Latest Intellectual Property News

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

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CONTROVERSY IN A WORD

By Reina Kakimoto

***Apple, Inc. v. Corephotonics, Ltd.*,** Appeal No. 2022-1350
(Fed. Cir. September 11, 2023, Stoll, Linn, and Stark, precedential)

- In a patent, unless clearly contraindicated by the specification, the word "a" in a claim is construed to mean "one or more," not "only one."
- 特許においてその明細書で明確に禁忌されていなければ、クレームにおける語"a"は"one or more（一以上）"、と解釈され、"only one （１つのみ）"と解釈されるものではない。
- 在专利中，除非说明书明确指出，权利要求中的单词"一个(a)" 应解释为"一个或多个"，而不是"只有一个"。
- 특허는 명세서에서 명확하게 사용을 금지하지 않는 한, 클레임에서의 "a"라는 단어는 "하나 또는 그 이상"을 의미하며, "오직 하나"를 의미하지 않는다.

Apple, Inc. ("Apple") petitioned for Inter Partes Review ("IPR") challenging the validity of various claims of U.S. Patent No. 10,225,479 ("the '479 patent"), owned by Corephotonics, Ltd.("Corephotonics"). The '479 patent relates to smartphone dual-aperture camera systems that can create aesthetically pleasing "portrait photos." Specifically, the patent discloses combining images from a wide-angle "Wide" lens and a telephoto "Tele" lens to produce a fused image showing a sharp subject in front of a blurred background. The parties disputed the proper construction of "fused image with a point of view (POV) of the Wide camera," recited in claim 1 of the '479 patent. The controversy centered on whether the use of "a" instead of "the" before "point of view" requires that the fused image maintain both the perspective and position of the Wide image, or whether maintaining only one of the perspective or the position of the Wide image. Apple argued that the required point of view maintains *either* the Wide image's perspective *or* position in the fused image. Corephotonics argued that the required point of view includes *both* Wide perspective *and* position, interpreting the claim language narrowly in an attempt to avoid the prior art. The narrower

construction urged by Corephotonics distinguishes certain prior art cited by Apple to demonstrate obviousness. The Patent Trial and Appeals Board ("PTAB") rejected Apple's argument and ruled in favor of Corephotonics, asserting that the specification "equates a camera's POV with how am object will appear in that camera's image plane," which, according to the PTAB, would include both position and perspective points of view.

On appeal, the Court of Appeals for the Federal Circuit ("CAFC") examined the disputed claim language and the specification of the '479 patent. The CAFC found that the specification discloses and distinguishes "different types of point of view," namely, "perspective POV" and "position POV." Noting that the specification goes to some pains to distinguish these types of POV, and discloses some embodiments where the fused image has a combination of Wide and Tele perspectives, the court explained that adopting a construction of "a point of view of the Wide camera" to require both the position POV and perspective POV of the Wide camera would exclude some embodiments disclosed in the specification. Accordingly, the court determined that "a" requires only one type of POV, not both. Based on this reading, the CAFC held that the claim term requires the fused image to retain either perspective POV or position POV but does not require a fused image to have both perspectives. The CAFC thus concluded that the PTAB had erroneously construed a disputed claim term by failing to appreciate the significance of "a" versus "the" in the claims and by failing to properly consider the claim language in light of the specification.

This decision underscores the importance of carefully choosing between indefinite article "a" and definite article "the" in patent claims. While "a" may confer a broader scope to a patent, it may also support a broader construction during litigation and review. Practitioners must exercise caution when drafting claims to balance the potential benefits and risks of broad and narrow claim constructions. This decision also highlights the benefit of including multiple claims having different scope and construction in a patent.

