico on November 4, 2013 ruled that infringement plaintiff sufficiently alleged similarities between its copyrighted software product

and defendant's accused software by claiming that defendant had unfettered access to plaintiff's product through defendant's working relationship with plaintiff and plaintiff's customer, and that plaintiff's agent heard two of defendant's agents discuss gaining access to functional elements of plaintiff's product through reverse engineering.

***Complex Sys., Inc. v. ABN AMRO Bank N.V.*, 88 BNA's PTCJ 161**

The U.S. District Court for the Southern District of New York on May 9, 2014 held that a bank that lost its license to use a software application when it sold its subsidiary in 2007 must stop using the copyrighted software within a year.

***Zenova Corp. v. Mobile Methodology, LLC*, 109 USPQ2d 1783**

The U.S. District Court for the Eastern District of New York on February 4, 2014 granted infringement plaintiff summary judgment on affirmative defense asserting that copyrighted website framework at issue is work made for hire owned by defendants, even though original agreement between parties include express, written language required for creation of work for hire, since under express terms of agreement, it would not be valid unless defendants executed it within 30 days after it was signed by plaintiff, and defendants did not meet that deadline.

***Cmty. Television of Utah, LLC v. Aereo, Inc.*, 109 USPQ2d 2099**

The U.S. District Court for the District of Utah on February 19, 2014 ruled that defendant Internet-based, broadcast, television-streaming service that, without license, streams infringement plaintiffs' broadcast television content captured by miniature antennas to subscribers' computers and mobile devices, "publicly performs" that content as defined by Copyright Act, and plaintiffs have therefore demonstrated likelihood of success on merits of their claims, and are granted preliminary injunction.

***Tarantino v. Gawker Media, LLC*, 110 USPQ2d 1518**

The U.S. District Court for the Central District of California on April 22, 2014 ruled that plaintiff film writer and director's claim for contributory copyright infringement against online media outlet is dismissed, since plaintiff avers that defendant facilitated and encouraged public's violation of plaintiff's copyright in screenplay, which was purportedly leaked to public without plaintiff's authorization, by providing hyperlinks to copies of screenplay on third-party websites, but plaintiff does not allege single act of direct infringement committed by any member of general public

COPYRIGHTS/CRIMINAL – Case Law – U.S. Courts of Appeals

***United States v. Liu*, 86 BNA's PTCJ 1115**

The U.S. Court of Appeals for the Ninth Circuit on October 1, 2013 ruled that to convict a defendant of willful criminal copyright infringement, prosecutors must show that the defendant knew he was breaking the law.

***United States v. Anderson*, 87 BNA's PTCJ 418**

The U.S. Court of Appeals for the Ninth Circuit on December 19, 2013 ruled that an award of restitution under the Mandatory Victims Restitution Act resulting from a verdict of criminal copyright/infringement in computer software must be based on the copyright holder's actual losses and not merely the full retail price of a genuine copy of the goods in question.

COPYRIGHTS/DMCA – Case Law – U.S. Courts of Appeals

***United States v. Reichert*, 87 BNA's PTCJ 1277**

The U.S. Court of Appeals for the Sixth Circuit on March 28, 2014 ruled that the jury had sufficient evidence from which to determine that a defendant "willfully" violated the Digital Millennium Copyright Act (DMCA) when he installed a modification chip on a Nintendo Wii that allowed the console to play pirated games. Jury instructions on "deliberate ignorance," in criminal prosecution under DMCA, did not negate DMCA's "willfulness" requirement by permitting jury to convict based on finding that defendant knew he was trafficking in technology for circumventing access-control measures.

COPYRIGHTS/DMCA – Case Law – U.S. District Courts

***Perfect 10, Inc. v. Giganeews, Inc.*, 87 BNA's PTCJ 869**

The U.S. District Court for the Central District of California on January 29, 2014 ruled that DMCA safe harbor does not mandate that all repeat infringer content be deleted.

