# Client Alert

**June 2019**

## Supreme Court [in] Brief: Two IP-Related Cases Will Be Heard by the Highest Court

On June 24, 2019, the Supreme Court granted petitions for a writ of certiorari in two separate IP-related cases, one having to do with the copyrightability of government legal publications (such as annotated code) and the other regarding the question of whether time-bar rulings by the Patent Trial and Appeal Board (PTAB) are reviewable on appeal.

### Are Government Legal Publications Copyrightable?

The Supreme Court agreed to hear a case that will determine whether local governments can claim copyright control over legal publications, such as an annotated code.

Many states, including Georgia, publish online a simplified, free version of their state code. Some also offer an annotated version, featuring citations, analysis and opinions from the state attorney general, available only after a fee is paid.

An activist group, called Public.Resource.Org, republished the annotated version of Georgia's code without permission. As a result, the Code Revision Commission, for the benefit and on behalf of the General Assembly of Georgia, sued Public.Resource.Org for copyright infringement and was granted a partial summary judgment on that issue in district court.

The *government edicts doctrine* mandates that the question of copyrightability for government legal works is dependent on whether the work is the law, or sufficiently like the law to be deemed the product of the direct exercise of sovereign authority, and thus a product of authorship attributable to the public at large.

In October 2018, the Eleventh Circuit overturned the district court's summary judgment, instead siding with Public.Resource.Org and finding that annotations to the Georgia Code are not protected by copyright. The Eleventh Circuit held, "[W]hile not having the force of law, [annotations] are part and parcel of the law. They are so enmeshed with Georgia's law as to be inextricable…. They are therefore uncopyrightable." *Georgia, et al. v. Public.Resource.Org Inc.,* 906, F.3d 1229, 1243 (11th Cir. 2018), cert. granted sub nom., *Georgia v. Public.Resource.Org, Inc.* (U.S. June 24, 2019).

The Court will now decide "whether the government edicts doctrine extends to—and thus renders uncopyrightable—works that lack the force of law, such as the annotations in the Official Code of Georgia Annotated."

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**Are Time-Bar Rulings by the PTAB Appealable?**

The Supreme Court agreed to hear a case that will determine whether the Federal Circuit can review determinations by the PTAB regarding the timeliness of a petitioner's request for *inter partes* review (IPR).

Under 35 U.S.C. § 315(b) of the America Invents Act (AIA), a petition for IPR challenging the validity of a patent must be filed within one year of the service (on the petitioner, the real party in interest or a privy of the petitioner) of a complaint alleging infringement of the challenged patent. Accordingly, if the PTAB determines that a petition was filed after expiration of the one-year deadline, it will not institute an IPR.

35 U.S.C. § 314(d) of the AIA prohibits the review of institution decisions. Last year, the Federal Circuit interpreted this provision narrowly, only prohibiting appeal of those determinations closely related to the preliminary finding on the patentability of claims. *See Wi-Fi One, LLC v. Broadcom Corp.*, 878 F.3d 1364 (Fed. Cir. 2018) (*en banc*) (holding that the question whether an IPR petition is filed within the one-year period falls outside this scope and therefore is appealable).

Following the precedent of *Wi-Fi One*, the Federal Circuit recently ruled that an IPR petition by Dex Media, challenging the validity of a patent owned by Click-to-Call Technologies, was not timely, overturning the PTAB's decision to institute. *Click-to-Call Techs., LP v. Ingenio, Inc.*, 899 F.3d 1321 (Fed. Cir. 2018).

Dex Media appealed to the Supreme Court, arguing that *Wi-Fi One* disregarded the plain language of 35 U.S.C. § 314(d) and failed to follow the Court's decision in *Cuozzo v. Lee*, 136 S. Ct. 2131 (2016), which generally bars appeal of IPR institution decisions (except under very narrow circumstances).

The Court will now decide whether the Federal Circuit has authority to review PTAB decisions regarding the timeliness of IPR petitions.

(Dex Media also raised a second question in its appeal, regarding whether a voluntarily dismissed patent infringement suit starts the tolling of the one-year period to file an IPR petition, but the Supreme Court has declined to consider this question.)

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