



7th Annual Texas A&M Intellectual Property Scholars Roundtable

FINAL PROGRAM

FRIDAY, NOVEMBER 3, 2023

8:30 Breakfast

9:00 Welcoming Remarks

Dean Robert B. Ahdieh, Anthony G. Buzbee Endowed Dean's Chair, Texas A&M University School of Law and Vice President for Professional Schools and Programs, Texas A&M University

9:15 Panel 1: Copyright Law

Moderator: Prof. H. Brian Holland, Texas A&M University School of Law

Presenters: Prof. Timothy J. McFarlin, Cumberland School of Law, Samford University
"How State Law Could Repair the Past and Change the Future of U.S. Copyright"

Dr. Emma Perot, Faculty of Law, University of the West Indies, St. Augustine (Trinidad and Tobago)

"Music Copyright Ownership: Factors Behind the Increase in Writer Credits and Rights Clearance"

Prof. Zvi S. Rosen, Southern Illinois University School of Law
"Who Framed Mickey Mouse"

Prof. Guy A. Rub, Michael E. Moritz College of Law, Ohio State University
"Reimagining Digital Lending"

11:00 Coffee Break

11:15 Panel 2: Patent Law

Moderator: Prof. Lucas S. Osborn '00, Campbell University School of Law

Presenters: Prof. Nikola Datzov, University of North Dakota School of Law
“Predictable Unpredictability” (with Jason Rantanen)

Prof. Timothy T. Hsieh, Oklahoma City University School of Law
“The History and Legacy of Judge Ronald Whyte’s Local Patent Rules”

Prof. Karen E. Sandrik, Willamette University College of Law
“More Genus Claim Vulnerability? How *Amgen v. Sanofi* Enables New PTAB Challenges”

Prof. V.K. Unni, Indian Institute of Management Calcutta (India)
“Standard Essential Patents, Anti-Suit Injunctions and Jurisdictional Rivalry—The Need for Judicious Approach”

Prof. Saurabh Vishnubhakat, Benjamin N. Cardozo School of Law, Yeshiva University
“Credible Commitment and New Major Questions: The Patent Office as a Case Study”

1:15 Lunch

2:15 Panel 3: Global IP Issues

Moderator: Prof. Doris E. Long, University of Illinois Chicago School of Law

Presenters: Prof. Robert Hu, St. Mary’s University School of Law
“Apology as Intellectual Property Remedy in China: A Preliminary Examination of American Litigation Experiences”

Prof. Eric E. Johnson, University of Oklahoma College of Law
“Competition Among Nations, National Patent Laws, and Global Context”

Prof. Lucas S. Osborn '00, Campbell University School of Law
“Christianity and IP”

3:45 Coffee Break

4:00 Panel 4: Trademark Law

Moderator: Prof. Marshall Leaffer, Indiana University Maurer School of Law

Presenters: Prof. Rachael Dickson, Suffolk University Law School
“High Hopes: Cannabis Trademarks at the USPTO”

Prof. Barbara Lauriat, Texas Tech University School of Law
“Borrowing Goodwill”

Prof. Andrew C. Michaels, University of Houston Law Center
“Confusion in Trademarked NFTs”

5:30 Roundtable Adjourns for the Day
7:00 Dinner for Roundtable Participants

Waters
301 Main Street, Fort Worth

SATURDAY, NOVEMBER 4, 2023

8:30 Breakfast

9:15 Panel 5: Copyright and Artificial Intelligence

Moderator: Prof. Peter K. Yu, Texas A&M University School of Law

Presenters: Prof. Danny Friedmann, Peking University School of Transnational Law (China)
“Copyright as Affirmative Action for Human Authors Until the Singularity”

Prof. Michael D. Murray, J. David Rosenberg College of Law, University of Kentucky
“Generative AI Art: Copyright Infringement and Fair Use”

Prof. Alina Ng Boyte, Mississippi College School of Law
“Painting with Data: Authorship, Ownership, and Content in the Age of Generative AI”

10:45 Coffee Break

11:00 Panel 6: Other Intellectual Property Issues

Moderator: Prof. Jeff W. Slattery, Texas A&M University School of Law

Presenters: Prof. Aman K. Gebru, University of Houston Law Center
“Trading on Traditions: Cultural Appropriation as Passing Off”

Prof. Lee Jyh-An, Faculty of Law, Chinese University of Hong Kong
“Thriving NFTs in the Shadow of IP Law”

Prof. Doris E. Long, University of Illinois Chicago School of Law
“Using the Past to Innovate the Future”

Prof. Peter K. Yu, Texas A&M University School of Law
“WIPO Negotiations on Intellectual Property, Genetic Resources and Associated Traditional Knowledge”

12:45 Closing Remarks

Prof. Peter K. Yu, Texas A&M University School of Law

1:00 Lunch

6:00 Dinner for Roundtable Participants

Del Frisco’s Grille
154 E. 3rd St., Fort Worth

Commentators

- Prof. Hannah Bloch-Wehba, Texas A&M University School of Law
- Prof. Han Xiuli, School of Law, Xiamen University (China); Visiting Scholar, Texas A&M University School of Law
- Prof. H. Brian Holland, Texas A&M University School of Law
- Prof. Marshall Leaffer, Indiana University Maurer School of Law
- Prof. Jeff W. Slattery, Texas A&M University School of Law
- Prof. Saurabh Vishnubhakat, Benjamin N. Cardozo School of Law, Yeshiva University