COPYRIGHTS/JOINDER – Case Law – U.S. Courts of Appeals

***AF Holdings, LLC v. Does 1-1058*, 110 USPQ2d 1838**

The U.S. Court of Appeals for the District of Columbia on May 27, 2014 ruled that "John Doe" defendants in infringement action, who allegedly downloaded and shared copyrighted film using "BitTorrent" file-sharing service, are not subject to joinder under Fed. R. Civ. P. 20(a)(2), since plaintiff has offered no reason to believe that Doe defendants were ever participating in same file-sharing "swarm" at same time.

COPYRIGHTS/LICENSING – Case Law – U.S. District Courts

***Oracle USA, Inc. v. Rimini St., Inc.*, 87 BNA's PTCJ 867**

The U.S. District Court for the District of Nevada on February 13, 2014 ruled that some Oracle software licenses do not allow copying by third-party servicer. Provision in licensing agreement

between plaintiff enterprise software developer and city licensee, authorizing city to make reasonable number of copies of licensed software for use in accordance with terms of license, for archive or emergency back-up purposes, and/or disaster recovery testing purposes, does not authorize defendant third-party software services provider to make copies of licensed software in order to provide software support services to city.

Small Justice LLC v. Xcentric Ventures LLC, 110 USPQ2d 1218

The U.S. District Court for the District of Massachusetts on March 24, 2014 ruled that defendant website operator's motion to dismiss copyright claims is denied in action in which plaintiffs contend that they hold copyrights to allegedly defamatory "reports" about attorney posted on defendant's gripe site, and defendant asserts that it acquired exclusive license to use reports when they were posted pursuant to defendant's "Terms & Conditions."

COPYRIGHTS/FALSE ADVERTISING – Case Law – U.S. District Courts

Kwan Software Eng'g. Inc. v. Foray Techs., LLC, 87 BNA's PTCJ 870

The U.S. District Court for the Northern District of California on February 11, 2014 ruled that plaintiff's definition of "authentication" fails with regard to digital evidence software. Defendant is granted summary judgment that its advertising, claiming that its Authenticated Digital Asset Management System (ADAMS) software "authenticates" digital images, is not literally false, since defendant's ADAMS software can verify that image has not been altered between time image is placed in software system until it is retrieved, and since record shows that in this industry, both manufacturers and purchasers of software use term "authentication" to refer to process of ensuring that image is unaltered from time it is entered into system.

TRADEMARKS – Case Law – U.S. Courts of Appeals

Bose Corp. v. Ejaz, 86 BNA's PTCJ 1192

The U.S. Court of Appeals for the First Circuit on October 4, 2013 held a defendant's contention, without supporting evidence, that eBay customers are less likely than ordinary customers to be confused about differences between authorized goods and gray market goods was not sufficient to stave off Bose Corp.'s entitlement to summary judgment on its trademark infringement claims based on the defendant's unauthorized sale of Bose Equipment to Australians.

In re Health Sci. Funding, LLC, 86 BNA's PTCJ 1028

The U.S. Court of Appeals for the Federal Circuit on September 13, 2013 ruled that the Trademark Trial and Appeal

Board properly upheld a refusal to register terms incorporating the word "prasterone" for a website offering information about prasterone.

1-800 Contacts Inc. v. Lens.com Inc., 86 BNA's PTCJ 679

The U.S. Court of Appeals for the Tenth Circuit on July 16, 2013 ruled that the purchase of a competitor's trademark as a trigger for advertising through Google's AdWords program was unlikely to create confusion on the part of consumers and thus did not give rise to a claim of trademark infringement through initial interest confusion.

Slep-Tone Entm't Corp. v. Karaoke Kandy Store, Inc., 108 USPQ2d 1500

The U.S. Court of Appeals for the Sixth Circuit on March 7, 2013, in an unpublished opinion, ruled that affidavit of defendants' former employee warrants reversal of summary judgment for defendants in action in which plaintiff alleges that defendants copied its karaoke discs onto hard drives and MP3 players, and that defendants' customers, when they use these devices, will see plaintiff's "Sound Choice" trademarks on video displays and believe that "Sound Choice" brand is in some way associated with defendants.

Webceleb, Inc. v. Procter & Gamble Co., 87 BNA's PTCJ 819

The U.S. Court of Appeals for the Ninth Circuit on February 5, 2014 in an unpublished opinion, ruled that Microsoft and Procter & Gamble did not infringe "Webceleb" trademark.

