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## Foreword

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# FOREWORD

*Misa Eiritz<sup>†</sup> and Allison A. Schmitt<sup>††</sup>*

The Annual Review is a yearly publication of the *Berkeley Technology Law Journal* that provides a summary of many of the major developments at the intersection of law and technology. Our aim is to provide a valuable resource for judges, policymakers, practitioners, students, and scholars. Each Note provides a primer on a particular area of law, a development in that area of law, and commentary on that development.

The twenty-two Notes in this issue continue a tradition of covering a wide range of topics. The Notes address developments in traditional intellectual property areas—patent, copyright, and trademark law—along with developments in cyberlaw and privacy. Following the Notes in each area of law, we have included a Survey of Additional IP Developments, which contains brief descriptions of important cases that were not addressed in the Notes.

## I. PATENT LAW

Our first Note<sup>1</sup> in the Patent Law Section examines the promise of transparent patent ownership and reviews the United States Patent and Trademark Office (“PTO”)’s now-abandoned Attributable Ownership rulemaking.<sup>2</sup> In light of the failure of that proposal, this Note also examines alternative legislative proposals and recommends the adoption of a two-tiered disclosure system that would better balance the costs and benefits of ownership transparency requirements.

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1. Nathan P. Anderson, Note, *Striking a Balance: The Pursuit of Transparent Patent Ownership*, 30 *BERKELEY TECH. L.J.* 395 (2015).

2. Changes to Require Identification of Attributable Owner, 79 Fed. Reg. 4105, 4106 (Jan. 24, 2014) (considered for codification at 37 C.F.R. pt. 1; currently abandoned).

The second Note<sup>3</sup> examines the Supreme Court's ruling in *Nautilus, Inc. v. Biosig Instruments, Inc.*,<sup>4</sup> focusing on how the decision advances a “duty of clarity” in patent prosecution with its observation that “[e]liminating that temptation [to claim ambiguously] is in order.”<sup>5</sup> The Note critiques suggested approaches for improving clearer claiming and proposes the use of crowdsource-assisted examination as an additional approach to improve clearer claiming.

The third Note<sup>6</sup> explores both statutory and procedural changes made to Section 337 proceedings at the International Trade Commission (“ITC”), and finds that these adjustments have maintained the ITC's role enforcing a distinct set of trade-related patent rights in an evolving global landscape of intellectual property enforcement. Through recent procedural adjustments, the ITC has avoided becoming a haven for non-practicing entities' patent hold-up attempts, while continuing to provide at-the-border protection against unfair competition in imported goods.

The fourth Note<sup>7</sup> examines the evolution of three new patent validity procedures ushered in by the America Invents Act (“AIA”)<sup>8</sup> over the past two years. The AIA reviews combine a one-year statutory timeline, lower costs, and more favorable standards for challengers; however, the compressed timeline and streamlined evidentiary procedures raise concerns that the new procedures treat patent owners unfairly. This Note assesses whether the AIA reviews afford patent owners a fair opportunity to defend their patents by analyzing the most common practitioner complaints, addressing constitutional and administrative law concerns, and drawing upon prior judicial challenges to PTO patent validity proceedings to conclude that the AIA reviews likely dodge these concerns.

The fifth Note<sup>9</sup> analyzes domestic patent subject matter eligibility in the wake of recent Supreme Court<sup>10</sup> and Federal Circuit<sup>11</sup> decisions,

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3. Norris Boothe, Note, *Exercising a Duty of Clarity: Nautilus, Inc. v. Biosig Instruments, Inc.*, 30 BERKELEY TECH. L.J. 445 (2015).

4. 134 S. Ct. 2120, 2124 (2014).

5. *Id.* at 2129.

6. Joshua D. Furman, Note, *Reports of Section 337's Death Have Been Greatly Exaggerated: The ITC's Importance in an Evolving Patent Enforcement Environment*, 30 BERKELEY TECH. L.J. 489 (2015).

7. Ryan J. Gatzemeyer, Note, *Are Patent Owners Given a Fair Fight? Investigating the AIA Trial Practices*, 30 BERKELEY TECH. L.J. 531 (2015).

8. Leahy-Smith America Invents Act, Pub. L. 112-29; 125 Stat. 284 (2011).

9. Eneida Hoxha, Note, *Stemming the Tide: Stem Cell Innovation in the Myriad-Mayo-Roslin Era*, 30 BERKELEY TECH. L.J. 567 (2015).

10. *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (2012); *Ass'n for Molecular Pathology v. Myriad Genetics*, 133 S. Ct. 2107 (2013).

particularly as it applies to stem cells. It also examines the potential effects these decisions will have on stem cell industries, both at home and abroad.