MORE TROUBLE FOR ANTIBODY CLAIMS

By Jay Beale

***Baxalta Inc. v. Genentech, Inc.*,** Appeal No. 2022-1461
(Fed. Cir., Sept. 20, 2023, Moore, Clevenger, and Chen, precedential)

- In claiming a genus based on the disclosure of a set of examples far smaller than the genus, the specification should provide the public with more information as to how to produce more members of the claimed genus than the inventors had when they started.
- ある属(genus)を、その属よりはるかに小さい一連の具体例の記載に依拠してクレームする際、その明細書は公衆に対して、クレームされた属が発明者が（発明を）始めた時よりも多くの要素をどのようにして生成するかについてのより多くの情報を提供しなければならない。
- 在基于公开的一组远小于该属的示例来要求保护一个属时，说明书应该向公众提供更多关于如何产生比发明人开始时更多的所要求保护的属成员的信息。
- 상위발명 (genus)보다 훨씬 작은 실시예들의 공개로 상위발명을 청구할 때, 명세서는 발명자가 시작했을 때 가진 것보다 더 많은 하위발명들을 어떻게 만들어 내는지에 대해 더 많은 정보를 대중에게 제공해야 한다.
- Hybridoma screening is a trial-and-error process that alone cannot enable a broad antibody claim.

- ハイブリドーマ・スクリーニングは試行錯誤の過程であってそれ自体が広範な抗体を実施可能とすることができない。
- 杂交瘤筛查是一个反复试验的过程，仅凭这一点无法实现广泛的抗体权利要求。
- Hybridoma 스크리닝은 시행착오의 과정이며, 그것만으로는 광범위한 항체 클레임을 가능케 할 수 없다.
- Where an antibody patent having broad functional claims relies solely on hybridoma screening processes for enablement, a showing that such processes produce a large number of results that must be extensively screened may be enough to show that the specification of the patent lacks enablement.
- 広い範囲の機能クレームを有する抗体特許における実施可能要件がハイブリドーマ・スクリーニング方法にのみ依拠している場合において、その方法が大規模なスクリーニングを要する大量の結果を生じさせることを示す証拠が、その特許の明細書が実施可能要件を欠如していることを示すに十分となり得る。
- 如果具有广泛的功能性权利要求的抗体专利仅依赖于实现的杂交瘤筛选过程，则表明此类过程产生大量必须进行广泛筛选的结果（这一现象）可能足以表明该专利说明书缺乏可行性。
- 넓은 기능적 클레임을 갖는 항체 특허가 오직 Hybridoma 스크리닝 과정에만 의존하는 경우, 이러한 프로세스가 수많은 결과물을 생성하고 그 결과물을 철저히 스크리닝해야 한다는 것을 보여줌으로써 특허 명세서가 enablement 가 부족하다는 것을 보여주기에 충분할 수 있다.

Background:

Baxalta Inc. and Baxalta GmbH (collectively, Baxalta) sued Genentech for infringement of U.S. Patent No. 7,033,590, entitled "Factor IX/factor IXa Activating Antibodies and Antibody Derivatives." The District Court granted Genentech's motion for summary judgment of invalidity on the basis that the asserted claims were not enabled. Baxalta appealed.

Holding:

The district court did not err in finding the claims invalid because the '590 patent fails to teach skilled artisans how to make and use the full scope of claimed antibodies without unreasonable experimentation.

Discussion:

The Federal Circuit held that "[t]he facts of this case are . . . indistinguishable from [the facts] in *Amgen*" (citing *Amgen Inc. v. Sanofi*, 598 U.S. 594 (2023)). The Federal Circuit evaluated enablement of the '590 patent claims according to two approaches: "[t]o make and use the undisclosed claimed antibodies, skilled artisans could either follow the 'roadmap' disclosed in the patent or employ a technique known as 'conservative substitution'." The "roadmap" was to follow the procedure set forth in the '590 patent to generate a range of antibodies and test them. The "conservative substitution" was to start with an antibody disclosed in the '590 patent and make scientifically conservative modifications thereto, and test the result to see if it performed as the disclosed antibody.

In *Amgen*, the Supreme Court stated, "[I]t may suffice to give an example (or a few examples) if the specification also discloses 'some general quality…running through' the class that gives it 'a peculiar fitness for the particular purpose.'" *Amgen*, quoting *Consol. Elec. Light Co. v. McKeesport Light Co*., 159 U.S. 465, 475 (1895). The Court held, however, that the hybridoma screening process Amgen relied upon for enablement was nothing more than a trial-and-error process, requiring extensive experimentation to make embodiments that match the claims.

