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OBVIOUS ERRORS CANNOT SUPPORT OBVIOUSNESS

By [Michael P. McComas](#)

[LG Electronics Inc. v. Immervision, Inc.](#), Appeal Nos. 2021-2037 & 2021-2038
(Fed. Cir., July 11, 2022, Newman, Stoll, and Cunningham)

- An obvious error in a prior art reference cannot be used to support an assertion of obviousness, even when an expert needed over ten hours to determine the source of the error.
- 선행문헌의 명백한 오류는 "전문가가 오류의 원인을 결정하는데 10 시간 이상이 걸렸다고 하더라도 자명성 주장의 근거"로 사용할 수는 없다.
- 现有技术参考文献中的明显错误不能用来支持明显性的主张，即使专家需要十多个小时才能确定该错误的来源。
- 先行技術引例中の明らかな誤りを、たとえ専門家はその誤りの原因特定に10時間以上を要したとしても、非自明性主張の根拠とすることができない。

Immervision owns U.S. Patent 6,844,990 ('990 patent), which includes claims directed to a panoramic objective lens having an image point distribution function relative to a field angle that compresses the center and edges of the image and expands an intermediate zone. In a pair of inter partes reviews, LG Electronics ("LG") challenged the relevant claims of the '990 patent as being unpatentable over Tada's U.S. Patent 5,861,999 ('999 patent), which claims priority from Japanese Patent 09-201903 ('903 patent). LG's assertion of obviousness was based on a table in the '999 patent listing a set of optical parameters from which LG's expert derived an image point distribution (not explicitly disclosed in the '999 patent) having the claimed compression and expansion zones. Immervision countered with expert testimony claiming that the optical parameters had been mistakenly copied from a table in a separate embodiment in the '903 patent. Immervision's expert stated that the existence of an error was apparent from the outset based on internal inconsistencies, but that ten to twelve

hours of investigation were required to ultimately identify the copying mistake as the source of the error. Based on the length of the investigation, LG claimed that the error was so obscure that the ‘999 patent provided support for its assertion of unpatentability. The Board agreed with Immervision’s argument that the “transcription error” was obvious such that LG had not met its burden of proof with respect to the challenged claims. LG appealed.

Because the existence of an error was undisputed and LG had relied solely on its claim that the error was not obvious, the Federal Circuit (“court”) considered the primary question to be whether substantial evidence existed to support the Board’s factual finding that the error would have been apparent to a person of ordinary skill in the art. The court agreed with Immervision and affirmed the Board’s decision, citing its predecessor’s holding in *Yale* in which a prior art reference listed a previously unknown chemical compound due to a typographical error. In *Yale*, the predecessor court held that where a prior art reference includes an obvious error of a typographical or similar nature, the errant information cannot be said to disclose subject matter. After reviewing the evidence of internal inconsistencies and duplicated data presented by Immervision’s expert, the court concluded that the Board’s finding of an obvious error in the ‘999 patent was reasonable. The court indicated that while the amount of time required to detect an error may be relevant, *Yale* does not require that an error be immediately recognizable to be considered obvious. The court also rejected LG’s argument that *Yale* should be limited to spelling errors of a typographical nature, instead stating that “the error at issue here is not so far afield so as to warrant a different outcome.”

SILENCE DOES NOT SUPPORT NEGATIVE CLAIM LIMITATIONS

By [Bobbie Wu](#)

[Novartis Pharms. Corp. v. HEC Pharm. Co., Ltd.](#), Appeal No. 2021-1070
(Fed. Cir., June 21, 2022, [Moore](#), Linn, Hughes)

- Written description support for a negative element of a patent claim must include express or inherent disclosure of the negative element. Mere silence is not enough.
- 발명의 상세한 설명이 청구항의 부정적 한정요소를 뒷받침할 때는 그 부정적 한정요소에 대해 명시적 또는 내재적 공개를 하고 있어야 한다. 아무런 언급이 없다는 것만으로는 충분하지 않다.
- 专利权利要求中对于否定性权利要求的书面说明支持必须包括对该否定性权利要求的明示或固有披露。仅仅沉默是不够的。
- 特許クレームにおける否定的要件をサポートする記載には、その否定的要件の明示するまたは内在する記載が含まれていなければならない。単に何の記載もないということだけでは十分ではない。

Novartis sued HEC for infringement of all claims of U.S. Patent No. 9,187,405 (“405 patent”). The ‘405 patent relates to methods of treating relapsing-remitting multiple sclerosis (RRMS) using the immunosuppressant fingolimod. Each claim recites administering fingolimod “at a daily dosage of 0.5 mg, absent an immediately preceding loading dose regimen.” The patent does not otherwise mention loading doses or the absence thereof, but merely describes administering fingolimod at regular intervals.

