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A review of developments in Intellectual Property Law

## Build Your Brand Without Bullying

By James M. McCarthy



It is time for a new look at trademark bullying. In recent months, trademark bullying has captured the attention of the trademark bar and the national media. The Wall Street Journal has written about

it, the International Trademark Association has sponsored programs and articles to address it, and the United States Patent and Trademark Office has even reported to Congress about it. This increased attention is not because the actions of brand owners have changed—cease and desist letters have been around for decades. Instead, it is the actions of “accused infringers” that have taken center stage as they have taken their cases to the court of public opinion. In many cases, brand holders who thought they were enhancing their brands by enforcing them, have found that unwanted attention to their enforcement efforts can actually damage the public’s perception of their brand. As a result, trademark owners need to develop a new approach to brand building and trademark enforcement.

### New Responses to Trademark Bullying Can Damage Your Brand

Regardless of the cause of trademark bullying, it has become newsworthy mostly because of the creative responses developed by the accused infringers. In the past, an accused infringer was often limited to either complying with the cease and desist demands or negotiating a coexistence agreement with the trademark owner. In either case, the accused infringer was usually forced to agree to some sort of limitations in order to avoid an expensive lawsuit. More recently, however, the availability of social media and other Internet resources have expanded the menu of available responses. Accused infringers can now use crowd funding sites to raise money for legal fees to resist questionable legal claims of trademark owners or simply make the cease and desist letter public in an effort to embarrass the trademark owner by labeling them as a trademark bully. When these types of responses spread rapidly via social media, the damage to a trademark owner’s brand can

be greater than the original conduct of the accused infringer.

Some of the most creative responses are now well known. The seller of “Eat More Kale” shirts launched a social media public relations campaign against Chick-fil-A after it asserted its “Eat Mor Chikin” brand against him. Later, the accused infringer used crowd funding sites to raise money for his legal battle. In another example, after Louis Vuitton challenged the University of Pennsylvania Law School’s use of the famous LV pattern (in which the LV was replaced by a TM in a clever poster for a symposium addressing trademarks in the fashion industry), the students invited Louis Vuitton’s counsel to their symposium and posted both the cease and desist letter and their response online.

Due in large part to the success and popularity of these social media campaigns, the strategies are being copied by other accused infringers. As recently as December 2013, the owner of the Missouri bar Exit Six, who was selling “Frappicino” beer and received a standard cease and desist letter from Starbucks, posted his response letter online

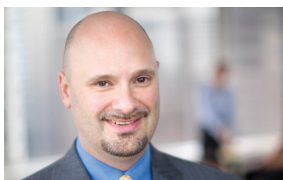
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along with an image of the check for \$6 that he included for any tongue in cheek “damages” to Starbucks.

## Be A Leader, Not A Bully

Now that accused infringers have become more sophisticated and creative when responding to cease and desist letters, it is time for trademark owners and their attorneys to change their approach. Instead of asking “can I enforce my mark against the accused infringer,” the trademark owner needs to ask whether he should be enforcing the mark. Instead of looking for any basis to support a cease and desist letter, trademark attorneys should be asking their clients what type of brand they are trying to build and determining whether offensive action is helping to protect a brand or if such action may ultimately damage the brand. While it may be easier to tell an accused infringer to stop, using creative energy to build something new will always be more fruitful in the long term.

Trademark owners and their lawyers must keep in mind that if they are not actively developing their own brand, a brand is already being assigned to your work by others. In fact, this is the very reason why every trademark owner spends time, energy, and resources to market their trademarks and define their brand. Trademark owners cannot afford to allow their trademark enforcement efforts to backfire. They cannot afford to have a single cease and desist letter made public in a way that undermines their branding efforts. They cannot afford to allow their trademark to be controlled by others. Therefore, trademark attorneys need to work with brand holders to be ready for situations that arise unexpectedly and require immediate action.

## Develop A Story and Development Plan For Your Brand

Before even thinking about potential infringers and cease and desist letters, trademark attorneys need to talk with their clients about what their brands represent and how they want their brand to grow. Every brand conveys an emotional message to consumers and a brand promise. Every brand is associated with certain goods or services, and every business has a plan to build and expand the brand. Many companies have detailed brand guidelines that provide a written account of

these messages and plans. For companies that do not have such guidelines, trademark attorneys have an obligation to understand these plans before sending out a cease and desist letter.

Brand owners are very unlikely to become a trademark bully if they understand what trademarks they own and how they want their businesses and brands to grow. In fact, if expansion plans are clearly developed, a brand owner will be much less likely to try to enforce a trademark against someone using a mark in an unrelated area. Sometimes, it may be necessary to conduct a trademark audit to help a trademark owner understand what trademark rights they have, what brand message is being developed, and how they can expand on those rights. Trademark attorneys need to review the brand owners’ trademark registrations, products and services, packaging, web site, and advertisements, as well as any other

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marketing or promotional materials. Based on this review, a qualified trademark attorney can confirm which trademarks are being used properly and identify additional trademark rights that may exist or could be created or exploited.

## Keep Up With Changes

As a company grows and expands, it often extends the use of its primary brands to goods and services that were not anticipated by prior trademark registrations. McDonald’s Corporation, for instance, currently uses the MCDONALD’S trademark for a great deal more than the “drive-in restaurant services”

described in its 1963 United States trademark registration (Reg. No. 743,572). In order to avoid becoming a bully, a company’s trademark portfolio needs to grow consistently with the company’s business. Staying abreast of these changing and expanding trademark rights will allow the trademark owner to protect and enforce those rights in a consistent manner. Moreover, having a clear understanding of the trademark rights and how the business intends to grow will help keep the legal team from overreaching with its enforcement efforts.

## How To Enforce Trademarks Without Bullying

Once the brand owners understand their brands — what they have and where they want to go — then it will be possible to move beyond the traditional enforcements that often lead to the label of a “trademark bully.” Instead, trademark attorneys can help trademark owners develop a comprehensive enforcement system. The enforcement plan can include basic elements such as watch services for primary brands in key countries, investigation of potential infringers, and traditional enforcement methods such as cease and desist letters, oppositions, cancellations, and litigation as well as a periodic analysis of potential false advertising claims and consideration of whether U.S. Customs officials should be made aware of the potential for the importation of counterfeit goods. An enforcement plan can even anticipate situations when the trademark owner should not enforce trademark rights. For example, some brand owners may choose not to enforce rights against fan sites or other events involving children.

At the end of the day, even if a brand owner has sophisticated brand guidelines with development plans and enforcement systems, it is sometimes necessary to aggressively take on a genuine infringer. After all, the strongest brands are those that are used exclusively by one source, and there can be only one McDonalds, Apple, and Coca-Cola. In these situations, bullying can still be avoided.

When the time does come where some sort of enforcement action is necessary, a good rule of thumb for future brand owner and attorney decision-making comes straight from my grandmother — “Don’t put anything in writing that you wouldn’t like to see on

the cover of the New York Times.” Similarly, don’t send a cease and desist letter that you would be embarrassed to see being shared virally on Facebook, Twitter, or Instagram. In situations where a trademark owner is faced with clear infringement and would not hesitate to file a complaint, a firmly worded cease and desist letter will be recognized as thoughtful trademark enforcement, not bullying. Need proof? Look no further than Jack Daniel’s recent demand letter sent to a book author who used a knock off of the Jack Daniel’s label on the book cover. It was hailed as the “the most polite, encouraging, and empathetic cease-and-desist letter ever to be sent.”<sup>1</sup>

When faced with situations where trademark infringement is less clear, trademark

owners should consider other alternatives. For example, pick up the phone. A simple call between the trademark owner and the suspected infringer is a tool that has been used for generations and is often the quickest path to a resolution. Another traditional alternative to a cease and desist letter is to send a letter that either includes an offer to license the trademark (and thereby become part of the trademark owner’s team instead of an opponent) or simply explains the position of the trademark owner, asks about how the third party intends to use the mark, and invites the third party to discuss possible amicable resolutions.

Remember, when a trademark owner takes the time to understand their brand, it will be

easier to enforce that brand in a manner that is consistent with their goals. It is up to trademark attorneys and brand owners to change the conversation. Then, any enforcement efforts will be recognized as part of brand building, not bullying.

#### Endnotes

<sup>1</sup> (Megan Garber, “This Cease-and-Desist Letter Should Be the Model for Every Cease-and-Desist Letter,” *The Atlantic*, (Jul. 23, 2012)).

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## MBHB to Exhibit at 2014 BIO International Convention in San Diego

MBHB will be participating as an exhibitor at the 2014 BIO International Convention (“BIO”) set for June 23-26 in San Diego. We invite you to visit us at Booth #1337 in the exhibit hall to meet our attorneys, learn more about our services and enter our raffle. Billed as the largest global event for the biotechnology industry, 2014 BIO is organized by the Biotechnology Industry Organization. The organization represents more than 1,100 biotechnology companies, academic institutions, state biotechnology centers and related organizations across the United States and in more than 30 other nations. BIO members are involved in the research and development of innovative healthcare, agricultural, industrial and environmental biotechnology products. MBHB is also a proud sponsor of the North Carolina Pavilion at 2014 BIO (Booth #1727).

2014 BIO covers the wide spectrum of life science innovations and application areas. Drug discovery, biomanufacturing, genomics, biofuels, nanotechnology, and cell therapy are just a few of the industries represented. Thousands of

leaders from over 65 countries are expected to attend 2014 BIO. The key elements of the event are education, networking, BIO Business Forum partnering and the 1,700 companies showcasing the latest technologies, products and services in the BIO Exhibition. View complete details at <http://convention.bio.org>.



*The Global Event  
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June 23–26, 2014  
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### Patent Docs Blog Selected for Inclusion in the 2013 ABA Journal Blawg 100

MBHB is pleased to announce that the Patent Docs blog ([www.patentdocs.org](http://www.patentdocs.org)) has been selected for inclusion in the prestigious 2013 ABA Journal Blawg 100. Editors of the ABA Journal announced its seventh annual list of the 100 best legal blogs - or blawgs - following a nomination process that began earlier this year. MBHB partners Dr. Donald Zuhn, Jr. and Dr. Kevin Noonan are the founding co-authors of the Patent Docs weblog, a site focusing on biotechnology and pharmaceutical patent law. This is the second year in a row that Patent Docs has been so honored. View an alphabetical list of the 2013 ABA Journal Blawg 100 at [www.abajournal.com/magazine/article/7th\\_annual\\_blawg\\_100](http://www.abajournal.com/magazine/article/7th_annual_blawg_100).

