



# ideas on intellectual property law

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# 1 Potato, 2 Potatoes; 1 Chemical, 2 Chemicals

## *Defining and Supporting a Composition Patent*

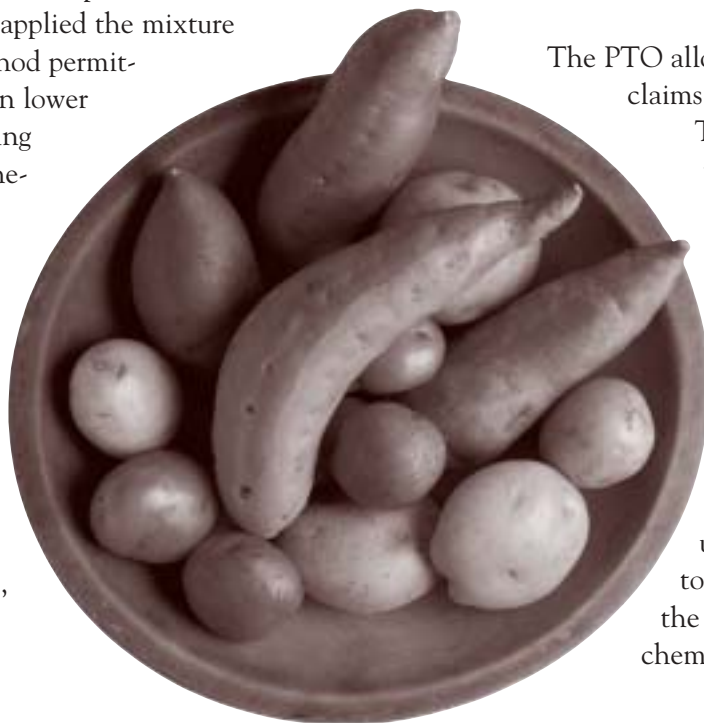
**W**hen potatoes are stored, they have a tendency to grow sprouts, causing undesirable texture and sugar levels, which results in a less desirable food product. Two “prior art” methods of inhibiting such sprouting were known (“prior art” means relevant knowledge, acts, patents or other publications predating the invention in question): the application of a synthetic chemical known as CIPC, and the application of natural substances known as substituted naphthalenes. But each of these methods had a disadvantage: CIPC is somewhat toxic, raising safety concerns, and substituted naphthalenes don’t have a desirably long-term effect. In a recent litigation, the court had to determine whether this prior art invalidated a broadly defined patent.

### **A NEW COMPOSITION**

Inventors at Platte Chemical Co. (Platte) combined CIPC and a substituted naphthalene into a single mixture and applied the mixture to the potatoes. This method permitted the CIPC to be used in lower amounts — thus minimizing toxicity — while simultaneously achieving longer-term effectiveness than was possible with substituted naphthalenes alone. Platte filed a patent application, the claims of which were originally directed to a “composition” comprising CIPC and a substituted naphthalene, and to a method of using such a composition for sprout inhibition.

While the patent application was pending in the Patent and Trademark Office (PTO), Platte became aware that its competitor PIN/NIP had developed a sprout inhibition method in which one of the two chemicals, CIPC or a substituted naphthalene, was first applied to the potatoes, and then, days or months later, the other one of those two chemicals was applied to the same potatoes. In an attempt to broaden its patent protection to cover PIN/NIP’s method, Platte added a new claim (claim 33) to its application. The new claim was directed to a method comprising the steps of applying CIPC and a substituted naphthalene to stored potatoes — the time or times of application being unspecified. The claim was not limited to a “composition” of two chemicals, but it did specify that *both* chemicals had to be present together on the potatoes for some of the time the potatoes were in storage. This claim was broad enough to encompass both Platte’s and PIN/NIP’s methods.

The PTO allowed all of Platte’s claims and the patent issued. The patent examiner reasoned that, though both CIPC and substituted naphthalenes were known to inhibit sprouting when used separately, the new combination of the two chemicals produced results unexpectedly superior to those produced by the use of either chemical alone.



