



IDEAS ON INTELLECTUAL PROPERTY LAW

YEAR END
2025

Managing Partner Philmore H. Colburn II

"Access" in the internet age

Social media sharing complicates copyright infringement analysis

Can trademark registrants sue co-owners for infringement?

PTO memo limits evidence in IPR proceedings

How prosecution history disclaimer doomed a patent infringement claim

Doctrine applies to both design and utility patents

**PROTECT
WHAT'S YOURS**



Cantor Colburn LLP

www.cantorcolburn.com

#9

US UTILITY PATENTS

#8

US DESIGN PATENTS

#11

US TRADEMARKS

2024 US PATENT DATA

“Access” in the internet age

Social media sharing complicates copyright infringement analysis

One element of a successful copyright infringement claim is showing that the defendant had access to the plaintiff’s copyrighted work. But how can a court assess the concept of access in a digitally interconnected world where social media can make a post available to millions of people around the globe?

The U.S. Court of Appeals for the Ninth Circuit recently considered this question. One of its conclusions? That *availability* shouldn’t be confused with *access*.

INSTAGRAM INSTIGATES INFRINGEMENT CLAIM

Rodney Woodland is a freelance artist and model who posts photographs of himself in different poses on Instagram. Montero Lamar Hill (also known as the recording artist Lil Nas X) also shares photos of himself in varying poses on Instagram.

Woodland sued Hill for copyright infringement. He alleged that eight of the photos on Hill’s Instagram account infringed 12 of his own. His photo posts garnered between eight and 75 “likes” each. Hill’s posts on Instagram receive hundreds of thousands, sometimes millions, of “likes.”

The trial court dismissed the claim before trial. It found that, among other things, Woodland didn’t allege any factors that would show a reasonable possibility that Hill viewed Woodland’s photos on Instagram. Woodland appealed.

COURT SHARES ITS ANALYSIS

To get to trial on a copyright infringement claim, a plaintiff must show 1) ownership of a valid copyright, and 2) copying of the original elements of the copyrighted work. The first prong wasn’t in question here, so the appellate court focused on the second. Under that prong, the plaintiff must show that the defendant copied the protected work.

Direct evidence of copying is, the court noted, rarely available. To prove copying circumstantially, plaintiffs often show that the defendant had access to their work and that the two works are “substantially similar.”

To show circumstantial evidence of access, the plaintiff generally can provide evidence of a “chain of events” between the work and the defendant’s access to it, or that the work was widely disseminated. The latter wasn’t the case for Woodland, meaning he



PHOTO ANALYSIS SHOWS LACK OF SUBSTANTIAL SIMILARITY

Even if the plaintiff in *Woodland* had established access (see main article), the copyright infringement claim would have failed because the U.S. Court of Appeals for the Ninth Circuit found none of the defendant's photos were "substantially similar." The court emphasized that the individual elements in photos (for example, subject, poses, lighting, costumes and makeup) aren't themselves protected by copyright. What's protected is the selection and arrangement of such elements.

After evaluating the individual photos at issue, the appellate court concluded that the plaintiff's photos bore few similarities to the defendant's. For example, it found that photos of a man reclining with certain body parts "strategically covered" presented a common pose for male models and actors. Moreover, the backgrounds, colors, lighting, perspectives and accessories on the respective men varied widely. Another set of photos shared nothing other than the depiction of a man with outstretched arms, an unprotectable idea. The differences between the plaintiff's and defendant's photos meant the plaintiff didn't establish unlawful appropriation of his photos.

needed to show a chain of events that raised a reasonable possibility that Hill viewed his work; a "bare possibility" wouldn't suffice.

Woodland attempted to do so by contending that Hill, as an Instagram user, had a reasonable possibility of seeing his photos there. The court noted that this argument highlights how platforms like Instagram can theoretically make it easier to show access for a copyright claim. After all, a work posted online is available to millions or billions of individuals worldwide.

To prove copying circumstantially, plaintiffs often show that the defendant had access to their work and that the two works are substantially similar.

Moreover, platforms such as Instagram, Spotify and YouTube actively connect content creators with content consumers. They use algorithms to recommend tailored content, thereby facilitating the discovery of content without consumers needing to search for it. The platforms continually push individualized content to users based on their preferences, usage and habits.