The sixth Note<sup>12</sup> examines the legal landscape for fee-shifting in exceptional cases following the Supreme Court's ruling in *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*<sup>13</sup> This note considers emerging trends post-*Octane Fitness* based on an empirical analysis of attorneys' fees granted under 35 U.S.C. § 285 post-*Octane Fitness* and discusses district determinations of "exceptional."

The seventh Note<sup>14</sup> asserts that the Supreme Court's decision in *Limelight Networks, Inc. v. Akamai Technologies, Inc.*<sup>15</sup> leaves a loophole in patent infringement law open with respect to divided infringement and multi-actor method patents. This Note examines emerging technologies where the doctrine of divided infringement is most relevant, taking into consideration the Supreme Court's recent decisions in *Mayo Collaborative Services v. Prometheus Laboratories*<sup>16</sup> and *Alice Corp. v. CLS Bank International*,<sup>17</sup> and explores alternatives to the current law of divided infringement.

The eighth Note<sup>18</sup> reviews the chronological development of the patent landscape and analyzes the evolution of defensive patent strategies. This Note presents defensive "plays" used by organizations to overcome webs of overlapping patent rights, the threat of non-practicing entities, and the increasing trend towards patent monetization.

The ninth Note<sup>19</sup> explores how the Supreme Court continued in *Medtronic, Inc. v. Mirowski Family Ventures, LLC*<sup>20</sup> the task, begun in *MedImmune, Inc. v. Genentech, Inc.*,<sup>21</sup> of bringing patent law declaratory judgments into line with other legal fields, despite the Federal Circuit's

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11. *In re Roslin Inst.*, 750 F.3d 1333, 1336 (Fed. Cir. 2014).

12. Hannah Jiam, Note, *Fee-Shifting and Octane Fitness: An Empirical Approach Toward Understanding "Exceptional,"* 30 BERKELEY TECH. L.J. 611 (2015).

13. 134 S. Ct. 1749 (2014).

14. Jingyuan Luo, Note, *Shining the Limelight on Divided Infringement: Emerging Technologies and the Liability Loophole*, 30 BERKELEY TECH. L.J. 675 (2015).

15. 134 S. Ct. 2111 (2014).

16. 132 S. Ct. 1289 (2012).

17. 134 S. Ct. 2347 (2014).

18. James M. Rice, Note, *The Defensive Patent Playbook*, 30 BERKELEY TECH. L.J. 725 (2015).

19. Sorin G. Zaharia, Note, *Burden of Proof in Medtronic: The Federal Circuit's Idiosyncratic Patent Jurisprudence Vetoed, Again*, 30 BERKELEY TECH. L.J. 777 (2015).

20. 134 S. Ct. 843 (2014).

21. 549 U.S. 118 (2007).

efforts to the contrary. While the Court's "simple legal logic"<sup>22</sup> partly relies on a historical quirk, the result in *Medtronic* was unavoidable in view of longstanding legal precedent, practical considerations and public policy. Yet, *Medtronic's* full impact will be seen only if and when the Court settles the tug-of-war between contract law and federal patent policy, in particular the issue of non-repudiating licensee estoppel.

The tenth Note<sup>23</sup> surveys how different courts and commentators have interpreted the Supreme Court's recent *Alice Corp. v. CLS Bank, International*<sup>24</sup> decision regarding patent-eligible subject matter and have applied this decision when evaluating software patents. Further, this Note proposes that the purpose of the patent-eligible subject matter exceptions is accomplished by finding that additional claim limitations reciting specifics of how a piece of software accomplishes a patent-ineligible abstract idea confer patentability, even if the additional claim limitations are themselves patent-ineligible abstract ideas.

## II. COPYRIGHT LAW

The first Note<sup>25</sup> explores two recent European Court of Justice cases<sup>26</sup> in an attempt to highlight how EU copyright laws place a higher burden on online intermediaries, like ISPs, to stop and prevent copyright infringement than what is required under U.S. copyright law. The Note contemplates how the high level of copyright protection in the EU creates higher legal uncertainties and compliance costs for online intermediaries in the EU than in the United States, and examines how more successful lobbying efforts by copyright holders may have been a factor.

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22. *Medtronic*, 134 S. Ct. at 849.

23. Ognjen Zivojnovic, Note, *Patentable Subject Matter after Alice—Distinguishing Narrow Software Patents from Overly Broad Business Method Patents*, 30 BERKELEY TECH. L.J. 807 (2015).

24. 134 S. Ct. 2347 (2014).

25. Ali Amirmahani, Note, *Digital Apples and Oranges: A Comparative Analysis of Intermediary Copyright Liability in the United States and European Union*, 30 BERKELEY TECH. L.J. 865 (2015).

