November 2013

Cases of Note -- Piling on Ebay via Patent Litigation

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Recommended Citation
DOI: https://doi.org/10.7771/2380-176X.4930

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tional. Since the NSL process is not subject to court supervision as a search warrant would be, the New York court ruled that National Security Letters were unconstitutional as a violation of the Fourth Amendment prohibition on issuing a search warrant without probable cause. According to the court’s opinion:

While the Fourth Amendment reasonableness standard is permissive in the context of administrative subpoenas, the constitutionality of the administrative subpoena is predicated on the availability of a neutral tribunal to determine, after a subpoena is issued, whether the subpoena actually complies with the Fourth Amendment’s demands. In contrast to an actual physical search, which must be justified by the warrant and probable cause requirements occurring before the search, an administrative subpoena “is regulated by, and its justification derives from, [judicial] process” available after the subpoena is issued.

It was this lack of subsequent judicial review that the District Court criticized. According to the opinion, the language of the statute “has the effect of authorizing coercive searches effectively immune from any judicial process, in violation of the Fourth Amendment.” The judge also ruled that the nondisclosure provisions were unconstitutional because they constituted both a prior restraint on speech and a restraint on speech because of the content.

The government appealed John Doe I to the 2nd Circuit, where it was consolidated with John Doe II. While the appeal was pending, the PATRIOT Act was amended, so the Court of Appeals requested that the parties provide supplemental briefs addressing the impact of the changes on their cases.

According to the Court of Appeals, because the PATRIOT Act amendments allow judicial review of NSLS and because these provisions are retroactive, the Fourth Amendment claims in John Doe I are now moot. However, there are still issues related to the gag order and the First Amendment. These issues have been remanded back to the District Court to “have the opportunity to receive amended pleadings, request new briefs, conduct oral arguments, and, in due course, furnish its views on the constitutionality of the revised version.”

The government requested that the Court of Appeals vacate the judgment from Connecticut in John Doe II. This would have had the effect of causing the decision to be moot. However, the 2nd Circuit did not grant this request. According to the opinion, “[g]iven the concession of the Government . . . that John Doe II can disclose its identity, the Government no longer opposes the relief granted by the District of Connecticut in its preliminary injunction ruling. Thus, the Government has effectively rendered this appeal moot by its own voluntary actions. This voluntary forfeiture of review means that the Government has failed to meet its burden of demonstrating that it is entitled to vacatur of the District of Connecticut’s preliminary injunction ruling.”

[Citations omitted.]

The importance of the Court of Appeals ruling in John Doe II is that the District Court’s ruling of unconstitutionality still stands and is the law in the District of Connecticut. Rather than overturn this ruling, the 2nd Circuit simply dismissed the appeal. Thus, future litigants now have persuasive authority to cite.

The PATRIOT Act Standard for Challenge

The renewed PATRIOT Act has been revised to clarify that recipients of National Security Letters will be able to request judicial review and may challenge the non-disclosure provisions of the NSL. In addition, the new language does allow the type of consultation that occurred, where George informed the executive committee of his Board of Directors, as well as speaking with an attorney. Although the individual recipient must disclose to the FBI the names of the individuals consulted, he or she does not have to disclose the name of the attorney.

Many types of library functions are now exempt from the NSL provisions in Section 505 of the PATRIOT Act because of a better definition of when an NSL may be issued. However, libraries are not entirely out of the woods, as some library functions may still be subject to an NSL.

For more information, see my “Legally Speaking” column in the June 2006 issue of Against the Grain.

One issue involving National Security Letters that still needs to be addressed is the standard for challenge. According to George Christian, “The revised language makes it almost impossible for anyone to do what we did.”

This is because the new provisions of the PATRIOT Act allow the government to certify that disclosure of the name of the NSL recipient will endanger national security. “If, at the time of the petition, the Attorney General, Deputy Attorney General, an Assistant Attorney General, or the Director of the Federal Bureau of Investigation, or in the case of a request by a department, agency, or instrumentality of the Federal Government other than the Department of Justice, the head or deputy head of such department, agency, or instrumentality, certifies that disclosure may endanger the national security of the United States or interfere with diplomatic relations, such certification shall be treated as conclusive unless the court finds that the certification was made in bad faith.”

In the Connecticut John Doe case, the government asserted that “national security” required that the gag order be enforced. However, the FBI later dropped the case and allowed George, Peter, Barbara, and Jan to identify themselves as being John Doe. The concurring opinion in the 2nd Circuit noticed the irony of the FBI seeking to maintain a permanent ban, even after the names had been revealed in the press. The concurring opinion also noted the problematic request of the FBI to expunge the court records.

According to George and Peter, a future NSL recipient can use this case as a specific precedent of an instance where the FBI has used the “national security” argument in bad faith. Perhaps this may assist those who receive NSLS in the future.

Conclusion

The District Courts in John Doe I and John Doe II were both troubled by the implications of the PATRIOT Act. The First Amendment provisions will be reargued in New York, while the ruling of unconstitutionality still stands in Connecticut. The procedure used by Library Connection and the ACLU — filing a lawsuit under seal — is a model for how future cases should be handled. Luckily, the four Connecticut John Does — George Christian, Barbara Bailey, Peter Chase, and Janet Nocek — have taken a very courageous stand, even at the potential loss of their own freedom. The library profession and the American people certainly owe a debt of gratitude to the Connecticut John Does.

