



ideas on intellectual property law



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It's not rocket science

Court clarifies written description requirement

Patent applicants run into numerous requirements to gain patent protection, including a “written description” of their inventions. This requirement has been a particularly high hurdle for inventions involving biotechnology. But the Federal Circuit appears to have eased the demands of the written description requirement in the biological arena — at least for one defendant.

BATTLE OF THE VACCINES

In *Falkner v. Inglis*, the court was reviewing the decision of the Board of Patent Appeals and Interferences (BPAI) regarding which party was the earliest inventor of a vaccine. Some vaccines against a virus (the “target virus”) incorporate harmless fragments of the target virus’s genetic material into a second virus, called a “vector virus.” These vaccines can sometimes cause symptoms of the very illness against which they inoculate but will ultimately confer immunity against it.

Traditionally, to reduce such symptoms, one or more inessential genes are inactivated, making the viral vector that produces the fragments much less pathogenic. Under this traditional approach, the vector virus can still fully reproduce itself, although more slowly, thereby reducing the amount of vaccine that can be produced in commercial quantities.



The inventors in *Falkner* discovered a method for simultaneously solving the production

problem, while also making poxvirus vaccines safer. Their method involved deleting an essential — rather than an inessential — gene. They did this by growing the vaccines in cells that have been modified to produce the absent essential viral gene product on behalf of the vector virus. The modified vector virus can be grown in these modified cells, but not in the cells of an inoculated person.

RACE FOR THE CURE

Falkner brought an interference action based on his patent and Inglis’ application. Both parties sought the benefit of earlier-filed applications to establish dates of constructive reduction of their inventions to actual practice, for the purposes of determining priority in the claims at issue.

Priority in a BPAI proceeding goes to the first to invent, but a rebuttable presumption exists that the inventors made their inventions in the chronological order of their effective filing dates. In other words, the senior party invented first, and the junior party bears the burden of proving otherwise, such as by proving that he or she actually reduced the invention to practice before the constructive filing date (priority date) of the senior party.

Falkner brought closely related motions before the BPAI:

1. Inglis’ claims were unpatentable because they failed to meet necessary written description requirements.
2. Inglis’ earlier application didn’t sufficiently describe or enable the claim in question.
3. The claims in Inglis’ application were anticipated and thus unpatentable.

The BPAI denied Falkner’s motions and ordered judgment in favor of Inglis.

THE COURT INJECTS ITSELF

On appeal, Falkner basically reiterated the same arguments that he had made before the BPAI. The Federal Circuit recognized that the three arguments were distinct but related and synthesized them into a single common issue: “whether the Inglis benefit applications adequately describe and enable a poxvirus-based vaccine” from the perspective of one of ordinary skill in the art, as of the relevant filing date.

An invention’s actual reduction to practice is not required.

The court reiterated that an applicant must convey to those skilled in the art that, as of the filing date, he or she was in possession of the invention. The court then observed that no length requirement exists for a disclosure to adequately describe an invention. Rather, the description’s adequacy depends on the content in relation to the invention, not its length. Several passages in Inglis’ application were directed to poxvirus, which the court evidently considered sufficient in conjunction with the existing knowledge of the art.

The court relied on unrefuted expert testimony that articles describing essential genes for poxvirus were well known in the art, and that a skilled person would have been able to choose an essential gene based on publicly available references.

THE WRITING ON THE WALL

The court then turned to the parties’ dispute over several aspects of its law of written description:

Must a written description include examples?

The court held that the lack of examples involving poxviruses didn’t render Inglis’ written description inadequate. A specification is targeted at a person of skill in the art, who comes to the patent with knowledge of what has come before. An

applicant need not spell out every detail but only enough to convince the person that the inventor possessed the invention and to enable the person to make and use the invention without undue experimentation.

Must a written description include a description of an actual reduction to practice? The court held that actual reduction to practice is *not* required. The BPAI was correct not to view the fact that Inglis hadn’t actually produced a poxvirus vaccine as dispositive.

Constructive reduction to practice is an acceptable method of disclosure of the technologic knowledge on which the patent is based. The court found this consistent with U.S. Supreme Court precedent that makes clear that, while reduction to practice generally provides the strongest evidence an invention is complete, it doesn’t follow that proof of reduction to practice is necessary in every case. An invention can be “complete” even in the absence of an actual reduction.

Must a written description include a recitation of known structures? The Inglis specification didn’t describe the “essential regions” of any poxvirus, or incorporate by reference any literature that described the DNA sequence of the poxvirus genome and locations of essential regions. But the court disavowed a “per se” rule “that whenever a claim limitation is directed to a macromolecular sequence, the specification must always recite the gene or sequence, regardless of whether it is known in the prior art.” Rather, where, as in this case, accessible literature clearly provided, as of the relevant date, genes and their nucleotide sequence (the essential genes), a written description doesn’t need a recitation or incorporation by reference of such genes and sequences.