The district court originally found that HEC infringes and that the claims are not invalid for inadequate written description. A panel of the Federal Circuit (O’Malley and Linn, with Moore dissenting), originally affirmed the district court, finding that a skilled artisan would read the patent’s disclosure to describe a negative limitation reciting “absent an immediately preceding loading dose.” HEC subsequently filed a combined petition for panel rehearing and rehearing en banc. Panel rehearing was granted, but meanwhile Judge O’Malley had retired. The new panel reversed the holding of the original panel and reversed the district court.

In the rehearing, the majority explained that for negative claim elements the written description is adequate when the specification describes a reason to exclude the relevant element, for example by revealing

disadvantages associated with the element or by giving alternatives. Silence is generally not sufficient disclosure support for a negative claim element. If it were, everything not mentioned in a patent specification could be negatively excluded from the patent claims. In some cases, disclosure of the negative limitation may be inherent where a skilled artisan would understand such disclosure, but disclosure by implication, or by possibility or probability, is insufficient.

The reviewing court found the determination by the district court that disclosure in the specification of a daily dosage, combined with silence regarding a loading dose, would tell a person of ordinary skill that loaded doses are excluded clearly erroneous. The court explained that a patent is not considered a “complete” legal document such that things not mentioned are necessarily excluded from the claims. A patent must have adequate written description of what is claimed. Observing that the patent was allowed only after addition of the no-loading-dose element to the claims to distinguish prior art, and finding inconsistent support for validity of the claims in trial testimony, the Federal Circuit held the claims lacking in written description support, reversing the district court and the prior panel holdings.

CLERICAL ERRORS DO NOT NECESSARILY EXCUSE WILFULL INFRINGEMENT

By [Subaru Kaneshaka](#)

[Pavo Solutions LLC, v. Kingston Technology Co, Inc.](#), Appeal No. 2021-1834
(Fed Cir., June 3, 2022, Lourie, Prost, Chen)

- An obvious clerical error in the language of a patent claim is not sufficient alone to avoid a verdict of willful infringement when the meaning of the language is clear and the correction does not change the metes and bounds of the claim.
- 청구항 언어의 의미가 명확하고 수정이 청구의 취지와 범위를 변경시키지 않을 때 청구항 언어의 명백한 오기만으로는 고의적 침해 평결을 피하기에 충분하지 않다.
- 专利权利要求的语言中明显的笔误不足以避免故意侵权的判决，因为该语言的意思是清楚的，且更正该笔误不会改变权利要求的范围和界限。
- 特許クレームの文言における明らかな事務的な手違いは、その文言の意味が明らかでありかつ修正したとしてもそのクレームの範囲を変更しないときには、それ自体では故意侵害の評決を回避するには十分ではない。

Pavo Solutions LLC (hereinafter “Pavo”) sued Kingston Technology Company, Inc. (hereinafter “Kingston”) in the District Court for the Central District of California, alleging infringement of US Patent No. 6,926,544 (“the ’544 patent”). In claims 1 and 24 of the ‘544 patent, the phrase “pivoting the **case** with respect to the flash memory main body” included a clerical error. The district court agreed with *Pavo* that the term “case” should be corrected to “cover”.¹

The district court may correct “obvious minor typographical and clerical errors in patents.” Correction is appropriate “only if (1) the correction is not subject to reasonable debate based on consideration of the claim language and the specification and (2) the prosecution history does not suggest a different interpretation of the claims.” On reviewing the specification and prosecution history, the district court determined that the claims contain an obvious minor clerical error. The specification and the drawings depict embodiments consistent with the understanding of the district court that “case” should be “cover,” and the prosecution history does not suggest a different interpretation. Thus, the district court judicially corrected the patent by replacing the word “case” with the word “cover”.

¹ Claim 7 also contains the same phrase, but was not asserted in the district court.

The Federal Circuit affirmed the decision of the district court that the ‘544 patent contained an obvious minor clerical error and should be corrected to “pivoting the **cover** with respect to the flash memory main body.” The court rejected Kingston’s argument that the word change was a substantial alteration, explaining that the claim as written does not describe a different structure—it merely makes no sense. This case is different, the court explained, from cases in which recited claim language could not be corrected merely because the result of practicing the claim as written would be undesirable. In this case, the recited language facially makes no sense, making correction appropriate. The court also noted that appellant’s expert testimony that the error in the claims was not minor or obvious was disregarded by the district court. The court also explained that no law prevents a district court from correcting obvious minor error even where correcting the error alters structure recited in the claim. Finally, the court found nothing in the prosecution history that suggests a different interpretation and determined that the correction was not subject to reasonable debate because an alternative correction proposed by Kingston would not have resulted in different claim scope.