ABSTRACTS

Prof. Nikola Datzov, University of North Dakota School of Law
“Predictable Unpredictability” (with Jason Rantanen)

More than a decade has passed since the Supreme Court’s decision in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.* established the current framework for evaluating patent subject matter eligibility. Despite widespread recognition that subject matter eligibility is one of the most important areas of patent law, the impact of the current eligibility framework continues to draw sharp criticism and remains a hotly contested issue. Some Federal Circuit judges have described the law on subject matter eligibility as “an incoherent body of doctrine” and the most recent proposed legislation on patent eligibility (the fourth in four years) identifies judges’ lack of consistency as the driver for overhauling the current law.

Yet, at least at the surface level, the Federal Circuit’s near-complete (95.5%) affirmance rate of USPTO decisions and very high (85.6%) affirmance rate of district court decisions on § 101 appears to tell a different story. In other words, the patent eligible subject matter framework is one that is widely described as fundamentally indeterminate while at the same time appellate outcomes demonstrate a high rate of agreement among trial judges and appellate judges. What explains this seeming contradiction?

To appreciate how the sole patent appellate court has shaped and evolved the predictability of this controversial doctrine requires looking deeper than just affirmance and reversal rates and other metrics of predictability that have been relied upon to date. Regardless of whether the future of patent eligibility law will be elucidated by Congressional action, the dim prospect of Supreme Court intervention, or the Federal Circuit’s decisions, a closer systematic examination of the Federal Circuit’s patent eligibility jurisprudence is critical to better understand what potential legislative or judicial fixes to § 101 might be appropriate.

After creating a dataset of all patent eligibility appellate cases since 2012—the most comprehensive such dataset created to date—we undertook an empirical analysis of all 367 decisions over the past decade to examine the conventional wisdom that patent eligible subject matter is unpredictable. We studied predictability using a multi-dimensional approach by taking into account judicial outcomes and reasoning through three predictability metrics: affirmance/reversal rates, lower tribunal analysis error rates, and dissent rates on appeal. Additionally, to build a more complete picture of § 101 outcomes at the Federal Circuit, we analyze the procedural stage, tribunal of origin, underlying § 101 exception, results of each step of the *Mayo/Alice* framework, eligibility decision, the Rule 36 affirmance “shadow” docket, each district court judge’s results, separate opinions, and each Federal Circuit judge’s decision-making for all § 101 decisions at the Federal Circuit since *Mayo*.

Our work reveals several significant disconnects between the doctrinal, theoretical, and policy assertions that have been advanced by leading scholars, judges, and commentators and the actual judicial decisions. Most significantly, our article reveals that there is no empirical support for the assertion that judges apply the law unpredictably.

Prof. Rachael Dickson, Suffolk University Law School
“High Hopes: Cannabis Trademarks at the USPTO”

On April 1, 2010, medical marijuana was added to the US Patent and Trademark Office’s Trademark ID Manual. This addition of a federally unlawful substance to the manual, which lists acceptable identifications of goods and services for applications to register federal trademarks, thrilled a “state-legal” cannabis industry eager for any sign of US government acceptance. Although this and two other medical marijuana related identifications were deleted from the manual mere months later, at least 86 applications for federal registration of trademarks with cannabis or marijuana related identifications were filed before their removal.

This incident, while creating a major headache for the trademark office, also brought mainstream attention to the inability of cannabis companies to register their trademarks federally. And although these applications had trickled into the trademark office and been refused under the auspices of the lawful use requirement as it has been read into the Lanham Act for years already (“state-legal” marijuana sales had begun in California in 1996, after all), the incident presaged the veritable flood of cannabis related or cannabis suspected applications—over 23,000—which have been filed at the USPTO since then.

This surge of cannabis trademark applications has posed particular problems for the agency. To handle these applications, examiners have had to learn laws far outside of the usual trademark sphere and apply them to applications to register trademarks with marijuana, hemp, and novel cannabinoids that are being newly extracted and developed all the time. To make things worse, the USPTO has avoided making statements about its policies regarding cannabis trademark applications and has failed to provide any resources indicating how producers of now federally lawful hemp goods can meet its expectations for these applications. For example, even though lawful cannabis CBD goods have been registrable since December 2018, the USPTO still has not added any cannabis or CBD identifications to the USPTO ID Manual. This lack of transparency has resulted in confusion among cannabis industry applicants and trademark attorneys alike and the refusal of many applications for even completely federal lawful hemp goods, simply for a failure to abide by the USPTO’s own unwritten rules regarding cannabis trademark identifications.

This Article builds on prior scrutiny of the lawful use requirement by taking an in-depth look at how the USPTO’s application of this illegitimate policy and lack of transparency regarding its treatment of cannabis trademark applications harms the state licensed cannabis industry without actually furthering the agency’s primary goals. I also provide recommendations for how the USPTO can improve application outcomes for providers of federally lawful hemp goods and reduce its own examiner workload by providing the same educational resources and options to applicants from the cannabis industry that it does to applicants from other industries.