# “Patent Trolls” Beware—Congress Tackles Vexatious Patent Litigation

By Andrew W. Williams, Ph.D.

If the mainstream media is to be believed, the patent system is now “broken.”<sup>1</sup> This notion is frequently blamed on the perceived increase in so-called patent assertion entities (“PAEs”), referred to derogatorily in the press as “patent trolls.” More often than not, these media reports cite to a limited number of examples illustrating the perceived abuses, and reach the conclusion that patents are stifling innovation.<sup>2</sup>

The Governmental Accountability Office (“GAO”) came to a different conclusion, noting that even though there may have been an increase in PAE activity, there was no cause for alarm.<sup>3</sup> This study was based on both empirical evidence and data from all patent infringement lawsuits filed between 2000 and 2011.<sup>4</sup> In fact, the GAO noted that trends in both the federal courts and the Patent Office already seeking to correct the perceived problems.<sup>5</sup> Nevertheless, even if there is some disagreement about the severity of the problem, almost everyone is in agreement that there has been an increase in abuses associated with the assertion of patents.

In response to these concerns, both the executive and legislative branches of the U.S. government have been working on patent reform. For example, the White House released a report last June entitled “Patent Assertion and U.S. Innovation,” accompanied by several executive initiatives and legislative recommendations.<sup>6</sup> In addition, several pieces of legislation have been introduced in both the House and the Senate to address this perceived “patent troll” problem. As Sens. Leahy and Lee explained, the goal of such legislation is “to make it harder for bad actors to succeed, while preserving what has made America’s patent system great.”<sup>7</sup> The difficulty is in narrowly crafting such legislation to specifically address the perceived problems without also ensnaring legitimate patent holders, and without introducing unexpected negative consequences for the patent system as a whole.

The House of Representatives has already passed legislation to curb abusive patent litigation. Rep. Goodlatte introduced the “Innovation Act” (H.R. 3309) on October 23, 2013, and with remarkable speed, the bill was passed by an overwhelming majority of the House on

December 5, 2013.<sup>8</sup> The Senate has not acted as quickly, but several key pieces of legislation have been introduced. One of these, Sen. Hatch’s “Patent Litigation Integrity Act” (S. 1612), is aimed at shifting reasonable fees from the prevailing to the non-prevailing party.<sup>9</sup> In addition, Sen. Leahy, along with Sens. Lee and Whitehouse, introduced the “Patent Transparency and Improvements Act” (S. 1720).<sup>10</sup> Action on one or more of these introduced bills is expected later this year. Of the provisions found in these legislative initiatives, two that are touted as necessary to address the perceived “patent troll” problem involve fee-shifting and heightened pleading standards for patent lawsuits.

## Fee-Shifting Provisions

The perception is that “patent trolls” are flourishing because there is virtually zero cost in bringing or threatening a patent infringement lawsuit. This is because even if a patent holder is unsuccessful against an alleged infringer, it is rarely required to pay the fees of the winning party. Moreover, PAEs often have a fraction of the discovery costs, because the documents related to obtaining the patent are commonly retained by the original assignee. As a result, even successfully defending against a patent infringement suit can cost millions of dollars, thereby creating an overwhelming incentive for the accused infringer to license the patent at the outset. As President Obama put it last year, “patent trolls” are essentially trying to “leverage and hijack somebody else’s idea and see if they can extort some money out of them.”<sup>11</sup> One solution is to make it easier for courts to shift the cost of attorney’s fees to the non-prevailing party, and there are several ways in which this can be accomplished.

Currently, 35 U.S.C. § 285 provides that a “court in exceptional cases may award reasonable attorney fees to the prevailing party.”<sup>12</sup> The Federal Circuit has held that a case is only exceptional when “both (1) the litigation is brought in subjective bad faith, and (2) the litigation is objectively baseless,” absent misconduct in litigation or in securing the patent.<sup>13</sup> However, Chief Judge Rader recently argued that the “court should return to the rule that a district court may shift fees when,

based on the totality of the circumstances, it is necessary to prevent a gross injustice,” thereby eliminating the need to parse evidence into subjective and objective categories.<sup>14</sup> This proposal comes as the Supreme Court is set to hear two cases dealing with the fee-shifting provision of § 285. In one, *Octane Fitness v. Icon Health and Fitness*, the issue was framed to address this exact issue: “does the Federal Circuit’s promulgation of a rigid and exclusive two-part test for determining whether a case is ‘exceptional’ under 35 U.S.C. § 285 improperly appropriate a district court’s discretionary authority to award attorney fees to prevailing accused infringers in contravention of statutory intent and this Court’s precedent . . . .”<sup>15</sup> Chief Judge Rader had previously spoken out about the fee-shifting provision, complaining that federal judges were not using § 285 with sufficient regularity to discourage “troll”-like behavior.<sup>16</sup> Therefore, it is possible that the Judiciary itself will partially rectify the problem.

The Executive Branch has suggested taking it a step further. Included in President Obama’s legislative recommendations was one aimed at permitting “more discretion in awarding fees to prevailing parties in patent cases.”<sup>17</sup> The hope was to make fee shifting in patent cases “similar to the legal standard that applies in copyright infringement cases.”<sup>18</sup> In copyright cases, there is no exceptional-case requirement, but rather a court may “award a reasonable attorney’s fees to the prevailing party as part of the costs.”<sup>19</sup> Without the exceptional-case requirement, the barrier to obtaining attorney’s fees in patent infringement suit would be much lower, thereby creating a disincentive for “patent trolls.”

The Congressional approach goes even further. In both the Innovation Act and the Senate’s Patent Litigation Integrity Act, § 285 would be modified to make the shifting of fees in patent cases the default, which could only be overcome by a showing that the litigation conduct was justified. The Innovation Act provides for the award of reasonable fees to the prevailing party unless “the position and conduct of the nonprevailing party or parties were reasonably justified in law and fact or that special circumstances . . . make an award

unjust.”<sup>20</sup> The Senate’s version of this provision has an even higher standard, requiring the conduct to be “substantially justified.”<sup>21</sup> This shift in the default would provide courts with the ability to “punish” non-practicing entities that are considered to have asserted their patents abusively. However, such a change could have unintended consequences. For example, legitimate patent infringement lawsuits could be stifled, regardless of whether the patent holder is a practicing entity or not. Nevertheless, organizations such as the Intellectual Property Owner’s Association have come out in favor of this default shift.<sup>22</sup>

The Senate’s bill also includes a provision not found in the Innovation Act for how to hold the patent-asserting plaintiffs accountable for such fees. S. 1612 provides courts with the ability to require bonding by the “party alleging infringement.”<sup>23</sup> Factors are provided to help determine whether such a bond is “unreasonable or unnecessary,” such as whether the party is an institution of higher learning, whether the party is the named inventor or original assignee, or whether the party practices the invention.<sup>24</sup> Such a provision, however, could result in the establishment of a patent enforcement system with two classes of plaintiffs—those for whom there are no upfront costs, and those for whom there is an “entry fee,” which could run in the millions of dollars. Even the White House has acknowledged the economic justification for non-practicing patent intermediaries, because they can help innovators that do not have the resources to capitalize their own inventions.<sup>25</sup> Such a “bond” provision could have a chilling effect on legitimate patent asserting entities, and therefore the unintended consequences of hindering innovation. Sen. Hatch has defended this provision by noting that fee-shifting without this option “is like writing a check on an empty account,” likely because “patent trolls” often have limited assets, and therefore would be “judgment proof” with regard to fee-shifting.<sup>26</sup> Therefore, he has insisted that a bonding provision is necessary in any legislation dealing with “trolls.”<sup>27</sup>

## Heightened Pleading Standards

“Patent trolls” are also thought to be flourishing because to bring a patent infringement suit requires only notice pleading as set forth by Form 18. Therefore little more than a statement of jurisdiction, the patent being asserted, and the alleged infringing product

or action needs to be disclosed for the complaint to be sufficiently pleaded. The Innovation Act and the Senate’s Patent Transparency and Improvements Act would shift the system from “notice” pleading to requiring information resembling that included with infringement contentions not normally provided until much later in a litigation. For example, the type of information required by a patent-asserting party would include an identification of each patent and claim allegedly infringed, where each element is found in each “accused instrumentality,” whether infringement is literal or under the doctrine of equivalents, and how the claim terms correspond to the functionality of the accused instrument.<sup>28</sup> It is unclear if claim charts will be required to satisfy this pleading requirement. The new pleading standard will also require a description of any direct or indirect infringement, the right of the party to assert the patent, an identification of lawsuits involving the same patent(s), and whether the patent is subject to any licensing terms or pricing commitments.<sup>29</sup>

On the one hand, requiring a more detailed statement of alleged infringement seems reasonable. However, with heightened pleading standards, a patent infringement suit could get mired in a challenge to the sufficiency of the pleadings before ever addressing the merits of the case. The Act does not specify the level of detail required, nor the penalty for failing to meet the new standard. Although parties normally have the right to amend a complaint once, it is not clear if leave will be freely granted if more than one is needed. Will an amended complaint be required if the patent holder’s infringement contentions are modified after discovery? Will limited discovery be allowed if the alleged infringer challenges the sufficiency of the complaint? None of these issues have been addressed.

The Innovation Act does address the situations where the information necessary to satisfy this heightened standard is not readily accessible to a party. The Act provides that a patent holder can explain why the undisclosed information was not available and the efforts undertaken to obtain the information.<sup>30</sup> Of course, it is unclear what standard that the courts will use to determine if information is, in fact, unavailable, and whether research efforts were satisfactory.

Of course, applying a heightened pleading standard to all patent cases could easily be a double-edged sword. It would likely have the

effect of reducing the number of vexatious patent “fishing expeditions,” in which minimal pleadings permit a plaintiff to conduct extensive (and expensive) discovery in search of a theory of infringement. On the other hand, it could discourage legitimate suits where infringement is likely to exist, but the exact theory of infringement requires at least some discovery to nail down.