## DEFINING COMPOSITION

PIN/NIP brought suit against Platte for a declaratory judgment of patent invalidity and noninfringement, and Platte counterclaimed for infringement. Before trial, the court ruled the term “composition” in Platte’s originally filed patent claims was broad enough to cover PIN/NIP’s separate application of the two chemicals to the same potatoes, and it was *not* limited to the physical combination of the two chemicals before application. The court reasoned that the two chemicals needn’t be mixed together as long as they worked in tandem to inhibit sprouting. A jury trial was then held, resulting in an infringement finding. The jury rejected a challenge to claim 33’s validity, despite the all-encompassing scope of that claim.

### *Was it legitimate for Platte to add a claim after the initial filing of its patent application for the specific purpose of covering a competitor’s known activities?*

But on appeal, Platte didn’t fare as well. First, the appellate court held the term “composition” had an established meaning in both chemistry and patent law that required a physical mixture of the two chemicals. Therefore, the trial court’s broader interpretation of that term was erroneous. And, thus narrowly interpreted, all the claims except claim 33 might be too narrow to cover PIN/NIP’s sequential use of the two chemicals, instead of a physical mixture of the chemicals.

In addition, the appellate court noted that Platte’s patent specification taught only the use of a physical mixture of the two chemicals — it never mentioned the possibility of sequential application. Therefore, if the claims were interpreted to cover

sequential as opposed to simultaneous application of the two chemicals, they would be unsupported by the specification and thus invalid.

Further, along with documents showing the separate use of CIPC and the separate use of substituted naphthalenes, the “prior art” also contained a publication of a doctoral thesis documenting some experiments in sprout suppression using these substances. The thesis mentions an instance in which both chemicals were applied unintentionally to the same potatoes at different times. This document didn’t invalidate Platte’s patent, because the experimenter didn’t conclude that unexpected effects might flow from both chemicals’ use on the same potatoes. But the accidental procedure mentioned was essentially the same as that adopted by PIN/NIP — and later accused of infringement by Platte.

But what about claim 33, which wasn’t limited to a “composition” and was broad enough to cover Platte’s method? Two issues surfaced in this regard. First, was it legitimate for Platte to add a claim after the initial filing of its patent application for the specific purpose of covering a competitor’s known activities? The appellate court answered this question in the affirmative.

But was claim 33 valid? No, said the appellate court, because the very breadth of that claim, which allowed it to cover PIN/NIP’s method, was its undoing. As noted above, Platte’s claims couldn’t be interpreted to cover any method not employing a physical mixture of the two chemicals because the patent specification wouldn’t support these claims. Thus, claim 33, which actually was that broad, lacked patent specification support, resulting in invalidity.

## SUPPORT YOUR CLAIMS

As this case shows, expanding your patent to include as broad a claim as possible has to be done carefully. You can’t patent a composition if it doesn’t fit within the established definition of the term “composition,” or a method that doesn’t fit within the bounds of the specification. 💡

# Down Periscope

## *The Doctrine of Laches Sinks Patent Application Delay*

The doctrine of laches penalizes litigants who unreasonably delay in enforcing their rights to the prejudice of the opposing party. In recent years, the courts have recognized that a party who unreasonably extends patent application prosecution in the Patent and Trademark Office (PTO) to delay the patent's issuance should be penalized — because the delay could harm any industry that might grow up in the interim. Even more recently, a question arose: Can the PTO also use patent prosecution laches to deny a patent's grant altogether, or is it limited to use only as a defense to infringement of an already-issued patent? That question was answered in the recent case of *In re Bogese*.

### **SUBMARINE PATENTS**

Suppose that the inventors of the original digital computer had contrived to keep a basic patent application pending until the blossoming of the personal computer industry decades later. Because pending applications have traditionally been held in secrecy, the issuance of such a patent could catch an entire industry by surprise. This is known as a “submarine patent,” because it surfaces without warning.