Prof. Danny Friedmann, Peking University School of Transnational Law (China)
“Copyright as Affirmative Action for Human Authors Until the Singularity”

To outsource the evolution of human culture, is to deprive humanity from actively shaping what it is like to be human and instead passively permeating society with a surrogate culture. This is at least the case, until AI becomes conscientious and/or sentient, exceeding human intelligence at the moment of singularity. To guarantee original creativity in the interim, society should provide preferential treatment to human creativity.

The Copyright Register becomes the training dataset and vice versa. Authors or copyright holders need to register their works at the Copyright Register with metadata, such as contact information and the date of creation of the work. This makes it easier for data gatherers and generative AI developers to train data; and easier for authors/copyright holders to receive remuneration for the inclusion of their works in the training dataset, or, if they wish so, to be excluded from the training dataset.

Ideally, the remuneration of the works must be made dependent on the degree in which a particular work was used during the “learning process,” corrected by the relative advantage of works being used first or the relative disadvantage of works being used later. The metadata need to be discernible from the generated output.

One can argue that in regard to signature styles, the expression weighs heavier than the idea, and that the combination of these is protectable (in contrast to the merged idea/expression, where there are only a few ways to express oneself, and the idea weighs heavier, so that the combination is not protectable). The authors of signature styles need to be compensated in proportion to the number of times that users instruct the AI to generate that particular signature style via prompts.

Prof. Aman K. Gebru, University of Houston Law Center
“Trading on Traditions: Cultural Appropriation as Passing Off”

As the globalized world witnesses an increased mingling of cultures, the act of cultural appropriation—adopting symbols from another culture without consent, understanding, or respect—has sparked fervent debates across social, ethical, and legal platforms. Legal scholars have studied general claims against cultural appropriation, at times suggesting reforms which will disrupt long-standing rights and freedoms. This law review article explores the complex question of whether there is, or should be, a legal basis for cultural appropriation. The research delves into the potential legal mechanisms supporting or refuting such a claim. It recognizes that building a claim of cultural appropriation is riddled with obstacles, including constitutional protection for freedom of expression, clearly defining the problematic action, and distinguishing between cultural diffusion and appropriation. However, the article develops a theory of “cultural passing off” that argues for the recognition of a narrow cause of action in the limited scenario of commercial cultural appropriation arising from targeted uses of commercially valuable cultural symbols. The tort of passing off, misappropriation, and trademark law are singled out as potential homes for such a claim. Particularly, the trademark standard of consumer confusion and the doctrine of deceptive marks are examined as a potential basis for a claim of cultural passing off. While current trademark law does not offer such a claim, a reformulation of these doctrines may enable legal claims against a subset of commercial cultural appropriation, a claim consistent with the policy goals of trademark law.

Prof. Timothy T. Hsieh, Oklahoma City University School of Law
“The History and Legacy of Judge Ronald Whyte’s Local Patent Rules”

This paper will provide a survey of the current Patent Local Rules in U.S. District Courts across the country and also summarize the historical context as well as the intentions that Judge Ronald Whyte had when initially architecting them. Statistics from the courts using Patent Local Rules will then be evaluated to measure the fulfillment of those goals over time. Finally, some amendments to the Patent Local Rules will be proposed that will hopefully more closely approximate the attainment of Judge Whyte’s initial aims.

Prof. Robert Hu, St. Mary’s University School of Law
“Apology as Intellectual Property Remedy in China: A Preliminary Examination of American Litigation Experiences”

Seeking, and receiving, an apology from the wrongdoer is a ubiquitous social phenomenon in Chinese culture and society. In the recent years, litigation and apologies appear to be natural elements of the contemporary life in China. Apologies as a legal remedy in Chinese laws and regulations has become prevalent for nearly four decades. In particular, in the area of intellectual property law, the last thirty years has witnessed an explosion of apology cases, where plaintiffs seek (and sometimes obtain) apologies from the defendants as a statutory remedy besides injunction and damages. American businesses operating in

China increasingly take to Chinese court to protect their intellectual property, and seeking apologies during litigation is deployed as a useful strategy to curb intellectual property thefts.

This article explains the apology legal remedy popular in China but little understood outside the country. The essay discusses the evolution of Chinese apology laws and examines in depth apologies as a legal remedy in intellectual property laws and litigation. Based on more than a dozen judicial opinions examined, this essay considers the experiences of American corporations seeking apologies in Chinese courts, analyzing the facts and issues of such litigation. Some preliminary assessment and recommendations are made following this examination.