Ultimately, these attempts to solve the “patent-troll” problem through legislative initiatives such as fee-shifting and heightened pleading standards are problematic because Congress has not attempted to define what a “patent troll” is. Without a clear understanding of the threat, any attempt to curtail it is bound to have unintended consequences. As such, all patent holders need to pay attention to determine the impact of this new legislation.

## Endnotes

- 1 See, e.g., *This American Life: 496: When Patents Attack . . . Part Two!*, Chicago Public Media (May 31, 2013) (downloaded using iTunes); *Planet Money: Episode 462: When Patents Hit the Podcast*, National Public Radio (May 31, 2013, 10:52 PM), <http://www.npr.org/blogs/money/2013/05/31/187374157/episode-462-when-patents-hit-the-podcast>; Patrick Hall, *Patent Law Broken, Abused to Stifle Innovation*, *Wired.com* (July 26, 2013, 11:32 AM), <http://www.wired.com/insights/2013/07/patent-law-broken-abused-to-stifle-innovation/>.
- 2 See, e.g., Hall, *supra* note 1.
- 3 U.S. GOV’T ACCOUNTABILITY OFFICE, GAO-13-465, *Intellectual Property: Assessing Factors that Affect Patent Infringement Litigation Could Help Improve Patent Quality* (2013), *available at* <http://www.gao.gov/products/GAO-13-465>.
- 4 *Id.* at 4-6.
- 5 *Id.* at 36-45.
- 6 EXECUTIVE OFFICE OF THE PRESIDENT, *Patent Assertion and U.S. Innovation* (June 2013), *available at* [http://www.whitehouse.gov/sites/default/files/docs/patent\\_report.pdf](http://www.whitehouse.gov/sites/default/files/docs/patent_report.pdf); Press Release, *The White House, FACT SHEET: White House Task Force on High-Tech Patent Issues* (June 4, 2013), *available at* <http://www.whitehouse.gov/the-press-office/2013/06/04/fact-sheet-white-house-task-force-high-tech-patent-issues>.
- 7 Sen. Patrick Leahy and Sen. Mike Lee, *America’s Patent Problem*, *POLITICO* (Sept. 15, 2013, 9:25 PM), <http://www.politico.com/story/2013/09/patrick-leahy-war-on-patent-trolls-96822.html>.
- 8 Innovation Act, H.R. 3309, 113th Cong. (as passed by Senate, Dec. 5, 2013).
- 9 Patent Litigation Integrity Act of 2013, S. 1612, 113th Cong. (2013).
- 10 Patent Transparency and Improvements Act of 2013, S. 1720, 113th Cong. (2013).
- 11 See EXECUTIVE OFFICE OF THE PRESIDENT, 2, *supra* note 6.
- 12 35 U.S.C. § 285 (2012).
- 13 *Brooks Furniture Mfg. v. Dutilleul, Inc.*, 393 F.3d 1378, 1381 (Fed. Cir. 2005).
- 14 *Kilopass Tech, Inc. v. Sidense Corp.*, No. 2013-1193, 2013 WL 6800885, at \*14 (Fed. Cir. Dec. 26, 2013) (Rader, C.J., concurring).
- 15 Octane Fitness, LLC v. Icon Health & Fitness, Inc. Questions Presented, *available at* <http://www.supremecourt.gov/qp/12-01184qp.pdf>.
- 16 Randall R. Rader, Colleen V. Chien, and David Hricik, Op-Ed., *Make Patent Trolls Pay in Court*, *N.Y. TIMES* (June 4, 2013).
- 17 Press Release, *The White House, supra* note 6.
- 18 *Id.*
- 19 17 U.S.C. § 505 (2012).
- 20 Innovation Act § 3.
- 21 Patent Litigation Integrity Act § 101.
- 22 113th Congress, 1st Session — IPO Positions on Bills/Recommendations Directed at Abusive Patent Litigation, *available at* <http://www.ipo.org/wp-content/uploads/2013/12/Patent-Litigation-Bills-Quick-Overview-Dec-Board-Meeting.pdf>.
- 23 Patent Litigation Integrity Act § 201.
- 24 *Id.*
- 25 EXECUTIVE OFFICE OF THE PRESIDENT, 3, *supra* note 6.
- 26 Press Release, *Orrin Hatch, Hatch Introduces Legislation to Combat Patent Trolls* (Oct. 30, 2013), *available at* <http://www.hatch.senate.gov/public/index.cfm/releases?ID=6f22f0c5-aa23-47ce-9f30-7d0bfb15491a>.
- 27 *Id.*
- 28 See, e.g., Innovation Act § 3.
- 29 *Id.*
- 30 *Id.*

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# Experience with the USPTO's First Action Interview Program

By Michael S. Borella, Ph.D. and Lawrence H. Aaronson

On May 5, 2011, the United States Patent and Trademark Office ("the Office") kicked off a new program intended to give applicants and examiners an opportunity to discuss the substance of a patent application before a formal, written examination report is mailed to the applicant.<sup>1</sup> Dubbed the First Action Interview (FAI) Pilot Program, it requires that the applicant electronically file, at least one day before the first action on the merits is mailed, a Request for First Action Interview.<sup>2</sup> The Request entitles the applicant to an interview with the examiner before mailing of the first action.<sup>3</sup> The examiner, in turn, provides the applicant with a pre-interview communication before the interview.<sup>4</sup> This communication is essentially an abbreviated office action, citing to sections of references that the examiner finds relevant to elements of the pending claims.<sup>5</sup>

The goal of the FAI Program is to facilitate communication between the applicant and examiner, so that the parties have an opportunity to come to agreement on the claims more rapidly and efficiently.<sup>6</sup> In order to encourage participation, there are no additional Office fees associated with enrolling.<sup>7</sup> However, eligibility for the program is limited to non-reissue, non-provisional utility applications or national stage applications filed with no more than 3 independent and no more than 20 dependent claims.<sup>8</sup> Further, there must be no multiple dependent claims, and the claims must be directed to a single invention.<sup>9</sup>

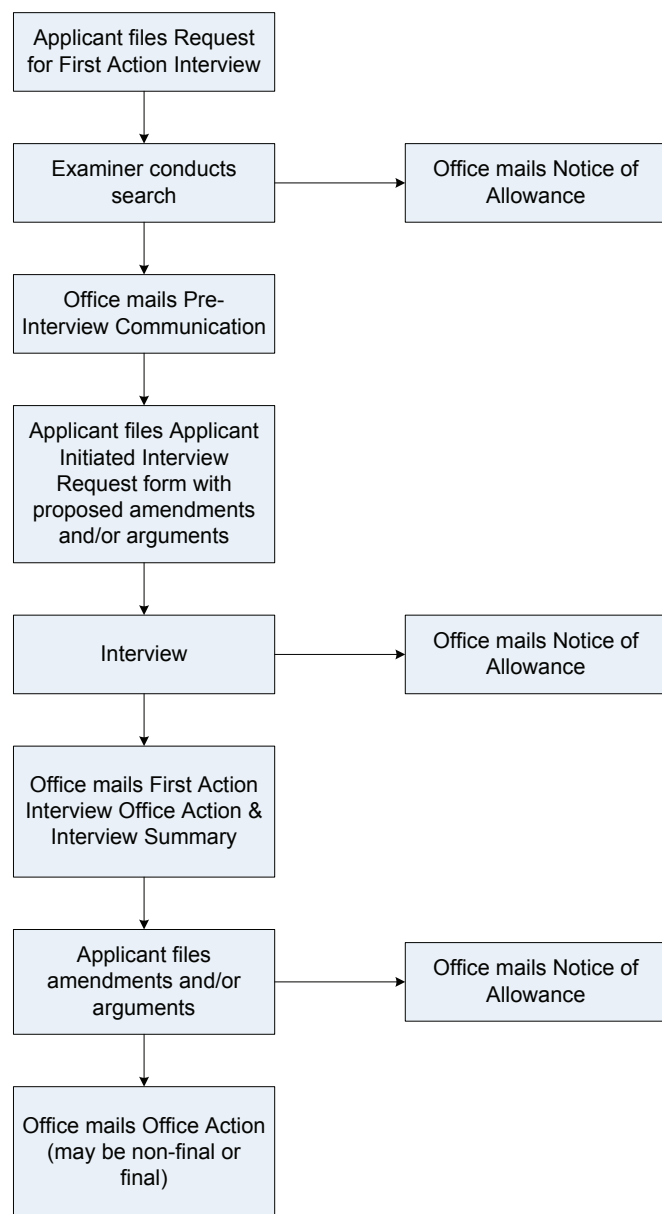
Our firm has handled over 150 patent applications using the FAI Pilot Program. Consequently, we believe that we have a unique perspective as to its strengths and weaknesses, as well as how an applicant can best take advantage of the program. This article provides an overview of the program and then discusses some of our experiences with it.

As an initial matter, it is our belief that early, frequent communication between the applicant and the Office tends to expedite prosecution. For some office actions, it can be difficult to decipher why the examiner has rejected claims. The examiner may have

reasonable grounds for the rejection. However, the examiner may base these rejections on interpretations of the claims and interpretations of the cited references that are significantly different from that of the applicant. In some cases, the grounds are not made clear by the office action, or may be buried by the formalities of the action. Additionally, applicants may prefer to file concise office action responses in order to reduce the likelihood of any patent that issues from the application being subject to prosecution history estoppel. In some cases, this results in the applicant and examiner talking past one another. An interview brings the parties to the table and gives them an opportunity to discuss the merits of the application openly in plain English.

As noted above, the applicant enrolls in the FAI Pilot Program by filing a Request for First Action Interview before the first action on the merits is mailed. When the application comes up for examination, the examiner conducts a search and may either allow the claims, or reject some or all of them.<sup>11</sup> If the claims are allowed, the Office mails a notice of allowance.

If the claims are rejected, the examiner will provide a Pre-Interview Communication.



A flow chart depicting the FAI process is shown above. This is an abbreviated version of the Office's official flow chart,<sup>10</sup> and focuses on the most-traversed paths through prosecution before, during, and after the first action interview. The flow chart of Figure 1 assumes that all papers are timely and properly filed by the applicant, and that the Office does not restrict the claims.