Woodland asserted that Instagram's recommendation algorithm increased the odds that Hill saw his works because the content they both post is similar. He provided no evidence, though, that similar profile content alone would prompt Instagram to promote a profile's posts to certain users. Rather, his evidence indicated that posts are recommended based on:

- Accounts users follow,
- Posts users like, share and comment on,
- Users' history of connecting with accounts, and
- How popular a particular post is and how others have interacted with it.

The court determined that Woodland therefore fell short of showing Hill had the requisite reasonable chance of seeing Woodland's works on Instagram.

STAY TUNED

The Ninth Circuit declined to delineate the precise facts a plaintiff must allege about a digital platform's algorithm or content-sharing policy to establish access. The court suggested, though, that it might be sufficient to allege that a defendant followed, liked or otherwise interacted with posts or accounts connected to or similar to the plaintiff's. Further clarification from the courts is likely in the future. □

Can trademark registrants sue co-owners for infringement?

Breaking up is hard to do — especially when trademark rights are involved. Recently, for the first time, the U.S. Court of Appeals for the Fifth Circuit considered whether a co-owner of a trademark may pursue claims against other owners for unauthorized use of the mark. The court summarized the relevant statutory text and U.S. Supreme Court precedent in reaching its ruling.

BATTLE OF THE BAND

In 1991, the singers Di Reed, Tonya Harris and Joi Marshall formed Jade. The group enjoyed significant success before breaking up in 1995.

During the band's period of success, the women registered the JADE service mark. The mark was canceled in October 2001. At that time, it was owned by Jade, a partnership that included all three of them.

In 2018, the singers agreed to a reunion tour and collectively applied for joint ownership of the service mark. Registration was issued in June 2019, with the registrants listed as Reed, Marshall and Harris, all in their individual capacities.

The reunion tour never transpired, though. Instead, in 2021, Marshall and Harris entered a work-for-hire contract with a new singer, Myracle Holloway. Despite cease-and-desist letters from Reed, the three performed as Jade at several concerts later that year.

Reed subsequently sued Marshall, Harris and Holloway for several claims under the Lanham Act, the federal trademark law, including trademark infringement and trademark dilution. The trial court dismissed her lawsuit before trial. It found that Reed couldn't pursue Lanham Act infringement or dilution claims against the two co-owners of the mark or Holloway, who performed as a licensee with their permission. Reed appealed.



THE ENCORE

The appellate court began by noting that Reed, Marshall and Harris had entered into *joint* ownership of the mark, meaning each individual owned a complete interest in it. The question was whether the Lanham Act provides a remedy for disputes among co-owners of a mark. The court concluded that it doesn't, based primarily on the division between owners and infringers.

All courts that have considered the rights of co-owners in trademark cases have held that federal infringement claims can't be maintained against co-owners.

The text of the Lanham Act makes the infringement cause of action exclusive to the registrant of the mark and designates the owner as the only proper party to apply for registration of a mark. In addition, the Supreme Court has recognized that registration of a mark enables *the owner* to sue an *infringer* under the Lanham Act. Similarly, the statute makes the dilution cause of action exclusive to "an owner" of a mark alleging dilution by "another person."

The law, the court said, protects two categories of people — consumers who are deceived by knockoff

products and owners whose products and services are defrauded — from a third group, imitators who profit from deception. "Co-owners of a mark, who generally have the right to use their marks as they please, fall only on one side of this dividing line," according to the appellate court. In other words, a co-owner with an equal right to use a mark can't be an imitator at whom the Lanham Act is targeted.

The court's reasoning puts it in line with other circuits. All courts that have considered the rights of co-owners in trademark cases have held that federal infringement claims can't be maintained against co-owners.

The appellate court also rejected Reed's infringement claims against Holloway. Marshall and Harris, who have complete ownership rights in the mark, had an unencumbered right to use the mark as they chose, including by granting a license to Holloway.

