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MOTIVATION TO COMBINE MUST FOCUS ON THE CLAIM

By *Reina Kakimoto*

[*Axonics, Inc. v. Medtronic, Inc.*](#), Appeal No. 2022-1451
(Fed. Cir. July 10, 2023, Lourie, Dyk, Taranto, precedential)

- In analyzing whether motivation to combine prior art elements would have made a patent claim obvious, the inquiry is why a relevant artisan would have combined the elements as in the claim, not whether a prior art requirement not relevant to the claim would have been frustrated.
- 先行技術の要件同士を組み合わせる動機付けが特許クレームをして自明であったかどうかを解析する際、問題となるのは、なぜ関連する当業者が、構成要件同士をクレームされているように組み合わせ得たかという点であり、クレームとは関連性が無い先行技術の前提条件が妨げられたかどうかではない。
- 在分析组合现有技术元素的动机是否会使专利权利要求变得显而易见时，要询问的是为什么相关技术人员会像权利要求中那样组合元素，而不是与权利要求不相关的现有技术要求是否会受到阻碍。
- 선행기술의 구성요건 결합하려는 Motivation이 청구항을 자명하게 만들었는지 여부를 분석할 때, 청구항과 관련이 없는 선행 기술 요건을 고려하는 것이 아니라, 왜 당업자가 구성요건들을 청구항과 같이 결합할 수 있었는가 라는 것이다.

Medtronic owns U.S. Patent Nos. 8,626,314 and 8,036,756, which claim a neurostimulation lead and a method for implanting and anchoring the lead. It is a medical device used to stimulate human nerves for regulating muscular contraction to treat certain symptoms and descriptions of the patents were focused on the stimulation of the sacral nerve for treating urinary incontinence. The device is linear in shape, with four electrodes at one end and four “tines” at the other end, the tines

having projections intended to immobilize the stimulator within human tissue. The patents mention the sacral nerve only in their background description of prior art problems, and in citing the need for a stimulation lead for stimulating the sacral nerve, but in the rest of the application the sacral nerve is mentioned only once as a “preferred embodiment. The claims do not make any reference to the sacral nerve and do not recite stimulation to the sacral nerve.

Axonics, Inc., petitioned for Inter Partes Review (IPR) challenging the validity of various claims of Medtronic's patents, claiming that the combination of two prior art references, Young and Gerber, would render the claims obvious. Young teaches an electrical neurostimulator for stimulating the trigeminal nerve in the face. Young has only one electrode, along with two sets of four tines. Young also teaches that the stimulator could be improved by adding multiple stimulation sites (i.e. electrodes). Gerber teaches a stimulator specifically for the sacral nerve, the stimulator having one electrode and an anchoring mechanism with holes that can be used for suturing. Axonics argued that the references are from the same field and address similar problems, providing motivation to combine teachings of the references.

The Patent Trial and Appeals Board rejected Axonics' argument regarding motivation to combine, finding that the relevant artisan would have experience with physiology of the sacral nerve area and medical leads for that area. The Board found that patents at issue do not solve the same problems, primarily because the physiology of the sacral area and the trigeminal area are different, and procedures for applying stimulation leads are also different. The Board thus found that the relevant artisan would not find motivation to combine teachings from the references, crediting the testimony of Medtronic's expert that the complex physiology of the trigeminal nerve region would have made the suggested changes to the Gerber stimulator impossible.

On review, the Court of Appeals for the Federal Circuit reversed and remanded the decision. The court considered the issue of whether Young and Gerber would have motivated the relevant artisan to combine their features to arrive at the claimed invention. In reviewing Medtronic's approach to obviousness, which was adopted by the Board, the court emphasized that, in considering motivation to combine prior art elements, the inquiry is not whether a relevant artisan would combine a first reference's feature with a second reference's feature to meet requirements of the first reference that are not requirements of the claims at issue. The real question is why a relevant artisan would have combined the elements in the way the claimed invention does. The court explained that, from the perspective of the relevant artisan, defined by the Board as a person with sacral nerve experience, a review of Young would have been couched in the context not of applicability in the trigeminal nerve area but in the sacral nerve area. Applicability to the trigeminal nerve area would not have been relevant for such an artisan, and the Board erred by grounding its motivation to combine analysis in the context of trigeminal area physiology. The Board thus improperly limited the Young-Gerber combination analysis to what would work in the trigeminal nerve area. Finding that such error was not harmless, the court remanded the case to the Board for further proceedings.