This mailing takes a form similar to that of a claim chart, and maps the cited references to claim elements. Unlike a full office action, however, much of the standard boilerplate is omitted. The mailing date of the Pre-Interview Communication sets a 30-day time period for

the applicant's response, which is extendable for another 30 days.<sup>12</sup>

In response to the Pre-Interview Communication, the applicant should file an Applicant Initiated Interview Request form, with a proposed date and time for the interview, as well as proposed claim amendments and/or arguments.<sup>13</sup> The proposed amendments and remarks must be clearly labeled as "proposed" in the header or footer of each page.<sup>14</sup>

The interview must be conducted within 60 days of this filing.<sup>15</sup> In order to expedite the scheduling process, we recommend contacting the examiner before filing the Applicant Initiated Interview Request form, to come to an agreement on when the interview will take place.

The interview should be, in substance, no different from any other examiner interview.<sup>16</sup> If the participants agree that the claims (in their original form or amended as proposed by the applicant) are allowable, the Office will enter the proposed amendments and mail a notice of allowance.<sup>17</sup> Otherwise the Office will mail a First Action Interview Office Action along with an interview summary.<sup>18</sup> This office action is considered the first action on the merits, and the applicant has only one month to file a response.<sup>19</sup> Alternatively, the applicant can waive receipt of the First Action Interview Office Action by requesting that the proposed amendments and remarks be converted to a formal reply.<sup>20</sup>

Regardless of the path taken to reach this point, if the applicant receives a First Action Interview Office Action rather than a notice of allowance, normal prosecution continues. In other words, the applicant then must file a response to this first office action, and any subsequent office action may be made final.<sup>21</sup>

We believe that the First Action Interview Pilot Program is beneficial to applicants, and we have recommended its use to numerous clients. Nonetheless, the program is not perfect. Some examiners to whom we have spoken freely admitted that they do not fully understand the procedural aspects of the program, and that they were not adequately trained in its operation. FAI applications are still relatively rare, so few examiners have substantial experience with the program. Below, we discuss a handful of difficulties and odd experiences that we have had with FAI procedures.

- *Blank Pre-Interview Communication.* On one occasion we received a Pre-Interview Communication with no

grounds for rejecting the claims. Provided with no position to rebut, we called the examiner and requested a properly formed Pre-Interview Communication, and that the time period for responding be reset.

- *Pre-Interview Communication in PAIR as a First Action Interview Office Action.* In this case, the Office mailed a First Action Interview Office Action instead of a Pre-Interview Communication. This muddled the file history of the application and could have potentially resulted in the applicant losing an opportunity to conduct the interview. Therefore, this situation required a call to the Office in order to have the status of the application set properly.
- *Non-Final Office Action mailed instead of a First Action Interview Office Action.* On numerous occasions we have not received a First Action Interview Office Action after conducting the interview. In some cases, we have received a non-final office action instead. This is typically not a problem, because the First Action Interview Office

Action is ostensibly a non-final office action, albeit with a shorter response period. We typically just respond to the non-final office action within the usual three-month deadline.

- *Final Office Action mailed instead of a First Action Interview Office Action.* On the other hand, receiving a final office action in lieu of a First Action Interview Office Action is problematic because the applicant should have one more bite at the apple. In these circumstances, we typically call the examiner and request that the finality of the office action be withdrawn.

Perhaps the most ambiguous aspect of the FAI program is how the program would address a scenario where the applicant or examiner introduces new proposed amendments *during* the interview, and where the examiner wishes to consider the amendments further. The FAI program does not explicitly allow for the applicant to submit updated proposed claims. In a conversation with the Office's Patent Legal Administration group, however, we have been

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## MBHB Highly Ranked in Key Intellectual Property-Related Practice Areas within 2014 Edition of U.S. News-Best Lawyers "Best Law Firms"

MBHB is highly ranked in key intellectual property-related practice areas within the 2014 edition of U.S. News-Best Lawyers "Best Law Firms" at the national and metropolitan levels. Overall rankings are based on a rigorous evaluation process that includes the collection of client and lawyer evaluations, peer review from leading attorneys in their relevant practice area(s), and a review of additional information provided by law firms as part of the formal submission process. Firms included in the 2014 "Best Law Firms" edition are recognized for professional excellence with persistently impressive ratings from clients and peers. Achieving a ranking signals a unique combination of quality law practice and breadth of legal expertise. Rankings are presented in tiers one through three both nationally and by metropolitan area or by state (with Tier 1 being the highest level). MBHB is ranked in the 2014 edition as follows:

### National Level

- Patent Law (Tier 2)
- Litigation - Intellectual Property (Tier 2)
- Litigation - Patent (Tier 2)
- Biotechnology Law (Tier 3)

### Chicago-Metro Level

- Patent Law (Tier 1)
- Litigation - Patent (Tier 1)
- Litigation - Intellectual Property (Tier 1)
- Biotechnology Law (Tier 1)
- Trademark Law (Tier 3)

Released by U.S. News & World Report and Best Lawyers, the 2014 results include the rankings of more than 11,000 law firms spanning 74 practice areas at the national level and as many as 120 practice areas at the metropolitan level. Lawyer feedback and client feedback are at the heart of the research.

# Experience with the USPTO's First Action Interview Program

(continued from page 7)

told that the applicant and examiner can agree to have the applicant file a supplemental set of proposed amendments and to continue the first action interview after the examiner has a chance to consider those amendments. In our experience, some examiners have agreed to this process, but others have not. In situations where the examiner will not allow submission of supplemental proposed amendments, the applicant then has to respond to the First Action Interview Office Action with the new amendments, rather than have the examiner consider the updated claims in a more timely fashion. Thus, unlike a traditional examiner interview, which usually takes place after the mailing of an office action but before the applicant files a response, the applicant may not be able to file a response that reflects the outcome of the interview until after the next office action is mailed.<sup>22</sup>

Despite these implementation flaws, we still believe that the FAI program is generally beneficial to applicants and worth consideration. While our experience is still somewhat anecdotal at this point, we believe that prosecution time and cost can be reduced by conducting an early interview, because both the applicant and the examiner enter the interview process knowing that the other is

willing to discuss the merits of the application in detail. Also anecdotal is our experience that some applications in which an FAI request is filed seem to be examined more quickly than non-FAI applications. Thus, using the FAI program may be more cost-effective than the Accelerated Examination or Prioritized Examination programs.<sup>23</sup>

Additionally, applications directed to complex technologies may benefit from an early interview so that the applicant has an opportunity to explain the invention to the examiner. Further, applications with relatively focused claims may especially benefit from the program, as the program may help facilitate quicker allowance.

Despite its flaws in execution, the FAI program is still a worthwhile option for applicants seeking early communication with the Office. With no additional Office fees required, filing a Request for First Action Interview with each patent application may become the default for some entities.

## Endnotes

- 1 USPTO, *Full First Action Interview Pilot Program*, [http://www.uspto.gov/patents/init\\_events/faipp\\_full.jsp](http://www.uspto.gov/patents/init_events/faipp_full.jsp), (last accessed Nov. 25, 2013). Earlier versions of the program date back to 2009, but were available only to limited art units.
- 2 *Id.*
- 3 *Id.*
- 4 *Id.*
- 5 *Id.*
- 6 USPTO, *Full First Action Interview Pilot Program Notice*, June 7, 2011,

<http://www.uspto.gov/web/offices/com/sol/og/2011/week23/TOC.htm#ref11>.

- 7 *Id.*
- 8 W. Garber, *Full First Action Interview (FFAI) Pilot Program*, April 26, 2011, at 5, [http://www.uspto.gov/patents/init\\_events/faipp\\_full\\_overview.ppt](http://www.uspto.gov/patents/init_events/faipp_full_overview.ppt).
- 9 *Id.*
- 10 *Id.* at 14.
- 11 According to the Office, this search should be no different from any other prior art search in terms of scope and thoroughness. *Id.* at 7.
- 12 *Id.*
- 13 *Id.* at 8.
- 14 USPTO, *Full First Action Interview Pilot Program Notice*, June 7, 2011, <http://www.uspto.gov/web/offices/com/sol/og/2011/week23/TOC.htm#ref11>.
- 15 Garber, at 8.
- 16 *Id.* at 9.
- 17 USPTO, *Full First Action Interview Pilot Program Notice*, June 7, 2011, <http://www.uspto.gov/web/offices/com/sol/og/2011/week23/TOC.htm#ref11>.
- 18 *Id.*
- 19 *Id.* A further one-month extension is available.
- 20 *Id.*
- 21 Garber, at 14.
- 22 Another possible result is the examiner asking the applicant to file the amendments as a response. In this case, the Office may treat that as a response to a first action on the merits.
- 23 Michael D. Clifford and Michael D. Anderson, "Accelerated Examination v. Prioritized Examination," *Snippets*, vol. 10, no. 1 (Winter 2012).

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## Evolving Data Protection Regimes in the Asia-Pacific Arena and Their Impact on Litigation: Overview of International Policies Governing Cross-Border Data Transfer

By S. Richard Carden

The worldwide expansion of data privacy laws and regulations has impacts that are being felt with increasing regularity in the litigation arena. Whenever data collections occur within foreign corporations or foreign subsidiaries or offices of U.S. corporations, those entities must consider whether there are laws that govern the entity's ability to share that data. Specifically, parties that collect and produce material in a litigation must determine whether they must redact private information from

data prior to production or whether they must notify data subjects of potential production and allow the data subjects the opportunity to object, among other considerations. Given that the broadest definitions of private data include anything that allows identification of a person,<sup>1</sup> and given the vast quantities of data involved in modern patent litigation, the potential burdens to a producing party can be significant. And given that the penalties for improper disclosure are increasingly severe, a party involved in litigation would do well to

fully understand the potential implications of production. No longer should the approach commonly taken in the past of mass collection and production be the norm when data privacy laws are in play.

Much analysis of data privacy issues in recent years has focused on the European Union. However, there have also been significant efforts regarding data protection in the Asia-Pacific region, an area of ever-increasing focus for patent practitioners. This article addresses the role of regional



organizations in developing and enforcing policies, laws and regulations throughout the Asia-Pacific arena, and considers the potential impacts of ongoing national and international efforts to protect the right of privacy. A subsequent article will be presented to address specific national implementations of data privacy laws and the implications for litigation involving Asia-Pacific entities.