26. Case C-466/12, Nils Svensson v. Retriever Sverige AB (Feb. 13, 2014), available at <http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62012CJ0466&from=EN>; Case C-314/12, UPC Telekabel Wien GmbH v. Constantin Film Verleih GmbH (Mar. 27, 2014), available at <http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62012CJ0314&from=EN>.

The second Note<sup>27</sup> examines the recent Supreme Court decision in *American Broadcasting Companies, Inc. v. Aereo, Inc.*,<sup>28</sup> where the Court rested its holding on Aereo's similarity to cable, the technology to which Congress responded when crafting the current public performance right. Despite the Court's narrow focus, the case may significantly impact the contours of copyright doctrine in many contexts.

The third Note<sup>29</sup> uses the recent high-profile *Marvel Characters, Inc. v. Kirby*<sup>30</sup> case to examine the instance and expense test, which is the works made for hire determinant under the 1909 Copyright Act. The Note concludes that while the instance and expense test does grant broad access of works to the public, the test's inherent flaws routinely harms creators and a proposed statutory amendment would help remedy existing inequities.

The fourth Note<sup>31</sup> examines how the Supreme Court overruled the Ninth Circuit in *Petrella v. Metro-Goldwyn-Mayer, Inc.*<sup>32</sup> to rule that the defense of laches is not available for copyright infringement suits for legal relief brought within the Copyright Act's three-year statute of limitations, thereby weakening an important safeguard of fairness in copyright law. The Court's decision—possibly an overreaction to the particular, sympathetic facts of the case—will likely result in a chilling effect in creative industries and new uncertainty for potential defendants as the door opens for plaintiffs to bring belated copyright lawsuits.

### III. TRADEMARK LAW

The first Note<sup>33</sup> in the Trademark Law Section discusses the Tenth Circuit's decision in *1-800-Contacts v. Lens.com*<sup>34</sup> and proposes that the ruling made succeeding on a claim of trademark infringement through initial interest confusion in a competitive keyword-advertising case almost

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27. Dallas T. Bullard, Note, *The Revolution Was Not Televised: Examining Copyright Doctrine after Aereo*, 30 BERKELEY TECH. L.J. 899 (2015).

28. 134 S. Ct. 2498 (2014).

29. Meredith Annan House, Note, *Marvel v. Kirby: A Clash of Comic Book Titans in the Work Made for Hire Arena*, 30 BERKELEY TECH. L.J. 933 (2015).

30. 726 F.3d 119 (2d Cir. 2013).

31. Jordyn Ostroff, Note, *Petrella v. Metro-Goldwyn-Mayer, Inc.: Is Equity in Copyright Law Down for the Count?*, 30 BERKELEY TECH. L.J. 965 (2015).

32. 134 S. Ct. 1962 (2014).

33. John Benton Russell, Note, *New Tenth Circuit's Standards: Competitive Keyword Advertising and Initial Interest Confusion in 1-800 Contacts v. Lens.com*, 30 BERKELEY TECH. L.J. 993 (2015).

34. 722 F.3d 1229 (10th Cir. 2013).

impossible in the Tenth Circuit. Despite previously finding infringement in this type of case if the competitive keyword advertising could merely divert consumers, the new ruling reflects an evolution in internet-based trademark doctrine by focusing instead on evidence of actual confusion—including defendant-friendly Google data.

The second Note<sup>35</sup> discusses the *Lexmark International, Inc. v. Static Control Components, Inc.*<sup>36</sup> test for federal false advertising standing and how it serves the Lanham Act's goal of protecting persons engaged in commerce against unfair competition better than the previous tests. The Note concludes that the *Lexmark* text is not perfect. The zone-of-interests prong, which requires that § 43(a) plaintiffs allege an injury to a commercial interest in reputation or sales, appropriately identifies parties within the class of plaintiffs the Lanham Act was intended to protect, but the proximate cause prong may unduly burden certain plaintiffs by requiring detailed pleadings establishing that the defendant's false advertising proximately caused its injury.

#### IV. CYBERLAW

The first Note<sup>37</sup> in the Cyberlaw Section discusses the sharing economy, which encompasses a broad range of peer-to-peer services. This new business model poses many regulatory challenges, and requires targeted legislative and administrative solutions.

The second Note<sup>38</sup> explores how Bitcoin and Blockchain technology pose a number of novel regulatory and legal issues. This Note examines how government agencies and courts have attempted to keep the society safe for—and sometimes from—Bitcoin and Blockchain users (with consumers and investors on one end and drug dealers, terrorists, and violent criminals on the other). The Note concludes with policy suggestions for changes to disclosure requirements and tax classifications to facilitate the broader adoption of Bitcoin as a currency by the general public.