CRITICAL CLAIM ELEMENTS UNREMOVABLE IN REISSUE

By Gregory P. Brummett

In re FLOAT'N'GRILL LLC, Appeal No. 2022-1438
(Fed. Cir. July 12, 2023, Prost, Linn, and Cunningham, precedential)

- Critical elements of an invention described by a patent specification cannot be removed from the claims in reissuing a patent.
- 特許明細書に記載されている発明の臨界的要件を、再発行特許のクレームから除外することができない。
- 专利说明书所描述的发明的关键要素不能在重新颁发专利时从权利要求书中删除。
- 특허 명세서에 기재된 발명의 중요한 구성요건을 재발행 특허의 청구항에서 제외할 수 없다.
- No express statement of criticality is needed to determine that a claim element is critical.
- クレームのある構成要件が臨界 (Criticality) であることを決定する際に臨界であるとする明示の供述が必要ではない。
- 不需要明确的关键性声明来确定权利要求要素是否关键。
- 청구항 구성요소가 중요하다고 판단하기 위해 그것에 대한 명시적인 진술이 필요하지 않습니다.

Float’N’Grill (“FNG”) is the owner of U.S. Pat. No. 9,771,132 (“the ‘132 patent”) which discloses a single embodiment of a floating grill holder (FIG. 1 is reproduced below) utilizing a “plurality of magnets” for removably mounting a grill mounted on the grill holder. As disclosed, the magnets (60) are arranged within a middle segment of the upper surface of the grill supports 46, 48.

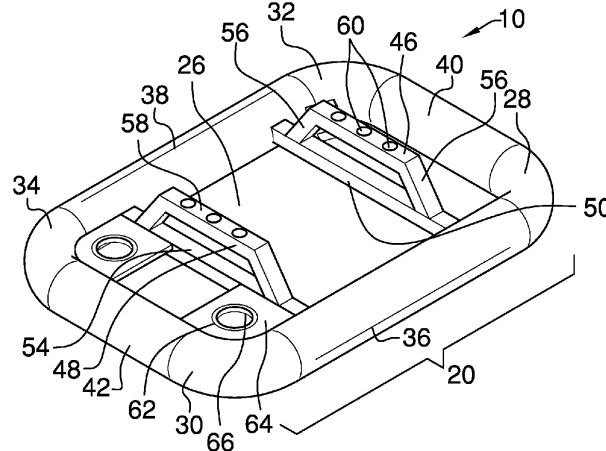


FIG. 1

After the '132 patent was issued, FNG, believing that it had claimed less than it was entitled to claim in the original patent, filed a reissue application that included claims omitting the “plurality of magnets” limitation. The reissue claims generically purported to cover removably securing a grill to the float apparatus.

The Examiner rejected claims 4, 8, 10–14, and 17–22 for failing to satisfy the reissue standard of 35 U.S.C. § 251, finding that the '132 patent disclosed “a single embodiment of a floating apparatus for supporting a grill” using a “plurality of magnets” and did not disclose the plurality of magnets as being “an optional feature of the invention.” The Examiner also found that “it is *prima facie* apparent that the magnets are a critical element of the invention, as the magnets alone are responsible for effecting a safe and stable attachment between the floating apparatus and the grill. The Board sustained all of the Examiner’s rejections under 35 U.S.C. § 251 and FNG appealed.

On appeal, FNG argued that the “plurality of magnets” was simply a *non-essential* embodiment of the original patent; that the disclosure directed to the function of removably securing the grill to the grill supports with a plurality of magnets is enough to support broadened reissue claims that recite the removeable attachment mechanism more generally; and that one of ordinary skill in the art “would understand that it is *unimportant* how the floating apparatus supports the grill.”

