NAPP 2022: Case Review Summaries

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Hibbs Law, LLC

Hibbs Law, LLC
Genna Hibbs

- Intellectual Property boutique firm **founded in 2013**
- **Bar Admissions:** Illinois, US Northern District IL, US Patents & Trade Office
- **Focus Areas:** Patents, Trademarks, Copyrights, Unfair Competition, Trade Secrets, Infringement Enforcement/Litigation, Licensing, Entity Formation, Regulatory Compliance, and Business Transactions.
- **Clientele**: Small business, medium corporations, individuals
- **Technology Areas**: Biotechnology, Genetics, Chemistry, products, and simple devices
- Substantial dedication to ***pro bono*** legal services (20-30% of time)

2021 Fed Cir ROAD MAP

- SIMO HOLDINGS INC. v. HONG KONG UCLOUDLINK NETWORK (DCT)
- KEYNETIK, INC. v. SAMSUNG ELECTRONICS CO., LTD (PTO)
- PM & K HOLDINGS, INC. v. SAMSUNG ELECTRONICS CO., LTD.(PTO)
- INTEX RECREATION CORP. v. TEAM WORLDWIDE CORPORATION (PTO)
- OMNI MEDSCI, INC. v. APPLE INC. (DCT)
- TEAM WORLDWIDE CORPORATION v. INTEX RECREATION CORP. (PTO)
- SYNCHRONOSS TECHNOLOGIES, INC v. DROPBOX, INC. (DCT)
- In Re SURGISIL, L.L.P. (PTO)
- INDIVIOR UK LIMITED v. DR. REDDY'S LABORATORIES S.A. (PTO)
- ASTRAZENECA AB v. MYLAN PHARMACEUTICALS INC. (DCT)
- INFINITY COMPUTER PRODUCTS v. OKI DATA AMERICAS, INC. (DCT)

Appeal from D.Ct.

SIMO HOLDINGS INC. v. HONG KONG UCLOUDLINK NETWORK

19-2411

5JAN21

Precedential

The Preamble: Uh-oh!

Everything after “comprising” = claim, especially “In supplying the only structure for the claimed apparatus, the preamble language supplies ‘**essential structure**,’ [AND] the **body does not** define ‘a structurally complete inventions’—which are two key reasons for preamble language to be deemed limiting.” (Not merely identifying an intended use or functional property)

A preamble is “limiting when it serves as **antecedent basis** for a term appearing in the body of a claim.”

“a plurality of”: Uh-oh!

preamble’s “a plurality of” list was not a pick two situation;
INSTEAD “We conclude, along with [Defendants], that ‘a plurality of’ requires at least two of *each* of the listed items in the phrase”.

Ending with “and” = one or more of EACH; = insert modifier before each list item.

“‘When there is a straightforward, parallel construction that involves all nouns or verbs in a series, a prepositive or postpositive modifier normally applies to the entire series.’”

Could have broken the carryover modifier with a fresh article preceding the noun.

Appeal from PTAB-IPR

KEYNETIK, INC. v. SAMSUNG ELECTRONICS CO., LTD.

20-1271

27JAN21

Nonprecedential

Claim Construction

The word "each" might mean only one:

(this case applied Pre-AIA and Pre-2018 PTAB Claim Const. Std.)

The word “each” referring to a set means that each member of a “set with potentially multiple members” has defined characteristics, but there need not be more than 1.

A “set” may have only one member, may have none (empty set), may have multiple; so use of “each” in claim language without more does not explicitly require multiple members with the defined characteristic (at least under BRI standards).

Dissent says this “defies common English usage.”

Appeal from PTAB-IPR

M & K HOLDINGS, INC. v. SAMSUNG ELECTRONICS CO., LTD.

20-1160

1FEB21

Precedential

Printed Publications

Publicly Accessible = available to find by exercising reasonable diligence.

Industry Standards presentation/ draft was the primary reference, primary mentioned secondary references, 200-300 conference attendee, summarized in meeting reports, then posted online.

Didn’t matter that the references were buried in the website, “[t]he relevant inquiry is whether the channel through which the references were publicized is prominent or well-known among [POSITA]”; since the industry standards org was prominent, that was enough to “motivate to track”.

Website repository had “title-search functionality and that the [secondary] references had descriptive titles, thus enabling routine searching of those references by subject matter.”

No content search = ok
If repository is indexed OR otherwise categorized by subject matter = ok

Appeal from PTAB-IPR

INTEX RECREATION CORP. v. TEAM WORLDWIDE CORPORATION

20-1144

21JUN21

Nonprecedential

Understand the difference between e.g. and i.e.

