

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

Table of Contents

Time bar determinations unreviewable _____	1
Trademark not abandoned where use continues _____	2
Co-author could be inventor _____	4
Self-similar is 'shure'ly definite _____	6
Additional Information _____	7

TIME BAR DETERMINATIONS UNREVIEWABLE

By [Joshua A. Hauptman](#)

[Atlanta Gas Light Co. v. Bennett Regulator Guards](#), 2021-1759 (Fed. Cir., May 13, 2022)
(Fed. Cir., decided May 13, 2022, before Newman, Lourie, and Stoll)

➤ Time bar determinations by the PTAB are not reviewable, even when such determinations are made in connection with a remand to consider another issue.

➤ 专利商标局所决定的多方审查的时限是不可被复审的，即便该时限决定与另外一个被发回重审的争点有关联。

➤ PTAB 에 의한 소위 "Time Bar" 결정이, 다른 이슈를 고려하기 위한 환송과 연관되어 내려진 결정이더라도 재심리는 가능하지 않다.

➤ 特許行政審判部 (PTAB) が設定された期日は、たとえそれが別争点を考慮する差し戻し命令に関連して設定された場合であったとしても、再考され得ない。

Bennett Regulator Guards ("Bennett"), the assignee of U.S. Patent 5,810,029 ('029), sued Atlanta Gas ("AG") for patent infringement. On July 18, 2013, exactly 1-year after Bennett served AG with a complaint, AG filed an IPR for review of '029. The IPR was instituted and litigated, but the Board vacated the institution decision before rendering a final decision, and terminated the IPR because AG failed to list all real parties-in-interest ("RPI") (AG failed to list their parent company). The Board instituted review and issued a final written decision on a second IPR filed by AG on the same grounds. Bennett argued the second petition was time barred under 35 USC Sec. 315(b). After the final written decision was issued, Bennett learned of a corporate merger involving AG's parent company, which occurred after the oral hearing but before the final decision was issued and was not disclosed to the

Board. The Board allowed AG to update the RPI listing, but awarded Bennett monetary sanctions for AG's failure to disclose the merger.

In the first appeal (Bennett I), the Federal Circuit held that the 1-year limitation to file an IPR is not reset when a petition is dismissed without prejudice, and that AG's petition was accordingly time barred. The court vacated and remanded the Board's decision, noting that the sanction order remained in effect despite termination of the underlying proceeding. Before the Board acted on the remand, the Supreme Court held in *Thryv* that the Federal Circuit lacks jurisdiction to review time bars because those determinations are intimately related to institution decisions, which are barred from review by section 314(d).

In the second appeal (Bennett II), the Federal Circuit remanded the sanction order for further consideration. The Board reconsidered the order and the time bar issue under Bennett I, which had motivated a change in USPTO policy. The Board vacated the institution decision, terminated the proceeding, and declined to award sanctions. AG appealed again, arguing that the Federal Circuit has jurisdiction to hear the appeal under 28 USC Sec. 1295(a)(4). The Federal Circuit disagreed and dismissed the appeal for lack of jurisdiction.

In Bennett II, the court considered the threshold issue of jurisdiction to review the Board's termination decision where the Board vacated its institution decision. The court held it lacked jurisdiction, because the decision under review had a substantive discussion of time-bar considerations, including discussion of Bennett I, which AG acknowledged were at the core of the decision, and remand from the Federal Circuit does not change that result. The new USPTO policy treats the service of a complaint on a party as starting the time-bar clock regardless of whether the district court action was subsequently dismissed without prejudice, and the Board's termination decision did not violate the Bennett II mandate to reconsider the sanctions order.

TRADEMARK NOT ABANDONED WHERE USE CONTINUES

By [Reina Kakimoto](#)

[Tiger Lily Ventures Ltd. v. Barclays Capital Inc.](#), Appeal No. 2021-1107
(Fed. Cir. June 1, 2022; Lourie, Bryson, Prost)

➤ A trademark is not abandoned by filing for bankruptcy liquidation, by allowing registrations to expire, or by disavowing a predecessor owner of the mark, where the successor continues to use the mark.

➤ 申請破産清算，允許注册期过期，或者在继承者继续使用该商标的情况下否认该商标的前任所有人，都不构成放弃该商标。

➤ 상표의 승계인이 상표를 사용하고 있다면, 그 전 소유자 (피승계인)가 파산청산 신청을 하거나, 상표 갱신을 하고 만료되도록 하거나, 피승계인과 승계인의 관련없음을 주장하는 사실만므로, 상표가 포기되었다고 볼 수 없다.

