



# IP Literature Watch

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Associates

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This newsletter contains an overview of recent publications concerning intellectual property issues. The abstracts included below are as written by the author(s) and are unedited.

## IP & Antitrust

### **Colluding Against a Patent**

Gregory Day (University of Georgia – C. Herman and Mary Virginia Terry College of Business)  
W. Michael Schuster (University of Georgia – C. Herman and Mary Virginia Terry College of Business)  
*Wisconsin Law Review, Forthcoming*

[https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3799477](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3799477)

The patent system fosters innovation by granting the right to exclude. Since a rightsholder can legally suppress competition and charge monopoly prices, a patent provides a type of antitrust immunity. Even when firms allegedly abuse their exclusive rights through the creation of patent thickets, meritless infringement litigation, or breaching one's FRAND commitment, courts and federal agencies have concluded that antitrust is ill-equipped to discipline patent practices. Without antitrust remedies, firms have banded together against rightsholders to negotiate for better terms. Their strategies have included boycotting abusive patentees as well as collectively negotiating against them. By using self-help remedies, they seek to pay fair rates for only the patents needed for their technology. This type of cooperation may ideally foster competition and innovation where patent abuses undermine both goals. The problem is, ironically, that combining against a monopolist is likely anticompetitive. Antitrust condemns collusion to manipulate prices—here, licensing rates—even when done against a monopolist. This renders a troubling outcome where “Big Pharma,” “Big Tech,” and others can insulate their monopoly power using the very laws meant to condemn monopolies. While debate has emerged about patent abuses, an equally salient issue involves whether antitrust should condemn firms who collude against patent holders and monopolists.

Using economic and historical evidence, this Article argues that antitrust should allow firms to defend an antitrust claim by citing their rival's market power. Our models show that powerful rightsholders do in fact harm competition and innovation in ways not meant to protect original technology. We then find that the benefits of collusion among smaller firms were advanced by the Sherman Act's drafters whose comments are critical to shaping and understanding modern antitrust. Support even comes from the labor arena: Congress excluded workers from antitrust law—as labor unions were once considered a form of collusion—so that workers, with their own market power, could counterbalance their employers' dominance with their own market power. As such, given the practical and theoretical difficulties of remedying anticompetitive abuses of patent rights under the antitrust laws, we assert that taking antitrust out of patent law would allow competition to flourish in dynamic markets while enhancing the patent system's incentives to innovate.

## **Antitrust Limits on Patent Settlements: A New Approach**

Erik Hovenkamp (University of Southern California School of Law)

Jorge Lemus (University of Illinois Urbana Champaign)

*Journal of Industrial Economics* (forthcoming 2021)

[https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3823315](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3823315)

Patent settlements between rivals restrain competition in many different ways. Antitrust requires that their anticompetitive effects are reasonably commensurate with the firms' expectations about (counterfactual) patent litigation. Because these expectations are private and non-verifiable, this standard is hard to administer; to date, it has been successfully applied only within a very narrow class of agreements. We show that it can be applied universally by policing the economic structure of the firms' contract. This approach determines whether settlement outcomes will be antitrust-compliant for any private beliefs the firms might have, thus avoiding the need to speculate about such beliefs.

## **IP & Licensing**

### **The Use and Abuse of Anti-suit Injunctions in SEP Litigation: Is There a Way Forward?**

Damien Geradin (Tilburg Law and Economics Center (TILEC); Geradin Partners; University of East

Anglia (UEA) – Centre for Competition Policy; University College London – Faculty of Laws)

Dimitrios Katsifis (Geradin Partners)

*Working Paper*

[https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3807899](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3807899)

Cross-border litigation over Standard Essential Patents (“SEPs”) entered into a new phase when the English courts decided in *Unwired Planet v Huawei* they have the power to set the terms of a global license within the context of national patent infringement proceedings. *Unwired Planet* appears to have unleashed a global race to the bottom and a race to the courthouse, with litigants racing to seize their preferred forum to set global rates while trying to prevent their opponent from bringing proceedings elsewhere through “anti-suit injunctions”, a type of relief traditionally granted by common law jurisdictions, but now increasingly so by other jurisdictions such as China. Yet this is now rarely the end of the matter, with litigants applying for anti-anti-suit injunctions or even anti-anti-anti-suit injunctions.