Prof. Eric E. Johnson, University of Oklahoma College of Law
“Competition Among Nations, National Patent Laws, and Global Context”

There is growing political pressure in the United States to liberalize subject-matter constraints on what is patentable. The U.S. Supreme Court has interpreted 35 U.S.C. § 101 to not allow the patenting of abstract ideas and natural laws. And, correspondingly, the Court has held that a patent cannot monopolize a natural law or abstract idea by claiming in a general way the application or implementation of that idea or law. The court has held that an abstract idea or natural law cannot be transformed into a patent-eligible invention by the recitation of a limitation that the natural law or abstract idea is used in the context of some well-worn or obvious activity. For instance, a claim that covers the use of a computer to apply an abstract idea or natural law is not, under Supreme Court jurisprudence, patent-eligible subject matter. Proposed bi-partisan legislation would do away with these judicially articulated limits on patentable subject matter. The reformed version of patent law would allow U.S. patents on natural laws and abstract ideas so long as they are claimed in the context of a process that utilizes them and where that process is not solely a series of mental steps taking place inside a human mind. The chief thrust among supporters of this legislation is that this reform is needed to allow the United States to keep pace against international rivals, including Europe and the People’s Republic of China. What is more, this is urged to be a matter of U.S. national security. This line of thinking is advanced by a number of influential persons and entities. The argument goes as follows: If Europe and China give out patents on a broader range of things than the United States does, then there will be more European and Chinese innovation. This argument presents a puzzle. The puzzle arises from the fact that U.S. patents are territorial in effect but open to applicants worldwide. That is, a U.S. patent’s right to exclude only has force within the United States. Yet U.S. patents must be made available equally to applicants from any country that has joined the Paris Convention for the Protection of Industrial Property. Put still differently: The advantage of wielding the power of U.S. patents can be accumulated by entities outside the United States, but the stopping power of U.S. patents can only be brought to bear against entities and their activities inside the United States. Given this context, to the extent the United States has a policy objective of gaining a strong competitive footing against nations perceived as rivals, that objective would seem best served by law that minimizes the availability of and rights offered by U.S. patents—at least insofar as is consistent with treaty minima. Reducing the offerings of U.S. patent rights in terms of infringement scope, remedies, and subject-matter eligibility would seem to leave commercial and innovative activities inside the United States less burdened by liability even as those activities would garner the comparatively more generous rewards offered by other countries’ patent regimes in those other countries’ markets. This paper will carefully explain this line of argument, consider its legal and economic context, and provide a critical evaluation that considers a variety of counterarguments and countervailing interests.

Prof. Barbara Lauriat, Texas Tech University School of Law
“Borrowing Goodwill”

Goodwill in a legal or commercial context is often described as a nineteenth-century legal creation, usually in connection with trademark protection. Yet goodwill as a property right has far more venerable origins, dating back to the sixteenth century at least. Gaining gradual recognition as a trade custom, goodwill as an intangible property right was a commercial and cultural reality that found its way into legal doctrines over time. By the eighteenth century, goodwill as property was mentioned in British law, literature, and advertising, and even government takings legislation began addressing the loss of goodwill separate from real property before 1800.

Thus, goodwill before the nineteenth century was understood as an intangible, alienable property right in a variety of businesses long before its appropriation as a trademark law concept. Eventually, by seeking doctrinal coherence in goodwill caselaw, trademark law came to overshadow the broader and older form of property over the course of the twentieth century. The history of goodwill and its absorption into trademarks can help us better understand the fundamental differences between the nature of primarily formalistic trademark regimes versus primarily use-based trademark regimes, such as that adopted by the United States. Late nineteenth and early-twentieth century English and American courts differed in their approach to incorporating the preexisting legal concept of goodwill into trademark law, setting them on very different theoretical and doctrinal paths. In contrast to the UK trademark system, which protects registered marks and goodwill only through the common law tort of passing off, in the United States, goodwill is a central organizing concept of the trademark system. The fact that goodwill was a proprietor-focused, use-based right for centuries before modern trademark law helps explain why identifying goodwill as the foundational basis for US trademark and unfair competition protection tends to maintain the proprietor’s use at the center of the analysis, despite judicial recognition of the other interests involved.

Prof. Lee Jyh-An, Faculty of Law, Chinese University of Hong Kong
“Thriving NFTs in the Shadow of IP Law”

Despite the upsurge in the non-fungible token (NFT) market, many participants, such as NFT minters, buyers, and marketplaces, know little about the nature of NFTs and their transactions. Intellectual property (IP) owners have claimed that these participants infringe on their IP by minting or allowing the minting of visual artworks into NFTs without their permission. Some scholars argue that IP laws have unduly restricted the development of the NFT market, and that a better approach is to govern NFT transactions by property law or sales law. This Article disagrees with proposals applying property law or sales law to NFT minting and transactions. As with many emerging technologies that pose intricate challenges to our existing legal framework, NFTs have ushered in a dual landscape of opportunities and concerns within our society. On one hand, NFTs, distinguished by their excludability and rivalry characteristics, serve as a valuable complement to the IP regime, fostering innovation and creativity. On the other hand, the inability of NFTs to definitively establish scarcity for their underlying digital assets has given rise to issues like double minting, batch minting, and over-minting, incurring significant social costs. Based on a thorough analysis of the legal complexities entwined with NFTs, we posit that the existing IP system stands as the most suitable regulatory framework to govern the NFT market by balancing various policy concerns such as innovation, fair competition, and consumer protection.

