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TIE EVIDENCE OF NON-OBVIOUSNESS TO NOVEL ELEMENTS

By [David Lynch](#)

[Yita LLC v MacNeil IP LLC](#), Appeal No. 2022-1373, -1374
(Fed. Cir. June 6, 2023, [Taranto](#), Chen, and Stoll, precedential)

- Evidence of commercial success grounded upon an element recited in a patent claim lacks nexus to demonstrate the claim non-obvious where the recited element is disclosed in prior art and an artisan of ordinary skill would have been motivated to use that element to achieve the claimed invention.
- 若基于专利权利要求中列举的某一要素已在现有技术中公开，并且普通技术人员会被激励使用该要素来实现所要求的权利要求发明，那么该要素具有商业成功的证据与证明该权利要求具有非显而易见性之间则缺乏联系。
- ある特許クレームの構成要件が先行技術に記載されており当業者がクレーム発明を実現するためにその構成要件を用いることが動機づけられていたであろう場合において、その構成要件を根拠とする商業的成功の証拠は、そのクレームの非自明性との結びつきを欠く。
- 특허 청구항에 언급된 요소에 기반한 상업적 성공 증거는 그 요소가 선행 기술에 이미 개시되어 있고, 당업자가 해당 특징을 사용하여 청구된 발명을 달성할 동기가 있었던 경우, 비자명성을 보여주기에는 부족합니다.

MacNeil owns patents claiming vehicle floor mats that “closely conform” to the walls of the footwell. In 2020, Yita filed two petitions at the Patent Trial and Appeals Board to invalidate two MacNeil patents related to vehicle floor trays, U.S. Patents, Nos. 8,382,186 (“the ‘186 patent”) and 8,833,834 (“the ‘834 patent”). Yita urged that MacNeil’s patents be invalidated as obvious in view of prior art references Rabbe, Yung, and Gruenwald. Rabbe teaches floor mats that “perfectly conform to the contour of the vehicle interior.” Yung teaches vehicle floor mats with a flexible, light weight, middle plastic layer that is “waterproof Polyethylene . . . or Polyethylene–Vinyl Acetate . . . foam.” Gruenwald is a book that teaches methods of thermoforming.

In IPR 2020-01139 (“the ‘1139 IPR), the PTAB found that a relevant artisan would have been motivated to combine the teachings of the three references to arrive at claims 1-7. However, the PTAB rejected the obviousness challenge to claims 1-7 of the ‘186 patent, finding that evidence of secondary considerations presented by MacNeil, stemming from commercial success of its WeatherTech product, was “compelling and indicative of non-obviousness” that was coextensive with the claims. In IPR 2020-01142 (“the ‘1142 IPR”), the Board rejected the same evidence of secondary considerations as lacking nexus with claims 13-15 of the ‘834 patent, finding those claims obvious. The Board rejected Yita’s challenges to claims 1-12 of the ‘834 patent after declining to consider an argument, regarding criticality of a dimension recited in the claims, that Yita had raised in a footnote in its reply brief. The Board concluded that the reply-footnote position was a “new position” and “outside the scope of a proper reply.”

On appeal, the Federal Circuit reversed the Board’s decision regarding the ‘1139 IPR. The court held that the Board relied upon legally incorrect reasoning for rejecting Yita’s obviousness challenge based on erroneous analysis of nexus regarding MacNeil’s secondary-consideration evidence of commercial success. The court found the Board’s reliance on a finding that Rabbe “does not establish that close conformance was well-known” to defeat a showing of obviousness in view of Rabbe erroneous. The Federal Circuit recognized that secondary-consideration evidence “may be linked to an individual element” of the claimed invention or “to the inventive combination of known elements” in the prior art. However, MacNeil’s evidence of commercial success related entirely to an individual element, which was disclosed in the prior art, and which an ordinary artisan would have been motivated to use. The Federal Circuit thus held that the evidence of commercial success was not pertinent and did not undermine the obviousness of the claimed invention.

Regarding the ‘1142 IPR, the Federal Circuit affirmed the Board’s decision not to consider an argument raised for the first time by Yita in a footnote in its Petitioner’s Reply. The court found no abuse of discretion because it has repeatedly ruled that the PTAB is within its discretion to decline to consider new theories of unpatentability when they are presented for the first time in a reply.