The purpose of this paper is to explore the new realities in SEP litigation post-*Unwired Planet*, with a focus on the use of anti-suit injunctions and the corresponding turf war between national courts. After discussing the legal test for granting such relief in various legal systems, the paper discusses the worrying proliferation of anti-suit injunctions across major jurisdictions, noting how this trend wastes judicial resources and may undermine international comity. It considers that in the absence of some form of international coordination, a satisfactory solution is unlikely to emerge in the short term. As a first step, it proposes that governments consider establishing “best practices” on SEP licensing dispute resolution, including on jurisdictional issues such as the scope of licenses fashioned by national courts.

### **A Framework For Evaluating Willingness of FRAND Licensees**

Jorge L. Contreras (University of Utah – S.J. Quinney College of Law)

*Law360*, (2021)

*University of Utah College of Law Research Paper No. 442*

[https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3810703](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3810703)

An increasing number of cases around the world turn on whether a manufacturer of a product – e.g., a smartphone, a tablet or a car -- (an “implementer”) is willing to pay a “fair, reasonable and nondiscriminatory” (FRAND) royalty for patents that are essential to an industry standard embodied in that product (standards-essential patents or SEPs). This determination is important both to the analysis

of the appropriateness of an injunction under the 4-factor eBay test in the U.S., and for assessing the appropriateness of injunctive relief under the Huawei v. ZTE competition law case in the EU. This essay explores the significance of “willingness” in the FRAND context primarily from a U.S. perspective, and offers a new legal framework for evaluating an implementer’s “willingness” to accept a license on FRAND terms. In doing so, it identifies conduct that typically indicate willingness or unwillingness, as well as an intermediate range of conduct that should be viewed as indeterminate -- subject to classification only after additional conduct has been observed. It is hoped that this framework will assist courts and parties in systematically and consistently analyzing implementer behavior when disputes over FRAND terms arise.

## IP & Innovation

### **Social Value of Patents: Evidence from the U.S. Court of Appeals for the Federal Circuit**

Yun Hou (National University of Singapore)

Ivan P. L. Png (National University of Singapore (NUS))

Xi Xiong (New York University (NYU), Department of Economics)

*Working Paper*

[https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3828299](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3828299)

To encourage invention, society awards inventors exclusive rights through patents. Patent law trades off incentives to invent new technologies against reduced access to already invented technology. However, patent law being national, it is difficult to investigate the trade off without confound by national economic and scientific changes. We exploit a unique quasi-natural experiment which changed patent law sub-nationally, within the United States. Beginning 1982, the Court of Appeals for the Federal Circuit shifted law in favor of patent owners, to degrees varying geographically by judicial circuit. For businesses in complex technology industries, we find that the CAFC increased costs to users by more than US\$5.6 billion per year, but did not significantly affect the technological quality of patented inventions. Our work contributes to a more nuanced appreciation of socially optimal patent law. Shifting the law in favor of patent owners, a policy to encourage innovation, seemed to increase economic rents without commensurate effect on invention quality.

### **Intellectual Property and Tabletop Games: A Case Study in Law and Innovation**

Christopher B. Seaman (Washington and Lee University School of Law)

Thuan Tran (Washington and Lee University School of Law)

*Iowa Law Review, Forthcoming*

[https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3828070](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3828070)

There is a rich body of literature regarding intellectual property’s (IP) “negative spaces”—fields where creation and innovation thrive without significant formal protection from intellectual property law. Scholars have written about innovation in diverse fields despite weak or nonexistent IP rights, such as fashion design, fine cuisine, stand-up comedy, magic tricks, tattoos, and sports plays. Instead, these fields rely on social norms, first-mover advantage, and other (non-IP) legal regimes to promote innovation in the absence of IP protection.

As a comparison, this Article explores the role of IP law in promoting innovation in tabletop gaming, including board games, card games, and pencil-and-paper role-playing games. Over the past few decades, the tabletop gaming industry has seen a proliferation of innovation. But surprisingly, there is almost nothing in the academic literature about IP law and tabletop games. IP rights, including patents, copyrights, and trademarks, each protect certain aspects of games, while at the same time being constrained by doctrinal limitations that leave considerable flexibility for others to develop their own games and improve upon existing ones. There are also numerous examples of user-based innovation in

tabletop gaming. This Article concludes by contending that IP rights, as well as their limitations, play a significant role in driving innovation in the tabletop gaming industry.