## The Role of Regional Organizations in Protecting Data Privacy

While the idea of an individual right to privacy has distant historical origins, the codification of this right and the generation of laws and regulations to protect that right have increased significantly during the past century. A full treatment of the evolution of the right to privacy is beyond the scope of this article, however, a brief historical background is helpful in setting the stage for a discussion of current legislation.

In 1948, Article 12 of the Universal Declaration of Human Rights specifically identified individual privacy as a fundamental human right.<sup>2</sup> Since that time, numerous other international covenants and treaties have recognized the fundamental right to privacy, including among others the International Covenant on Civil and Political Rights,<sup>3</sup> and the Charter of Fundamental Rights of the European Union.<sup>4</sup> Regional economic organizations worldwide have also enumerated principles addressing the right to privacy, and the various member nations of these organizations have adopted or are in the process of adopting domestic policies and implementing legislation providing for the protection of personal data.

### 1. The Organisation for Economic Co-operation and Development ("OECD")

From its origins in 1960, when it was composed of European nations, the U.S. and Canada, the OECD has expanded its membership to include several Asia-Pacific nations, including Australia, Japan and the Republic of Korea.<sup>5</sup> Although not yet members, OECD also has active partnerships with China, India and Russia.<sup>6</sup>

The OECD has long recognized the need for protection of private information, and in 1980 introduced guidelines that would serve as a foundation for much of the privacy law implemented in the past 30 years.<sup>7</sup> The

OECD Guidelines on the Protection of Privacy and Transborder Flows of Personal Data set forth eight basic principles governing privacy protection and the flow of personal information:

(1) collection of personal data should be limited (the Collection Limitation Principle), (2) personal data should be relevant to the purpose for which it is collected, as well as accurate, complete and up-to-date; (the Data Quality Principle), (3) the purposes for collection of private information should be specified at the time of collection (the Purpose Specification Principle), (4) personal information should not be used for unspecified purposes with the consent of the data subject or by authority of law (the Use Limitation Principle),

**Much analysis of data privacy issues in recent years has focused on the European Union. However, there have also been significant efforts regarding data protection in the Asia-Pacific region, an area of ever-increasing focus for patent practitioners.**

(5) personal data should be protected from loss and unauthorized disclosure (the Security Safeguards Principle), (6) policies and practices related to personal data, as well as identifying information regarding the data controller, should be readily available (the Openness Principle), (7) individual data subjects should have the right to obtain their own personal data, challenge the retention of such data, and request erasure or correction of their personal data (the Individual Participation Principle), and (8) measures should exist to ensure data controllers comply with the other principles (the Accountability Principle).<sup>8</sup>

The OECD revised the privacy guidelines in 2013; however, the guiding principles remain the same.<sup>9</sup> The 2013 update focuses on the implementation of programs for managing data privacy, including the creation of enforcement

authorities and provisions for notifying data subjects of breaches of their personal data. Recognizing the efforts of other organizations and countries throughout the world, the revised OECD guidelines invite non-member countries to work with member countries on the implementation of the guidelines.<sup>10</sup> The commentary on the revised guidelines also specifically recognizes the work of the Asia-Pacific Economic Cooperation ("APEC"; discussed in greater detail below) in creating data privacy programs.<sup>11</sup>

In the years between the 1980 guidelines and the 2013 update, the OECD continued to develop its privacy practices, and in 2007 adopted a recommendation regarding cross-border co-operation in the enforcement of privacy laws.<sup>12</sup> In 2011, the OECD reported that the 2007 recommendation had resulted in increased efforts among its member nations to ensure that appropriate protections were given to private data during crossborder transfers.<sup>13</sup>

### 2. APEC

APEC is an intergovernmental organization with 21 member economies, including the United States, Canada, Mexico, Russia, the People's Republic of China, Australia, Japan and the Republic of Korea among others.<sup>14</sup>

Building on the work of the OECD and the European Union, in 2004, APEC adopted its own set of privacy principles.<sup>15</sup> The APEC Privacy Framework<sup>16</sup> recognized the general applicability of the eight core principles of the 1980 OECD Privacy Guidelines, and proffered its own version of those principles while also expanding upon them. The nine APEC privacy principles largely mirror the OECD Guidelines, but introduce two additional concepts. First and foremost among the APEC principles is preventing harm to the individual data subject, a principle only implicit in the OECD Guidelines.<sup>17</sup> The APEC Framework also introduced the principle of individual choice in the collection of personal information.

The Privacy Framework detailed guidelines for international implementation of the principles and called for voluntary implementation of rules enforcing the principles in cross-border transfers of information.<sup>18</sup> Thus, in 2007 APEC began work on a set of Cross-Border Privacy Rules (CBPR's) that would control transfer of private information in APEC member economies.<sup>19</sup> The CBPRs have four governing elements:

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(1) self-assessment of privacy policies by organizations, (2) compliance review by an APEC-recognized Accountability Agent, (3) recognition of organizations that are compliant with the privacy framework, and (4) enforcement and dispute resolution mechanisms.<sup>20</sup> In 2009, APEC again echoed the work of OECD by endorsing its own cross-border privacy enforcement cooperation framework (CPEA), in coordination with the CBPRs.<sup>21</sup> In 2011, APEC endorsed an intake questionnaire for those seeking certification,<sup>22</sup> and shortly thereafter member economies began officially participating in the CBPR system. As of September 2013, 8 member economies were participants in the CBPR/CPEA system. In August 2013, IBM became the first U.S. company certified under the APEC CBPRs.<sup>23</sup> Since that time, Merck and Yodlee have also become APEC privacy certified.<sup>24</sup>

### 3. The Association of Southeast Asian Nations ("ASEAN")

ASEAN is an intergovernmental organization established in 1967 that currently consists of 10 member states, including Singapore, Thailand, Vietnam and the Philippines.<sup>25</sup> While ASEAN currently has no specific data protection policies, the general concept is recognized in the Roadmap for an ASEAN Community 2009-2015.<sup>26</sup> In recent years, the ASEAN communities have been active in implementing national privacy legislation, notwithstanding the lack of an overall set of organizational principles. Since 2010, five

ASEAN members (Malaysia, the Philippines, Singapore, Indonesia and Vietnam) have enacted or partially enacted privacy laws.<sup>27</sup>

## Implications for International Litigation

While much of the consideration of data privacy laws and regulations remains focused on healthcare and Internet commerce, the evolution of data privacy laws potentially has far-reaching implications with respect to litigation involving entities that are based in the Asia-Pacific region or that have subsidiaries or offices in the Asia-Pacific region from which documents must be collected. Regional organizations continue to develop and implement privacy enforcement regimes and procedures for protection of data privacy during cross-border transfers that litigants would be well-advised to consider before collection and production of documents. Moreover, national implementations of data privacy protections now may come with significant non-compliance penalties. A subsequent article will address some of the more significant country specific implementations of data privacy laws and will discuss ways to ensure compliance during litigation productions.

### Endnotes

- 1 For example, the 2013 OECD Privacy Guidelines define personal data as "any information relating to an identified or identifiable individual (data subject)." *Recommendation of the Council concerning Guidelines governing the Protection of Privacy and Transborder Flows of Personal Data (2013) [C(80)58/FINAL, as amended on 11 July 2013 by C(2013)79]*, at Chapter 1, Annex, Definition 1b. Similarly, the APEC Privacy Framework defines personal information as "any information about an identified or identifiable individual." *APEC Privacy Framework, APEC#205-SO-01.2 (2005)*, at 5 ¶ 9.
- 2 UN General Assembly, *Universal Declaration of Human Rights*, 10

- December 1948, 217 A (III), at Article 12.
- 3 UN General Assembly, *International Covenant on Civil and Political Rights*, 16 December 1966, United Nations, Treaty Series, vol. 999, at p. 171, Article 17.
- 4 See, e.g., European Union: Council of the European Union, *Charter of Fundamental Rights of the European Union (2007/C 303/01)*, 14 December 2007, C 303/1, at Articles 7 and 8.
- 5 See OECD's listing of Members and partners, available at <http://www.oecd.org/about/membersandpartners/>.
- 6 *Id.*
- 7 Recommendation of the Council concerning Guidelines governing the Protection of Privacy and Transborder Flows of Personal Data (2013) [C(80)58/FINAL].
- 8 *Id.* at Part 2.
- 9 Recommendation of the Council concerning Guidelines governing the Protection of Privacy and Transborder Flows of Personal Data (2013) [C(80)58/FINAL, as amended on 11 July 2013 by C(2013)79].
- 10 *Id.* at Chapter 1.
- 11 *Id.* at Chapter 2.
- 12 Recommendation of the Council on Cross-border Co-operation in the Enforcement of Laws Protecting Privacy [C(2007)67].
- 13 OECD Report on the Implementation of the OECD Recommendation on Cross-border Cooperation in the Enforcement of Laws Protecting Privacy, 2011, OECD Digital Economy Papers, No. 178, OECD Publishing, available at <http://dx.doi.org/10.1787/5kgdpm9wg9xs-en>.
- 14 See APEC listing of Member Economies, available at <http://www.apec.org/About/Us/About-APEC/Member-Economies.aspx>.
- 15 While the Framework was formally adopted in 2004, work on the Framework continued resulting in a complete formal document in 2005.
- 16 *APEC Privacy Framework, APEC#205-SO-01.2 (2005)*, available at [http://publications.apec.org/publication-detail.php?pub\\_id=390](http://publications.apec.org/publication-detail.php?pub_id=390).
- 17 *Id.* at Part III, APEC Information Privacy Principles, Section I, ¶ 14.
- 18 *Id.* at Part IV, Guidance on Int'l Implementation, Section II, ¶¶ 46-48.
- 19 APEC Cross-Border Privacy Rules System: Policies, Rules and Guidelines, available at <http://www.apec.org/Groups/Committee-on-Trade-and-Investment/-/media/Files/Groups/ECSC/CBPR/CBPR-PoliciesRulesGuidelines.aspx>. The CBPRs are similar in nature to the Binding Corporate Rules used by the European Union to assess compliance with European Data Privacy directives and regulations.
- 20 *Id.* at 4.
- 21 APEC Cooperation Arrangement for Cross-Border Privacy Enforcement, 2010/SOM1/ECSC/DPS/013, available at [http://aimp.apec.org/Documents/2010/ECSC/DPS1/10\\_ecsg\\_dps1\\_013.pdf](http://aimp.apec.org/Documents/2010/ECSC/DPS1/10_ecsg_dps1_013.pdf).
- 22 2011 CTI Report to Ministers, APEC#211-CT-01.5, at Appendix 6.
- 23 See *The Cross Border Privacy Rules System: Promoting consumer privacy and economic growth across the APEC region*, 5 September 2013, available at [http://www.apec.org/Press/Features/2013/0903\\_cbpr.aspx](http://www.apec.org/Press/Features/2013/0903_cbpr.aspx).
- 24 See TRUSTe APEC Privacy web page, available at <http://www.truste.com/products-and-services/enterprise-privacy/apec-accountability>.
- 25 See listing of ASEAN Member States, available at <http://www.aseansec.org/asean-member-states/>.
- 26 Roadmap for an ASEAN Community 2009-15 at 63, Section B-6 ("E-commerce"), available at <http://www.aseansec.org/wp-content/uploads/2013/07/RoadmapASEANCommunity.pdf>.
- 27 See, e.g., Review of e-commerce legislation harmonization in the Association of Southeast Asian Nations, UNCTAD/DTL/STICT/2013/1 at x-xi, available at [http://unctad.org/en/PublicationsLibrary/dtstict2013d1\\_en.pdf](http://unctad.org/en/PublicationsLibrary/dtstict2013d1_en.pdf).

