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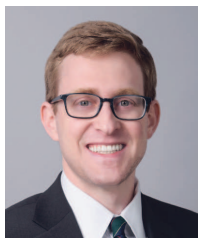
Where Does Judge Barrett Fall on IP Issues?





BY HOWARD S. HOGAN, LUCAS C. TOWNSEND, AND MAX SCHULMAN

The U.S. Supreme Court has increasingly taken a textualist approach to intellectual property issues in recent years, and President Donald Trump's nomination of Judge Amy Coney Barrett to the high court promises to continue that trend, if she is confirmed.

Barrett has decided only a small number of intellectual property cases over the three years that she has served on the U.S. Court of Appeals for the Seventh Circuit. She has applied a textualist approach in those cases, but has not written separate concurrences or dissents in these cases. Nor has Barrett addressed IP issues in her academic work.

While Barrett's record does not indicate that she would have the same level of interest in IP issues as the late Justice Ruth Bader Ginsburg, Barrett's history suggests that she is likely to join the consensus of other justices who have looked to statutory text to answer IP questions.

A Look at Her Opinions Overall, Barrett's written opinions have not clearly favored intellectual property owners or accused infringers. In five trademark and trade secret cases where there was a clear result, Barrett voted for the owner three times and for the accused infringer two times. In a handful of IP cases, there was no clear winner or loser, and Barrett wrote or joined decisions that gave partial wins to both sides.

One illustration of Barrett's approach is her July opinion in *J.S.T. Corp. v. Foxconn Interconnect Technology Ltd*. The case raised the question of what minimum contacts with a state are required to support specific personal jurisdiction in federal court over claims for misappropriation of trade secrets.

The plaintiff, a manufacturer based in Illinois, sued competitors headquartered in another state for allegedly stealing proprietary part designs. The defendants' only connection to Illinois was their alleged sale of the parts to other companies that they knew would ultimately sell the parts in that state.

Barrett wrote for a unanimous panel affirming the dismissal of the suit for lack of personal jurisdiction. In so ruling, Barrett analyzed the distinctions between different forms of intellectual property law.

She distinguished trade secret law, which focuses on the defendants' alleged acts, from both "trademark law, in which consumer confusion can be at the heart of the underlying claim," and "patent law, in which the sale of a patented invention to a consumer can be an act of infringement, even if the seller is unaware of the patent."

Because the defendants' alleged acts of trade secret misappropriation were all completed outside of Illinois, Barrett concluded that the court lacked personal jurisdiction over those claims on these facts.

Careful Examination of Distinctive Features of IP Claims Several other Seventh Circuit decisions that Barrett wrote or joined follow this same pattern of carefully examining the distinctive features of IP claims—including closely analyzing the text of intellectual property statutes in cases that present questions of statutory interpretation.

For example, in *PMT Machinery Sales Inc. v. Yama Seiki USA Inc.*, Barrett parsed the text of Wisconsin's Fair Dealership Law. That law provides contractual protections to "dealerships," which it defines to include agreements granting persons the right to "use a trade name [or] trademark." Barrett reasoned that the mere inclusion of another party's logos on the plaintiff's website did not qualify as "use" of those trademarks suffi-

cient to establish it as a ''dealership'' entitled to protection under the Wisconsin law.

Similarly, Barrett joined a 2019 decision in *Sullivan v. Flora Inc.* that answered a statutory question of first impression in the Seventh Circuit.

The Copyright Act permits a copyright holder ''to recover, instead of actual damages and profits, an award of statutory damages for all infringements involved in the action, with respect to any one work.'' The act also instructs that ''all the parts of a compilation or derivative work constitute one work,'' but it does not otherwise define the term ''one work.'' *Sullivan* presented the question of what constitutes ''one work'' when a jury finds infringement on multiple works registered in a single copyright application.

The Seventh Circuit analyzed the text of the act to determine that the holder's registration of certain illustrations as a group did not conclusively establish whether they were ''one work.'' Although the statutory damages provision was ''hardly a model of clarity,'' the court found clarification in the separate statutory definition of ''compilation.''

In light of that definition, the court interpreted the statutory damages provision to require courts or juries to determine whether the protected works have economic value only as a composite whole (and thus constitute a ''compilation'') or each hold independent value. Under the statutory text, only the latter would independently qualify as ''one work'' instead of a part of a compilation.

Barrett has joined panel majorities and has not written separately to concur or dissent on IP issues in the cases she has heard during her time on the bench. This could suggest that she does not hold idiosyncratic views on IP cases. She also has not focused on IP issues in academic writings during her career as a law professor.

Her academic work on statutory interpretation, however, reveals a strong textualist orientation that appears to be in step with the majority approach of today's Supreme Court on IP issues.

For example, the last three trademark cases in the Supreme Court—*Romag Fasteners Inc. v. Fossil Inc.*; *Lucky Brand Dungarees v. Marcel Fashions Group Inc.*; and *PTO v. Booking.com B.V.*—have all rejected attempts by lower courts and the PTO to construct rules that were not based in the text of the Lanham Act. Barrett's history suggests that, if confirmed, she is likely to join that consensus on the high court.

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