### **Artificial Intelligence and Intellectual Property Law – Position Statement of the Max Planck Institute for Innovation and Competition of 9 April 2021 on the Current Debate**

Josef Drexl, Reto Hilty, Luc Desautettes-Barbero, et al. (Max Planck Institute for Innovation and Competition)

*Max Planck Institute for Innovation & Competition Research Paper No. 21-10*

[https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3822924](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3822924)

This Position Statement presents a broad overview of issues arising at the intersection of AI and IP law based on the work of the Max Planck Institute for Innovation and Competition research group on Regulation of the Digital Economy. While the analysis is approached mainly from a perspective de lege lata, it also identifies questions which require further reflection de lege ferenda supported by in-depth interdisciplinary research. The scope is confined to substantive European IP law, in particular, as regards copyright, patents, designs, databases and trade secrets. Specific AI-related issues are mapped out around the core questions of IP law, namely, the eligibility for protection under the respective IP regimes, allocation of rights and the scope of protection. The structure of the analysis reflects three key components of AI: inputs required for the development of AI systems, AI as a process and the output of AI applications. Overall, it is emphasised that, while recent legal and policy discussions have mostly focused on AI-aided and AI-generated output, a more holistic view that accounts for the role of IP law across the AI innovation cycle is indispensable.

## **IP Law & Policy**

### **Patent Law's Deference Paradox**

Paul R. Gugliuzza (Temple University – James E. Beasley School of Law)

*Minnesota Law Review, Vol. 106, forthcoming*

[https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3819782](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3819782)

Courts frequently defer to the decisions of administrative agencies, particularly when the decision is thoroughly deliberated and within the agency's realm of technical and legal expertise. Conversely, when an agency gives little thought to a matter or brings no special knowledge to bear, the agency gets little or no deference. Patent law, however, does it backwards. The decision of a single examiner at the Patent Office to grant a patent—a decision made under significant time pressure and with incentives skewed in the applicant's favor—receives substantial deference when the patent's validity is later challenged in court as a defense to an infringement lawsuit. Issued patents are, by statute, presumed to be valid, so the challenger must prove the patent is invalid by clear and convincing evidence. But when a panel of expert administrative judges at the Patent Office has reassessed the validity of an issued patent in trial-like, adversarial proceedings, a de novo standard of review often applies when the Patent Office's decision is appealed to the Federal Circuit.

This article identifies and critiques patent law's deference paradox, under which the Patent Office's least deliberate decisions receive the most judicial deference and its most deliberate decisions get the least deference. Two reforms would eliminate this paradox. First, the presumption of validity should be weakened by the courts or eliminated by Congress. Second, the Supreme Court and the Federal Circuit should stop describing patent validity as a question of law, which is what causes the Patent Office's validity rulings to be reviewed de novo on appeal. Instead, those courts should hold that an invention's patentability is a mixed question of law and fact because it mainly involves applying the law to the facts of a particular case.

These changes would meaningfully improve the patent system. Doctrinally, they would simplify patent law's deference framework by granting all of the Patent Office's patentability determinations the same, sliding-scale deference under the Supreme Court's decisions in *Skidmore v. Swift & Co.* and *United States v. Mead*. As a matter of policy, this framework would better reflect how the patent system actually works: Initial examination is perfunctory, so examiners' decisions to grant patents should be closely scrutinized when a defendant accused of patent infringement argues, in court, that the patent is invalid. Post-issuance administrative review at the Patent Office, on the other hand, is increasingly elaborate and now often substitutes for court litigation over patent validity, so the Office should receive deference when its expert administrative judges have reassessed the validity of an issued patent and either confirmed or canceled it.

Importantly, these reforms are realistic. The Supreme Court's most recent decision on the standard of proof for patent invalidity in litigation, despite reaffirming the clear and convincing evidence standard, actually gives lower courts significant leeway to weaken the presumption of validity. As for the Patent Office, though a *de novo* standard of review remains on the books, recent Federal Circuit decisions are taking the first steps toward a more deferential approach by cautiously recognizing the fact-driven nature of many patent validity determinations.

