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## THE IMPOSSIBLE AND THE UNFATHOMABLE

By [David Cain](#)

[AlterWAN, Inc. v. Amazon.com Inc.](#), Appeal No. 2022-1349

(Fed. Cir., March 13, 2023, Lourie, Dyk, and Stoll, precedential)

- A stipulation of non-infringement (or infringement) must be specific, particularly about the grounds for finding non-infringement and the claims implicated, so the decision can be reviewed.
- 不侵权（或侵权）的规定必须是具体的，特别是认定不侵权的理由和涉及的权利要求，以便对裁决进行审查。
- 비침해(또는 침해) 규정은 특히 비침해를 인정하는 근거와, 관련된 청구항에 대해 구체적으로 명시해야 결정을 검토할 수 있습니다.
- 非侵害（または侵害）の規定は、後日その判決を検討できるよう、特に非侵害認定の根拠および対象クレームについて、具体的でなければならない。
- Claim construction cannot include impossible scenarios in the scope of a claim, unless the language is too clear to be read any other way.
- 权利要求的解释不能包括权利要求范围内的不可能的情景，除非语言太清晰而无法以任何其他方式阅读。
- 언어가 너무 명확하여 다른 방식으로 읽을 수 없는 경우를 제외하고는 청구범위에 있어서 불가능한 시나리오를 청구범위 해석에 포함시킬 수는 없습니다.
- クレーム解釈が、その文言が非常に明確でそれ以外に読み取りようがない場合を除き、

## Background:

AlterWAN sued Amazon for infringement of claims of two patents: 8,595,478 and 9,015,471. At the claim construction phase, the parties disputed two terms relevant to this appeal: “non-blocking bandwidth” and “cooperating service provider.” When claim construction was decided, the parties stipulated non-infringement by Amazon. AlterWAN appealed.

## Holding:

The stipulated judgment was vacated and remanded to the district court for further proceedings to clarify the parties’ non-infringement positions, and to determine whether a stipulation of non-infringement is even possible in the circumstances of this case

## Discussion:

The Federal Circuit vacated the stipulated judgement as too vague to be reviewed. The stipulated judgment held that Amazon does not infringe under the district court’s constructions of “cooperating service provider” and “non-blocking bandwidth.” However, the stipulation did not provide sufficient detail to allow a reviewing court to resolve claim construction issues. The stipulation also did not identify which claims remain at issue in the appeal. It was unclear whether the judgment required the affirmance of both “cooperating service provider” and “non-blocking bandwidth,” where the interpretation of cooperating service provider includes the term “non-blocking bandwidth.” It was also unclear whether affirmance required the approval of all aspects of the construction of “cooperating service provider.”

Regarding the claim term “non-blocking bandwidth,” the district court’s construction effectively required a system to provide bandwidth even when the Internet is inoperable. The court said this was not a reasonable construction in light of the specification since it requires the impossible.

## **PATENT ELIGIBLE SOLUTIONS MUST BE SPECIFICALLY CLAIMED**

By [Ronald Pawlikowski](#)

[Hawk Technology Systems, LLC. v. Castle Retail, LLC.](#), Appeal No. 2022-1222

(Fed. Cir., February 17, 2023, [Reyna](#), [Hughes](#), and [Cunningham](#), precedential)

- To be patent eligible as a solution to a technical problem, a patent claim must recite the specific elements that show how the solution is implemented. Using generic, functional language to describe the solution is insufficient to recite patent eligible subject matter, and detailed description of the solution in the specification, by itself, does not make the claim patent eligible.
- 想要通过作为一个技术问题的解决方案而成为专利适格(的专利申请), 专利权利要求必须列举出显示解决方案实现方式的具体要素。使用通用的、功能性的语言来描述解决方案不足以列举出专利适格标的, 并且说明书中解决方案的详细描述本身并不能使权利要求成为专利适格。
- 기술적 문제에 대한 해결책으로서 특허를 받으려면 특허 청구항에 어떻게 해결책이 구현되는지를 보여주는 구체적인 요소를 기재해야 합니다. 해결책을 설명에 있어 일반적인 기능적 언어를 사용하는 것만으로는 특허 받을 만한 내용을 포함하고 있다고

보기에 충분하지 않으며, 명세서에서 해결책에 대해 자세히 설명하는 것만으로는 청구항이 특허 적격이 되지 않습니다.

- ある技術的課題の解決として特許適格性を有するためには、特許クレームが、その解決がどう実施されるかを示す特定の構成要件を記していなければならない。その解決を開示する一般的、機能的な文言の使用は、特許適格性を有する主題の記載として不十分である。明細書におけるその解決に関する詳細な開示が、それだけでは、そのクレームを特許適格とするものではない。

#### Background:

Hawk Technology Systems, LLC. (Hawk) sued Castle Retail, LLC. (Castle) for alleged infringement of U.S. Patent No. 10,499,091 (“the ‘091 patent”). Castle filed a motion to dismiss under Federal Rule of Civil Procedure 12(b)(6), on the grounds that the claims were directed to ineligible subject matter, and thus invalid under 35 U.S.C. § 101. The District Court granted the motion. Hawk appealed the District Court’s ruling.