The Federal Circuit held that the specification of the '590 patent similarly failed to enable the claims under either the "roadmap" approach or the "conservative substitution" approach, finding that both approaches required unreasonable experimentation. The disclosure of the '590 patent left "the public no better equipped to make and use the claimed antibodies than the inventors were when they set out…."

The Federal Circuit further explained that the result in this case, and in *Amgen*, does not conflict with the result in *Wands* (*in re Wands*, 858 F.2d 731 (Fed. Cir. 1988)), chiefly because, in *Wands*, "no evidence was presented by either party on how many hybridomas would be viewed by those in the art as requiring undue experimentation to screen." *See Amgen, Inc. v. Sanofi Aventisub LLC*, 987 F.3d 1080, 1086 (Fed. Cir. 2021) (quoting *Wands*, 858 F.2d at 736). Thus, *Wands* remains a case of reference in the context of enablement of antibody patent claims.

IMPLIED EXPECTATION OF SUCCESS

By Subaru Kanesaka

Elekta Ltd. v. ZAP Surgical Sys., Inc., Appeal No. 2021-1985
(Fed Cir., September 21, 2023, Reyna, Stoll, and Stark)

- Reasonable expectation of success can be implied in obviousness conclusions, especially if questions of operability and intended purpose are considered.
- 成功の合理的期待は、特に動作可能性および意図した目的が争点である場合、自明性の決定に暗黙的に示され得る。
- 显而易见的结论可以隐含对成功的合理预期，特别是考虑到可操作性和预期目的问题时。
- 자명하다는 결론에는 성공의 합리적 기대가 개입될 수 있으며, 작동 가능성과 의도된 목적의 문제가 고려된다면 특히 그렇다.

Elekta Limited (hereinafter "Elekta") is the owner of US 7,295,648 (hereinafter the "'648 patent") directed to radiation treatment systems. ZAP Surgical Systems, Inc. ("ZAP") filed a petition for inter partes review ("IPR") before the Patent Trial and Appeals Board ("Board") challenging the claims of the '648 patent. The Board issued its Final Written Decision, concluding that all the challenged claims were unpatentable as obvious. Elekta appealed from a final written decision of the Board and challenged the Board's findings related to motivation to combine and reasonable expectation of success.

Elekta argued that no substantial evidence supported the Board's conclusion that a person of ordinary skill would have been motivated to combine teaching of a positionable X-ray system in one reference with teaching of a rotatable linac system for CT scanning in another reference chiefly because the X-ray system would not be operable with the weight of the heavy linac system attached, and because the linac system is an imaging system whereas the X-ray system is for delivering radiation treatment. The Federal Circuit disagreed, holding that the Board's conclusion was supported by disclosures in the

references and by testimony of ZAP's expert that a person of ordinary skill in the art would have been motivated to make the proposed combination. On review, the court noted that the Board based its conclusion, in part, on review of the prosecution history of the '648 patent. The Board observed that references directed to imaging were cited during prosecution, and Elekta never distinguished those references as non-relevant art.

Elekta also argued that the Board failed to make any findings regarding reasonable expectation of success in making the proposed combination. Noting that "an obviousness determination requires finding that a person of ordinary skill in the art would have had a reasonable expectation of success," the Federal Circuit explained that, unlike a motivation to combine determination, which requires an explicit analysis like above, a finding of reasonable expectation of success can be implicit. Specifically, the evidence that establishes a motivation to combine can also support a finding of reasonable expectation of success. The court noted that Elekta's argument, before the Board, that the proposed combination would be inoperable, would not "provide a viable solution for focusing a therapeutic radiation source on the target," and would not work for its intended purpose implied that a person of ordinary skill would have no reasonable expectation of success in making the proposed combination. In addressing such arguments, the court explained, the Board made at least implicit findings regarding reasonable expectation of success. The Federal Court concluded that, in rejecting Elekta's arguments, the Board considered and made implicit findings regarding reasonable expectation of success.