### **Issuing and Tailoring Patent Injunctions – A Cross-Jurisdictional Comparison and Synthesis**

Jorge L. Contreras (University of Utah – S.J. Quinney College of Law)

Martin Husovec (London School of Economics – Law Department; Stanford University - Stanford Law School Center for Internet and Society)

*Injunctions in Patent Law: A Trans-atlantic Dialogue on Flexibility and Tailoring* (Jorge L. Contreras and Martin Husovec, Editors, Cambridge University Press, Forthcoming)

University of Utah College of Law Research Paper No. 436

[https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3814049](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3814049)

This chapter is from the edited volume “Injunctions in Patent Law: A Trans-Atlantic Dialogue on Flexibility and Tailoring” (Jorge Contreras & Martin Husovec, eds., Cambridge Univ. Press, forthcoming). It offers a unique analytical synthesis of eleven national and two regional/international descriptions of flexibilities in patent remedies authored by leading scholars in the field. This synthesis identifies a range of similarities and differences among jurisdictions, explains the principal features of these different legal systems, provides an analytical framework for comparing them, and offers observations about trends and the outlook for the future. The countries studied include Canada, Finland, France, Germany, Israel, Italy, Netherlands, Poland, the United Kingdom, and the United States, with additional commentary on the European Union and the World Trade Organization TRIPS Agreement.

### **A Cross-Jurisdictional Analysis of the “Person Skilled in the Art” (PSITA)/ “Person Having Ordinary Skill in the Art” (PHOSITA) standard under Patent laws**

Esha Gupta (O.P. Jindal Global University)

*Working Paper*

[https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3828594](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3828594)

This research paper demonstrates a cross-jurisdictional analysis of the “Person Skilled in the Art” (PSITA) / “Person Having Ordinary Skill in the Art” (PHOSITA) standard under Patent laws. In order to receive a grant of a patent, it is necessary for the invention to be “novel”, have an “inventive step” and be capable of “industrial application”. It is also necessary for the invention to be sufficiently disclosed in the patent application. All the above-mentioned factors are judged by a hypothetical legal construction, i.e. the PSITA/PHOSITA. However, each jurisdiction has set its own standard for the PSITA/PHOSITA, leading to differential patenting standards across all the jurisdictions.

Therefore, this research paper aims to do a comparison in the skill standard of the PSITA/PHOSITA in India, U.S.A and U.K. This topic is of great importance as it is a neglected area in the field of Patent law. The aim is to find out which jurisdiction has set the most favorable skill standard which should be followed by others as well. The outcome of the research paper is that the skill standard set by India is the most logical as they have set a higher standard to assess the Inventive step and have diluted the standard when it comes to disclosure requirements. Further, developing a uniform skill standard to be followed by all jurisdictions should also be strongly considered.

### **Nonobviousness: Before and After**

Dmitry Karshedt (George Washington University – Law School)

*106 Iowa Law Review (forthcoming 2021)*

[https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3820851](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3820851)

The requirement of nonobviousness, codified in 35 U.S.C. § 103, has been called “the ultimate condition of patentability” because of its crucial function of keeping technically trivial inventions out of the patent system. The obviousness determination must be made based on the state of the invention’s field at a particular point in time—in the Patent Act’s current version, the date that the patent application was effectively filed with the U.S. Patent and Trademark Office (PTO).

However, in spite of the critical role of time in patent law and the danger that hindsight bias could distort the § 103 analysis when patentability is evaluated long after the relevant date (as it usually is), the seminal Supreme Court obviousness opinion in *Graham v. John Deere* said little about temporal considerations. Instead, *Graham*’s lasting contribution was to suggest that the § 103 inquiry is to be divided into two stages based on the source of the proffered evidence. The Court said that as an initial matter, the PTO or a court should look to pre-patent publications and other materials in the public domain and determine the differences between those disclosures and the patent claim at issue. Further, should the parties introduce additional evidence that the Court called “secondary considerations,” such as commercial success of the patented product or failure of others to come up with the claimed invention, decision-makers would need to continue the analysis to determine the relevance and weight of this evidence before making a final judgment on validity. Although courts and commentators disagree vigorously about the relative roles of these two aspects of the nonobviousness calculus, the primary-secondary framework has a central place in the law of § 103.

