

## SYMPOSIUM

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### INTRODUCTION: NEGOTIATING IP'S BOUNDARIES IN AN EVOLVING WORLD

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You can learn a lot about the center of a thing by studying its edges. This is, perhaps, the best defense that can be made on behalf of law professors, who stubbornly insist on teaching topics that students are unlikely to encounter if they practice forty years. Peruse a typical law school syllabus and you'll surely find, milling about with treatments of the most commonly litigated questions and important workaday doctrines, a generous helping of cases that are nonrepresentative, rare, or downright *sui generis*. *Why*, in a semester of only twenty-six precious class sessions, a thoughtful copyright student might wonder, must we pause to ponder the legal status of paintings composed by gorillas and selfies taken by monkeys?<sup>1</sup>

I'm guilty of this too. I customarily begin my patent course with a discussion of *Kewanee Oil*<sup>2</sup> and *Bonito Boats*,<sup>3</sup> both cases considering whether state law was preempted by federal patent law. The significance of their holdings ranges from moderate (good to know: state trade secret law is a real thing) to basically irrelevant (states may not create IP-like protections for unpatented boat hull designs), but neither opinion exposit doctrine that future attorneys are especially likely to confront in practice. These particular matters are long-settled; both trade secrets<sup>4</sup> and boat hulls<sup>5</sup> are afforded federal protection now anyway; and, though new IP preemption questions can arise with

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1 See *Naruto v. Slater*, 15-cv-04324, 2016 WL 342231, at \*3 (N.D. Cal. Jan. 18, 2016); U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES ch. 313.2 (3d ed. 2014), <https://copyright.gov/comp3/chap300/ch300-copyrightable-authorship.pdf>.

2 *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470 (1974).

3 *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989).

4 See Defend Trade Secrets Act of 2016, Pub. L. No. 114-153, 130 Stat. 376.

5 See Vessel Hull Protection Act, Pub. L. No. 105-304, 112 Stat. 2860, 2905 (1998) (codified at 17 U.S.C. §§ 1301–32 (2012)).

time,<sup>6</sup> it's the rare case rather than the quotidian one that forces them to the surface.

But I like these opinions, in large part because the interaction between state and federal law requires us to stop and think about what we're doing here. What, really, are the reasons for offering a particular form of IP? What are the limitations of the means that have been chosen to advance those goals? Are the activities that IP seeks to encourage meant to displace alternative activities, or simply supplement them? These questions, so easily assumed away or ignored in cases of "core" doctrine, come rushing to the fore when federal and state law collide,<sup>7</sup> when Congress brushes the outer limits of its powers,<sup>8</sup> when idle hands start tinkering with expiration dates.<sup>9</sup> Questions at the margin demand contemplation of the middle.

This basic move is employed repeatedly, and profitably, throughout the pages that follow. Timothy Holbrook, for example, shows us how throwing a sovereign border down the middle of a patent case forces us to confront difficult questions about which harms, exactly, patent remedies ought to compensate.<sup>10</sup> Graeme Dinwoodie likewise uses territorial edges—here, in the EU trademark context—to raise timely questions about the meaning of and obstacles to market integration more generally.<sup>11</sup> In both instances, how we think about cases involving small-scale, distant uses turns out to have great significance for how we should think about large-scale uses much closer to home.

Other contributors have subbed in doctrinal frontiers for national ones, but their work runs in the same channel. Rebecca Tushnet suggests that copyright preemption could provide a much-needed limit for the right of publicity, a domain where "lack of judicial attention to the right's justifications contributes to [ ] lack of judicial attention to the right's boundaries."<sup>12</sup> Pamela Samuelson similarly investigates how utility patent law can constrain the reach of copyright law and vice versa, exploring a number of potential

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6 See generally Camilla A. Hrdy, *The Reemergence of State Anti-Patent Law*, 89 COLO. L. REV. (forthcoming 2017).

7 See *Bonito Boats*, 489 U.S. 141; *Kewanee Oil*, 416 U.S. 470; *NBA v. Motorola, Inc.*, 105 F.3d 841 (2d Cir. 1997); see also *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 33–34 (2003) (observing a potential conflict between Lanham Act and federal copyright law).