Prof. Doris E. Long, University of Illinois Chicago School of Law
“Using the Past to Innovate the Future”

Despite a long history as a front line regulator of new communication, distributive and productive technologies, copyright law has not proven terribly adept at dealing with the challenges of these new technologies. Instead, since the advent of photography, copyright law in the US has featured a four stage

technology learning curve whose end result has been attempts to regulate new technology at the point when it has become nearly unregulatable. We are experiencing a technological “perfect storm” with simultaneous advances in AI, deep fakes, and NFTs (to name a few) that mandates a different approach. One that ensures that the advantages of these technologies are allowed to flourish while preventing the predictable worst excesses that are bound to follow. To do so, we must look to the past in order to innovate the future. For example, when it comes to AI we should look to the earlier decisions reached with regard to its closest technological relatives—computer software. We already have a wealth of decisions regarding such critical issues as authorship of computer generated and computer assisted works, originality in expression, the role of databases and fair uses from the earliest days to point the way to the questions we should be asking today about AI. The answers will not always be the same, but we can always hope that this time the regret stage of the technology learning curve might be shorter.

Prof. Timothy J. McFarlin, Cumberland School of Law, Samford University
“How State Law Could Repair the Past and Change the Future of U.S. Copyright”

Authorship exists independent of federal law—it can first be protected by state law, even today. The implications of this fundamental yet controversial point could change the course of U.S. copyright.

Federal copyright applies only when an author’s creative expression is fixed in a tangible medium, and per the U.S. Copyright Act, this fixation can occur only “by or under the authority of the author.” Courts and commentators have so far largely presumed that “authority” is synonymous with permission, causing federal copyright to envelop most everything performed or spoken by an author but recorded by someone else, like in a music or movie studio.

But here I explore an idea that the statutory term “authority” may, in this context, mean something beyond mere permission to have one’s creativity recorded—perhaps even requiring an “intent to be regarded as an author of the recording” in order for such authority to truly exist. And without that authority, federal copyright cannot apply, though state copyright can.

Under this idea, then, (1) past authors whose creativity was not fixed by them or under their authority, as well as those authors’ heirs, may be able to bring state-law copyright infringement claims not previously thought to exist, (2) future authors may gain greater leverage with respect to record companies, movie studios, and others who make recordings of their creativity and claim to own it, and (3) state law may take on a renewed importance in the future of U.S. copyright.

Prof. Andrew C. Michaels, University of Houston Law Center
“Confusion in Trademarked NFTs”

The recent rise of the blockchain based technology of non-fungible tokens (NFTs) has already led to a number of lawsuits where NFTs are alleged to infringe trademarks. These cases have generally centered around the inquiry of likelihood of confusion, as most trademark cases do, but have also raised disputes as to the First Amendment and first sale doctrines and their relation to the likelihood of confusion inquiry. This article will discuss three such cases in detail, and draw some general insights about the likelihood of confusion inquiry and its interaction with these other doctrines, as well as make some more specific recommendations as to how these doctrines should be applied in the newer context of NFTs.

One of the primary recommendations of this article will be that courts should generally consider whether the alleged confusion would likely increase the amount that consumers would pay for the product at issue, particularly when evaluating survey evidence of actual confusion. Specifically with respect to NFTs, this may be especially likely to be the case because the value of NFTs is almost entirely based on “clout.” But when a true parody is at issue, this may be less likely, as consumers may not particularly care whether the

parody was authorized by the brand that is being ridiculed. Alleged confusion that will not tend to affect consumer purchasing decisions should generally be discounted or at least given less weight.

Another more general recommendation will be that likelihood of confusion should be considered a question of law based on underlying facts, which is surprisingly contrary to the current approach of a majority of circuit courts that currently view the question as one of fact. This article also considers when the First Amendment based Rogers doctrine might apply to NFTs in light of the recent but limited guidance from the Supreme Court in *Jack Daniel's v. VIP Products*, and makes recommendations as to how courts should approach the doctrine when it does apply. As for the first sale doctrine, this article argues that it should generally not protect NFTs linked to physical products, as the NFTs should generally be considered separate products and evaluated under the standard likelihood of confusion analysis.

Prof. Michael D. Murray, J. David Rosenberg College of Law, University of Kentucky
“Generative AI Art: Copyright Infringement and Fair Use”

The discussion of AI copyright infringement or fair use often skips over all the required steps of the infringement analysis in order to focus on the most intriguing question, “Could a visual generative AI generate a work that potentially infringes a preexisting copyrighted work?” and then the discussion skips further ahead to, “Would the AI have a fair use defense, most likely under the transformative test?” These are relevant questions, but without considering the actual steps of the copyright infringement analysis, the discussion is misleading or even irrelevant. This neglecting of topics and stages of the infringement analysis fails to direct our attention to a properly accused party or entity whose actions prompt the question. Making a sudden transition from a question of infringement in the creation of training datasets to the creation of foundation models that draw from the training data to the actual operation of the generative AI system to produce images makes a false equivalency regarding the processes themselves and the persons responsible for them. The questions ought to shift focus from the persons compiling the training dataset used to train the AI system and the designers and creators of the AI system itself to the end users of the AI system who conceive of and cause the creation of images.