INOCULATING THE PATENT APPLICATION

The amount of information required to fulfill the written description requirement depends on the nature and scope of the invention, as well as the existing scientific and technologic knowledge in the field. Nonetheless, the *Falkner* decision may have lightened the load for future applicants. 💡

Separated at birth

Identical trademarks without likelihood of confusion

Trademark holders might be surprised to learn that their marks aren't necessarily protected from virtually identical marks. Instead, according to the Federal Circuit, the *DuPont* factors must be used to analyze the likelihood of confusion.



EVIL TWIN OR IDENTICAL COUSIN?

In *M2 Software, Inc. v. M2 Communications, Inc.*, the defendant applied for the trademark “M2 Communications” for interactive multimedia CD-ROMs targeted exclusively to the pharmaceutical and medical industries. It disclaimed any rights to the term “Communications” during the application process. M2 Software already owned registration for the trademark “M2” for interactive multimedia CD-ROMs with a customer base solely in the music and entertainment industries.

M2 Software opposed M2 Communications’ registration. Under the federal Lanham Act governing the registration of trademarks, the U.S. Patent and Trademark Office (PTO) can

refuse to register a trademark that is so similar to a registered trademark “as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” But in this case the Trademark Trial and Appeal Board (TTAB) found confusion unlikely and dismissed the opposition.

MORE THAN MEETS THE EYE

The Federal Circuit applied some of the factors enumerated in *In re E.I. DuPont de Nemours & Co.* to analyze the likelihood of confusion. The case lists 13 factors for courts to consider, but the TTAB focused its analysis on five of the factors:

1. The similarity of the goods in question,
2. The intersection of channels of trade and purchasers,
3. The similarity of the trademarks,
4. The strength of the plaintiff’s trademark, and
5. The defendant’s intent in registering its trademark.

In its review of the TTAB’s decision, the Federal Circuit focused on these five factors “that are relevant and of record,” noting that even a single factor may control a particular case. The TTAB put the greatest weight on the similarity of the goods and the channels of trade and purchasers. The Federal Circuit found no error in the TTAB’s decision.

CLOSE BUT NO CIGAR

In assessing the similarity of the goods in this case, the court considered the applicant’s goods as set forth in its application and the opposer’s goods as set forth in its registration. M2 Software’s registration refers to goods for the film and music industries. M2 Communications’ goods were limited to interactive multimedia CD-ROMs in the pharmaceutical and medical fields.

Be like the PTO

The factors in *In re E.I. DuPont de Nemours & Co.* don't represent the only test for evaluating the likelihood of confusion. Different federal courts may rely on different sets of factors. For example, cases in the Ninth Circuit follow the factors found in *AMF Inc. v. Sleekcraft Boats*, while the Second Circuit follows those found in *Polaroid Corp. v. Polarad Electronics Corp.* But it is the *DuPont* factors that the U.S. Patent and Trademark Office (PTO) uses during the prosecution of applications to register marks.

The PTO's *Trademark Manual of Examination Procedures* outlines the procedures that PTO examining attorneys are required or authorized to follow in the examination of trademark applications. According to the manual, the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services. The following factors also are listed as among the most relevant in the examination of applications:

- ① The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression,
- ① The relatedness of the goods or services as described in an application or registration or in connection with which a prior mark is in use,
- ① The similarity or dissimilarity of established, likely-to-continue trade channels,
- ① The conditions under which and the buyers to whom sales are made,
- ① The number and nature of similar marks in use on similar goods, and
- ① A valid consent agreement between the applicant and the owner of the previously registered mark.

Application of these factors can help an attorney determine whether a likelihood-of-confusion argument has merit.

The court acknowledged that the goods might nonetheless be related based on other considerations. But it rejected the notion that the goods were related solely because they both take the form of interactive multimedia CD-ROMs. The relevant goods were not CD-ROMs “broadly conceived,” but CD-ROMs produced for particular fields — and the fields in this case were distinct.

The Federal Circuit emphasized that the proper focus belongs on the goods' subject matter, not their media format. Given software and software-related goods' pervasiveness in society, the court wouldn't presume relatedness on the basis of goods being delivered in the same media format, especially where both the application and registration define the goods narrowly and along distinct industry lines.

Finally, the court agreed with the TTAB that the parties' channels of trade are different. And neither party submitted evidence of inherent overlap of customers or trade channels between the respective fields.

LOOKS ONLY GO SO FAR

The court stated that the unrelated nature of the goods, and the different purchasers and trade channels, weighed heavily against M2 Software. The court concluded that it's difficult to establish likelihood of confusion in the absence of overlap as to either factor and agreed with the TTAB that confusion wasn't likely. So even if trademarks are virtually identical, parties must support challenges with stronger evidence of confusion. 💡

When infringement isn't literally infringement

Patent liability under the doctrine of equivalents

If a product doesn't *literally* infringe a patent claim, there's no liability for patent infringement, right? Not according to the doctrine of equivalents. The Federal Circuit has issued a rare opinion involving the doctrine that provides some insight on how it operates.