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Well, with our finger ever on the pulse of legal trends in USA, we’ve been chattering in ATG about the Supreme Court reining in frivolous patent suits, and here we have one. See — “The End of Automatic Injunctions in Patent Litigation,” Bet You Missed It, ATG v.1883, June, 2006, p.72.

Ebay of course you know for its Internet Website where goods may be listed for sale and purchased by really bored people in work cubicles. Mercexchange sought to license a business method patent to Ebay but no contract was formed. Ebay used the method anyhow.

Mercexchange sued and got a jury verdict of patent infringement. The District Court said an award of money damages would be just, but declined to issue an injunction against using the method. (1) A willing—
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The only confusion arises from the Patent Act's declaration that to have the "attributes of personal property," § 261, including "the right to exclude others from making, using, offering for sale, or selling the invention," § 154(a)(1). The Court of Appeals felt this required a mandatory injunction.

And of course, that’s consistent with the treatment of a copyright holder who has "the right to exclude others from using his property," *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127, 52 S. Ct. 546 (1932). But in copyright the issuance of an injunction is a "may issue" based on principles of equity. See, e.g., *New York Times Co. v. Tasini*, 533 U.S. 483, 505 (2001). Which is to say you have to apply the four factors.

If *Tasini* accomplished nothing else, he’s certainly made himself into a boring footnote for future generations of law students.

And What about that Willingness to License Business?

While the Supreme Court’s automatic injunction, they likewise did not care for the District Court’s broad brush stroke of no injunction where a Merceexchange is willing to license and not using the invention itself.

Inventors might prefer to license their patents themselves rather than have every Tom, Dick and Ebay come along and grab the thing and force a fight over damages. See, *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405, 422-430 (1908).

The District Court was focusing on (4) serving the public interest. Presumably, they would have been okay if they had just applied the four factors and come down heavily on (4) to justify the result in that particular case.

The brain teaser is both patents and continued on page 74
Biz of Acq — Big Deal E-Journals Packages and Third Party Subscription Vendors: Does It Make Sense Anymore?

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Subscription Vendor Services

Subscriptions to both large and small e-journal bundles from publishers have become commonplace in academic libraries during the past few years. It is not the purpose of this article to debate the pros and cons of these e-journal bundles, also known as “big deal” packages; they are a reality. The terms and conditions of these subscriptions are as varied as the titles and publishers themselves; managing the various and complex terms, title lists, contracts, and conditions has been challenging for libraries and subscription vendors alike. Most academic libraries in the United States contract with a third party subscription vendor to handle their e-journal and print subscriptions, whether they are individual titles or large, comprehensive bundles. In return for a fee that is usually based in part on the total cost of a library’s serials subscriptions, subscription vendors provide a variety of services to libraries. The utility of these services is important without a doubt, especially to libraries with limited staffing. While subscription vendors have played a central role in managing library subscriptions in the past, the time has come to investigate the usefulness of their services in the “big deal” world.

New Realities and a Hypothetical Scenario

For better or worse, publishers offer comprehensive e-package bundles where a library pays an annual fee to access all titles that a publisher may offer. This is especially true of the larger publishers in the disciplines of science, technology, and medicine, also known as STM. The price basis of these “big deal” packages varies greatly. In consortial deals, some publishers use a pooled historical (print) title list gathered from multiple institutions while others base the price on FTE, Carnegie Classification, or usage data. The complexity of pricing models, consortial deals, and even direct-to-publisher deals has created an enormous amount of data that a library needs to have readily available. A library needs ready access to title lists, coverage dates, license details, renewal dates, contact information, access URLs, and the list goes on and on. In addition, while ERM (Electronic Resource Management) systems are alleviating some of the information management burden, we are far from a comprehensive solution. It really is not necessary to describe how completely different managing e-resources is from managing print resources. We all know that it is an enormous and never-ending task. So where does the subscription vendor fit in with “big deal” packages?

Let us consider a hypothetical but completely realistic scenario. A library has existing electronic subscriptions to approximately 100 titles from Publisher X and is interested in licensing access to all of Publisher X’s titles for an annual subscription fee. This is the quintessential “big deal” package. Since some subscription vendors are now offering negotiation services, the library now considers whether to have their subscription vendor negotiate the deal.

Negotiation: Who Handles It?
The art of negotiation is a skill that is perfected with experience. It is not a skill that is routinely taught in library schools although some, including myself, would argue that it should be. Some librarians are very astute at negotiating and some are not. As a group, however, librarians are not business-oriented people and we lack negotiation skills. In fact, many of us abhor corporate culture and identify the academy as the culture with which we feel most at home, both personally and professionally. It is a simple fact that librarians tend to be poor negotiators by nature. It is my opinion that librarianship could use an injection of the business mentality when it comes to negotiating subscription contracts. That does not mean being unethical, but we should all “go to bat” for our institutions; it is what we are paid to do. Furthermore, it has been my experience that vendors and publisher representatives respect good negotiation and that they are genuinely good people. They are not the pro-getting-booby-trap men that some of us make them out to be. Ask your representative questions, ask for deeper discounts and price caps, be creative, and remember that the answer is always “no” if you never ask.

As much as I would love to see librarians “go to bat” for themselves, we need to ask the question, “Should we ask third party subscription vendors to do our negotiating for us?” Is negotiating contracts a new service for which libraries should pay vendors a percentage fee?