Specht v. Google Inc., 87 BNA's PTCJ 1367

The U.S. Court of Appeals for the Seventh Circuit on April 4, 2014 ruled that a technology company that used the "Android Data" mark in the 1990's conclusively abandoned the mark when it ceased operating in 2002 and never successfully reclaimed the mark before Google launched its Android operating system in 2007. The appeals court accordingly affirms a grant of summary judgment in Google's favor on claims that its Android operating system for mobile phones infringed the Android Data mark.

TRADEMARKS – Case Law – U.S. District Courts

Chloe SAS v Sawabeh Info. Servs. Co., 86 BNA's PTCJ 1233

The U.S. District Court for the Central District of California on October 8, 2013 ruled that an online marketplace was secondarily liable for counterfeiting and trademark infringement claims resulting from transactions entered into by its users. Granting partial summary judgment in favor of several owners of luxury brand names, the court found no triable question on claims of contributory counterfeiting, contributory trademark infringement and unfair competition.

***Rebellion Devs. Ltd. v. Star-Dock Entm't Inc.*, 107 USPQ2d 2160**

The U.S. District Court for the Eastern District of Michigan on May 9, 2013 ruled that two-pronged test that requires trademark owner to show either that title of expressive work has no artistic relevance to work, or explicitly misleads as to source or content of work, is appropriate test to apply on defendants' motion to dismiss claim alleging that title of "Sins of a Solar Empire: Rebellion" computer game infringes plaintiffs' registered trademark for "Rebellion" video game development company; plaintiff has failed to meet this test, and claim is dismissed.

***Parts.com, LLC v. Yahoo! Inc.*, 87 BNA's PTCJ 339**

The U.S. District Court for the Southern District of California on December 4, 2013 ruled that claims under California state law of trademark infringement and dilution targeting Yahoo's keyword advertising program were barred by the Communications Decency Act.

***Stevo Design, Inc. v. SBR Mktg. Ltd.*, 109 USPQ2d 1307**

The U.S. District Court for the District of Nevada on August 29, 2013 ruled that domestic sports-handicapping service cannot succeed on its infringement claims against offshore website on theory that defendant encouraged message board users to post, with knowledge that users would mention plaintiff's marks and thereby drive search engine results that favored defendant's site, allegation that uses are "in a privity of relationship" with defendant does not change fact that uses of plaintiff's marks constitute nominative fair use.

***Del Monte Int'l GmbH v. Del Monte Corp.*, 87 BNA's PTCJ 817**

The U.S. District Court for the Central District of California on February 5, 2014 ruled that a failed bid to secure a new gTLD did not result in a 'registration' of a domain name that would support an action under the Anticybersquatting Consumer Protection Act.

***Infostream Grp. Inc. v. Avid Life Media Inc.*, 109 USPQ2d 1512**

The U.S. District Court for the Central District of California on November 12, 2013 ruled that Plaintiff has failed to state trademark infringement and related claims by alleging that defendants' use of plaintiff's "What's Your Price" and "Seeking Millionaire" marks as Internet advertising keywords causes paid advertisements for defendants' "sugar daddy dating" websites to be displayed in response to search for plaintiff's marks, since defendants' advertisements are displayed off to side of actual search results, under heading "ads," and neither those ads, nor domain names of sites they advertise, reference any protected mark.

***Hanginout, Inc. v. Google, Inc.*, 88 BNA's PTCJ 188**

The U.S. District Court for the Southern District of California on May 12, 2014 ruled that the company behind the "Hanginout" mobile app failed to show that Google's "Hangout" app would create a likelihood of confusion with its product. Denying Hanginout's motion for a preliminary injunction, the court also rejects Google's motion to dismiss Hanginout's trademark claims, after finding that it had sufficiently pleaded its claims against Google, even if there had not been sufficient evidence in the record for an injunction.