➤ 商標は、承継者がその商標の使用を継続している場合、破産の清算申請、期限満了の登録許可、あるいはその商標の先の所有者の否認によって、放棄されない。

➤ Likelihood of confusion with a famous mark is enhanced in an identical mark used for goods and services similar to those licensed by the owner of the famous mark, despite lack of any evidence of actual confusion.

▶在与著名商标所有人许可的相似的商品和服务中使用相似的商标，就算缺乏任何实际混淆的证据，但会增加与著名商标近似混淆的可能性。

▶실제적인 혼동이 일어났다는 증거가 부족하더라도, 동일상표가, 유명상표의 권리자에 의해 라이선스를 받은 상품과 서비스가 유사하다면, 유명상표의 혼동가능성은 높아진다.

▶著名な商標との出所の混同は、その著名商標の所有者によりライセンスされた類似のモノやサービスに対し使用されている同一商標との間で、より高められる。

▶Bona fide intent to use a mark can be supported by licensing use of the mark and by capacity to offer goods and services identified in an application for registration of the mark, despite lack of any evidence of specific intent to use the mark.

▶尽管没有任何证据表明使用该商标的具体意图，但通过许可该商标的使用权以及证明有能力提供该商标注册申请中指定的商品和服务，可以支持有使用该商标的真实意图。

▶구체적인 선의의 사용의사에 대한 증거가 불충분하더라도, 상표에 대한 선의의 사용의사는 상표사용에 대한 라이선싱과 상표등록을 위한 출원서에 지정된 상품/서비스를 제공할만한 능력에 의해 뒷받침될 수 있다.

▶善意の商標使用の意図は、たとえその商標使用の特定の意図を示す証拠が欠如していたとしても、その商標の使用のライセンスにより、およびその商標登録出願において特定されたモノやサービスを申し出する法的能力によって、裏付けられる。

This case stems from the bankruptcy of Lehman Brothers in 2008, followed by Barclays Capital Inc. (Barclays) purchase of Lehman’s businesses and assets including rights to the “LEHMAN BROTHERS” trademark. Barclays eventually allowed all registrations of the “LEHMAN BROTHERS” mark to expire.

In March 2013, Tiger Lily Ventures Inc. (Tiger Lily) filed a trademark application for a standard character mark, “LEHMAN BROTHERS,” for beers and spirits. In October 2013, Barclays filed a trademark application for the same word mark for various financial services. In June 2014, Tiger Lily filed another trademark application for the same word mark for bar and restaurant services. All applications were filed under §1(b) intent-to-use basis, and eventually allowed and published for oppositions.

In November 2014, Barclays filed oppositions to Tiger Lily’s two trademark applications on the ground of likelihood of confusion and false suggestion of connection, lack of bona fide intent and dilution. Shortly after, Tiger Lily filed an opposition to Barclays’ trademark application on the ground of lack of bona fide intent to use. The Board dismissed Tiger Lily’s opposition. The Board sustained Barclays’ opposition only on likelihood of confusion. Tiger Lily appealed, alleging that the Board erred in (a) determining that Barclays’ had not abandoned the “LEHMAN BROTHERS” mark; and (b) in finding no likelihood of confusion with Tiger Lily’s mark. Barclays cross-appealed dismissal by the Board of false suggestion, lack of bona fide intent to use, and dilution allegations.

Tiger Lily alleged that Barclays abandonment of the “LEHMAN BROTHERS” mark foreclosed its opposition to the Tiger Lily mark under 15 U.S.C. § 1052(d). In response, Barclays showed substantial evidence that the mark had been used prior to the filing of Tiger Lily’s trademark applications, giving Barclays at least a common law trademark, and circumstances supported an inference that the

mark would be used in the future, as well. The Federal Circuit affirmed the Board’s judgment on this ground.

The court also affirmed the Board’s judgment that Tiger Lily’s use of the “LEHMAN BROTHERS,” rejecting Tiger Lily’s evidence of no actual confusion and explaining that “a famous mark casts a long shadow which competitors must avoid.” The court also dismissed Barclays’ cross-appeal as moot.

CO-AUTHOR COULD BE INVENTOR

By [Gregory P. Brummett](#)

[Google LLC v IPA Technologies Inc.](#), Appeal Nos. 2021-1179, -1180, and -1185 (Fed. Cir., decided May 19, 2022, before **Dyk**, Schall, and Taranto)

➤ While co-authorship does not presumptively make the co-author a co-inventor, co-authorship is still “significant corroborating evidence that a co-author contributed to the invention.”

➤ 虽然合著者并不能假定合著者成为合发明人，但合著者仍然是“合著者对该发明做出贡献的重要确证证据”。

➤ 공동저자권이 추정적으로 공동저자 또는 공동발명자를 만드는 것은 아니지만, 공동저자권은 공동저자가 그 발명에 기여했다는 여전히 중요한 보강 증거이다.