A FINAL NOTE

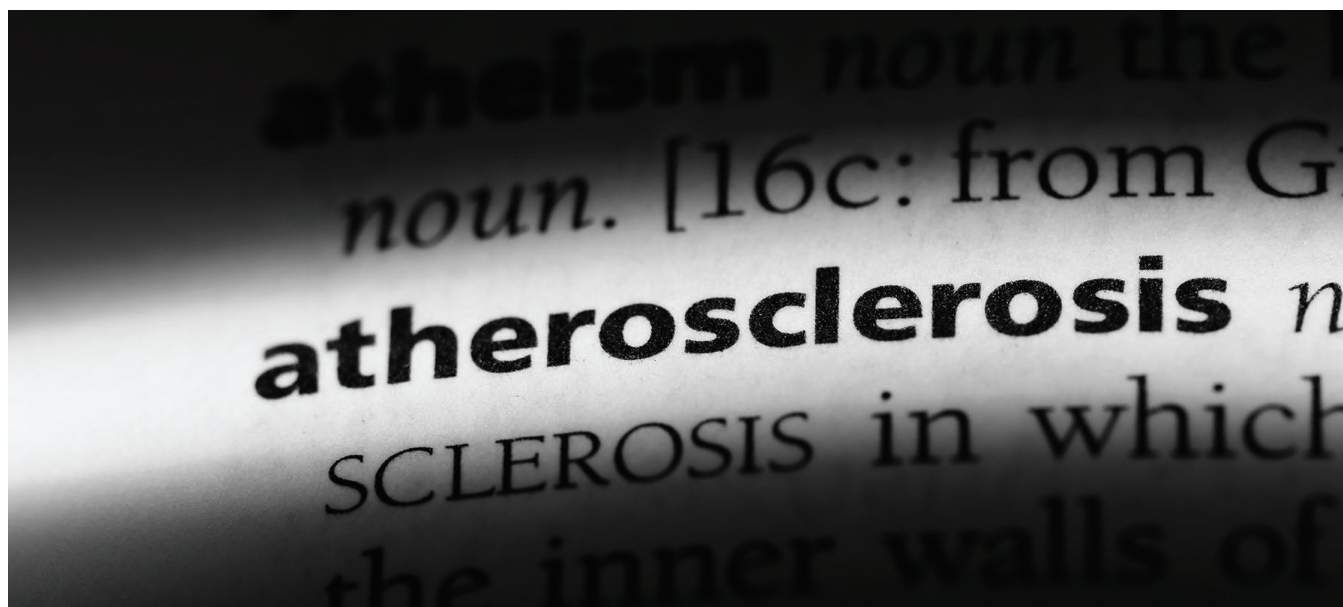
Although joint ownership is legal, the appellate court noted that it's disfavored in the law because discord among co-owners can lead to "multiple, fragmented use," which may result in consumer confusion and deception. Where joint ownership is nonetheless desired, the court said, this case should serve as a "clarion call" that the parties should enter a contractual agreement that outlines their rights in the event they part ways. ▣

PTO memo limits evidence in IPR proceedings

The U.S. Patent and Trademark Office (PTO) announced this past summer that it would begin limiting the use of "applicant admitted prior art" (AAPA) in inter partes reviews (IPRs). The change came on the heels of a ruling by the U.S. Court of Appeals for the Federal Circuit that, contrary to the PTO's new position, allowed such evidence to show missing claim limitations.

THE COURT RULING

On July 14, 2025, the Federal Circuit issued its opinion in a case that involved an IPR challenge to a patent for a device for treating atherosclerosis. The device adds electrodes and a pulse generator to a "typical over-the-wire angioplasty balloon catheter." The challenger argued that the device would have been obvious to a person with ordinary skill in the field (a "skilled artisan").



Specifically, the challenger contended that it'd be obvious to modify a certain piece of prior art with the typical catheter. Prior art is existing material that would have made a patented invention obvious and thus unpatentable. AAPA is prior art referenced in a patent application; in this case, the catheter was the AAPA. The patent holder maintained that the Patent Trial and Appeal Board (PTAB) improperly relied on the AAPA in finding its patent claims obvious.

The Federal Circuit acknowledged that the only types of prior art that can be considered in IPRs are patents and printed publications. It also reiterated its holding in an earlier case that AAPA can't be the basis of an unpatentability ground in an IPR petition.

But the court noted that the obviousness analysis requires an assessment of the "background knowledge" a skilled artisan would possess. And background knowledge can supply "missing claim limitations," meaning claim limitations in the challenged patent that weren't previously disclosed by the prior art.