***The law now measures a patent's term from the application filing date, instead of from the date of issuance.***

The rules governing patent application prosecution seem to allow indefinite delay. An unsuccessful applicant can simply file a “continuation” application, provided he or she pays the new filing fee. The assumption has been that an applicant wouldn't take such an expensive step unless he or she intended to amend the patent claims or adduce some new argument or evidence supporting patentability. But if a well-heeled applicant wanted to use the continuation procedure for the sole purpose of keeping the application alive, nothing in the PTO's rules of practice prevented it.

### **SINKING THE SUBMARINE**

In recent years, Congress has amended the patent laws to discourage submarine patents. In particular, the law now measures a patent's term from the application filing date, instead of from the date of issuance. So any delay the applicant introduces during the prosecution has the disadvantage of shortening the patent's enforceable life. In addition, instead of being held in total secrecy, many pending applications are now published, thus reducing the chance of surprising an industry.

Also, a few years ago, a court held the doctrine of laches applied to protect an infringer from a submarine patent's harmful effects, even though the patentee's practice of keeping the patent



application pending for many years was accomplished strictly in accordance with the rules of practice. But the infringer in that case had to endure the expense and uncertainty of a major lawsuit to establish it was entitled to the laches defense. And, because this defense has traditionally applied only to the defendants involved in the particular case, the decision in the case didn't clearly benefit any other infringer. *In re Bogese* made it possible for the courts to address the issue of prosecution laches before the patent ever issues.

### **PATENT PROSECUTION LACHES**

Bogese filed a patent application on a telephone connector in 1978, replaced it with a continuation application in 1980, and then prosecuted the latter application to two appeals to the Federal Circuit Court of Appeals, which twice sent the case back to the PTO without allowing any of Bogese's patent claims. In 1987, after the second court appeal, Bogese replaced the then-pending application with yet another continuation. He did the same thing in January of 1988, and again in October of that same year. He continued to file the same patent claims eight more times between 1989 and 1994 — never amending the claims or submitting any new arguments or evidence in support of patentability. All he did was continue the pendency of the old claims into their third decade.

Finally, in 1994, the patent examiner warned Bogese that if he repeated this procedure one more time, the PTO would apply the doctrine of patent prosecution laches, which until that time had only been applied in the courts. Bogese didn't heed the warning. One last time, in 1995, he replaced his then-pending application with a continuation while doing nothing to advance the claims' prosecution — no amendment to the claims and no submission of new evidence or arguments. This time, the examiner rejected the application on the ground of prosecution laches.

Bogese responded by finally amending his claims and submitting affidavits in support of patentability. He also pointed out that his delaying tactics hadn't violated the rules of practice. But it was too late; the examiner stuck to the laches rejection.


Bogese requested reconsideration, but that too was denied. He then appealed to the PTO's Board of Appeals, which also turned him down. Finally, Bogese appealed for the third time to the Federal Circuit Court of Appeals. This court had applied the doctrine of prosecution laches to patent infringement litigation. But would it extend that doctrine to pending applications?

By a two-to-one vote, the court did so. The dissenting judge deemed it unfair to penalize Bogese for merely following the rules too literally. The judge also reasoned that it wasn't necessary to change patent prosecution practice so radically in view of Congress' recent corrective changes to the patent laws.

***The freedom to file an unlimited number of continuation applications wasn't intended to permit a 1970s invention to be patented in the 1990s or later.***

But the majority held sway: The freedom to file an unlimited number of continuation applications under the rules of practice was based on the assumption that such applications would be used to advance the prosecution of the claims to some conclusion, favorable or unfavorable. It wasn't intended to permit a 1970s invention to be patented in the 1990s or later. The majority's view has the advantage of relieving the telephone connector industry of the need to litigate the issue of laches, perhaps repeatedly.

### **DON'T DELAY**

The doctrine of laches has now been successfully used to sink submarine patents and stop pending application delays. The PTO, as well as the Federal Circuit Court of Appeals, has had enough delay. 