The Federal Circuit reviewed the language of 35 U.S.C. § 251, which requires that reissue claims be directed to “the invention disclosed in the original patent,” and cases interpreting that language. Noting guidance from the United States Supreme Court that a reissue claim does not meet the requirements of section 251 merely because the newly claimed invention might have been claimed in the original patent because it was suggested or indicated in the specification, the Federal Circuit understood cases stemming from that Supreme Court guidance require reissue claims not omit elements of claims in the original patent that are not disclosed as being optional in the specification.

The Federal Circuit accordingly held that:

- 1) Reissue claims that are broadened so far as to cover undisclosed alternatives to a limitation that is deemed to be necessary, critical, or essential to the original invention are improper under § 251;
- 2) There is no requirement that an express statement of criticality of an element in the original specification be present in order to determine that the element in question is essential to the invention claimed in the original patent; and
- 3) Whether persons of ordinary skill in the art could replace the disclosed plurality of magnets with some other undisclosed mechanism to achieve a similar removably securable functionality is inapposite to a determination under § 251.

The Board’s decision was affirmed.

PURE AIA PATENTS CANNOT PARTICIPATE IN INTERFERENCES

By *Chang Yang*

SNIPR Technologies Ltd. v. Rockefeller University., Appeal No. 2022-1260
(Fed. Cir. July 14, 2023, Chen, Wallach, and Hughes)

- Pure pre-AIA and mixed patents and applications are subject to an interference, but pure AIA patents and applications are not.
- 純粋な前AIA（旧法下）および（新法・旧法）混合下の特許および出願は抵触審査の対象であるが、純粋なAIA（新法下）特許および出願はそうではない。
- 純AIA前專利和混合專利和專利申請會受到抵触審查的約束，但純AIA專利和專利申請不會。

- 완전한 pre-AIA (구법)와 혼합 (신법/구법) 특허 및 출원은 충돌 심사 대상이지만, 완전한 AIA (신법) 특허 및 출원은 충돌 심사 대상이 아니다.

Background:

SNIPR owns five patents directed to methods of selectively killing bacteria: U.S. Patent Nos. 10,463,049; 10,506,812; 10,561,148; 10,524,477; 10,582,712 (SNIPR Patents). The SNIPR Patents claim priority to PCT Application No. CT/EP2016/059803, filed May 3, 2016, which is after the AIA implementation date of March 16, 2013, so the SNIPR patents are pure AIA patents according to the AIA's implementation requirements.¹ Rockefeller's application 15/159,929 (Rockefeller Application) is also directed to selectively killing bacteria, and claims priority to PCT Application No. PCT/US2014/015252, filed on February 7, 2014, and U.S. Provisional Application 61/761,971 (Rockefeller Provisional), filed February 7, 2013, which is before the AIA implementation date, making the Rockefeller application at least a mixed case.

The Patent Trial and Appeal Board denied two SNIPR's motions to terminate the interference because the Rockefeller application is subject to an interference by claiming benefit of a priority date that is before the implementation date of the AIA. The Board granted priority to Rockefeller application because SNIPR did not file a priority statement that antedated the Rockefeller's earliest priority date. SNIPR appealed.

Holding:

Reversed. SNIPR's pure AIA patents were examined and issued under the AIA's first-inventor-to-file patentability requirements; they cannot then be cancelled under the different, pre-AIA invention priority requirements regardless of the status of an arguably interfering patent or application. As such, despite the earlier case being "subject to interference" from the later case, a pure-AIA case cannot be involved in an interference, and the Director erred by declaring an interference involving the SNIPR Patents.