This Article shows that *Graham*’s apparent creation of two tiers of obviousness evidence has caused confusion and error, and should be rejected in favor of a different approach that is focused on time. First, the rigid segmenting of the patentability inquiry into two steps, which is seen in some lower-court decisions interpreting *Graham*, has caused certain evidence to be arbitrarily discounted or bolstered depending on whether it falls into the primary or secondary silo. Second, and more pernicious, these evidentiary tiers have obscured the significance of time for patentability. This Article argues that, instead, the filing date of the patent application as the default dividing line between the pre- and post-invention state of the relevant field provides a more logical fulcrum around which to organize the § 103 analysis. Accordingly, obviousness evidence should be classified based on whether it came into existence independently of the patent and generally prior to filing (*ex ante*) or, instead, whether it appeared in response to the invention or during its further, post-filing, development (*ex post*). This Article demonstrates that the proposed scheme would pave the way to a more rational approach to § 103 by helping decision-makers determine the relevance and weight of various obviousness evidence with greater accuracy.

## The Supreme Court's Chief Justice of Intellectual Property Law

Robert W. Gomulkiewicz (University of Washington – School of Law)

*Nevada Law Journal*, Vol. 22, 2022 Forthcoming

[https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3822741](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3822741)

Justice Clarence Thomas is one of the most recognizable members of the United States Supreme Court. Many people recall his stormy Senate confirmation hearing and notice his fiery dissenting opinions which call on the Court to reflect the original public meaning of the Constitution. Yet observers have missed one of Justice Thomas's most significant contributions to the Court—his intellectual property law jurisprudence. Justice Thomas has authored more majority opinions in intellectual property cases than any other Justice in the Roberts Court era and now ranks as one of the most prolific authors of patent law opinions in the history of the Supreme Court. Thus, at a time when intellectual property has become one of America's most important assets, Justice Thomas has played an important role in the evolution of America's innovation law and policy.

This article is the first to highlight the significance of Justice Thomas's intellectual property jurisprudence. It considers how Justice Thomas emerged as the Roberts Court's "chief justice" of intellectual property law, authoring more majority opinions than even colleagues known for their intellectual property law prowess. The article analyzes Justice Thomas's key intellectual property opinions to understand their importance. It also highlights the distinguishing features of these opinions, including their faithful adherence to textualism, appreciation for the role of remedies, attention to technological and business context, awareness of the impact on intellectual property practitioners, and surprising unanimity. The article concludes that Justice Thomas's deep respect for the constitutional separation of powers is at the heart of his intellectual property jurisprudence, as his opinions invite and sometimes nudge Congress to play its leading role in crafting intellectual property law.

## Copyright Law

### Copyright Term Extension: Good Morning to You Productions v Warner/Chappell Music

Giancarlo Frosio (Université de Strasbourg – CEIPI; Stanford University – Stanford Law School Center for Internet and Society)

*in Enrico Bonadio and Aislinn O'Connell (eds.), Intellectual Property Excesses (Hart Publishing, Forthcoming)*

[https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3822018](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3822018)

This chapter focuses on a widely reported case related to the famous folk song 'Happy Birthday to You'. Written in the late 19th century, the tune was held in copyright by a series of amendments and statutory actions which rendered the world's most popular song unable to fall into the public domain. This Southern District of New York case allows the chapter to ponder the ever-lengthening copyright term (most commonly life + 70) and point out the absurdity of protecting a work for over a century. Term extension and copyright complexities upset the fair balancing of interests that is taken into consideration by traditional welfare incentive theory when regulating intellectual property rights. Copyright extension and expansion lead to commodification of intellectual assets, which, at least in case of retroactive copyright extension, find no justification in welfare incentive theory and economic analysis of law. Derangement from this theoretical approach, and from proportional balancing of competing interests at stake, then, increasingly exacerbates the 'intellectual property paradox' by eroding access and emphasizing protection, while creating a vast array of negative externalities, including depriving the public of the 'public domain effect', orphan works, and chilling effects on free speech. In sum, overextended—and overexpanded—copyright protection fundamentally detaches modern copyright policy from its pristine civic purposes and anti-monopolistic sentiments.

