Justices Sotomayor's and Kagan's Intellectual Property Views

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Despite considerable speculation about how the two newest appointees to the Supreme Court view IP, particularly prior to their appointment, their views are difficult to discern. Justice Sotomayor gives us much more to work with, but there is remarkably little evidence of the views of either.

Justice Sotomayor, appointed in August 2009, has now been on the Court for more than a year. She has written two minority and eight majority opinions. She is also named as having joined twenty-three other opinions, notably including Justice Steven's opinion in Bilski. But her joining that opinion says little.

Biographical reports commonly mention that she was involved with IP enforcement prior to initial appointment to the bench in 1993. What she did as an advocate, however, is less telling than 437 Southern District of New York opinions identified by Westlaw. And even more relevant are eleven opinions selected by BNA for publication in the U.S.P.Q.2d.

Of those, Castle Rock Entertainment v. Carol Pub. Group, Inc., 955 F. Supp. 260 (1997), is well known. Her finding that publication of The Seinfeld Aptitude Test constituted copyright infringement was affirmed by an opinion of the same name at 150 F.3d 132 (2nd Cir. 1998).

Her opinion in Tasini v. New York Times Co., 972 F. Supp. 804 (1997), however, was reversed four years later, 206 F.3d 161 (2d Cir. 2001). And the Second Circuit's opinion was upheld in New York Times Co. v. Tasini, 533 U.S. 483 (2001). There, only Justices Stevens, since replaced by Justice Kagan, and Breyer agreed with her conclusion. *Id.* at 507.

Neither now-Justice Sotomayor's nor the Second Circuit's opinion flag, much less

dwell on, the potential effects of the authors' prevailing. The potential for "punch[ing] gaping holes in the electronic record of history," *id.* at 505, however, received some attention in the Supreme Court. The majority nevertheless dismissed the risk, saying, "Notwithstanding the dire predictions from some quarters [citing Justice Stevens' dissent], it hardly follows from today's decision that an injunction against the inclusion of these Articles in the Databases (much less all freelance articles in any databases) must issue." *Id.*

What was intended is unclear. But the remark seems to have substantially reduced the potential for prevailing patent or copyright owners to obtain injunctions. *See* eBay Inc. v. MercExchange, L.L.C., 547 U.S. 388, 392–93 (2006) (citing *Tasini*).

Moreover, the dispute between freelance authors and newspapers over the privilege to publish revisions without additional compensation is still unresolved. *See* Reed Elsevier, Inc. v. Muchnick, 130 S.Ct. 1237, 1242 (2010) ("The relevant proceedings in this case began after we issued our opinion in New York Times Co. v. Tasini....").

Judge Sotomayor seems to have ruled as she did primarily because she found publishers' selection of articles to be their most significant contribution to various collective works. *See* 972 F. Supp. at 825-26. Although sympathetic to arguments that they were receiving a windfall, she refused to speculate about "how Congress might have done things differently had it known then what it knows now." *Id.* at 827.

The Second Circuit seems to have taken exception primarily because it found publishers' presentation of articles on pages to control. 206 F.3d at 168-69. The difference is subtle, and it is not at all clear that anyone, including the authors, is markedly better off because that view prevailed.

As a member of the Second Circuit bench, Justice Sotomayor is linked by

Westlaw with 231 opinions between 1994 and 2009, most her own. From those, BNA selected five for inclusion in the U.S.P.Q.2d.

Four centered in the Lanham Act. Playtex Products, Inc. v. Georgia-Pacific Corp., 390 F.3d 158 (2004), the latest, was overtaken by a change in the statute. Two involved cybersquatting, and Schering Corp. v. Pfizer Inc., 189 F.3d 218 (1999), addressed false advertising.

Her remaining IP opinion, Nadel v. Play-By-Play Toys & Novelties, Inc., 208 F.3d 368 (2000), is notable for its thorough analysis and lucid synthesis of New York law governing idea submissions since the still-leading case, Downey v. General Foods Corp., 286 N.E.2d 257 (1972).

From the foregoing, I would hazard no guesses about how Justice Sotomayor views IP or how she might rule in cases that the Court chooses to accept.

That observation applies with double force to Justice Kagan, appointed only in August of 2010. As others note, her views about IP have not been aired. Indeed, she may have none.

Westlaw lists Justice Kagan as the author of eleven papers and co-author of one. Two are about Harvard; three are obituaries; one lauds Judge Richard Posner's many contributions as judge and scholar; and one is a book review.

Her other five papers are substantial articles published in prestigious law reviews between 1993 and 2001. The three earliest concern free speech; the last two, one co-authored, focus on executive and legislative powers. The latest was published nearly a decade ago. Entitled *Presidential Administration,* 114 Harv. L.Rev. 2245, it runs 122 pages and draws on her experience as Deputy Assistant to President Clinton for Domestic Policy and Director of his Domestic Policy Council.

Some find significance in her bringing Lawrence Lessig back to Harvard, as well

as her supporting a Harvard clinic's defense of file sharer, Joel Tenenbaum. Neither tells us much. Nor does mention of IP in one of her papers about Harvard curricular reform. From such evidence, it is impossible to see more than that Dean Kagan regarded IP, in the most comprehensive sense, as worthy of a place in Harvard's curriculum.

Others mention that, as Solicitor General, Justice Kagan had a hand in four IP cases, two resulting in opinions. But one should not regard an attorney as personally endorsing positions taken as an advocate. (The record of Justice Souter, whom Justice Sotomayor replaced, seems to furnish ample support for that proposition.)

I see no reason to expect from either of our newest Supreme Court Justices anything other than an open mind and willingness to be persuaded by good legal arguments well anchored to credible facts.