The court concluded the challenger used background knowledge only to supply missing claim limitations — not to support unpatentability grounds. Therefore, the court found the use of the AAPA as evidence of the background knowledge was permissible.

THE PTO MEMO

Barely two weeks later, though, the PTO released a significant memo regarding its approach to AAPA in the IPR context. Most importantly, the memo explicitly states that AAPA *can't* be used to supply a missing claim limitation.

The memo supersedes 2020 and 2022 PTO memos that both waived PTAB enforcement of Rule 104(b)(4), which requires an IPR petition to specify "where each element of the claim is found in the prior art patents or printed publications relied upon." The rule is now back in effect for any petition filed on or after September 1, 2025.

The memo labels AAPA, expert testimony, common sense and other evidence that isn't prior art in the form of patents or printed publications as "general knowledge." According to the memo, such general knowledge can be used in an IPR only to support a motivation to combine prior art or to demonstrate the knowledge of a person having ordinary skill in the art.

GOING FORWARD

The PTO's memo has critical implications for patent applicants, patent holders and IPR challengers. For all these parties, thorough checks of prior art are more important than ever. ▣

How prosecution history disclaimer doomed a patent infringement claim

Doctrine applies to both design and utility patents

A patent doesn't always provide the protection a patentee expects. In fact, the prosecution history (all communication between the patent applicant and the examiner) can come back to haunt a patentee when it later pursues an infringement action.

HOODIE HULLABALOO

Cozy Comfort Co. LLC owns a design patent for an “enlarged over-garment with an elevated marsupial pocket.” It is popularly marketed as “The Comfy.” Its patent application was initially rejected during prosecution because it was anticipated by another patent (the White design). To overcome the rejection, the company agreed that its design was similar but differed from the White design in some particular respects.



Cozy Comfort subsequently accused Top Brand of patent infringement. In response, Top Brand sought a declaratory judgment of noninfringement. Cozy Comfort counterclaimed for infringement. A jury found that Top Brand infringed the patent.

NO POCKET PROTECTOR

On appeal, Top Brand argued that the trial court should have overridden the jury and granted it a judgment as a matter of law of no infringement, meaning no reasonable jury could find infringement. The question was whether the trial court erred by declining to interpret the design patent claim as limited by the doctrine of “prosecution history disclaimer.”

This doctrine allows a court to limit the scope of patent claims based on the prosecution history. The disclaimer can arise from claim amendments or arguments made to the Patent and Trademark Office. The doctrine is well established for *utility* patents, but Cozy Comfort argued that it doesn't apply to *design* patents.

The Federal Circuit disagreed. According to the court, it would be contrary to the purpose of design patent prosecution to allow the patentee to make arguments in litigation that contradict the representations that led to the grant of the patent and later recapture surrendered claim scope.

The court next considered whether the doctrine applied in the case. The doctrine applies only to “unambiguous disavowals” during prosecution.

To obtain the patent, Cozy Comfort had explained how its design differed from White by focusing on distinguishing features, including the shape and placement of the marsupial pocket (the pocket on the front of a sweatshirt) and the shape of the bottom hemline. The court determined that Cozy Comfort surrendered the identified distinguishing features.

Unfortunately for Cozy Comfort, the court found that multiple aspects of Top Brand's allegedly infringing products were the same features that Cozy Comfort disclaimed during prosecution. The company, therefore, couldn't rely on the features to show design similarity between the products.

WRAPPED UP

With the prosecution history disclaimer properly applied, the court said, the evidence permitted only one reasonable conclusion — no infringement. It therefore reversed the trial court and the jury's verdict. □

Cantor Colburn LLP is committed to providing top quality, comprehensive, responsive, and cost-effective intellectual property legal services to a diverse roster of domestic and international technology-based clients.

Our full-service intellectual property practice areas include:

Litigation

Patents

Trademarks

Copyrights

Due Diligence

Transactions &

Licensing

Post Grant & IPRs

Trade Secrets

Opinions

Anti-Counterfeiting

Strategic Portfolio Management &
Development



www.cantorcolburn.com

HARTFORD | WASHINGTON, D.C. | ATLANTA

860.286.2929 | 404.607.9991 | 703.236.4500 | 713.266.1130 | 248.524.2300