The Latest Intellectual Property News

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Welcome to The Latest Intellectual Property News, a newsletter for updating you with recent information about Intellectual Property.

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FACTUAL COMPONENTS OF CLAIM CONSTRUCTION

By Sean A. Passino, Ph.D., Esq./Partner (spassino@ipfirm.com)

The United States Supreme Court held that when reviewing a district court's resolution of subsidiary factual matters made in the course of its construction of a patent claim, the United States Court of Appeals for the Federal Circuit must apply a "clear error," not a *de novo*, standard of review in accordance with Federal Rule of Civil Procedure 52(a)(6)(a court of appeals "must not . . . set aside" a district court's "[f]indings of fact" unless they are "clearly erroneous."). *Teva Pharm. USA v. Sandoz, Inc.*, Slip op. 13-854 (Jan. 20, 2015).

Teva Pharmaceuticals owns a patent directed to a manufacturing method for the multiple sclerosis drug Copaxone. Sandoz tried to market a generic Copaxone, and Teva sued them for patent infringement. Sandoz countered that the patent was invalid, because the asserted claim recited that the active ingredient had "a molecular weight of 5 to 9 kilodaltons," which was fatally indefinite under 35 U. S. C. §112 ¶2, because the claim did not state which of three methods to use to calculate the molecular weight.

After considering conflicting expert evidence, the District Court concluded that the patent claim was sufficiently definite, and the patent was thus not invalid. Importantly, it found that a skilled artisan would understand that the term "molecular weight" referred to molecular weight as calculated by the first of the three methods. In finding the "molecular weight" term indefinite and the patent invalid on appeal, the Federal Circuit reviewed *de novo* all aspects of the District Court's claim construction, including the District Court's determination of subsidiary facts.

What the Federal Circuit did by reviewing these facts *de novo* was an error. FRCP 52(a)(6) sets out a "clear command," i.e., findings of fact by the district court are reviewed for clear error. The Federal Circuit should have reviewed whether or not it was a "clear error" to find that the term "molecular weight" referred to molecular weight as calculated by the first of the three methods. If so, the claim cannot be indefinite. If not, the analysis of *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 572 US __ (2014) begins.

EVIDENTIARY BAR RAISED ON THE PTO FOR GEOGRAPHIC DESCRIPTIVENESS

TRADEMARK REFUSALS

By Jeffrey H. Greger, Esq. (jhgreger@ipfirm.com)

The CAFC reversed a decision by the USPTO TTAB which held the term NEWBRIDGE was geographically descriptive under Section 2(e)(2). The elements for a refusal require evidence showing (1) the mark is the name of a place that is generally known to the public, (2) the public would make a goods/place association and believe the involved goods originate in that place, and (3) the involved goods come from that place.

The Examiner's internet evidence established NEWBRIDGE as a geographical location in Ireland known for the silverware goods as in the application. The CAFC held substantial evidence was required to establish a nexus of the location with the perception of the American consumer. Failing to meet the evidentiary burden the Court reversed on the first prong.

Examiners typically reference internet sites to establish a geographic nexus leaving the applicant a shifted burden to show pertinent American consumers would not perceive the mark as primarily geographic. The heightened evidentiary burden to support geographic descriptiveness refusals should prevent the PTO from shifting the evidentiary burden for refusals based merely on internet website information without evidence of pertinent American consumers having "any meaningful knowledge of the locations mentioned in websites".

Foreign applicants should have more success obtaining geographic marks on the Principal Register in light of In re The Newbridge Cutlery Co., Appeal No. 2013-1535 (Fed. Cir. January 15, 2015) [precedential].

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