Discussion:

The Federal Circuit extensively discussed the purpose of the transition from the first-to-invent system to the first-inventor-to-file system. The court explained that using a patent's filing date to determine priority is objective and simple, whereas determining an invention date, for example in trying an interference, is often uncertain and typically requires corroborating evidence as part of an adjudication. The Federal Circuit further discussed AIA § 3(n) and the language of pre-AIA 35 U.S.C. § 135, and held that the plain language of AIA § 3(n) clearly states that only pure pre-AIA patents and mixed patents can be involved in an interference and pure AIA patents and applications cannot. The Federal Circuit held that the language "any unexpired patent" from pre-AIA § 135 does not apply to pure AIA patents, because such a reading would be inconsistent with AIA § 3(n), which forbids involving pure AIA patents and applications in interference proceedings. Interpreting "any unexpired patent" in pre-AIA § 135 to include pure AIA patents would defeat a central purpose of the AIA. The Federal Circuit noted that the AIA entirely replaced interference proceedings with derivation proceedings, and deleted all other references to interferences, indicating an intent that no patent or application claiming priority after the implementation date of the AIA be involved in an interference. Furthermore, the Federal Circuit stated that the specific provisions of AIA § 3(n) control over the general "any unexpired patent" language in pre-AIA § 135.

¹ The Leahy-Smith America Invents Act, 125 Stat. 284, was enacted September 16, 2011. Portions of the AIA relating to treatment of patents and applications with respect to prior art and invention became effective on March 16, 2013. Section 3(n) of the AIA specifies that the provisions of the AIA apply fully to patents and applications claiming priority to a date after the implementation date.

CLARIFICATION OF SIXTH DUPONT FACTOR IN TRADEMARK PROSECUTION

By *Subaru R. Kanesaka*

Spireon, Inc. v. Flex Ltd., Appeal No. 2022-1578
(Fed. Cir., June 26, 2023, Dyk, Mayer, and Reyna)

- Under the sixth DuPont factor “the number and nature of similar marks in use on similar goods,” an applicant has a burden of producing evidence of relevant third-party registrations, and an opposer has a burden of establishing non-use of those relevant third-party registrations.
- DuPont 第 6 ファクタ 「類似のモノの使用における類似のマークの数および性質」について、関連する第三者の登録の証拠を提示する挙証責任は出願人が有し、相手側はそれら関連する第三者登録の不使用を立証する挙証責任を有する。
- 根据 DuPont 因素第六项“在类似商品上使用的类似商标的数量和性质”，申请人有责任提供相关第三方注册的证据，而异议人有责任确定未使用这些相关第三方注册。
- DuPont 제 6 요소 "유사상품의 사용에 있어서 유사상표의 수와 성질"에 대해 출원인은 관련 제 3 자 등록의 증거를 제시할 입증책임이 있고, 상대방은 관련 제 3 자 등록을 사용하지 않았다는 증거를 제시할 입증책임이 있다.

Background:

Spireon, Inc. (hereinafter “Spireon”) filed a trademark application with the United States Patent and Trademark Office (USPTO) seeking to register the mark FL FLEX for “electronic devices for tracking the locations of mobile assets in the nature of trailers, cargo containers, and transportation equipment using global positioning systems and cellular communication networks.” The Examining Attorney from the USPTO approved the trademark application for publication. Thereafter, the trademark application was published for opposition. Flex Ltd. (hereinafter “Flex”) opposed registration on the grounds of priority and likelihood of confusion with Flex’s previously registered marks FLEX, FLEX (stylized), and FLEX PULSE. The Board addressed the strength of Flex’s marks, including the marks’ conceptual and commercial strength, and found that there was a likelihood of confusion between Spireon’s and Flex’s marks, and accordingly sustained Flex’s opposition. Spireon appealed.

Holding:

The Federal Circuit concluded that the Board erred in its analysis of conceptual strength by discounting composite third-party registrations, even though Spireon’s mark is itself a composite mark, and the Board also erred in its analysis of commercial strength in declining to consider composite marks as to which there was evidence of use.

Discussion:

In re E.I. DuPont DeNemours & Co. (476 F.2d 1357, C.C.P.A. 1973) sets forth relevant factors to consider when determining likelihood of confusion between two marks. The sixth DuPont factor “[t]he number and nature of similar marks in use on similar goods,” is a measure of the extent to which other marks weaken the assessed mark. There are two prongs of analysis for a mark’s strength under the sixth factor: conceptual strength and commercial strength.

On review, the Federal Circuit held that the Board erred in its analysis of conceptual strength. The existence of third-party registrations on similar goods can bear on a mark’s conceptual strength.

