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# IP SAVVY

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*THE Newsletter for the Intellectual Property Community*

May 2012

## THE DEVIL IS IN THE DETAILS

How much detail is required in a patent application? Enough detail so a “person of ordinary skill in the art” could make and use the patented invention. Not a very satisfying answer is it?

In one old case, a patent for an electronic organ included a block diagram with a “recognition logic block” but no disclosure regarding its circuitry. A jury found the patent invalid. In several more recent cases, one example of the claimed invention was disclosed but other examples covered by the patent claims were not. The patents were held invalid.

In *Typhoon Touch Technologies, Inc. v. Dell, Inc.*, 100 USPQ2d 1690 (Fed. Cir. 2011) a patent for a keyboard-less computer claimed, in part, a “cross referencing” algorithm. The computer code for the algorithm was not disclosed. Still, the algorithm was described to a certain extent and that description would enable a computer programmer to implement the required functionality. The patent was upheld.

It is usually best to include more rather than less detail in patent applications and as many examples as possible – not only to counter charges of invalidity but also to provide fall back positions for claiming narrower subject matter in case a broader as-filed claims are rejected. A patent is not a production specification but it is best not to leave too much to the imagination, especially since judges and juries deciding whether your patent is valid or not typically don’t have science or engineering degrees.

## PATENING LAWS OF NATURE

The patent eligibility question as between unpatentable ideas or laws of nature and patentable application of ideas or laws of nature is thorny:

Our opinions spend page after page revisiting our cases and those of the Supreme Court, and still we continue to disagree vigorously over what is or is not patentable subject matter.

*MySpace Inc. v. GraphOn Corp.*, 101 USPQ2d 1873, 1879 (Fed Cir, 2012).

These are the words of the appellate judges of the Court of Appeals of the Federal Circuit which decides all patent cases. Their proposed “solution” to the problem? Table it for later. See *id.*, at 1880-1881.

18 days later, the United States Supreme Court held in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 101 USPQ2d 1961 (2012) that a medical diagnostic procedure was not patentable since it was basically a law of nature.

If a law of nature is not patentable, then neither is a process reciting a law of nature, unless that process had additional features that provide practical assurance that the process is more than drafting effort designed to monopolize the law of

nature itself. A patent, for example, could not simply recite a law of nature and then add the instruction “apply the law.” Einstein, we assume, could not have patented his famous law by claiming a process consisting of simply telling linear accelerator operators to refer to the law to determine how much energy an amount of mass has produced (or vice versa). Nor could Archimedes have secured a patent for his famous principle of floatation by claiming a process consisting of simply telling boat builders to refer to that principal in order to determine whether an object will float.

Id. at 1968.

In light of this holding, it will be interesting to see what the Federal Circuit Judges do when they revisit their previous upholding of a patent for isolated DNA. In that case, they’ll have to address the patent eligibility question head on.

## FIRST TO FILE

As the United States moves to a first to file patent system in 2013, it is interesting to note there already is at least one existing scenario where the first filer wins a patent over the first to invent: where the first to invent suppresses or conceals the invention.

If the first to invent does not suppress or conceal the invention, the first to invent can wipe out the first filed patent. Does the first to invent have to completely understand the invention to be the first to invent? According to *Teva Pharm. Industries, Ltd. V. AstraZeneca Pharm., LP*, 100 USPQ2d 1852 (Fed. Cir. 2011), the answer is no.

Also, under the new law, a prior commercial use defense is available to an accused infringer of the patent.

## MUSIC DISPUTE

A new top level domain name, such as “dot music” cost hundreds of thousands of dollars. A trademark only costs a few thousand. So, one company sought to register the trademark “dot music” and, then, presumably could have sued all the top level domain owners who paid hundreds of thousands of dollars for that top level domain. The Trademark Office, however, rejected the applicant’s registration stating “dot music” was merely descriptive of a top level domain name in the field of music and was thus not registerable. *In re the Dot Communications Network, LLC* (TTAB 2011).