INVENTORS MAKE SIGNIFICANT CONTRIBUTIONS

By Wonjun Choi

[*Blue Gentian, LLC v. Tristar Products, Inc.*](#), Appeal No. 2021-2316
(Fed. Cir. June 9, 2023, Prost, Chen, and Stark, precedential)

- Joint inventorship is a fact-specific question that requires a significant contribution to the invention, corroboration of that contribution, and collaboration.
- 共同発明人是一个事实特定的问题，(共同発明人) 需要对发明做出重大贡献，证实这一贡献，并进行合作。
- 共同発明者の地位とは具体的事実の問題であり、その発明に対する意味ある貢献、その貢献への裏付け証拠、および共同作業を必要とする。
- 공동 발명의 성립여부는 사실관계에 따라 판단되는 질문입니다. 발명에 대한 상당한 기여, 그 기여에 대한 입증, 그리고 발명자들간의 협력이 필요합니다.
- Since errors/omissions in inventorship may be corrected after issuance, patentees should carefully evaluate any potential attacks on inventorship before bringing an infringement suit.

- 由于发明权的错误/遗漏在（专利）授权后可以被纠正，专利权人在提起侵权诉讼之前应仔细评估对发明权的任何潜在攻击。
- 発明者の地位の誤り／漏れは特許発行後に訂正し得るため、特許権者は侵害訴訟を提起する前に発明者の地位への潜在的攻撃の有無を注意深く評価すべきである。
- 발명자 지위의 오류/누락은 특허허여 후 수정될 수 있으므로 특허권자는 침해 소송을 제기하기 전에 발명자 지위에 대한 잠재적 공격을 신중하게 평가해야 합니다.

Blue Gentian, LLC, National Express, Inc., and Telebrands Corp. (collectively, “Blue Gentian”) sued Tristar Products, Inc. (“Tristar”) for infringement of six U.S. Patents, U.S. Patent Nos. 8,291,941, 8,291,942, 8,479,776, 8,757,213, D722,681, and D724,186. Tristar counterclaimed to correct inventorship of all six patents. After an evidentiary hearing, the district court determined that a nonparty, Gary Ragner, should have been a named co-inventor on all asserted patents. The district court ruled in Tristar’s favor and ordered correction of the patents.

In 2011, Ragner Technology Corporation (“Ragner Tech.”) was seeking investors to bring its MicroHose product, an expandable hose, to market. Mr. Ragner, founder of Ragner Tech., and six others met with Mr. Berardi, the named inventor of the patents at issue. Mr. Ragner has a B.S. in physics and an M.S. in aero-space engineering, and prior to the meeting, had designed many expandable hose prototypes. Mr. Berardi has a degree in sociology, and at the time of the meeting, had no experience designing or building hoses. Mr. Berardi testified that he went to Home Depot a few hours after the Ragner Tech meeting and purchased materials to make his own expandable hose prototype where water flowed through an outer tube and an inner elastic tube was used for retraction. This prototype was similar in key respects to a prototype shown at the meeting. Three months later, Mr. Berardi filed his first expandable hose patent application (which was eventually issued as the ’941 patent). The district court found that Mr. Ragner had conveyed three key elements of the hose to Mr. Berardi during a meeting, and found that these key elements amounted to a significant contribution to the conception of at least one claim in all six patents.

The Court of Appeals for the Federal Circuit affirmed. The reviewing court rejected Blue Gentian’s arguments that the district court erred by not construing the claims, by not sufficiently tying the elements contributed by Mr. Ragner to the claims, and by finding Mr. Ragner’s contributions significant despite, according to Blue Gentian, that the claims do not reflect those contributions. The Federal Circuit rejected each of these arguments.

The reviewing court explained that *Trovan, Ltd. v. Sokymat SA*, 299 F.3d 1292 (Fed. Cir. 2002), does not establish a threshold requirement that claims be construed prior to drawing any conclusions about inventorship if all questions of claim scope have been resolved. A district court is not required to prospectively address hypothetical claim construction issues. Because there was no issue of claim scope identified in the appeal, there was no showing that claim construction was a necessary prerequisite to the inventorship question.

Regarding the key elements of the claims, the Federal Circuit found the district court had properly noted that all the claims of the asserted utility patents required the three elements, which was an undisputed fact of the trial. The Federal Circuit further noted that Blue Gentian had relied on the same three elements to distinguish prior art during prosecution of at least one patent, tying those elements to the claims and demonstrating their significance. The Federal Circuit also agreed with the district court

that the three elements also carry the elements of the designs in the design patents, as Mr. Berardi had testified.

Finally, the Federal Circuit rejected Blue Gentian’s argument that the three contributed elements, singled out, were each in the prior art, noting that this argument does not address the combination of the elements. The reviewing court found that Blue Gentian had not shown clear error in the district court’s finding that the three contributed elements, in combination, were significant and were contributed by Mr. Ragner.