Specifically, third-party registrations containing an element that is common to both the opposer’s and the applicant’s marks can show that that element has “a normally understood and well-recognized descriptive or suggestive meaning.” The Board here erred by discounting composite third-party registrations, even though Spireon’s mark is itself a composite mark.

The Federal Circuit also held that where the applicant has introduced evidence of third-party registrations, the burden of proof should rest on the opposer to establish non-use rather than the applicant to establish use of third-party registrations for commercial strength analysis, and Flex as opposer failed to show that the identical marks for identical goods were not used in the marketplace. The court stated that, on remand, Flex should be given the opportunity to make such a showing.

CONVENTIONAL COMPONENTS YIELDING AN IMPROVED RESULT NOT PATENT ELIGIBLE

By Jay Beale

[*Trinity Info Media, LLC v. Covalent, Inc.*](#), Appeal No. 2022-1308

(Fed. Cir. July 14, 2023, Stoll, Bryson, and [Cunningham](#), precedential)

- Patent claims that recite use of conventional components, such as computers, servers, network, and mobile devices, in conventional ways to achieve an improved result do not recite improvement in computer technology itself for purposes of patent eligibility analysis.
- コンピュータ、サーバ、ネットワークやモバイル装置などの従来部品を、改良された結果を達成する従来の手法の下での使用を記した特許クレームは、特許適格性の解析の目的において、コンピュータ技術自体の改良を記してはいない。
- 專利權利要求提及了使用传统组件(如计算机、服务器、网络和移动设备)以传统方式实现改进的结果, 在进行专利资格分析的情况下, (该专利要求应被判定为) 并未提及对于计算机技术本身的改进。
- 컴퓨터, 서버, 네트워크 및 모바일 장치와 같은 기존 구성 요소를 기존 방식으로 사용하여 개선된 결과를 달성하는 특허 청구항은 특허 적격성 분석의 목적상 컴퓨터 기술 자체의 개선을 기재하는 것은 아니다.
- Patent claims can be directed to an abstract idea even though the claims require generic computer components or require operations that a human could not perform as quickly as a computer.
- 特許クレームは、たとえそのクレームが、人間がコンピュータほどには素早く実行することができない汎用コンピュータの部品や動作を要件としていたとしても、抽象的概念を対象していたとされ得る。
- 專利權利要求可以指向一个抽象的概念, 即使这些权利要求需要(用到)通用的计算机组件或需要人类无法做到的像计算机那样快速执行的操作。

- 특허 청구항이 인간이 컴퓨터만큼 빠르게 실행할 수 없는 범용 컴퓨터의 부품이나 동작을 요구하고 있더라도 추상적인 개념을 대상으로 한 특허 청구항이라고 할 수 있다.

Background:

In the District Court, Trinity sued Covalent for infringement of patent nos. 9,087,321 and 10,936,685, entitled “Poll-Based Networking System.” Covalent moved for dismissal, arguing that the asserted claims were invalid under 35 U.S.C. § 101. The District Court agreed, finding that the asserted claims were directed to an abstract idea and did not contain an inventive concept.

On appeal to the Court of Appeals for the Federal Circuit (“Federal Circuit”), the District Court's judgment was affirmed.

Holding:

The Federal Circuit agreed with the District Court’s decision, holding that Trinity's asserted claims were directed to an abstract idea and that the asserted claims did not transform the abstract idea into patent-eligible subject matter.

Discussion:

The Federal Circuit focused heavily on the first step of determining whether the claims were directed to an abstract idea. The Court found that the claims were primarily directed to the mental steps of analyzing and collecting information, as implemented using a general-purpose computer/computing network. The Court's analysis of the claims cited portions of the specification indicating that the focus of the invention was on analyzing and collecting information, and *not* on improving the operation of the computing system that implemented the analysis and collection.

In the second step of the analysis, the Court focused on whether other elements of the claims (i.e., elements *not* directed to the abstract idea) and/or the overall arrangement of the claims transformed the claims into patent-eligible subject matter, such that the claims amounted to *significantly more* than claims to the ineligible concept of analyzing and collecting information. The Court found nothing to suggest that the computing elements recited in the claims were anything more than a general-purpose implementation of the abstract idea.

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