The analysis of infringement or fair use in the generative AI context has suffered from widespread misunderstanding concerning the generative AI processes and the control and authorship of the end-user. Claimants, commentators, and regulators have made incorrect assumptions and inaccurate simplifications concerning the process, which I refer to as the Magic File Drawer theory, the Magic Copy Machine theory, and the Magic Box Artist theory. These theories, if they were true, would be much easier to envision and understand than the actual science and technology that goes into the creation and operation of a contemporary visual generative AI system. Starting in Part I of this Article, the Introduction, I will attempt to clarify and correct the understanding of the science and technology of the generative AI processes and explain the different roles of the training dataset designers, the generative AI system designers, and the end-users in the rendering of visual works by a generative AI system. Part II will discuss the requirements of a claim of copyright infringement including each step from the copyrightability of the claimant’s work, the doctrines that limit copyrightability, the requirement of an act of copying, and the infringement elements. Part III will summarize the copyright fair use test paying particular attention to the purpose and character of the use analysis, 17 U.S.C. § 107(1), and the current interpretation of the “transformative” test after *Andy Warhol Foundation v. Goldsmith*, particularly in circumstances relating to technology and the use of copyrighted or copyrightable data sources. Part IV will analyze potential infringement or fair use by the creators of generative AI training datasets. Part V will analyze potential infringement or fair use by the creators of visual generative AI systems. Part VI will analyze potential infringement or fair use by the end-users of visual generative AI systems.

For all their complexity, visual generative AI systems are tools that depend on an end-user who conceives of and designs the image and provides the system with a prompt to set the generative process in motion.

The end-users are responsible for crafting the prompt or series of prompts used, for evaluating the outputs of the generative AI, for adjusting and editing the iterations of images offered by the AI system, and ultimately for selecting and adopting one of the images generated by the AI as the final image. The end-users then make further decisions about the actual use and its function and purpose for the images the end-users selected and adopted from the outputs of the AI. While working with the AI tool to try to produce a certain image, an end-user might steer the system to produce a work that could, under an infringement analysis, be regarded as potentially infringing, which would lead us again to the fair use analysis based on the end-user's use of the image.

Prof. Alina Ng Boyte, Mississippi College School of Law

“Painting with Data: Authorship, Ownership, and Content in the Age of Generative AI”

Copyright's means of appropriating creative resources for private ownership has invariably, throughout history, been through the devices of authorship and originality, two essential and existential concepts central to being human. With generative AI, authorship and originality have become challenging to locate. AI-generated outputs, such as DALL-E-created images or ChatGPT-produced texts, are produced by computer programs autonomously. Consequently, the Copyright Office and courts have denied copyright protection for AI-produced content because a human author did not create it. As a normative inquiry, this paper questions whether federal copyright law should protect autonomously created AI content and argues that federal copyright laws should only protect AI-generated content with a readily identifiable author because authored content is the only measure to claim ownership rights in federal copyright law. By exploring how non-copyrighted works have found protection in other areas of the law, such as state statutory and common-law rules, and norms, such as fashion industry norms, this paper demonstrates that the uncopyrightability of AI-generated content is unlikely to impact investments into the development and use of generative AI.

Prof. Lucas S. Osborn '00, Campbell University School of Law

“Christianity and IP”

“In the beginning, God created...” What does Christianity have to say about IP law, if anything? Christians, among others, believe that humans were created in God's image. Does that image-bearing include being creative? This paper explores aspects of Christian theology that (1) bear on IP theory and (2) either enjoy broad agreement across Christian thought or, where such agreement does not exist, contain varying viewpoints that point in the same direction vis-à-vis IP theory.

Dr. Emma Perot, Faculty of Law, University of the West Indies, St. Augustine (Trinidad and Tobago)

“Music Copyright Ownership: Factors Behind the Increase in Writer Credits and Rights Clearance”

The music industry has gone through a period of rapid change ushered in by the digital era. Changes in the way music is made include more active involvement in song creation by producers, the use of song writing camps, the practice of artistes taking credit even with minimal creative input, and the popularity of sampling and interpolation. Notwithstanding the evolution of these practices, there have been allegations that recent copyright infringement cases, namely, the Blurred Lines case, have had a profound impact on the creation of music. However, this allegation ignores the fact that prior to the Blurred Lines case, there were significant music copyright cases that have considered originality, subconscious copying, inverse ratio rule, and bright line standards that have shaped the approach to music creation and licensing since 1976.

To prove that the impact of the recent copyright infringement decisions have been overblown, this article analyses the year end Billboard Top 20 songs from 2000–2022, which shows that the number of songwriters per chart topping song has increased from an average of 3 in 2000 to over 5 in 2022, with a notable spike in the period 2017–2019. The spike in number of songwriters coincides with two key incidents: the damages in the *Gaye v Williams* (Blurred Lines) appeal in 2018, as well as a spike in the number of year end Billboard

Top 100 songs that utilize an interpolation or sample (26 songs in 2016, 29 songs in 2018, and 21 songs in 2019). The outcome and publicity surrounding the Blurred Lines case has undoubtedly impacted the music industry, but the reasons for the increase in number of songwriters are far more complex. However, that is not to say that the risk mitigation impact of the Blurred Lines is unreal, but the steady trend of increasing number of songwriters predates the case.

