

# PATENT LAW UPDATE FALL 2013

(PAY ATTENTION TO THE SMALL STUFF)

# 3M INNOVATIVE PROPERTIES CO. V. TREDEGAR CORP.

- ◉ 3M Innovative Properties Company and 3M Company, Plaintiffs-Appellants, V. Tredegar Corporation and Tredegar Film Products Corporation, Defendants-Appellees. \_\_ F.3d \_\_ (Fed. Cir. 2013). No. 2012-1241. United States Court of Appeals, Federal Circuit. Decided: August 6, 2013.
- ◉ Addressing claim construction of a term with disputed grammar, the U.S. Court of Appeals for the Federal Circuit affirmed in part the district court's construction and remanded the case, explaining that grammatical rules give way to the written description when construing claims.
- ◉ The claim reads: 1. An elastomeric laminate consisting essentially of at least one elastomeric layer and at least one continuous microtextured skin layer over substantially the entire laminate wherein:
  - (a) the microtexture on said skin layer is formed by stretching an untextured laminate past the deformation limit of at least one untextured skin layer and allowing the stretched laminate to elastically recover over the entire region stretched and
  - (b) said at least one elastomeric layer and said at least one continuous microtextured skin layer are in substantially continuous contact.
- ◉ Does “continuous” apply to the microtexturing, the skin layer, or both? Should it be “continuously microtextured skin layer” (the microtexturing is continuous throughout the skin layer) or maybe “continuous, microtextured skin layer” (the skin layer is continuous and has at least some microtextured areas)?

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- On appeal, the parties disagreed as to whether “continuous” applied to the microtexturing, the skin layer, or both. In essence, the parties dispute the extent of the microtexturing on the skin of the laminate.
- 3M, citing The Chicago Manual of Style, argued that if the applicant intended that the microtexture to be “continuous” it would have used the adverb “continuously” instead of the adjective “continuous.” Tredegar, also citing The Chicago Manual of Style, argued that adjectives separately modifying a noun are generally separated by a comma.
- The Federal Circuit did not rely on this extrinsic evidence. Instead, the Federal Circuit linked the “continuous microtextured skin layer” of the claims to the “unique continuous microtextured surfaces” of the written description and determined that the microtexturing is continuous, but not restricted to a single zone or region of the skin layer.

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- ◉ In a concurring opinion, Judge Plager also rejected 3M’s arguments regarding grammar, stating that “the nuances of comma usage, like 3M’s adverb argument, seem to me a tenuous foundation for an entire claim construction on which substantial liabilities may rest.”
- ◉ However, Judge Plager did not agree that the written description provided sufficient clarity, pointing out that **the phrase “continuous microtextured skin layer” does not appear anywhere in the specification.** Instead, Judge Plager proposed applying the contract drafting doctrine contra proferentem: **“When a term is ambiguous, . . . the ambiguity should be construed against the draftsman.”** Judge Plager proposed that, alternatively, claims introducing such ambiguities **“should simply be invalidated as indefinite.”** Because the applicant “knew or should have known that the claim term . . . was highly relevant to the patented technology,” the applicant should have demonstrated this relevance in the disclosure. Because the patent applicant has “the last clear chance” to avoid ambiguity in claim terms, the competitor “should not have the risk of guessing wrong about what a claim term could possibly mean.”
- ◉ Dissenting-in-part, Judge O’Malley agreed with 3M that, based on “a natural reading of term, i.e., its plain and ordinary meaning,” the adjective “continuous” can only modify the “microtextured skin layer.”

# PLANTRONICS, INC. V. ALIPH, INC.

- ◉ Plantronics, Inc., Plaintiff-Appellant, V. Aliph, Inc. and Aliphcom, Inc., Defendants-Appellees. No. 2012-1355. (July 31, 2013). United States Court of Appeals, Federal Circuit (Nonprecedential.)
- ◉ Addressing the **disavowal of claim scope by an election in response to a restriction requirement where the examiner provided no guidance regarding the differences** by which he distinguished the patentably distinct inventions, the U.S. Court of Appeals for the Federal Circuit overturned a district court's summary judgment of no infringement, holding that an **election in response to such a restriction requirement does not amount to a clear and unmistakable disavowal of claim scope.**

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- ◉ The Federal Circuit has used a response to a restriction requirement to limit claims:
- ◉ In *LG Electronics, Inc. v. Bizcom Electronics* 453 F.3d 1364 (2006) states “because the statements relied upon by defendants relate to the invention not elected during prosecution, there is no clear disavowal with respect to the invention actually claimed.”
- ◉ *Acco Brands, Inc. v. Micro*, 346 F.3d 1075 (2003) states “[t]he presence in the '989 specification of embodiments carried over from the parent application, but claimed in other patents, does not serve to broaden the scope of the '989 claims that were the subject of the divisional application.