## **A Public Service Role For Digital Libraries: The Unequal Battle Against (Online) Misinformation Through Copyright Law Reform And The Emergency Electronic Access To Library Material**

Argyri Panezi (IE Law School; Stanford PACS Center, Digital Civil Society Lab)

*Forthcoming, 31 CORNELL J.L. & PUB. POL'Y \_\_ (2021)*

[https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3813320](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3813320)

This article analyzes the role of copyright doctrine and case law in preserving the institutional function of libraries—both on- and offline—as trusted and, in principle, neutral hubs equalizing access to credible information and knowledge in societies with structural inequalities. In doing so it examines the ongoing *Hachette v. Internet Archive* litigation before the US District Court of the Southern District of New York in the context of earlier copyright cases, finding that there is a persistent need for electronic access to library material online.

Libraries have traditionally served an important role as reserved spaces for legally permissible distribution of books outside of markets. Copyright law, however, has the potential to hinder the function of libraries and other cultural heritage institutions particularly in equalizing access to knowledge. While there exist some exceptions and limitations that partially alleviate this, their applicability in the digital environment is still contested. Two novel challenges are interfering: first, an unmet and contentious need for emergency access to electronic library material to be granted online, and second, the need to counteract historical biases and misinformation, both of which multiply when spread within a hyper-connected and digitized society. In order to ensure electronic access to credible information and knowledge, policymakers must address these challenges strategically and reassess the needs of subjects and institutions that are currently subject to copyright exceptions.

*Hachette v. Internet Archive* follows a string of copyright cases that involved challenges to digitization without permission and to providing electronic access to digitized library material. The plaintiffs in *Hachette v. Internet Archive*, four publishers, brought copyright claims against the Internet Archive for the latter's operation of a "National Emergency Library" within the context of the COVID-19 pandemic. The case introduces a new dimension to existing debates around electronic access to library material, particularly around e-lending, raising the question: Can emergencies justify additional exceptions to copyright laws covering electronic access to library material, and if so, under what circumstances?

After analyzing the relevant settled case law and the ongoing litigation against the Internet Archive and then looking back into the history of and rationale for copyright laws, the article advances a normative claim—that copyright should provide better support to libraries and digital libraries in particular (broadly defined) as the institutional safeguards of our literary treasures. Libraries have a public service mandate to preserve, curate, and provide access to a plurality of original and authoritative sources, and thus ultimately aspire not to compete in the marketplace but to become trusted hubs that equalize access to knowledge. In the context of a society currently struggling to fight historical biases and (online) misinformation, providing libraries with the legal support needed to fulfill this mandate will enable them to more effectively safeguard and provide equal access to (at least relatively) credible information and knowledge, including in the digital environment.

## **Who Controls COVID-Related Medical Data? Copyright And Personal Data**

Michael Birnhack (Tel Aviv University – Buchmann Faculty of Law)

*International Review of Intellectual Property and Competition Law (Forthcoming, 2021)*

[https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3827413](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3827413)

Who controls big medical data of relating to COVID-19 vaccines? The January 2021 Real-World Epidemiological Evidence Collaboration Agreement between Pfizer and the Israeli Ministry of Health highlights the interrelationship between two modes of protecting data: data protection law and copyright

law. The former provides legal protection to data subjects and limits the data controller, but generally speaking, allows the data to be processed for the benefit of public health; the latter awards the databases' controller with rights regarding the dataset, a control which may hinder others' access to highly important data. This editorial unpacks this relationship.

Under the Agreement, the Ministry shares “aggregate project data” with Pfizer, meaning “any de-identified data.” “Project data” are owned by the MoH or Israeli Health Maintenance Organizations. The data are about millions of people from a variety of sources and are used as they are collected. Combining copyright law and the obligations imposed by data protection law, pushes the parties to protect data under both copyright law and additional layers of protection, such as trade secret law. This result means that other parties may have access to outcomes but not to raw data. To facilitate broad access to crucial data during a global health crisis, we need to address both bodies of law in an integrated manner.