Consequently, this article makes a new contribution to the field by creating a timeline of key music copyright cases and music industry practices, and assess these factors against the increase in the number of songwriters per chart topping song to provide a holistic picture of the music landscape in the last two decades. This research is important because overemphasis on recent case law fails to consider other factors that have shaped the music industry and some of the broader issues that have arisen because of the average increase in songwriters per song. Namely, career songwriters have negatively been impacted by this trend as more writers means less revenue per person. This is exacerbated against the background of streaming where the revenue share for these songwriters is smaller than previously received from physical sales. Understanding the various factors that have contributed to the trend is vital for aiding songwriters in their fight to receive equitable remuneration.

Prof. Zvi S. Rosen, Southern Illinois University School of Law
“Who Framed Mickey Mouse”

In 1998, the United States passed a package of copyright reforms, including the extension of most copyright terms by 20 years. In the news at the time it was derisively called the Mickey Mouse Protection Act, and it was widely noted that it was passed with the expiration of copyright in the first Mickey Mouse cartoon looming. Steamboat Willy is now set to enter the public domain at the stroke of midnight at the start of 2024.

Those knowledgeable about the issue have long known that Europe made this 20 year extension in 1993, and the 1998 amendments represented at least partially the American accession to these changes given the rule of the lesser term. However, the part of the story which has been told less is the importance particularly of songwriters and composers, who were concerned about losing performance royalties on both sides of the Atlantic, and lobbied heavily for this measure. Conservative activists were also a major part of publicizing the narrative that the law was a giveaway to Disney, part of a shift in Disney’s relationship with the right.

This piece explores how we tell stories about the law, the uses of donation and lobbying data in public discourse, and given how Disney’s involvement in the 1998 term extension has become internet lore and a political hot topic again recently, discuss how and why it matters.

Prof. Guy A. Rub, Michael E. Moritz College of Law, Ohio State University
“Reimagining Digital Lending”

Public libraries are among the most cherished institutions in our society, and most Americans use and love them. However, many are unaware of the crisis that libraries face nowadays. The gradual shift towards digital distribution of copyrighted goods, a trend greatly accelerated by the COVID-19 pandemic, challenges both the role and operation of libraries in our society.

Specifically, libraries struggle with a difficult digital lending problem. While in the physical world, libraries can operate in the shadow of well-established exemptions to copyright liability, those exemptions do not apply in the digital realm. As a result, libraries need to secure specific licenses from the publishers to acquire and lend digital content. This development has left the libraries at the mercy of the publishers and their restrictive and expensive licenses, which drain the libraries’ resources and undermine their ability to fulfil

their missions. Changes in the post-COVID world, including an important case going through our federal judiciary system and proposed statutes in various states, put the issue front and center.

So far, lower courts have failed to appreciate the unique role libraries play in our society and the need to partly shield them from market forces. At the same time, legal scholars have largely ignored this crisis, leaving the libraries to fend for themselves. This Article seeks to begin closing this surprising gap in legal scholarship by analyzing the digital lending problem from legal, comparative, and economic perspectives. It explains why it is highly problematic to let libraries—which have always operated alongside the market—be completely subject to the publisher’s powerful commercial interests. The Article instead offers several alternative frameworks to try to balance the libraries’ role in providing access to knowledge to members of society and the publishers’ role in supporting the creation of new works. Copyright law has always evolved in response to new technologies. It now needs to adapt to address the libraries’ crisis and their role and needs in our growingly digitalized world.

Prof. Karen E. Sandrik, Willamette University College of Law

“More Genus Claim Vulnerability? How *Amgen v. Sanofi* Enables New PTAB Challenges”

Over the past twenty-five years, the Federal Circuit has created an uphill battle for patent applicants and patentees in the chemical and life sciences practices. Through heightened enablement and written description standards, the genus claim is vulnerable to attack. When the Supreme Court granted certiorari to Petitioners *Amgen in Amgen, Inc. v. Sanofi*, the genus claim was quickly the hero and the villain. Is the genus claim “the central feature of patent law in the life sciences” and a heightened enablement standard “threatens patent protection for many inventions in the chemical and life sciences” (Amici Brief of Intellectual Property Professors in Support of Petitioners); or, alternatively, do large genus claims, like that in *Amgen*, function to “bar scientists and competitors from [immensely valuable] building blocks of invention” (Amici Brief of Robin Feldman in Support of Respondents)? The Supreme Court affirmed the Federal Circuit’s holding that *Amgen*’s functionally claimed genus of nonclonal antibodies were invalid due to lack of enablement. This decision underscores a recent recalibration of sorts—a movement towards a tightening of standards and more focused and narrowly tailored claims. While patents will still be issued to reward and protect innovation in the chemical and life sciences, or more generally in the unpredictable arts, patents should not be so broad as to impede any more innovation or competition than necessary. While many of the amici briefs and post-decision commentary highlighted various potential downstream impacts of *Amgen v. Sanofi*, one has largely been missed.