The Federal Circuit also held that reliance on an obvious minor clerical error in the claim language is not a defense to willful infringement. Because judicial correction does not re-make the claim, but “gives effect to its obvious meaning;” Kingston cannot hide behind the error to escape a judgment of willful infringement.

UNCERTAINTY IN CLAIM LANGUAGE REQUIRES RESORT TO SPECIFICATION AND PROSECUTION HISTORY

By [Thomas S. Auchterlonie](#)

[University of Massachusetts, Carmel Laboratories, LLC \(UMass\) v. L’Oréal S.A., L’Oréal USA, Inc.](#),

Appeal No. 2021-1969

(Fed. Cir., June 13, 2022; Prost, Mayer and [Taranto](#))

- Claim construction must not rely solely on the ordinary meaning of the recited words, but must rely also on the specification and the prosecution history.
- 청구 범위 해석은 청구항에 사용된 단어의 통상적인 의미뿐만 아니라 명세서와 출원과정의 이력도 참고해야 한다.
- 权利要求的解释不能仅仅依赖于所引用词语的普通含义，还必须依赖于说明书和审批历史。
- クレーム解釈する際、記載された単語の通常の意味のみに依拠してはならず、必ず明細書および審査履歴にも依拠しなければならない。
- Where aspects of the record suggest that jurisdictional discovery might uncover probative jurisdictional evidence, then a party is entitled to jurisdictional discovery before a determination is made regarding jurisdiction.
- 기록의 측면에서 보았을 때 관할권 디스커버리로 중요한 관할권 증거를 발견할 수 있는 경우, 당사자는 관할권에 관한 결정이 내려지기 전에 관할권 디스커버리에 대한 권리가 있다.
- 如果记录的某些方面表明，管辖权的证据开示可能发现有说服力的管辖权证据，则当事人有权在就管辖权作出判决之前进行管辖权的证据开示程序。
- その記録の形勢が、管轄権に関する証拠開示（ディスカバリ）によって相当な管轄的証拠が明らかになることを示唆している場合、当事者は、司法管轄権に関する決定がなされる前に、管轄権に関する証拠開示を行う権利を有する。

UMass exclusively licenses U.S. Patent Nos. 6,423,327 and 6,645,513 to Carmel Labs. The patents are directed to enhancing non-diseased skin by topical application of naturally occurring nucleoside adenosine. The Delaware district court granted a motion by L'Oréal S.A. (based in France) to be dismissed from the litigation for lack of personal jurisdiction, which prevented UMass from conducting jurisdictional discovery of L'Oréal S.A. As the district court case continued against L'Oreal USA, Inc., the court held claim 1 to be indefinite.

Representative claim 1 recites “topically applying to the skin a composition comprising a concentration of adenosine in an amount effective to enhance the condition of the skin without increasing dermal cell proliferation, wherein the adenosine concentration applied to the dermal cells is 10⁻⁴ M to 10⁻⁷ M.” In construing the claim, the district court adopted a “plain meaning” construction of “concentration applied to the dermal cells” from an earlier *inter partes* review of the two patents filed by L'Oreal USA. Based on that construction favored by UMass and opposed by L'Oréal USA, the Patent Trial and Appeals Board denied institution of the review making the result non-appealable. The adopted construction interprets the recited concentration as referring to concentration within the dermal cell layer below the skin surface. The district court held the claim indefinite. UMass appealed.

Upon review, the Federal Circuit rejected the construction adopted by the district court. The reviewing court found that UMass, during prosecution and during trial, had relied upon interpretations of the phrase in question as meaning concentration of adenosine *as applied to the skin surface*, not concentration within the dermal cell layer. The court observed that the changing interpretations advanced by UMass show the language of the claim is not plain.

The reviewing court observed that the same thing can be “applied” directly to the skin and indirectly to the dermal cells, and that reference in the claim to “the adenosine concentration applied to the dermal cells,” suggests only one concentration. The court further noted that no embodiments described in the specification as being within the scope of the invention refer to concentration within a dermal cell layer. The court further noted that the claim was allowed after the phrase in question was added during prosecution and based on a representation that the amendment to claim 1 merely recited concentrations originally recited in dependent claims, but that the original claims contained no reference to dermal cells. The Federal Circuit concluded that the prosecution history, along with the other intrinsic evidence, requires a different construction of the claim and remand to the district court. The Federal Circuit also vacated the district court’s denial of jurisdictional discovery because UMass had made more than frivolous allegations L'Oréal S.A. was subject to personal jurisdiction, none of which L'Oréal S.A. specifically denied.

ADDITIONAL INFORMATION

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