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- ◉ Plantronics, **without traverse**, elected and prosecuted one of the identified species, which eventually issued as the asserted patent. **Neither the USPTO nor Plantronics made any specific remark concerning the differences between what the USPTO found to be patentably distinct inventions. The district court’s claim construction limited the claim scope to the elected invention, and, on summary judgment, the district court concluded that the claimed invention was invalid as obvious. Plantronics appealed.**
- ◉ As to the district court’s finding of disavowal of claim scope, the Federal Circuit found that, **unlike the fact patterns in LG Electronics and Acco Brands**, the restriction requirement imposed here “did not clearly demarcate the actual differences among the species of inventions.” **Because the USPTO gave no reasons as to why the figures represented different species, the Federal Circuit found no guidance forming a basis to limit the broadly drafted claims. As a result, there was no clear or unambiguous disavowal of claim scope. Without direction as to what distinguished the four species of invention, and because the terms at issue were not structurally limited either by the claim language or the corresponding description in the specification, the Federal Circuit reversed the district court’s construction limiting the scope to structural aspects exhibited by the figures and vacated the finding of non-infringement.**

# ULTRAMERCIAL V. HULU

- ◉ Ultramercial, LLC and Ultramercial, Inc., Plaintiffs-Appellants, v. HULU, LLC, Defendant, WildTangent, Inc., Defendant-Appellee. 657 F.3d 1323 (2011).
- ◉ The ruling on 35 USC 101 patentable subject matter states: **“meaningful limitations may include the computer being part of the solution, being integral to the performance of the method, or containing an improvement in computer technology.”**
- ◉ In the specific case of Ultramercial, the CAFC ruled that patent claims to a method of advertising on the Internet **were patent eligible, at least because they “plainly require that the method be performed through computers, on the Internet, and in a cyber-market environment.”** The claims did not, according to the Court, pre-empt all uses of the abstract idea underlying the invention.

# ULTRAMERCIAL V. HULU

- ◉ The courts have provided several clues as to which claims are likely to remain patent eligible, regardless of where the line is eventually drawn:
- ◉ First, patent claims for computer-based inventions should be crafted to ensure that **they do not merely describe an abstract idea or mathematical formula, but rather specific applications of the idea** (Ultramercial 657 F.3d at 1328).
- ◉ Where possible, the **intricate and complex computer programming, steps that require specific application to the Internet and a cyber-market environment**, and those that involve an **extensive computer interface** should be explicitly recited in claims to rely upon the logic presented in Ultramercial 657 F.3d at 1328.
- ◉ Finally, care should be taken to ensure that the claim **does not pre-empt all practical uses of the underlying abstract idea** (Diamond v. Diehr 450 U.S. at 187 and In re: Bilski 545 F.3d 943 (2008)).

# IN RE BIGIO

- ◉ In Re Alberto Lee Bigio, 381 F.3d 1320, 1325-1326 (Fed. Cir. 2004) analogous art must be either (1) from the **same field of endeavor** as the claimed invention; or (2) **reasonably pertinent to the particular problem faced by the inventor**, if the art is not from the same field of endeavor.
- ◉ On the issue of “**reasonably pertinent**,” In re Icon Health and Fitness, Inc., 496 F.3d 1374, 1379-80 (Fed. Cir. 2007) tells us that a reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, **logically would have commended itself to an inventor’s attention** in considering his problem.” In re Clay, 966 F.2d 656, 659 (Fed. Cir. 1992). In other words, “familiar items may have obvious uses beyond their primary purposes” KSR Int’l Co. v. Teleflex, Inc., 127 S. Ct. 1727, 1742 (2007).
- ◉ The court in Health and Fitness therefore concludes, for example, that an inventor considering a hinge and latch mechanism for portable computers would naturally look to references employing other housings, hinges, latches, springs, etc., which in that case came from areas such as a desktop telephone directory, a piano lid, a kitchen cabinet, a washing machine cabinet, a wooden furniture cabinet, or a two-part housing for storing audio cassettes.

## IN RE CLAY

- ◉ In re Clay, 966 F.2d at 658-59, while an older 1992 case, still seems to have some precedential strength and states that:
- ◉ **If a reference has the same purpose as the claimed invention and the reference relates to the same problem, this supports use of that reference in an obviousness rejection.**
- ◉ **However, if the reference is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.**