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# The Blurred Lines of Copyright Infringement of Music Become Even Blurrier as the Robin Thicke v. Marvin Gaye's Estate Lawsuit Continues

By Emily Miao, Ph.D. and Nicole E. Grimm

Robin Thicke's massively popular and controversial "Blurred Lines" song has captured much public attention, including the attention of the family of Marvin Gaye who accused Thicke of using elements of Marvin Gaye's song, "Got to Give It Up" in "Blurred Lines" and allegedly threatened litigation if a monetary settlement were not paid.<sup>1</sup> Thicke filed a preemptive declaratory judgment

lawsuit against Gaye's family after alleged preliminary settlement negotiations had failed. Subsequently, Gaye's family filed separate counterclaims in response, accusing Thicke of copyright infringement of Gaye's songs "Got to Give It Up" and "After the Dance," as well as EMI April, Inc. ("EMI") of breach of contract and its fiduciary duties.<sup>2</sup> In this article, we discuss the latest developments in this high-stakes legal fight and the difficulty the

court will have in drawing the line between inspiration and copying in the blurry area of copyright infringement of music.<sup>3</sup>

## Gaye's family launches separate counterclaims against Thicke and EMI

Thicke, along with "Blurred Lines" co-writers Pharrell Williams and Clifford Harris, Jr. (p/k/a

T.I.), filed a declaratory judgment action on August 15, 2013 in the U.S. District Court for the Central District of California in Los Angeles against Gaye's family and Bridgeport Music ("Defendants").<sup>4</sup> The declaratory judgment action requested a ruling that "Blurred Lines" does not infringe on Gaye's "Got to Give It Up" as well as Funkadelic's song "Sexy Ways."<sup>5</sup> The complaint asserts that Defendants alleged that "Blurred Lines" copied their compositions, but that "there are no similarities between plaintiffs' composition and those the claimants allege they own, other than commonplace musical elements."<sup>6</sup> The Plaintiffs allege that they created a hit and did it without copying anyone else's composition. The complaint further asserts:

The basis of the Gaye defendants' claims is that "Blurred Lines" and "Got To Give It Up" "feel" or "sound" the same. Being reminiscent of a "sound" is not copyright infringement. The intent in producing "Blurred Lines" was to evoke an era. In reality, the Gaye defendants are claiming ownership of an entire genre, as opposed to a specific work, and Bridgeport is claiming the same work.<sup>7</sup>

However, Gaye's family disputes Thicke's position. After Thicke filed his preemptive lawsuit against Gaye's family, Frankie Christian Gaye and Nona Marvisa Gaye, and Marvin Gaye III filed separate counterclaims in response, alleging that Thicke's "Blurred Lines" and "Love After War" infringe Gaye's "Got to Give It Up" and "After the Dance," respectfully.<sup>8</sup> In their filings, Gaye's family claims that Thicke's idolization of Marvin Gaye's music has led to a pattern of wholesale copying from Gaye's songs, which in addition to "Blurred Lines" and "Love After War," included Thicke's "Make U Love Me" (allegedly copied from Gaye's "I Want You") and Thicke's "Million Dolla Baby" (allegedly copied from Gaye's "Trouble Man"), though the latter two songs are not at issue in the counterclaims.<sup>9</sup> Gaye's family complains that those tunes "contain substantially similar compositional material in their choruses, including the melodies of their hooks."<sup>10</sup>

In the first set of counterclaims, Frankie Christian Gaye and Nona Marvisa Gaye name several other defendants in addition to Thicke, Williams, and Harris, collectively referred to as the "Blurred Lines Defendants" for infringement of "Got to Give It Up" and the

"Love After War Defendants" for infringement of "After the Dance."<sup>11</sup> Specifically, Count I of Frankie and Nona Gaye's counterclaim alleges that the Blurred Lines Defendants copied at least eight "distinctive and important compositional elements" of "Got to Give It Up."<sup>12</sup> Count II alleges that the Love After War Defendants infringed Gaye's "After the Dance" by copying the chorus and hook, which is allegedly "recognizable by an ordinary observer."<sup>13</sup> Specifically, the counterclaim alleges that both "Love After War" and "After the Dance" share: (1) unusual and distinct harmonies accompanying the hooks; (2) distinct rhythm on the last note of the hooks; and (3) choruses that constitute an unusually large proportion of each song.<sup>14</sup>

Frankie and Nona Gaye further sued third parties Jobete Music Co., EMI, and Sony/ATV Music Publishing Acquisition, Inc. (collectively referred to as "EMI") for breach of contract, breach of the covenant of good faith and fair dealing, and breach of fiduciary duty.<sup>15</sup> Frankie and Nona Gaye countered that EMI,<sup>16</sup> the Sony/ATV-owned song publisher that has a contractual relationship with both sides, failed to protect their interests by attempting to interfere with the Gaye family's pursuit of these claims.<sup>17</sup> In particular, Frankie and Nona Gaye allege that EMI showed such an allegiance to the "Blurred Lines" writers to go so far as to falsely tell the press that Gaye's family turned down a "six figure settlement" offer from Thicke in order to make Gaye's family seem unreasonable.<sup>18</sup> According to Frankie and Nona Gaye, "no such offer was made."<sup>19</sup> Frankie and Nona Gaye, however, subsequently dropped their counterclaims against these third parties.<sup>20</sup>

Marvin Gaye III, the eldest son, filed his own counterclaims to Thicke's preemptive suit naming the same counterclaim defendants as Frankie and Nona Gaye.<sup>21</sup> While Marvin Gaye III also alleged copying of four Gaye songs, like his siblings, his copyright counterclaims are directed against "Blurred Lines" and "Love After War" only.<sup>22</sup> Unlike his siblings' counterclaims, Marvin Gaye III did not allege that EMI breached a contract and its fiduciary duty by failing to protect Gaye's songs.

In addition to monetary damages, Gaye's family seeks a permanent injunction by the court to prohibit the sale, distribution, reproduction, and any public performance of "Blurred Lines" and "Love After War" by the counterclaim defendants.<sup>23</sup>

Thicke filed answers to both Frankie and Nona Gaye's and Marvin Gaye III's counterclaims on December 13, 2013 and December 16, 2013, respectively, mostly denying all of the allegations.<sup>24</sup> In addition, the Plaintiffs have settled the declaratory relief claim against Bridgeport Music, Inc. over the allegation that "Blurred Lines" also infringed George Clinton's song, "Sexy Ways," and Bridgeport is no longer a party to the suit.<sup>25</sup>

Discovery is scheduled to begin in April, 2014, with a three-week jury trial scheduled to begin in January, 2015.<sup>26</sup>

Thus, the Gaye family's counterclaims further complicate the lawsuit by alleging that in addition to "Blurred Lines," Thicke's "Love After War" also infringed Gaye's "After the Dance" song.

## Ninth Circuit's Standard for Copyright Infringement of Music

Thicke's case was filed in the Central District of California and therefore the Ninth Circuit's standard for copyright infringement applies. In order to prove copyright infringement, the plaintiff needs to demonstrate: (a) that it is the owner of a valid copyright, and (b) that protected elements of the copyrighted work were copied by the defendant.<sup>27</sup> Assuming that the plaintiff can demonstrate proper ownership with the copyright registration, the plaintiff must then prove that the defendant copied the work with either direct or circumstantial evidence.<sup>28</sup>

To prove copying with circumstantial evidence, the plaintiff needs to demonstrate: (a) access to the copyrighted work, and (b) substantial similarity between the allegedly infringing work and the copyrighted work.<sup>29</sup> Access to the copyrighted work may be shown by demonstrating that the defendant had actual knowledge of the plaintiff's work or had a "reasonable opportunity" to access the plaintiff's work.<sup>30</sup> For cases involving musical compositions, a plaintiff may have more success proving access through widespread dissemination of its work by presenting evidence such as record sales or radio performances.<sup>31</sup>

Courts in the Ninth Circuit have applied an "Inverse Ratio" rule with respect to circumstantial evidence.<sup>32</sup> That is, the more access the defendant had to the copyrighted work, the less similarity must be shown to

*(continued on page 12)*

# The Blurred Lines of Copyright Infringement of Music Become Even Blurrier as the Robin Thicke v. Marvin Gaye's Estate Lawsuit Continues

(continued from page 11)

prove copying has occurred.<sup>33</sup> The Ninth Circuit has also clarified that a court does not need to apply a “substantially similar” analysis when there is direct evidence that the defendant duplicated the plaintiff’s entire work.<sup>34</sup>

The inquiry into whether two musical works are substantially similar depends on the facts of each case.<sup>35</sup> In determining whether two musical works are substantially similar, the Ninth Circuit employs a two part analysis: (1) an objective “extrinsic” test, and (2) a subjective “intrinsic” test.<sup>36</sup> The extrinsic test is applied by the judge, and typically relies on testimony from musicologist experts to establish substantial similarity.<sup>37</sup> If substantial similarity of ideas is found under the extrinsic test, summary judgment is precluded and the case moves before a jury who applies the intrinsic test.<sup>38</sup>