“Inflatable Body”, i.e., an air mattress

Court considered file wrapper estoppel to narrow a claim based on practitioner's use of "i.e." (note that this is not "e.g.") in an argument distinguishing a reference in remarks made during patent prosecution. The **use of "i.e." was considered "definitional."**

Appeal from D.Ct.

OMNI MEDSCI, INC. v. APPLE INC.

20-1715

2AUG21

Precedential

Automatic Assignment

(Public policy to protect inventor)

University bylaws, incorporated in employment agreement of an inventor, listing an invention "**shall be** the property of" the university and "shall be owned" by the university are **agreements to assign and not an assignment**,

True Auto Assignment requires “present-tense verbs of execution” or “active verbal expression of present execution,” and therefore are insufficient to transfer ownership of patent rights under the *Arachnid* case.

(Dissent points out that future tense was required by the context, namely that this clause referred to inventions not yet in existence but that might be developed in the future.)

Appeal from PTAB-PGR

TEAM WORLDWIDE CORPORATION v. INTEX RECREATION CORP.

20-1975

9SEP21

Nonprecedential

More Inflatable Mattresses, Pre-AIA

112(f)/ ¶6: "assembly" or "module" (and other nonce words) can make your claim M+F, as can "configured to" (two cases).

A "pressure controlling assembly" was deemed to be a "means/function" element that was merely functional without reciting clear structure and thus invalid under *Williamson*.

POP-POP goes the pressure controlling assembly

A Chinese priority application had good structural detail but the US application did not **incorporate by reference** (and/or cutting corners on translation?), AND

Appellant failed to raise the **prosecution presumption** in their opening brief or give supporting authority.

Appeal from D.Ct.

SYNCHRONOSS TECHNOLOGIES, INC v. DROPBOX, INC.

19-2196

12FEB21

Precedential

“a user identification module configured to control access of. . .” something is held to be subject to § 112(6) (now § 112(f)) and indefinite under § 112(2) (now § 112(b)) because no algorithm or structure is disclosed (per *Williamson*);

this is true even though the “module” is within a method claim;

the use of “*configured to*” did not prevent this claim element from being a “means/function” element

Appeal from PTAB

In Re SURGISIL, L.L.P.

20-1940

4OCT21

Precedential

Preamble of a design patent's claim are significant to scope / analogous art.

"**A design claim is limited to the article of manufacture identified in the claim; it does not broadly cover a design in the abstract**."

"ornamental design for a lip implant" does not "cover other articles of manufacture" = no anticipation for a stump that is used "for smoothing and blending large areas of pastel or charcoal."

Appeal from PTAB-IPR

INDIVIOR UK LIMITED v. DR. REDDY'S LABORATORIES S.A.

20-2073

24NOV21

Precedential

How to claim a range and what it means (two cases).

Discussion of what it takes to show written description of a **range** (with dissent).

Appeal from D.Ct.

ASTRAZENECA AB v. MYLAN PHARMACEUTICALS INC.

21-1729

8DEC21

Precedential

The opinion rejects arguments that the narrower construction limits the scope of the claims to the preferred embodiment and that the prosecution history is not controlling because of the absence of clear and unmistakable disavowal of claim scope.

The claim calls for .001% of something or other. **The question is whether than means one tenth of one percent rounded to the nearest digit (which would mean .0005% to .0014%) or one tenth of one percent with some degree of "minor variation." The Fed Circuit considered it a "close call" but found the latter, over a dissent,** and thus vacated a finding of infringement, considering the specification as supporting a conclusion of .00095% to 0.00104%. The dissent would have excluded .00045%-.00054% based on the disclaimer and construed the term as .00055% to .0014%. The opinion is noteworthy because it rejects arguments that the narrower construction limits the scope of the claims to the preferred embodiment and that the prosecution history is not controlling because of the absence of clear and unmistakable disavowal of claim scope.

Appeal from D.Ct.

INFINITY COMPUTER PRODUCTS v. OKI DATA AMERICAS, INC.

20-1189

10FEB21

Precedential

Be consistent as to what you say in responding to office actions because you can kill your client's patent.

Claims indefinite because Infinity took conflicting positions on the endpoint of the “passive link” during prosecution compared to during reexamination

Waking Nightmare or Why Not Both?

- Passive connection from fax to I/O bus
- Passive connection from fax to computer port

  = is this mutually exclusive?

  = is this a matter of perspective?

- Nature of the prosecution process? PA → Rxn → PA → Rxn
- Where does the computer stop/start and the passive link start/stop? Solutions: Define everything?

The End.

Questions?