***NetJets Inc. v. IntelliJet Grp. LLC*, 109 USPQ2d 1553**

The U.S. District Court for the Southern District of Ohio on December 19, 2013 ruled that plaintiff private jet services company that uses "IntelliJet" as name for software that it employs as necessary tool to provide high level of services to its customers has failed to show that it uses "IntelliJet" in commerce as trademark, since plaintiff does not market software itself.

TRADEMARKS – Case Law – U.S. Patent and Trademark Office

***In re Hollywood Lawyers Online.*, 88 BNA's PTCJ 112**

The Trademark Trial and Appeal Board on May 2, 2014 ruled that a company that offers attorney referrals for entertainment practitioners cannot register the "Hollywood Lawyers Online" mark because the public will associate the first word in the mark with a place, not the entertainment industry. The board affirms a refusal to register the mark on the grounds that it is primarily geographically descriptive, rejecting the applicant's argument that consumers would understand the term "Hollywood" to be a reference to the entertainment industry.

TRADEMARKS/CYBERSQUATTING – Case Law – U.S. Courts of Appeals

***Petroliam Nasional Berhad v. Godaddy.com*, 87 BNA's PTCJ 273**

The U.S. Court of Appeals for the Ninth Circuit on December 4, 2013 ruled that the federal anticybersquatting statute does not create a cause of action for contributory cybersquatting. Affirming summary judgment in favor of a domain name registrar, the court determines that neither the plain text of the statute, nor the legislative history, support an action for contributory cybersquatting.

TRADEMARKS/FALSE ADVERTISING – Case Law – U.S. District Courts

***AvePoint, Inc. v. Power Tools, Inc.*, 109 USPQ2d 2073**

The U.S. District Court for the Western District of Virginia on November 7, 2013 ruled that plaintiff software provider's allegations that defendants posted messages on social media that misrepresented geographic origin of plaintiff's goods,

and impugned quality of plaintiff's goods and services, are sufficient to state claims for false advertising under Lanham Act and Virginia law; social media posts constituted commercial speech, and were aimed at relevant purchasing public so as to constitute "advertising".

TRADEMARKS/JURISDICTION – Case Law – U.S. Courts of Appeals

***Advanced Tactical Ordnance Sys., LLC v. Real Action Paintball, Inc.*, 88 BNA's PTCJ 185**

The U.S. Court of Appeals for the Seventh Circuit on May 9, 2014 ruled that the maintenance of an interactive website that is accessible in Indiana and the sale of a few products to Indiana residents do not create necessary minimum contacts that would subject the website's owner to personal jurisdiction in Indiana. The appeals court accordingly reverses a trademark infringement award that was based on the defendant's alleged use of plaintiff's "PepperBall" trademarks.

***Louis Vuitton Malletier v. Mosseri*, 87 BNA's PTCJ 278**

The U.S. Court of Appeals for the Eleventh Circuit on December 2, 2013 held that a district court properly declined to vacate a judgment against the operator of a website selling counterfeit Louis Vuitton products.

TRADEMARKS/TRADE DRESS – Case Law – U.S. District Courts

***Express Lien Inc. v. Nat'l Ass'n of Credit Mgmt. Inc.*, 86 BNA's PTCJ 894**

The U.S. District Court for the Eastern District of Louisiana on August 23, 2013 ruled that allegations that a commercial website copied the stylistic choices of the plaintiff's widely recognized website were sufficient to state a claim of trade dress infringement, finding that a federal Lanham Act claim can be brought to protect the trade dress of a website, without the need for a registered trademark.

TRADE SECRETS – Case Law – U.S. Courts of Appeals

***Storage Craft Tech Corp. v. Kirby*, 109 USPQ2d 2110**

The U.S. Court of Appeals for the Tenth Circuit on March 11, 2014 affirmed jury's award of reasonable royalty damages to plaintiff software company for misappropriation of trade secrets, even though defendant did not put trade secrets to his own commercial use, since state law permits royalty award for disclosure of trade secret, and defendant shared misappropriated source code with rival company.

***Dice Corp. v. Bold Techs.*, 87 BNA's PTCJ 692**

The U.S. Court of Appeals for the Sixth Circuit on January 24, 2014 affirmed summary judgment against security software developing outfit.