CALL OF THE WILD

Primos, Inc. v. Hunter's Specialties, Inc., revolved around mouth calls used by hunters to simulate animal sounds. Primos held a patent on a call that includes a membrane that vibrates to produce sound and a shelf or plate extending above the membrane. Claim 2 of the patent was amended during the application process (known as patent prosecution) to refer to "a plate having a length" and "the plate being differentially spaced above" the membrane. The patent claims an improvement over prior mouth call devices because the shelf or plate provides a constant distance above the membrane.

Primos filed suit against Hunter's, based on the competitor's "Tone Trough" device. This call has a dome extending above the membrane instead of a shelf or plate.

IF IT WALKS LIKE A DUCK ...

The jury found that Hunter's infringed Primos' patent under the doctrine of equivalents. The doctrine permits a finding of infringement when an accused product doesn't literally infringe on a patent claim's express terms. The infringement is premised on *equivalence* between elements of the accused product (the Tone Trough dome) and the patented invention's claimed elements (Primos' plate).

... AND QUACKS LIKE A DUCK

On appeal, Hunter's argued that prosecution history estoppel barred application of the doctrine to the term "plate." Prosecution history estoppel

limits a patent's claim scope based on amendments made during patent prosecution that allow the patent to issue.

Specifically, Hunter's asserted that amendments to the term "plate" narrowed Claim 2's scope. The district court had determined that amending "plate" by requiring that it have a "length" did not narrow the claim's scope because "every physical object has a length." The court also found that adding "differentially spaced" did narrow the scope. But because the amendment was "merely tangential," prosecution history didn't apply.

The appellate court acknowledged that, when a patent claim is amended during prosecution for reasons relating to patentability, a presumption arises that the patentee surrendered all of the "territory" between the original claim limitation and the amended claim limitation. A patentee can overcome that presumption, it added, when the rationale underlying the amendment bears no more than a tangential relationship to the equivalence in question.

The court agreed with the lower court's reasoning on "length" and that the territory surrendered by "differentially spaced" comprises plates *not* differentially spaced above the membrane. It noted that Primos had added the latter limitation to distinguish its mouth call from prior art that had a shelf-like structure on top of the membrane, without any spacing. The Tone Trough call, on the other hand, includes a dome spaced above the membrane, which led the court to find that the amendment was merely tangential to the contested element.

ANOTHER SHOT

Hunter's also argued that the district court shouldn't have allowed application of the doctrine

of equivalents because doing so violated the “all limitations” rule. The rule prevents application of the doctrine when it would invalidate a claim limitation (in this case, “plate”).

The appellate court noted the district court’s finding that Hunter’s was essentially contending that no equivalence to the claimed “plate” could exist. No set formula applies for determining whether a finding of equivalence would invalidate a claim limitation in violation of the all-limitations rule. Courts must consider the totality of the circumstances in a case-by-case determination of whether the alleged equivalent can be fairly characterized

as an insubstantial change from the claimed subject matter without rendering the relevant limitation meaningless. The court concluded that the theory that a dome is equivalent to the plate didn’t effectively eliminate the limitation in its entirety, so the all-limitations rule wasn’t violated.

CLOSE COUNTS IN PATENTS

The appellate court therefore affirmed the trial court’s findings of liability for patent infringement. Imitation may be the sincerest form of flattery, but *Primos* shows that replicating a patented element too well, even if not exactly, can still prove costly. 💡

State right of publicity falls to federal copyright law

The sampling of other artists’ songs has gained in popularity in recent years, and litigation has naturally followed. But do artists have any recourse when they don’t hold the copyright to their music? The plaintiff in *Laws v. Sony Music Entertainment* pursued a recovery based on her state law right against invasion of privacy.

Elektra/Asylum Records held several rights in some of Debra Laws’ recordings, including the sole and exclusive right to copyright and license the recordings and the right to use and permit others to use Laws’ name and likeness. In 2002, Elektra gave Sony a nonexclusive license to sample a Laws song in a Jennifer Lopez/LL Cool J duet, with credit given to Laws in the CD booklet. After the new song became a hit, Laws filed a lawsuit alleging violation of state law as to invasion of privacy based on the use of her name and voice without her consent.

The appeals court applied a two-part test to determine if the federal Copyright Act preempted her state law claims:

1. Whether the subject matter of the state law claim falls within the subject matter of federal copyright laws, and
2. Whether the rights asserted under the state law are equivalent to the rights of copyright holders.

The Ninth Circuit Court of Appeals found that Laws’ copyrighted recordings clearly fell within the subject matter covered by the Copyright Act, which specifically refers to “sound recordings.” The court also concluded that the rights asserted under the state law right of publicity were equivalent to those protected by the federal Copyright Act. The test is whether the state claim protects qualitatively different rights — the state claim must contain an extra element that changes the nature of the action.

In this case, the court found that the nature of Laws’ state law claim was “part and parcel” of a federal copyright claim. As the Ninth Circuit stressed, the right of publicity doesn’t allow an artist to limit a copyright holder’s rights merely because the artist disagrees with decisions to license the copyright. The court noted that copyright owners would have meaningless rights to license artistic works if the artist could claim “invasion of privacy” whenever the work was reproduced.