3 KEY TAKEAWAYS

From the New York City Bar Association's 2024 *Intellectual Property Institute*

Kilpatrick was honored to be a Platinum sponsor of the New York City Bar Association's 2024 Intellectual Property Institute. Jonathan W. Thomas, Megan E. Bussey, Sindy Ding-Voorhees, and Anna Antonova represented Kilpatrick at the day-long Institute, which featured panels on wide-ranging topics, including the effects of the Supreme Court's decision in "Bad Spaniels" on the arts and entertainment industries' use of trademarks in expressive works; generative AI and copyright law; and the scope of patents in the 21st century.

The key takeaways from these panels and more include:

1

Expressive Works After "Bad Spaniels": Trademark Use or Not? Historically, members of the arts and entertainment industries invoked the Second Circuit's seminal decision in Rogers v. Grimaldi when a brand owner challenged their use of a trademark in an "expressive work," such as a motion picture or book. In Rogers v. Grimaldi, the Second Circuit held that the First Amendment allows the use of a term—even if otherwise registered as a mark—in an expressive work; provided, however, that the use has some degree of artistic relevance to the underlying work and is not explicitly misleading as to the work's source or content. Last year, the Supreme Court narrowed Rogers v. Grimaldi, when it held in Jack Daniel's Properties, Inc. v. VIP Products LLC, 599 US 140, 216 (2023) that Rogers v. Grimaldi does not apply when the defendant uses the challenged term as a mark—i.e., an identifier of source—for its own goods or services; instead, Rogers applies only when the defendant uses the challenged term in a non-trademark sense to convey a different, non-source-identifying message to consumers. The Supreme Court emphasized the defendant's decision to apply to register its challenged terms as trademarks. **Takeaway**: Producers of expressive works will have to strike a careful balance between trademark versus non-trademark use in their works, as well as work closely with key stakeholders to align on the ramifications of claiming trademark rights in the terms used in their works.

2

Copyright Registration and AI: Human Authorship Remains the Rule. With the advent of generative AI, the Copyright Office has seen an increase in applications that list a generative AI machine as the author, as well as applications that comprise material authored by a generative AI machine and a human. Regarding the former, Suzanne Wilson, the U.S. Copyright Office's General Counsel, reiterated that U.S. Copyright Office will not register a work that is entirely AI-generated (generative or not); instead, human authorship remains the requirement. **Takeaway**: Human authors should be prepared to have to disclaim the AI-generated portion(s) of their applied-for-work if they want to receive a copyright registration, which, in the United States, is a pre-condition to suing for infringement.

3

Functional Claim Language in Patent Law: Balancing Functional Limitations with § 112 Requirements: Patent law requires the claims particularly point out and distinctly claim the subject matter of the invention. Historically, an invention could not be claimed using functional claim language. Then, in 1952, Congress created a safe harbor for "means-plus-function" claiming in the 1952 Patent Act. The Federal Circuit now appears to see "nothing wrong" with functional claiming, while also noting that the task of determining whether a claim limitation defined in purely function terms is sufficiently definite is "a difficult one that is highly dependent on context." Halliburton Energy Services, Inc. v. MI LLC, 514 F. 3d 1244, 1255 (Fed. Cir. 2008). **Takeaway**: While functional claim language can be a useful tool for providing broad patent protection, practitioners should carefully consider if such limitations are "sufficiently definite" when drafting claims and whether they could complicate proving infringement by a competitor.

We look forward to sponsoring next year's Institute and seeing what the rapidly advancing legal field of intellectual property law has in store for us.

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