While many courts have identified criteria for analyzing a musical composition, the Ninth Circuit has never announced a set of criteria under the extrinsic test since “a musical composition can be comprised of a number of otherwise unprotectable elements, including lyrics, rhythm, pitch, cadence, melody, harmony, tempo, phrasing, structure, chord progression, instrumental figures, and others.”<sup>39</sup> Without expressly delineating the extrinsic elements of musical works, the Ninth Circuit acknowledged that it would be difficult for the lower courts to apply the extrinsic test.<sup>40</sup>

When the copying of unprotectable musical elements is in dispute, the Ninth Circuit has also applied a *scenes a faire* analysis.<sup>41</sup> Under U.S. copyright law, the doctrine of *scenes a faire* provides that “when certain commonplace expressions are indispensable and naturally associated with the treatment of a given idea, those expressions are treated like ideas and therefore not protected by copyright.”<sup>42</sup> The court’s *scenes a faire* analysis is not dependent on whether or not the plaintiff copied the prior work.<sup>43</sup> Instead, the court must explore whether “‘motive’ similarities that plaintiffs attribute

to ‘copying’ could actually be explained by the commonplace presence of the same or similar motives within the relevant field.”<sup>44</sup> In order for the court to grant summary judgment on *scenes a faire* alone and without independent evidence, the *scenes a faire* allegation must be uncontested.<sup>45</sup>

Yet, the Ninth Circuit has found that the combination of unprotectable elements

**Is “Blurred Lines” a product of inspiration or is it a derivative of Gaye’s song? With muddled precedent in the Ninth Circuit, the Court will need to address this difficult question, and will undoubtedly rely on the opinions of musical experts.**

in a musical work may support a finding of substantial similarity.<sup>46</sup> For example, in *Three Boys Music Corp. v. Bolton*, the Ninth Circuit upheld the jury’s finding that two songs were substantially similar due to the presence of the same five individually unprotectable elements: “(1) the title hook phrase (including the lyric, rhythm, and pitch); (2) the shifted cadence; (3) the instrumental figures; (4) the verse/chorus relationship; and (5) the fade ending.”<sup>47</sup>

Here, it appears that Thicke, Williams, and Harris will argue that a high falsetto voice, vocal and musical layering and beat are common unprotectable elements, that “Blurred Lines” was intended to be a tribute to an era, and that being reminiscent of a “sound” is not copyright infringement.<sup>48</sup>

However, Gaye’s family has honed in on Thicke’s admission that he was inspired by Marvin Gaye and was quoted in GQ as stating: Pharrell and I were in the studio and I told him that one of my favorite songs of all time was Marvin Gaye’s ‘Got to Give It Up.’ I was like, ‘Damn, we should make something like that, something with that groove.’ Then he started playing a little something and we literally wrote the song in about a half hour and recorded it.<sup>49</sup>

Courts in the Ninth Circuit may consider such statements as an admission of Thicke’s access to Gaye’s music, or evidence of subconscious copying.<sup>50</sup>

While no direct copying is involved since there was no actual sampling or literal copying of Gaye’s music and lyrics, there are audible similarities between “Blurred Lines” and “Got to Give it Up.” The question is whether these similarities are protectable elements of Gaye’s song and if so, whether these protectable elements were appropriated in “Blurred Lines” such that the works are substantially similar. Case law supports that appropriation of even a few notes from a copyrighted song may be enough to establish copyright infringement.<sup>51</sup>

The lawsuit raises issues related to the idea/expression dichotomy of copyright law, namely that copyright protects the expression of an idea but not the idea itself. That is, a copyright protecting Gaye’s song would not protect those portions of the song that are common; it protects only those parts of the song that are original to Gaye.<sup>52</sup> Since the requirement is one of substantial similarity to protected elements of the copyrighted work, the trier of fact must first distinguish between the protected original, expressive elements and unprotectable commonplace material in plaintiff’s work.<sup>53</sup> Once these specific protected elements in Gaye’s song have been identified, the trier of fact must then determine whether “Blurred Lines” substantially appropriated these protected elements of Gaye’s song such that the works are substantially similar.

## The Case will turn on the Expert Opinion Reports

Courts in the Ninth Circuit will determine the reliability of a musicologist's expert report by considering the way in which the expert analyzes the similarities and differences between songs. Courts may find a report less credible if the musicologist highlights the few similarities and downplays the many differences between two songs.<sup>54</sup> Courts are likely to find an expert's report more credible if the expert explains his or her methodology.<sup>55</sup> However, courts will not require that a musical expert also be a legal expert, and will not derive legal meaning from an expert's use of the terms "musical idea" or "idea" within the report.<sup>56</sup>

In their counterclaims, Frankie and Nona Gaye quoted several leading music critics from *The New York Times*, *Vice*, *Rolling Stone*, and *Bloomberg Businessweek* who remarked on the similarities between Thicke's hit and Gaye's song.<sup>57</sup> Gaye's family asserts that the similarities between the two songs "are the result of many of the same creative choices . . . , far surpassing the similarities that might result from attempts to evoke an 'era' of music or a shared genre."<sup>58</sup>

Gaye's family further included an expert report by musicologist Judith Finell, which points to multiple parallels in the two songs. According to the report, "Blurred Lines" contains "a constellation of at least eight substantially similar features" with Gaye's "Got to Give It Up": (1) the signature phrase; (2) hooks; (3) hooks with backup vocals; (4) the core theme in "Blurred Lines" and the backup hook in "Got to Give It Up"; (5) backup hooks; (6) bass melodies; (7) keyboard parts; and (8) unusual percussion choices.<sup>59</sup> Additionally, according to the report, both songs share "departures from convention such as the unusual cowbell instrumentation, omission of guitar and use of male falsetto."<sup>60</sup> The Finell report did not comment as to the similarity between Thicke's "Love After War" and Gaye's "After the Dance."

Other expert opinions contradict Finell's report. In a statement to *Hollywood Reporter*, Thicke's attorney made reference to other expert opinions of three musicologists as well as EMI's musicologists to support that the Gaye family's claims are baseless.<sup>61</sup> Those musicologists apparently opined that "[t]he genres of the songs are the same but the notes

are different," supporting Thicke's allegation that no infringement has occurred.<sup>62</sup>

## Conclusion

Is "Blurred Lines" a product of inspiration or is it a derivative of Gaye's song? With muddled precedent in the Ninth Circuit, the Court will need to address this difficult question, and will undoubtedly rely on the opinions of musical experts. Writing something "with that groove," or consistent with the sounds of a particular genre, will likely fall closer to a product of "inspiration." That is, any similarities between the songs could be due to elements that are naturally associated when composing a song in a particular style or genre of music.<sup>63</sup> On the other hand, if the Court finds that "Blurred Lines" and "Love After War" share a protectable combination of unprotectable elements with "Got to Give It Up" and "After the Dance," infringement may be found.

Whether Thicke's "Blurred Lines" and "Love After War" are a product of inspiration or a derivative of Gaye's work will depend on the evidence that is presented to the fact-finder in this case. The evidence will inevitably be supported by contradictory expert reports from both sides, which will make this an interesting case to follow. Stay tuned for more updates.

## Endnotes

- 1 Interestingly, Gaye's Family allegedly declined to accept Thicke's six-figure settlement offer. See Alex Pharm, *Marvin Gaye's Family Rejected Robin Thicke's Six-Figure Offer*, BILLBOARD.COM (Aug. 23 2013; 10:30 AM), <http://www.billboard.com/articles/news/5672505/marvin-gayes-family-rejected-robin-thicke-six-figure-offer>.
- 2 Defendants' Frankie Christian Gaye and Nona Marviva Gaye First Amended Counterclaims at ¶¶ 4–9, *Williams v. Bridgeport Music, Inc.*, No. 13-06004 (C.D. Cal. Oct. 30, 2013) [hereinafter "Counterclaim"].
- 3 For our previous analysis of this case, see Emily Miao & Nicole E. Grimm, *The Blurred Lines of What Constitutes Copyright Infringement of Music: Robin Thicke v. Marvin Gaye's Estate*, 20 WESTLAW J. INTELLECTUAL PROP. 1 (2013) (originally published in the Fall 2013 edition of MBHB'S SNIPPETS).
- 4 Complaint for Declaratory Relief, *Williams v. Bridgeport Music, Inc.*, No. 13-06004 (C.D. Cal. Aug. 15, 2013) [hereinafter "Complaint"].
- 5 *Id.* at ¶¶ 15, 20.
- 6 *Id.* at ¶ 1.
- 7 *Id.* at ¶ 2.
- 8 Counterclaim at ¶¶ 34, 51.
- 9 See Counterclaim at ¶ 8; Defendant Marvin Gaye III's Counterclaim; Demand for Trial of Causes by Jury at ¶ 5, *Williams v. Bridgeport Music, Inc.*, No. 13-06004 (C.D. Cal. Nov. 19, 2013) [hereinafter "Counterclaim Marvin Gaye III"].
- 10 Counterclaim at ¶ 58.
- 11 Thicke, William, Harris, Stark Trak Entertainment ("Stark Trak"), Interscope Records, UMG Recordings, Inc. ("Universal"), and Universal Music Distribution ("UMD"), collectively "Blurred Lines Defendants," were sued for copyright infringement of "Got to Give It Up." See Counterclaim at Count I. Thicke, Paula Maxine Patton, individually and d/b/a/ Haddington Music, Stark Trak, Geffen Records, Universal, and UMD, collectively "Love After War Defendants" were sued for copyright infringement of "After the Dance." See Counterclaim at Count II.
- 12 Counterclaim at ¶ 79.
- 13 Counterclaim at ¶ 99–100. Marvin Gaye III also filed an answer to Thicke's complaint on November 19, 2013. See Defendant Marvin Gaye III's Answer and Affirmative Defenses to Plaintiffs' Complaint; Jury Demand, *Williams v. Bridgeport Music, Inc.*, No. 13-06004 (C.D. Cal. Nov. 19, 2013).
- 14 See Counterclaim at ¶ 60, see also Counterclaim Marvin Gaye III at ¶ 18.
- 15 Counterclaim at ¶¶ 121–39.
- 16 Although the Gaye family holds the rights to the two Gaye songs in question, EMI apparently controls the administration and protection of their copyrights. Counterclaim at ¶ 9. EMI is also a co-publisher of

Williams's work and thus co-owns "Blurred Lines." See Eriq Gardner, *Marvin Gaye's Family Sues EMI Over Robin Thicke's 'Blurred Lines'*, BILLBOARD.COM (Oct. 30, 2013; 3:25 PM), <http://www.billboard.com/articles/news/5770731/marvin-gayes-family-sues-emi-over-robin-thicke-blurred-lines>. Sony-ATV is half-owned by Michael Jackson's estate. See Alan Duke, *Marvin Gaye Heirs Sue 'Blurred Lines' Artists*, CNN.COM (Nov. 1, 2013; 11:04 AM), <http://www.cnn.com/2013/10/31/showbiz/blurred-lines-lawsuit/>.