Accordingly, the Federal Circuit found the Board's conclusions supported by substantial evidence and affirmed.

POSSIBLE LACHES TROUBLE FOR CONTINUATION PRACTICE

By Michael McComas

***Sonos, Inc. v. Google LLC*, Appeal No. 3:20-cv-06754-WHA**
(U. S. District Court for the Northern District of California, October 6, 2023, Alsup)

- Patents arising from continuation applications based on applications originally filed after 1995 could be rendered unenforceable under the doctrine of prosecution latches if the totality of circumstances indicates an unreasonable and inexcusable delay in prosecution, and an accused infringer suffered prejudice attributable to the delay.
- 1995年より後に最初に提出された出願に基づく継続出願からの特許は、もし全体的な状況証拠から見て非合理的であり、出願審査が弁解の余地なく遅延し、かつ侵害被疑者がその遅延に起因する不利益を被っている場合、審査懈怠の法理に基づき権利行使不能とされ得る。
- 如果总体情况表明起诉存在不合理且不可原谅的延误，并且被指控的侵权人因延误而遭受损害，则基于 1995 年之后最初提交的申请的连续申请所产生的专利可能根据起诉锁定原则而被认定为不可执行。
- 1995년 이후에 출원된 특허를 모출원으로 하는 계속 출원 (continuation application) 으로부터 발생한 특허는, 전체적인 상황으로 보았을 때, 심사과정에서 불합리하고 변명할 수 없는 지연이 있었으며 지연으로 인한 피고의 손해가 있는 경우, prosecution latches 원칙에 따라 무효화될 수 있다.

Background

In 2005, Sonos began selling wireless audio systems in which individual zone players could be organized into zone groups using "ad hoc grouping." Automatic linking of zone players was limited to a "party mode" in which all zone players in the system could be simultaneously selected. Sonos subsequently filed a provisional patent application directed to zone scenes in which selections of multiple zone players could be stored and invoked through a user interface (UI).

From 2007 through 2019, Sonos filed a series of non-provisional applications, each claiming priority to the provisional application, which included modified versions of internal UI documents. Multiple patents issued, each including claim scopes narrowed significantly to overcome applied references.

Google and Sonos discussed potential collaboration in 2013 and 2014, after which Google notified Sonos of its intent to sell its own products including saved groups in which an individual player could be included in multiple groups.

Sonos initiated infringement actions against Google in 2020, eventually relying on two patents filed in 2019 and directed to overlapping groups. Following an award of $32 million to Sonos in a jury trial, both sides filed motions for judgement as a matter of law.

Holding

The U. S. District Court for the Northern District of California ("Court") agreed with Google that prosecution latches rendered the two patents unenforceable and vacated the award.

Discussion

In its opinion, the Court reviewed cases decided by the Court of Appeals for the Federal Circuit ("Federal Circuit") and noted that although no decisions explicitly held prosecution latches to be applicable to post-1995 patent applications, the Federal Circuit had described prosecution latches as a "flexible doctrine."

The court went on to cite the Supreme Court in *Miller v. Bridgeport Brass Co*., 104 U.S. 350, 355 (1881), which stated that "[i]t will not do for the patentee to wait until other inventors have produced new forms of improvement, and then, with the new light thus acquired, under pretence of inadvertence and mistake, apply for such an enlargement of his claim as to make it embrace these new forms." In this case, the Court considered the thirteen year delay between the filings of the provisional application and the claims filed in continuation applications directed to overlapping groups to be "exactly what the Supreme Court has long said should not be done."

The court also held that the claimed overlapping groups were new matter based on the UI document modifications and amendments to the patents at issue during prosecution, but asserted that "[e]ven if the provisional application… had actually disclosed the invention, that would be all the more reason to hold Sonos waited too long to claim it, to the prejudice of Google, not to mention other companies and consumers."

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