#### Holding:

Claims directed to receiving, displaying, converting, storing, and transmitting digital video using result-based functional language did not recite a specific solution to a technical problem, and so were not eligible for patenting.

#### Discussion:

The Federal Circuit affirmed grant of the motion to dismiss by the district court under Rule 12(b)(6) for ineligible patent claims.

The ‘091 patent is titled “high-quality, reduced data rate streaming video product and monitoring system.” The ‘091 patent relates to a method of viewing multiple simultaneously displayed and stored video images on a remote viewing device of a video surveillance system. The ‘091 patent states that the use of the recited methods results in reduced costs to the user, lower memory storage requirements, and the ability to handle a larger monitoring application due to bandwidth efficiency. The ‘091 patent states that a configuration in Figure 3 uses “existing broadband infrastructures” and a “generic PC-based server.”

The Federal Circuit applied the two-step analytical framework of *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208 (2014). At the first step, the Federal Circuit agreed with the district court that the claims of the ‘091 patent are directed to a patent-ineligible abstract idea, specifically, to a method of receiving, displaying, converting, storing, and transmitting digital video “using result-based functional language.” *Two-Way Media Ltd. v. Comcast Cable Commc’ns, LLC*, 874 F.3d 1329, 1337 (Fed. Cir. 2017). The reviewing court rejected Hawk’s argument that the claims are directed to a solution to a technical problem, explaining that the solution urged by Hawk is not recited in the claims. The reviewing court explained that the analysis at step one “must focus on” the claim language. *ChargePoint, Inc. v. SemaConnect, Inc.*, 920 F.3d 759, 769 (Fed. Cir. 2019). It is not enough merely to describe the solution in the specification. The Federal Circuit found that the claims do not recite performing any “special data conversion” or otherwise describe how the alleged goal of “conserving bandwidth while preserving data” is achieved. The Federal Circuit stated that converting information from one format to another—including changing the format of video data or compressing it—is an abstract idea. *Adaptive Streaming, Adaptive Streaming Inc. v. Netflix, Inc.*, 836 F. App’x 900, 903 (Fed. Cir. 2020). Finding that the claims contain no elements relating to the solution urged by Hawk, the Federal Circuit agreed with the district court that the claims are directed to an abstract idea.

Turning to the second *Alice* step, the Federal Circuit found nothing but generic, conventional elements in the claims, nothing that would “transform the nature of the claim into a patent-eligible application of the abstract idea.” *Two-Way Media*, 874 F.3d at 1338. The Federal Circuit rejected Hawk’s argument that recitation, in the claims, of specific tools, parameters, and even specific frame rates achieve the technical solution described in the patent. The Federal Circuit found, however, that the claims “only use generic functional language to” achieve the purported solution and require nothing “other than conventional computer and network components operating according to their ordinary functions” (e.g., a “personal computer,” “storage device,” “external viewing device,” etc.). *Two-Way Media*, 874 F.3d at 1339. Recognizing that the claims include “parameters,” the Federal Circuit explained that the claims fail to specify precisely what the parameters are, and that the parameters at most concern abstract data manipulation—image formatting and compression, and affirmed the district court dismissal under Rule 12(b)(6).

## COMBINATION OF ELEMENTS FROM PRIOR ART IS OFTEN OBVIOUS

By *Reina Kakimoto*

*Intel Corp. v. PACT XPP Schweiz AG*, Appeal No. 2022-1037

(Fed. Cir., March 13, 2023, Newman, Prost, and Hughes, precedential)

- For obviousness purposes, motivation to combine prior art teachings may be found where (1) a prior art reference addresses a known problem; (2) a solution to the problem found in the reference; and (3) combining teachings of the references is not beyond the capability of a person of ordinary skill in the art.
- 在考虑显而易见性时，结合现有技术知识的动机可以在以下情况下找到：(1)现有技术参考解决了一个已知的问题；(2)在参考中发现了问题的解决方案；(3)结合参考知识并不超出本领域普通技术人员的能力。
- 자명성을 판단에 있어서, (1) 선행 기술 문헌이 알려진 문제를 다루고 있고, (2) 그 문헌에서 발견된 문제에 대한 해결책이 있으며, (3) 그 문헌들의 내용을 결합하는 것이 당업자의 능력을 넘어서는 것이 아닌 경우 선행 기술 문헌들을 결합할 동기를 찾을 수 있습니다.
- 自明とする理由において、(1) 先行技術引例がある既知の課題に言及していて、(2) その課題の解決が引例の中に見出せ、かつ(3) 引例の教示同士を組み合わせることが当業者の能力を超えるものでない場合、先行技術の教示同士を組み合わせる動機付けを見出し得る。

### Background:

PACT XPP Schweiz AG (“PACT”) owns U.S. Patent No. 9,250,908 (“the ‘908 patent”), which relates to multiprocessor systems and how processors in those systems access data. The claim language at issue in this case recites a processing system with a plurality of processors, at least one separated cache with segments, and an interconnect system interconnected each of the separated cache segments with each of the processors, each processor with neighboring processors, and each separated cache segment with neighboring segments. Intel asserted that figures from prior art references Kabemoto and Bauman teach all elements, and that a person of ordinary skill in the art would combine Bauman’s segmented global secondary cache with Kabemoto’s hardware.