- 17 Frankie and Nona Gaye allege that, despite EMI's fiduciary obligation to raise claims against copyright infringers, EMI refused to bring such claims against the "Blurred Lines" composers due to EMI's business relationship with Williams. Joint Rule 16(b) at p. 4. Of the six causes of action listed in Frankie and Nona Gaye's Counterclaim, four are directed toward EMI: Count III: breach of covenant of good faith and fair dealing; Count IV: breach of fiduciary duty; Count V: breach of contract; and Count VI: recession. See Counterclaim at ¶¶ 113–139. According to Frankie and Nona Gaye's counterclaim, EMI's alleged misconduct includes: (1) failure to identify claims on Gaye's copyrights; (2) "instructing its litigation attorney to intimidate the Gaye Family from filing an action by antagonistically warning that any lawsuit would be frivolous," despite admitting that there were similarities between "Got to Give It Up" and "Blurred Lines"; (3) refusing to bring counterclaims after reviewing a musicologist's report; (4) failing to remain neutral in light of a conflict of interest by showing bias towards the "Blurred Lines" composers; (5) refusing to assign the rights to the Gaye Family to raise counterclaims; and (6) explicitly advising the Gaye Family not to pursue counterclaims. *Id.* at ¶ 10.
- 18 *Id.*
- 19 *Id.*
- 20 Voluntary Notice of Dismissal of Counterclaim Against EMI Third-Party Defendants, *Williams v. Bridgeport Music, Inc.*, No. 13-06004 (C.D. Cal. Jan. 13, 2014).
- 21 Counterclaim Marvin Gaye III at ¶ 1.
- 22 *Id.* at ¶¶ 36–53, 54–72.
- 23 See Counterclaim at ¶¶ 88–91, 109–112; Counterclaim Marvin Gaye III at ¶¶ 50–53, 68–72.
- 24 See Answer to Defendants Frankie Christian Gaye and Nona Marviva Gaye's Counterclaims; Request for Jury Trial, *Williams v. Bridgeport Music, Inc.*, No. 13-06004 (C.D. Cal. Dec. 13, 2013); Answer to Defendant Marvin Gaye III's Counterclaims; Request for Jury Trial, *Williams v. Bridgeport Music, Inc.*, No. 13-06004 (C.D. Cal. Dec. 16, 2013).
- 25 Joint Rule 16(b) Report at p. 2 n.1, *Williams v. Bridgeport Music, Inc.*, No. 13-06004 (C.D. Cal. Dec. 6, 2013).
- 26 Joint Rule 16(b) Report at p. 12, Exhibit A, *Williams v. Bridgeport Music, Inc.*, No. 13-06004 (C.D. Cal. Dec. 6, 2013).
- 27 See *Feist Publications, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 361 (1991).
- 28 See *Straughter v. Raymond*, No. CV 08-2170 CAS, 2011 WL 3651350, at \*8 (C.D. Cal. Aug. 19, 2011).
- 29 See *Swirsky v. Carey*, 376 F.3d 841, 844 (9th Cir. 2004).
- 30 See *Jason v. Fonda*, 526 F. Supp. 774, 776 (C.D. Cal. 1981), *aff'd*, 698 F.2d 966 (9th Cir. 1982).
- 31 See, e.g., *Acuff-Rose Music, Inc. v. Jostens, Inc.*, 988 F. Supp. 289, 293 (S.D.N.Y. 1997), *aff'd*, 155 F.3d 140 (2d Cir. 1998) (finding a reasonable opportunity of access by the defendant due to evidence that the plaintiff's song was ranked as a top five country hit at the time the defendant composed the song, showing that the defendant had "ample opportunity" to view the plaintiff's lyrics).
- 32 See *Straughter*, 2011 WL 3651350, at \*13.
- 33 *Id.*
- 34 See *Range Road Music, Inc. v. East Coast Foods, Inc.*, 668 F.3d 1148, 1154 (9th Cir. 2012).
- 35 *Straughter*, 2011 WL 3651350, at \*13.
- 36 See *Swirsky*, 376 F.3d at 845.
- 37 See *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 485 (9th Cir. 2000).
- 38 See *Smith v. Jackson*, 84 F.3d 1213, 1218 (9th Cir. 1996) ("[T]he subjective 'intrinsic test' asks whether an 'ordinary, reasonable observer' would find a substantial similarity of expression of the shared idea.").
- 39 *Straughter*, 2011 WL 3651350, at \*13.
- 40 See *Swirsky*, 376 F.3d at 848 (internal citations omitted).
- 41 In French, the saying *Scène à faire* refers to "scene to be made" or "scene that must be done." See *Swirsky*, 376 F.3d at 849–50.
- 42 *Id.* at 850.
- 43 *Smith*, 84 F.3d at 1219.
- 44 *Swirsky*, 376 F.3d at 850.
- 45 *Id.*
- 46 See *Three Boys Music Corp.*, 212 F.3d at 485 (upholding the jury's finding of copyright infringement because the two songs both had a combination of five unprotectable musical elements). Other circuits agree with the Ninth Circuit on this rule. See, e.g., *Hobbs v. John*, 722 F.3d 1089, 1093 (7th Cir. 2013) ("[T]here is a wealth of authority recognizing that, in certain situations, a unique arrangement of individually unprotectable elements can form an original expression entitled to copyright protection.").
- 47 *Id.* at 485.
- 48 Complaint at ¶ 2.

(continued on page 14)

# The Blurred Lines of Copyright Infringement of Music Become Even Blurrier as the Robin Thicke v. Marvin Gaye's Estate Lawsuit Continues

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- 49 See Stelios Phili, *Robin Thicke on That Banned Video, Collaborating with 2 Chainz and Kendrick Lamar, and His New Film*, GQ.com (May 7, 2013; 1:20 AM), <http://www.gq.com/blogs/the-feed/2013/05/robin-thicke-interview-blurred-lines-music-video-collaborating-with-2-chainz-and-kendrick-lamar-mercy.html>; see also Counterclaim at ¶5. But Thicke may have recanted this statement after initiating the lawsuit when he responded to a TMZ reporter:  
"Q: So, so, when you, when you wrote ['Blurred Lines'], do you like think of Marvin Gaye like when you write the music?  
A: No."  
See *Marvin Gaye Family Sues Robin Thicke: Admitted 'Blurred Lines' Is A Rip-Off*, TMZ.com (Oct. 30, 2013; 11:45 AM), <http://www.tz.com/2013/10/30/marvin-gaye-family-kids-robin-thicke-blurred-lines-counter-lawsuit>. Thicke's interview on TMZ occurred on Sept. 25, 2013; see also Counterclaim at ¶ 6.
- 50 See *Three Boys Music Corp.*, 212 F.3d at 484 (in upholding the district court's finding of Bolton's subconscious copying due to the Isley Brother's widely disseminated music, noted that "Bolton confessed to being a huge fan of the Isley Brothers and a collector of their music.").
- 51 See *Baxter v. MCA, Inc.*, 812 F.2d 421, 425 (9th Cir. 1987) ("Even if a copied portion be relatively small in proportion to the entire work, if qualitatively important, the finder of fact may properly find substantial similarity."); *Elsmere Music, Inc. v. Nat'l Broad. Co., Inc.*, 482 F. Supp. 741, 744 (S.D.N.Y. 1980), *aff'd sub nom.*, 623 F.2d 252 (2d Cir. 1980) (finding that copying four notes, which were considered a significant part of the musical composition, was "capable of rising to the level of copyright infringement").
- 52 See *Swirsky*, 376 F.3d at 845 ("Because the requirement is one of substantial similarity to protected elements of the copyrighted work, it is essential to distinguish between the protected and unprotected material in a plaintiff's work.").
- 53 See *id.*
- 54 See *Straughter*, 2011 WL 3651350, at \*16 ("The Ninth Circuit has held that 'lists of similarities are inherently subjective and unreliable, especially where they emphasize random similarities scattered throughout the works.'") (quoting *Olson v. Nat'l Broad. Co.*, 855 F.2d 1446, 1450 (9th Cir. 1988)).
- 55 See *Swirsky*, 376 F.3d at 853.
- 56 See *Straughter*, 2011 WL 3651350, at \*15 ("The Ninth Circuit has held that "a musicologist is not an expert on what the term 'idea' means under the copyright laws. Labeling something as a 'musical idea' does not

necessarily bear on whether it is also an 'idea' under the copyright laws and unprotectable for that reason.").

57 Counterclaim at ¶ 7. The Counterclaim cites to these interviews as evidence to support the Defendants' position that the ordinary observer would appreciate and recognize that composition elements of "Got to Give It Up" were copied into "Blurred Lines." *Id.*

58 Counterclaim at ¶ 37.

59 Counterclaim. Expert report at ¶ 43.

60 *Id.*

61 Eriq Gardner, *'Blurred Lines' Lawsuit: Marvin Gaye [sic] Family Now Claims Robin Thicke Stole Two Songs (Exclusive)*, HOLLYWOODREPORTER.COM (Oct. 30, 2013; 10:56 AM), <http://www.hollywoodreporter.com/thr-esq/blurred-lines-lawsuit-marvin-gaye-651427>.

62 *Id.*

63 See *Swirsky*, 376 F.3d at 845.

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