***Kendall Holdings, Ltd. v. Eden Cryogenics LLC*, 108 USPQ2d 1910**

The U.S. Court of Appeals for the Sixth Circuit on April 5, 2013 reversed and remanded a summary judgment ruling that four-year statute of limitations barred plaintiff's misappropriation claim, on ground that plaintiff should have known of defendants' misappropriation when defendants' employee, who had worked for plaintiff's predecessor, kept copies of shop drawings on his home computer, since defendants' contention that employee did not acquire drawings by improper means, and had predecessor's permission to possess and use drawings, undermined defendants' statute of limitations argument.

TRADE SECRETS – Case Law – U.S. District Courts

***AirWatch LLC v. Mobile Iron, Inc.*, 109 USPQ2d 2035**

The U.S. District Court for the Northern District of Georgia on September 4, 2013 ruled that claim alleging misappropriation of trade secrets embodied in plaintiff's security software for mobile devices will not be dismissed, since Georgia Trade Secrets Act states that "programs" may qualify for trade secret protection, and information regarding plaintiff's software thus may be trade secret, even if appearance and functionality of software program is not, and since plaintiff alleges that users of its software were subject to end user license agreements containing confidentiality provisions.

TRADE SECRETS/CRIMINAL – Case Law – U.S. Courts of Appeals

***United States v. Agrawal*, 86 BNA's PTCJ 752**

The U.S. Court of Appeals for the Second Circuit on August 1, 2013, ruled that evidence that software that a securities trader shared with a competitor was used internally by his employer to trade securities was sufficient to satisfy the interstate commerce element of the Economic Espionage Act.

LANHAM ACT – Case Law – U.S. Courts of Appeals

***Brown v. Elec. Ats, Inc.*, 86 BNA's PTCJ 680**

The U.S. Court of Appeals for the Ninth Circuit on July 31, 2013 ruled that football player Jim Brown cannot sustain a false endorsement claim under the Lanham Act for the use of his likeness in *Madden NFL* video games, applying the *Rogers* test to determine whether the video game deserves First Amendment protection.

RIGHT OF PUBLICITY – Case Law – U.S. Courts of Appeals

***In re NCAA Student-Athlete Name & Likeness Licensing Litig.*, 86 BNA's PTCJ 681**

The U.S. Court of Appeals for the Ninth Circuit on July 31, 2013 declined to apply the *Rogers* test in finding that Electronic Arts *NCAA Football* video game series might offend a player's right of publicity under California law.

RIGHT OF PUBLICITY – Case Law – U.S. District Courts

***Jackson v. Odenat*, 88 BNA's PTCJ 1210**

The U.S. District Court for the Southern District of New York on March 24, 2014 ruled that a defendant that operates a popular website featuring hip-hop mixtapes and music videos was liable for copyright infringement and violated rapper 50 Cent's right of publicity by using various images of the rapper in the website's masthead. ■



2015 Edward F. Langs Writing Award

Essay Competition Rules

1. Awards will be given to up to six student essays, which in the opinion of the judges make the most significant contribution to the knowledge and understanding of information technology law. Factors to be taken into consideration include: originality; timeliness of the subject; depth of research; accuracy; readability; and the potential for impact on the law.
2. Essay must be original, deemed to be of publishing quality, and must not have been submitted to any other contest within the previous 12 months.
3. Essay must be typed, double spaced, at least ten pages in length, must contain proper citations listed as either endnotes or footnotes, and must have left, right, top, and bottom margins of one inch.
4. Essay must include the submitter's name, email address, mailing address, telephone number, and school attended.
5. A total of up to \$3,000 in US dollars shall be divided between the award winning essays, and all rights to award winning essays shall become the property of the State Bar of Michigan.
6. The Information Technology Section of the State Bar of Michigan reserves the right to make editorial changes, and to publish award winning essays in the Section's newsletter, the Michigan IT Lawyer. (Previous issues of the *Michigan IT Lawyer* can be accessed at <http://www.michbar.org/it/newsletters.cfm>.)
7. Essay must be submitted as a Microsoft Word document, **postmarked by June 30, 2015**, and emailed to dsyrowik@brookskushman.com. ■