## APP STORE A WEAK TRADEMARK

Apple’s mobile software download service “app store” is weak held a United States District Court. Apple had sued Amazon (which also used “app store”) as well as Microsoft who had objected to Apple’s pending trademark application. Apple’s motion for a preliminary injunction against Amazon was denied in *Apple Inc. v. Amazon.com, Inc.*, 100 USPQ2d 1835 (N.D. Cal., 2011).

## COPYRIGHT FAILS

Some people continue to believe copyright protection is strong. Richard Pollick designed a pair of “diaper jeans” (diapers that look like jeans) and obtained a U.S. Copyright Registration. He then submitted his “diaper jeans” to Kimberly-Clark, Corp. Kimberly-Clark, which does understand copyright law, then started selling its own diaper jeans. Pollick sued.

His case was dismissed: copyright cannot and does not protect ideas (like diapers that look like jeans) and instead only protects Pollick’s particular diaper that looks like jeans. Since Kimberly-Clark’s jean diapers look different than Pollick’s, no copyright could protect Pollick. *Pollick v Kimberly-Clark Corp.*, 100 USPQ2d 1858 (E.D. Mich., 2011).

## THREE STRIKES

Here is a fun game: A sues B for infringing A's patent. B asserts A's patent is invalid. A wins, B loses. B is enjoined and cannot sell products which infringe A's patent. B appeals and loses again.

B then begins a re-examination of A's patent back at the Patent Office. The Patent Office rules A's patent is invalid.

Is it right that B gets three tries at invalidating A's patent? Whether right or wrong, under current law, B does in fact get three tries.

The more interesting question is whether B now gets to sell its' product given that A's patent is now invalid? Under the current law, that is unclear and the answer could be no. See *In re Construction Equipment Co.*, 100 USPQ2d 1922 (Fed Cir 2011).

## MOVIE DOWNLOADERS TARGETED

Remember when I told you to stop your high school and college age students from downloading music because the downloaders were getting sued by the music industry? Well, tell them its now time to stop downloading movies. In the Massachusetts case *Liberty Media Holdings LLC v. Swarm Sharing Hash File*, 100 USPQ2d 1929 (D. Mass, 2011), 38 people were sued for using BitTorrent to download a movie.

## GOATS ON A GRASS ROOF®

Al Johnson's "Swedish Restaurant & Butik" is located in Wisconsin and has a sod roof with goats on it. No, I am not making this up. So, Johnson's federally registered trademark is a depiction of goats on a sod roof.

Anyways, a guy by the name of Robert Doyle apparently didn't like Johnson's trademark registration and tried to cancel it in *Doyle v. Al Johnson's Swedish Restaurant & Butik, Inc.*, 101 USPQ2d 1780 (Fed Cir, 2012). Doyle failed. Further research reveals Al Johnson's has threatened litigation for other restaurants with goats on their roofs.

## NAKED COWBOY

Times Square's "Naked Cowboy" (where else?) sued CBS' the "Bold and the Beautiful" soap opera because a character therein briefly dressed in cowboy boots, a cowboy hat, and underwear while bearing a guitar. No, I'm not making this one up either. Anyways, CBS won because its naked cowboy looked different than the Times Square naked cowboy. *Naked Cowboy v. CBS*, 101 USPQ2d 1841 (S.D.NY 2012).

## FIRM NEWS

Partner Kirk Teska continues his monthly column PATENT WATCH® in Mechanical Engineering Magazine.

Partner Roy Coleman, in collaboration with the Boston Chapter of the Biomedical Engineering Society, is hosting an event "Engineers Meet Biology, A Look to the Future" at The Charles Stark Draper Laboratories in Cambridge on May 31, 2012 at 6:00pm. The event is open to the public.

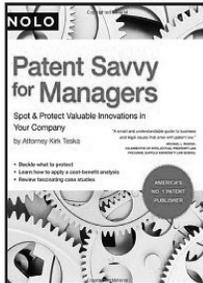
Also, Mr. Coleman won a patent for one of his clients and sued Dick's Sporting Goods when it began selling a competing product. The case settled favorably for his client.

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