8 See *Golan v. Holder*, 132 S. Ct. 873 (2012); *Graham v. John Deere Co.*, 383 U.S. 1, 5–11 (1966).

9 See *Kimble v. Marvel Entm't, LLC*, 135 S. Ct. 2401 (2015); *Eldred v. Ashcroft*, 537 U.S. 186 (2003).

10 Timothy R. Holbrook, *Boundaries, Extraterritoriality, and Patent Infringement Damages*, 92 NOTRE DAME L. REV. 1743 (2017).

11 Graeme B. Dinwoodie, *Territorial Overlaps in Trademark Law: The Evolving European Model*, 92 NOTRE DAME L. REV. 1669 (2017).

12 Rebecca Tushnet, *Raising Walls Against Overlapping Rights: Preemption and the Right of Publicity*, 92 NOTRE DAME L. REV. 1539, 1541–42 (2017).

approaches for managing overlaps between the two regimes.<sup>13</sup> And Perry Saidman suggests it's time to revisit the boundary between utility and design patents, as the functionality doctrine created to enforce this divide is simply no longer up to the task.<sup>14</sup>

Laura Pedraza-Fariña and Arti Rai turn our attention to another kind of boundary, exploring the legal and competitive conditions that can enable (or thwart) productive information sharing across firms. Pedraza-Fariña's work begins by looking to the past—telling of the informal networks that facilitated collaborative innovation during the Industrial Revolution—and then connects this history to more recent empirical scholarship to develop a number of consequences for modern theories of trade secrecy.<sup>15</sup> Rai's contribution, by contrast, opens in the not-so-distant future, as she predicts and addresses challenges for data aggregation in sectors recently excluded from patentable subject matter as a result of the *Mayo*<sup>16</sup> and *Myriad*<sup>17</sup> decisions.<sup>18</sup> Nicholson Price writes of inter-firm information exchange as well, with a focus on a time of particular importance to any IP regime—the moment of a right's expiration.<sup>19</sup> Building on work they previously coauthored,<sup>20</sup> Price and Rai now separately raise important questions about the ability of our regulatory frameworks to ensure competitors have access to the information they need to practice new technologies effectively.

A final pair of articles confront looming challenges for trademark law as a result of technological and legal change. Mark McKenna and Lucas Osborn explore how digitization is making it increasingly difficult to define what, exactly, counts as “goods or services” for purposes of the Lanham Act.<sup>21</sup> And Mark Lemley takes us back where we started, posing yet another remedies puzzle—under what circumstances would consumer confusion *not* cause irreparable injury?—that forces us to address important questions about why we have trademark law in the first place.<sup>22</sup>

13 Pamela Samuelson, *Strategies for Discerning the Boundaries of Copyright and Patent Protections*, 92 NOTRE DAME L. REV. 1493 (2017).

14 Perry J. Saidman, *The Demise of the Functionality Doctrine in Design Patent Law*, 92 NOTRE DAME L. REV. 1471 (2017).

15 Laura G. Pedraza-Fariña, *Spill Your (Trade) Secrets: Knowledge Networks as Innovation Drivers*, 92 NOTRE DAME L. REV. 1561 (2017).

16 *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (2012).

17 *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107 (2013).

18 Arti K. Rai, *Risk Regulation and Innovation: The Case of Rights-Encumbered Biomedical Data Silos*, 92 NOTRE DAME L. REV. 1641 (2017).

19 W. Nicholson Price II, *Expired Patents, Trade Secrets, and Stymied Competition*, 92 NOTRE DAME L. REV. 1611 (2017).

20 See W. Nicholson Price II & Arti K. Rai, *Manufacturing Barriers to Biologics Competition and Innovation*, 101 IOWA L. REV. 1023 (2016).

21 Mark P. McKenna & Lucas S. Osborn, *Trademarks and Digital Goods*, 92 NOTRE DAME L. REV. XX (2017).

22 Mark A. Lemley, *Did eBay Irreparably Injure Trademark Law?*, 92 NOTRE DAME L. REV. 1425 (2017).

The common element in this work is a refusal to dismiss these difficult questions with mechanical formality, to paper over the wrinkles that emerge when the simple models that function in the middle flounder at the edge. As this Symposium Issue will show, those wrinkles have a lot to tell us.