# Is “Windows” An Invalid Trademark?

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**M**any people are familiar with Microsoft Windows, the operating system that runs the overwhelming majority of the world’s personal computers. You may also have heard of Linux, the David that may someday challenge this Goliath. But David doesn’t yet have a proper slingshot: Linux doesn’t run the most popular Windows-compatible software, such as word processors, spreadsheets and Internet browsers. Now a new company is determined to create and market a Linux version that runs the same application programs as Windows, and thus give the Microsoft juggernaut some competition in the operating system market. But how closely can this new competitor mimic the name of Microsoft’s operating system without committing trademark infringement?

## THE UPSTART

The new company wanted a name that would alert consumers that their product is Windows-compatible. So they named the operating system “Lindows OS,” and the company and its Web site “Lindows.com.” Not surprisingly, Goliath thought that David’s new name infringed the Windows trademark. So Microsoft brought suit against Lindows.com for trademark infringement.

To stop Lindows.com from using the Lindows name even before the case comes to trial, Microsoft asked the court for a preliminary injunction. To be eligible for this premature remedy, Microsoft had to show a substantial probability of success at trial. Lindows.com, however, argued that Microsoft couldn’t make this showing because (are you ready for this?) Windows, one of the most recognizable trademarks on this planet, is invalid!

## GENERIC TERMS AS TRADEMARKS

Lindows.com’s argument is a potentially devastating one, because it’s a long-established trademark

principle that a generic term *cannot* be a valid trademark — no matter how strongly associated it may be with a single source. At some early date the term “windows” was a generic term as applied to computer software, and therefore, according to Lindows.com, wasn’t subject to exclusive appropriation as the trademark of any one company. Microsoft, however, argued that Windows was merely descriptive of windowing software, not

*At some early date the term “windows” was a generic term as applied to computer software, and therefore, according to Lindows.com, wasn’t subject to exclusive appropriation as the trademark of any one company.*

generic. Trademark law has also long recognized that a descriptive term, unlike a generic term, can become a valid trademark if it becomes generally recognized as referring to one particular source. This is known as “secondary meaning.” Because of Windows’ extremely heavy promotion and huge sales volume, it’s difficult to find many trademarks in today’s world that have more secondary meaning than Microsoft’s Windows.

But even if the software giant succeeded in this argument, it might not necessarily win the case.

Why? Because even when the term “Windows” clearly refers to Microsoft’s product in particular, and not simply to windowing software in general, it’s sometimes used merely to indicate that some third-party product is compatible with Microsoft Windows. Such compatibility usage isn’t trademark infringement because it doesn’t imply that the third party’s product is produced by, affiliated with, or endorsed by, Microsoft. (Microsoft does have other marks it uses to certify the Windows compatibility of third-party products, but that is a separate issue).

### **PRESUMPTION OF VALIDITY**

Microsoft did have one ace in the hole. “Microsoft Windows” was registered in the U.S. Patent and Trademark Office (PTO) in 1995. The PTO was reluctant to grant the registration at first, but eventually changed its mind. And once a mark is registered, it’s entitled to a presumption of validity.



That put the burden initially on Lindows.com to show the mark was generic. The presumption was overcome, however, by all the evidence of past and present generic and compatibility usage that Lindows.com was able to bring forward. Therefore, the presumption “dropped out” of the case, leaving the issue of validity still up in the air.

### **A CRACK IN THE GLASS?**

And that’s where the case stays for the moment. The court denied the preliminary injunction, deciding it simply didn’t have enough evidence at the litigation’s pre-trial hearing to decide whether Microsoft was likely to prevail on the genericness issue at trial.

What will happen when the case comes to trial isn’t clear, but it’s possible that Windows, one of the world’s strongest trademarks, won’t be upheld against the upstart Lindows. 💡

## **What Is a W/window?**

**The most outstanding feature of the user interface employed by Microsoft Windows and other modern computer operating systems is the use of a screen display containing overlapping or adjacent rectangles commonly called “windows.” Each window contains the display associated with one or several programs concurrently running on the same computer. This type of graphical user interface, and the accompanying “windows” terminology, predated the appearance of Microsoft’s own Windows program in the marketplace. Such usage continues to some extent: Writers sometimes refer to computer display “windows” with a lower case “w,” as distinguished from Microsoft Windows with an upper case “W.”**

An idea.  
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