VIOLATING PTAB BRIEFING RULES CAN HAVE SERIOUS CONSEQUENCES

By Shawn Joseph

Parus Holdings, Inc. v. Google LLC, Appeal No. 2022-1269
(Fed. Cir. June 12, 2023, Lourie, Bryson, and Reyna, precedential)

- In an IPR, the PTAB may consider issues beyond the statutory grounds for petitioning for IPR, especially where a party has raised such issues in a defensive brief.
- 在多方复审（IPR）中，专利审判和上诉委员会（PTAB）可以考虑超出多方复审（IPR）中所请求法定理由的问题，特别是当一方在辩护摘要中提出此类问题时。
- 無効審判において審判部は、特に一方当事者が弁駁書において提起している場合、審判請求の法的根拠を超えた問題点を考慮しても良い。
- IPR 심판에서 PTAB 는 청원 이유 외에도 추가적인 문제를 심사할 수 있습니다. 특히, 당사자가 답변 보고서에서 이러한 문제를 언급한 경우 더욱 그렇습니다.
- The requirement for the PTAB to consider all evidence in an IPR does not relieve parties to the IPR from compliance with briefing rules established by the PTAB.
- 专利审判和上诉委员会（PTAB）考虑多方复审（IPR）中所有证据的要求并不能免除多方复审（IPR）当事人遵守专利审判和上诉委员会（PTAB）制定的简报规则的义务。
- 無効審判における全ての証拠を考慮するという審判部に対する要求が、その無効審判の両当事者を、審判部が確立した状況説明ルールを遵守することから解放するものではない。
- IPR 심리 과정에서 PTAB 가 모든 증거를 고려해야 한다는 요건이 있다고 하더라도 당사자가 PTA 가 정한 보고서 작성 규칙을 준수해야하는 책임이 면제되지는 않습니다.

Google petitioned for inter partes review of claims in two patents owned by Parus, U.S. Patent Nos. 7,076,431 (“the ‘431 patent”) and 9,451,084 (“the ‘084 patent”). The Patent Trial and Appeals Board held, in these two IPRs, that claims 1, 2, 4–7, 10, 13, and 14 of the ’431 patent, and claims 1, 2, 4–7, 10, and 14 of the ’084 patent, are unpatentable as obvious. The challenged patents are directed to an interactive voice system that allows a user to request information from a voice web browser. The challenged patents are continuations of a patent application filed on February 4, 2000, and published as U.S. Patent Publication No. 2001/0047262 (“Kurganov-262”). Google LLC, Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., LG Electronics Inc., and LG Electronics USA, Inc. (collectively, “Appellees”) petitioned for inter partes review by USPTO, alleging obviousness over

Kovatch, WIPO publication WO01/050453 (filed on July 12, 2001 and earliest possible priority date of January 4, 2000), and Kurganov-262.

Parus argued that Kovatch was not prior art under applicable law because the claimed inventions had been conceived at least by July 12, 1999, and reduced to practice at least by December 31, 1999. To show prior invention, Parus submitted approximately 40 exhibits totaling 1,300 pages, in addition to claim charts exceeding 100 pages, but with “only minimally cited small portions of that material in its IPR briefs without meaningful explanation.”

The Board declined to consider Parus’s arguments and evidence that the challenged patents were conceived and reduced to practice prior to Kovatch’s priority date because it found that Parus had failed to comply with 37 C.F.R. § 42.6(a)(3), which prohibits incorporation by reference in IPR briefs. The Board further found that the evidence submitted by Parus demonstrated that the challenged claims were not entitled to the February 4, 2000, priority date, so Kurganov-262 therefore qualified as prior art because the computing device “configured to periodically search via one or more networks to identify new web sites and to add the new web sites to the plurality of web sites,” as recited in the challenged claims, was not disclosed in Kurganov-262.

On appeal, the Court of Appeals for the Federal Circuit affirmed both conclusions by the Board. Regarding the PTAB briefing rules, the reviewing court explained that “...when a patent owner attempts to antedate an asserted prior art reference, the patent owner assumes a temporary burden of production,” and that “[t]he burden of production cannot be met simply by throwing mountains of evidence at the Board without explanation.” Finding that Parus does not dispute that it incorporated arguments by reference, the Federal Circuit found it was not an abuse of discretion for the Board to ignore Parus’s arguments, and that by seeking to antedate a prior art reference, Parus had the burden to explain how its cited evidence was effective to remove the prior art reference.

The Federal Circuit also rejected Parus’s argument that the Board improperly based its priority conclusion on a written description analysis, and that the Board’s analysis was erroneous. The court explained that 35 U.S.C. § 311(b) limits the grounds on which an IPR petition can be based, but does not limit the issues the Board may consider in resolving the IPR. Because Parus sought to antedate the Kovatch reference, the Board was required to consider written description support to resolve the issue raised by Parus. The court also found that the Board’s conclusions about written description support for the challenged claim language were supported by substantial evidence.

ADDITIONAL INFORMATION

2318 Mill Road, Suite 1400
Alexandria, VA 22314 USA

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

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

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

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

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

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

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