### **Google v. Oracle and the Grateful (API) Dead: What a Long Strange Trip Its Been**

Peter S. Menell (University of California, Berkeley – School of Law)

DAILY JOURNAL (Forthcoming)

[https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3824442](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3824442)

The battle over intellectual property protection for computer software has raged for more than four decades. The most significant issue has been whether copyright protection constrains the ability of competitors and innovators to develop interoperable products. This commentary discusses the Supreme Court's decision in *Google v. Oracle*, which goes a long way toward establishing that the functional specifications of computer software can be reimplemented without violating copyright law.

### **Google v. Oracle: When Innovation Overwhelmed Copyright Law**

Carlos Muñoz Ferrandis (Max Planck Institute for Innovation and Competition; University of Alicante)

*Working Paper*

[https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3821548](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3821548)

The US Supreme Court Decision on *Google v. Oracle* (*Google LLC v. Oracle America, Inc.*, US Supreme Court, No. 18–956) may well be one of the most prominent decisions of the decade, with regards to copyright law and software (and broadly, to innovation and IP laws).

As the author states: “This story is about changing times, about an era where a constant and voracious pace of innovation is overwhelming legal systems, and in this case, copyright law”. More precisely, the US ‘fair use’ framework is instrumentalized by the judges aiming at achieving a much needed equilibrium between copyright law and the use of specific software features, such as API-related code (i.e. declaring code) crucial for interoperability purposes. Notwithstanding the complexity of the case and the considerable merits of such a decision, the price to pay to achieve the outcome of the case was an exceptional instrumentalization of the ‘fair use’ framework.

## Other Topics

### **Exploring the Aspects of Need of Patenting**

Vikash Kumar (Galgotias University)

*Working Paper*

[https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3823525](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3823525)

As the world is at its peak of technological development and there are multiple discoveries are taking place every day. Companies and even startups are inventing and coming up with new technologies. If

we see from the commercial or economic point of view patents play a prominent role for companies and startups to establish in the market. The new ideas and inventions are the hard work of the inventor and that needs to be protected against infringement. Inventions come under Intellectual Property Rights and the best way to protect an invention is to patent it. This paper begins with an analysis as to why there is a need to patent. This paper also focuses on several different aspects that lead to the importance and need to patent the invention. The main focus of the paper is to make the readers understand the need for patenting in simple language. And make everyone aware of the importance of patents. The result contributes to a better understanding of the need for patenting.

### **Fight or Surrender to Counterfeiters: Litigation as a Response to Trademark Infringement**

Shreekanth Mahendiran (University of Lausanne)

Chirantan Chatterjee (Indian Institute of Management, Ahmedabad)

Anthony J. Dukes (University of Southern California – Marshall School of Business)

D. Daniel Sokol (University of Florida Levin College of Law)

*Working Paper*

[https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3817945](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3817945)

This research explores the role of trademark litigation as a deterrent strategy against counterfeiters in markets where government trademark enforcement is weak. Litigation can convey to potential counterfeiters that a trademark-holding firm would sue upon entry. We explore this idea empirically in the context of pharmaceutical trademarks in India using the framework of a stylized theoretical model. We construct a database of trademarks and examine litigation activity by certain trademark-holders. Our findings indicate that litigation reduces subsequent counterfeiting. Because litigation can be extremely costly for a trademark-holding firm, it is worthwhile only when it has legal advantages in pursuing cases. Not all trademark-holding firms have such legal advantages and are, therefore, better off surrendering to infringers and incurring a cycle of settlements with future counterfeiters.

### **Race, Glass Ceilings, and Lower Pay for Equal Work**

Deepak Hegde (New York University (NYU) – Leonard N. Stern School of Business)

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*NYU Stern School of Business, Forthcoming*

[https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3811410](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3811410)

Using detailed administrative data that allow us to hold gender, education, productivity, timeliness, and work quality constant, we document that minority patent examiners at the U.S. patent office face substantial glass ceilings and pay gaps. The promotion gap relative to White examiners averages 24.3% for Blacks, 10.5% for Hispanics, and 4.5% for Asians, with Black examiners 41.7% less likely than Whites to be promoted to the highest rank. Consistent with statistical discrimination, we find that the promotion gap for senior Black examiners halves around Obama's 2008 election win and that greater exposure to successful minority examiners affects managers' promotion decisions positively. We show that promotion gaps have adverse effects on the services the patent office provides to inventors and society.

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