This Article argues that one potential downstream impact of *Amgen v. Sanofi*, and more generally the heightened standards of § 112, is how competitors can (and already are) backdoor these arguments at the PTAB by instituting *inter partes* review (IPR) proceedings that indirectly implicate § 112 issues. We rarely think about bio/pharma patents in this space because these patents themselves are so rarely subject to IPR proceedings, with § 311(b) restricting the scope of IPR petitions to 35 U.S.C. § 102 and § 103, anticipation and obviousness, respectively, and bio/pharma patents more often challenged as they relate to § 112, written description and enablement. Moreover, claims in the unpredictable arts, even when challenged in IPR, seem to survive unscathed at a higher rate than those in more predictable arts. Yet in recent years, there are increasingly more instances of successful indirect challenges to § 112 in IPR proceedings. To be clear, § 112 is not being assessed or analyzed as a stand-alone challenge. Instead, § 112 is merely an intertwined part of the priority assessment to determine the applicability of intervening prior art (whether under § 102 or § 103). While this strategy is not necessarily new, it is still developing, and *Amgen* has only added another attractive layer. I argue here that challenges to older patent portfolios in the chemical and life sciences just got more attractive with *Amgen*, yet this strategy has already left a path of frustration, wasted time and money, and increased uncertainty.

Prof. V.K. Unni, Indian Institute of Management Calcutta (India)

“Standard Essential Patents, Anti-Suit Injunctions and Jurisdictional Rivalry—The Need for Judicious Approach”

All the major markets around the globe are witnessing numerous patent disputes pertaining to mobile communication technologies and at least in some instances courts are overstepping their jurisdiction and intruding upon the jurisdiction of courts in other sovereign countries, by way of anti-suit injunctions. This paper gives an overview of the various judicial approaches taken by courts in the United States, China, France, India, the United Kingdom etc. and the manner in which they interface with the principles of comity, public policy and judicial sovereignty.

Prof. Saurabh Vishnubhakat, Benjamin N. Cardozo School of Law, Yeshiva University

“Credible Commitment and New Major Questions: The Patent Office as a Case Study”

This project explores the problem of credible commitments under the new major questions doctrine using the Patent Office as a case study. The Supreme Court’s recent usage of the major questions doctrine is likely to affect the ability of federal agencies—including the Patent Office—to make credible commitments about regulatory policy. Against the backdrop of a besieged *Chevron* doctrine and the Court’s recent quartet of major questions cases during the Biden administration, the key driver is the Court’s 2005 decision in *NCTA v. Brand X*. As Jonathan Masur persuasively argued after *Brand X*, the Court’s elevation of *Chevron* over *stare decisis* meant that judicial interpretation of a statute could no longer “effectively fix the meaning of that statute, binding it in place until either Congress chose to amend the statute or the court agreed to overturn its prior holding.” The result would be a kind of “permanent instability” in which agencies can no longer bind themselves because future administrations will remain free to reinterpret and command deference of their own. Yet this was only for ambiguous statutes. For precedents that find a statute at *Chevron* Step One to be unambiguous, *stare decisis* would still preserve that finding.

In 2018, the Supreme Court decided just such a dispute in *SAS Institute v. Iancu*. The Court held in *SAS* that 35 U.S.C. § 318(a) unambiguously required the USPTO Patent Trial and Appeal Board to issue a final written decision as to the patentability of every claim challenged in a petition for *inter partes* review—rather than cherry-pick some claims to adjudicate while excluding others. That holding was recently tested in *Nike v. Adidas*, where the Federal Circuit had blessed the PTAB’s decision to raise unpatentability grounds *sua sponte* to strike down a substitute claim proposed by patentee Nike. Though the Court declined certiorari, the Federal Circuit’s approach seems to contradict the *SAS* Court’s view of *inter partes* review as a party-driven process where the litigants’ proposed arguments and evidence define the scope of the patent challenge. What is more, the asymmetric *Brand X* framework does not give the Patent Office the sort of flexibility under *Chevron* that the agency has ordinarily been able to claim as to PTAB procedures.

Thus, the issue before us is whether Congress’s delegation to the USPTO of patent revocation powers constitutes a major question. Concerns about credible commitments are now in a posture of potentially unavoidable formalism, and it is unclear whether the major questions doctrine is to be applied in a given case at Step Zero, One, or Two of *Chevron*. Over its evolution from *MCI v. AT&T* and *FDA v. Brown & Williamson* to the present, the major questions doctrine has variously been applied at each of those steps. Clarity on this issue is quite important if we are to have a coherent understanding of which judicial interventions can constrain agencies in ways that agencies themselves might find useful as a precommitment mechanism—and which ones cannot.

Prof. Peter K. Yu, Texas A&M University School of Law

“WIPO Negotiations on Intellectual Property, Genetic Resources and Associated Traditional Knowledge”

Since its establishment in September 2000, the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore of the World Intellectual Property Organization (WIPO) has engaged in discussions of the development of appropriate instruments to offer protection in this area. These longstanding discussions eventually led to an agreement by the WIPO membership in July 2022 to hold a diplomatic conference to consider the Draft International Legal Instrument Relating to Intellectual Property, Genetic Resources and Traditional Knowledge Associated with Genetic Resources. What are the key issues and challenges in the draft negotiating text? How will the upcoming diplomatic conference impact future negotiations for the protection of traditional knowledge and traditional cultural expressions?