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35. Virginia E. Scholtes, Note, *The Lexmark Test for False Advertising Standing: When Two Prongs Don't Make a Right*, 30 BERKELEY TECH. L.J. 1023 (2015).

36. 134 S. Ct. 1377 (2014).

37. Vanessa Katz, Note, *Regulating the Sharing Economy*, 30 BERKELEY TECH. L.J. 1067 (2015).

38. Misha Tsukerman, Note, *The Block is Hot: A Survey of the State of Bitcoin Regulation and Suggestions for the Future*, 30 BERKELEY TECH. L.J. 1127 (2015).

## V. PRIVACY LAW

The first Note<sup>39</sup> in the Privacy Law Section explores the European Union's recent "right to be forgotten" ruling,<sup>40</sup> which raises vital questions about free speech and privacy as the internet cements its importance in modern life. While a right to be forgotten may be useful for specific problems like nonconsensual pornography and criminal rehabilitation, this Note argues that in the United States, a blanket rule like the one in the EU raises numerous policy concerns and cannot be squared with the country's strong free speech right.

The second Note<sup>41</sup> discusses Delaware's recently enacted legislation<sup>42</sup> that provides for fiduciary access to assets that exist in digital form at the death of the owner. This Note proposes that in order to combat conflicting terms of service in service providers' user agreements, a necessary complement to this new law is a combined legislative and user-policy plan that assesses and respects users' individualized wishes for their digital assets.

The third Note<sup>43</sup> in this Section considers the California appeals court ruling in *Digital Music News v Superior Court*,<sup>44</sup> where the court ruled for the first time that the right to post anonymous online comments is grounded both in the First Amendment of the federal Constitution, but also in the 'privacy clause' of the California Constitution. This Note situates *Digital Music News* in the larger scholarly and judicial conversation about anonymous online speech, arguing that the court's reasoning is representative of a new way of thinking about online speech where the First Amendment and the right to privacy do not always work at cross purposes. It also provides detailed discussion of the origins of the California constitutional right to privacy, the state of First Amendment

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39. Ravi Antani, Note, *The Resistance of Memory: Could the European Union's Right to Be Forgotten Exist in the United States?*, 30 BERKELEY TECH. L.J. 1173 (2015).

40. Case C-131/12, *Google Inc. v. Mario Costeja González* ¶ 94, available at <http://curia.europa.eu/juris/document/document.jsf?docid=152065&doclang=en> (May 13, 2014).

41. Elizabeth Holland Capel, Note, *Conflict and Solution in Delaware's Fiduciary Access to Digital Assets and Digital Accounts Act*, 30 BERKELEY TECH. L.J. 1211 (2015).

42. Fiduciary Access to Digital Assets and Digital Accounts Act, H.B. 345, 147th Gen. Assemb. (Del. 2014), available at <http://www.legis.delaware.gov/LIS/LIS147.NSF/vwLegislation/HB+345>.

43. Thaddeus Houston, Note, *Constitutional Drag Race: Anonymous Online Speech After Digital Music News v. Superior Court*, 30 BERKELEY TECH. L.J. 1243 (2015).

44. *Digital Music News v. Super. Ct. of L.A. Cnty.*, 171 Cal. Rptr. 3d 799, 809 (May 14, 2014).



doctrine as it applies to anonymous online speakers, and *Digital Music News* itself.

The final Note<sup>45</sup> in this Section examines the recent Supreme Court decision in *Riley v. California*,<sup>46</sup> where the Court addressed the issue of “whether the police may, without a warrant, search digital information on a cell phone seized from an individual who has been arrested.”<sup>47</sup> In 2011, noted Fourth Amendment scholar Orin Kerr hypothesized that the Supreme Court decides Fourth Amendment cases with an eye to maintaining a balance between police power and individual rights initially established by the Framers; Kerr calls this theory Equilibrium-Adjustment.<sup>48</sup> This Note applies Kerr’s theory to *Riley* in order to illustrate three main limitations on his theory: (1) the application of the theory varies based on the analyst, making the theory too broad to provide much insight, (2) the current balance between police power and individual rights that the Court attempts to restore is difficult to define; one jurisdiction’s equilibrium may be another’s imbalance, and (3) the theory fails to account for profit-minded third parties that may cause a sudden shift in societal norms in a way that neither introduces a new crime nor practice yet still upsets the equilibrium.

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45. Maya Ziv, Note, *Riley v. California, Can You Hear the Equilibrium Now?*, 30 BERKELEY TECH. L.J. 1283 (2015).

46. 134 S. Ct. 2473 (2014).

47. *Id.* at 2480.

48. Orin Kerr, *An Equilibrium-Adjustment Theory of the Fourth Amendment*, 125 HARV. L. REV. 476 (2011).