➤ 共著が共著者を推定上の共同発明者とはしないが、共著はそれでも“共著者をしてその発明に貢献したとする重要な裏付け証拠”である。

➤ During an *inter partes* review (“IPR”) proceeding, deciding whether or not an asserted reference is prior art “by another” the Board **must**:

determine which portions of the reference were relevant to finding that the reference anticipated/obviated the claim(s) at issue;

evaluate the degree to which those relevant portions were conceived “by another;” and

determine whether that other person’s contribution was significant enough, when measured against the full disclosure of the reference, to render that person a joint inventor of the relevant portions of the reference.

➤ 在多方审查 (“IPR”) 程序中，要确定所主张的参考文献是否是“他人”的现有技术，委员会必须：

确定参考文献的哪些部分与发现该参考文献技术占先/排除的权利要求有关；

评估这些相关部分被“由他人”构思的程度；以及

根据参考文献的全部披露，来判定他人的贡献是否足够重要，以至他成为参考文献相关部分的共同发明人。

➤ 당사자간 검토 (IPR) 절차동안, 주장된 참고문헌이 타인에 의한 선행문헌인지를 결정함에 있어서, 심판원은:

참고문헌의 어느 부분이 이슈가 되는 청구항을 예견하는지 결정해야 한다.

그 관련부분이 타인에 의해 구상된 정도를 평가해야 한다. 그리고,

참고문헌의 전체공개와 비교하여, 그 타인의 기여가 그 사람을 참고문헌 관련 부분의 공동발명자로 만들 만큼 충분히 중요했는지 여부를 결정해야 한다.

▶当事者系レビュー（IPR）審理手続きにおいて、主張された引例が“他人による”先行技術であるかの決定に際し、行政特許審判部は以下のことをしなければならぬ。

その引例のどの部分が争点クレームの新規性否定／否定排除と関連するのかを決定、

それら関連する部分が“他人による”着想であることへの程度を評価、および

その引例の記載全体に対する比較評価する際、他人の貢献がその者をしてその引例の係る関連部分の共同発明者たらしめるに十分に重要であることを決定。

IPA is the owner of two patents issued from applications filed January 5, 1999, U.S. Pat. No. 6,851,115, and March 17, 1999, U.S. Pat. No. 7,069,560, that relate to software-based Open Agent Architecture (OAA). The two patents list Martin and Cheyer as the inventors. On March 23, 1998, an academic paper describing the OAA project had been published in the *Proceedings of the Third International Conference on the Practical Application of Intelligent Agents and Multi-Agent Technology* and named inventors Martin and Cheyer and their non-inventor supervisor Dr. Douglas B. Moran as co-authors (the Martin reference). In 2019, Google petitioned the Board for *inter partes* review (“IPR”) of certain of the patent claims in light of the Martin reference arguing that the identified claims were obviousness in view of the Martin reference and that because the authors of the Martin reference (Martin, Cheyer, and Moran) were not the same as the named inventive entity (Martin, Cheyer), the Martin reference was valid prior art “by others.” The Board instituted the requested IPR but determined that Google did not meet its burden of providing sufficient support for establishing the correct inventive entity of the claimed subject matter and concluded that Moran’s testimony, while credible, was insufficiently corroborated. Google appealed.

On review, the Federal Circuit explained that because, in an IPR, “the burden of persuasion is on the petitioner to prove ‘unpatentability by a preponderance of the evidence,’ and that burden never shifts to the patentee” there was no error in the Board’s assertion that it was Google that had the burden of establishing that the Martin reference was prior art “by another.” The reviewing court noted agreement among the parties that the Board’s holding was based on a conclusion that there was insufficient corroboration of Dr. Moran’s inventorship. The court, however, further explained that while co-authorship on a paper does not presumptively make the co-author a co-inventor, that co-authorship is still “significant corroborating evidence that a co-author contributed to the invention” disclosed in that paper.

Because Dr. Moran’s co-authorship was “significant corroborating evidence,” the court concluded that the Board had erred by not addressing the inventorship issue on the merits. The court also held that in light of the direct conflict between Martin and Cheyer, who asserted that Moran was not an inventor, and Dr. Moran, who asserted that he was, in fact, an inventor, the Board was obligated to make findings of fact regarding Dr. Moran’s inventorship, or lack thereof. The Federal Circuit did not consider the evidentiary conflict appropriately resolved, and remanded the case to the Board to resolve

the conflict and to make appropriate findings of fact regarding the applicability of the Martin reference to the patent claims at issue.