At IPR, PACT did not dispute that the references taught all elements, but argued that Intel failed to demonstrate a motivation to combine the teachings. The Board found that the references do not teach all recited elements, particularly the segment-to-segment interconnection, and that Intel failed to show motivation to combine the teachings. Intel appealed.

Holding:

To show a motivation to combine prior art references for purposes of obviousness, it is enough to show that there was a known problem in the prior art, that a prior art reference addressed the problem, and that combining the teachings of the prior art was not beyond the skill of the ordinary artisan.

Discussion:

Before the Board, Intel argued that one of ordinary skill would have been motivated to combine the known techniques of Kabemoto and Bauman because Kabemoto described structure similar to Bauman’s interconnect to solve problems associated with cache coherency in multiprocessor systems. The Board rejected Intel’s “known technique” rationale because Kabemoto has its own solution to cache coherency problems without resort to any teachings of Bauman. Reasoning that a person of ordinary skill would not, therefore, regard Bauman’s technique as an obvious improvement to Kabemoto, the Board held for PACT.

The Court of Appeals for the Federal Circuit analyzed the “known techniques” rationale in the context of *KSR Int’l Co. v. Teleflex, Inc.* (550 U.S. 398 (2007)), explaining that the motivation to combine analysis is flexible, and motivation can be found, according to KSR where “any need or problem known in the field of endeavor at the time of invention” is addressed by a prior art reference, “even absent any hint of suggestion in the references themselves.” The Federal Circuit concluded that “it’s enough for Intel to show that there was a known problem of cache coherency in the art, that Bauman’s secondary cache helped address that issue, and that combining the teachings of Kabemoto and Bauman wasn’t beyond the skill of an ordinary artisan. Nothing more is required to show a motivation to combine under KSR.” The Federal Circuit reversed the Board’s conclusion that prior art did not disclose all elements recited in the claims, finding that the figures of Bauman and Kabemoto clearly did disclose all recited elements. The Federal Circuit also reversed the Board’s conclusion that Intel’s “known technique” was insufficient to show motivation to combine the teachings of the two references. The Federal Circuit finally remanded the case for further proceedings to resolve remaining disputes regarding a dependent claim.

## CONSISTENCY WHEN CONSTRUCTING TERMS

By [Thomas S. Auchterlonie](#)

[Univ. of Mass. v. L’Oréal S.A.](#), Appeal No. 2021-1969

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

- Construction of terms in a patent claim cannot conflict with usage of the terms in the specification and the prosecution history.
- 專利權利要求中術語的解釋不能與說明書和專利申請歷史中術語的用法相沖突。
- 특허 청구항의 용어 해석은 명세서 및 심사이력에서 사용된 용어와 충돌해서는 안됩니다.
- 特許クレーム内の用語の解釈が、明細書の及び審査履歴における用語の使用と矛盾してはならない。

- 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.
- 如果记录的某些方面表明，管辖权证据开示可能会发现证明性的管辖权证据，则一方当事人有权在就管辖权作出决定之前进行管辖权证据开示。
- 기록의 일부가 관할권 조사를 통해 입증력 있는 관할권 증거를 발견할 수 있음을 시사하는 경우, 당사자는 관할권에 관한 결정이 내려지기 전에 관할권 조사를 할 권리가 있습니다.
- 記録の状況が、管轄地域の証拠開示が管轄地域の証明力ある証拠を明らかにするであろうことを示唆しているのであれば、当事者は管轄地域に関する決定が行われる前に、管轄地域の証拠開示がなされる権利を有する。

### Background:

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<sup>-4</sup> M to 10<sup>-7</sup> 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’Oreal 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.

### Holding:

Where usage of a claim term in a patent specification, and by the patent applicant during prosecution of the patent, conflicts with a “plain meaning” construction of the term, the “plain meaning” construction cannot be adopted.

### Discussion:

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.

Further explaining that public use may occur where, as here, the inventor used the device such that at least one member of the public without any secrecy obligations understood the invention (citing *Netscape Commc'ns Corp. v. Konrak*, 295 F.3d 1315, 1321 (Fed. Cir. 2002)), the Federal Circuit concluded that there was no genuine factual dispute that the devices shown at AAGL 2009 disclosed the SDMP term of claim 13. The inventors conceived the SDMP technology before AAGL 2009 as evidenced by a lab notebook with August 2009 CAD drawings and other documents entered at trial.

## ADDITIONAL INFORMATION

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