SELF-SIMILAR IS ‘SHURE’LY DEFINITE

By Chang Yang

ClearOne Inc., v. Shure Acquisition Holdings Inc., Appeal No. 2021-1517

(Fed. Cir., June 1, 2022, Moore, Newman, Hughes)

➤ The term “self-similar,” when used in a patent claim, is not indefinite, but has a definite meaning where examples described in the patent specification fully explained the meaning of the term.

➤ “自相似”一词在专利权利要求中使用，并非是不明确的，而是在专利说明中描述的例子充分解释了该术语的含义时，该术语则具有明确的含义。

➤ 청구항에 사용될 때 Self-similar 라는 용어가 불명확하지는 않다. 그러나, 명세서에서 실시예가 용어의 의미를 충분히 설명하면 그 의미는 명확해진다.

➤ “自己類似”という用語は、特許のクレームにおいて用いられたとき、不明瞭ではないが、特許明細書中に記載された実施例がその用語の意味を十分に説明している限りにおいて、明瞭な意味を持つ。

➤ Sanctions for abusive behavior before the Board are imposed at the Board’s discretion, and a motion to sanction is heard at the Board’s discretion.

➤ 面对委员会的滥用行为的制裁由委员会自行决定，而制裁动议也由委员会自行决定听取。

➤ 특허권 남용에 대한 제재는 심판원의 재량에 따라 부과되고 제재 명령 신청은 심판원의 재량에 따라 심리된다.

➤ 行政特許審判部の前での悪態に対する制裁が、その審判部の裁量により課される。また、制裁の動議がその審判部の裁量により審理される。

Shure owns U.S. Patent 9,565,493 (‘493 patent), which claims microphone arrays and housings in a “self-similar” configuration. During inter partes review filed by ClearOne, Shure moved to add new independent claim 57 reciting the “self-similar configuration.” The Board granted the motion concluding that a skilled artisan would understand the meaning of the term “self-similar,” and would understand that meaning to include the specification’s disclosure of “factual-like configurations or constellations.” The Board also determined that the description of the term in the specification does not create ambiguity about the terms’ meaning. ClearOne moved for rehearing, and for sanctions against Shure on grounds that Shure filed for inter partes review of a ClearOne patent, also about microphone arrays, citing prior art that was not disclosed to the Board in the IPR of the ‘493 patent. The Board denied ClearOne’s request for rehearing and did not authorize ClearOne to file the sanctions motion. ClearOne appealed.

Upon review, the Federal Circuit determined that the written description of the ‘493 patent provides, with reasonable certainty, the scope of the term “self-similar.” The specification describes examples of microphones arranged in a “similar or repeating configuration;” “a fractal, or self-similar, configuration surrounding a central microphone;” and in other repeating shapes including “ovals, squares, rectangles, triangles, pentagons, or other polygons.” Fig. 9 of the ‘493 patent also illustrates a

self-similar arrangement of microphones in nested concentric circles. Extrinsic evidence reviewed by the court was also consistent with the intrinsic record. The reviewing court affirmed the Board’s holding that, in light of the specification, the term “self-similar” informs skilled artisans, with reasonable certainty, about the scope of the invention.

The court finally reviewed the Board’s decision to refuse to authorize ClearOne to file a sanctions motion. The court held that the Board, in finding that the arguments ClearOne raised in its sanctions motion were “essentially the same as the arguments presented and developed in its Request for Rehearing,” and that Shure did not intend to breach its duty to disclose references, did not abuse its discretion to refuse authorization.

ADDITIONAL INFORMATION

2318 Mill Road, Suite 1400
Alexandria, VA 22314 USA

Tel: +1 (703) 684-1111
Fax: +1 (703) 518-5499

Room B565, No. 5 building
Huayangnian Meinian International Square
Nanshan District, Shenzhen, China, 518067

Chiyoda Kaikan Bldg. 6F
1-6-17 Kudan Minami, Chiyoda-Ku,
Tokyo 102-0074 Japan

H-Business Park D 314, 26
Beobwon-ro 9-gil, Songpa-gu
Seoul, Korea

Tel: +81 3 6256-8970
Fax: +81 3 6717-2845

Tel: +82 (0)2 6412-0626
Fax : +82 (0)2 6412-0627

The articles in this newsletter are for informational purposes only and not for the purpose of providing legal advice or soliciting legal business. You should contact your attorney to obtain advice about each issue. Use of and access to this newsletter or any of the e-mail links contained herein do not create an attorney-client relationship between Hauptman Ham, LLP and the user. The opinions expressed at or through this newsletter are the opinions of the individual author and may not reflect the opinions of the firm, any individual attorney, or the firm's clients. Unsolicited information sent to Hauptman Ham, LLP by persons who are not clients of the firm is not subject to any duty of confidentiality on the part of Hauptman Ham, LLP.

All rights reserved. ©2022