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## MORE THAN ADDING A COMPUTER NEEDED FOR PATENT ELIGIBILITY

By [David Cain](#)

[Ficep Corp. v. Peddinghaus Corp.](#), Appeal No. 2022-1590

(Fed. Cir., August 21, 2023, Prost, Wallach, and [Chen](#))

- Claims must do more than transfer information from a computer to a machine to be eligible under 35 U.S.C. 101.
- クレームは、情報を、コンピュータから米国特許法 101 条下で特許適格性を有する機械へと転移する以上のことをしなければならない。
- 미국 특허법 101조와 관련하여 특허를 받을 수 있으려면 청구항은 정보를 컴퓨터에서 기계로 정보를 전환하는 것 이상의 역할을 해야 한다.
- 权力要求必须不仅仅是将信息从计算机传输到机器，才能符合35 U.S.C. 101的规定。

### Background:

Ficep sued Peddinghaus in the District of Delaware, alleging infringement of one or more claims of US patent 7,974,719 (the '719 patent). Peddinghaus moved for summary judgment on the basis that the '719 patent's claims are patent ineligible under 35 U.S.C. § 101. The district court granted Peddinghaus's motion. The district court concluded that the claims of the '719 patent are directed to an abstract idea without an inventive concept.

The '719 patent is directed to the automatic transfer of design data contained in a computer-aided design (CAD) model to a machine that can manufacture an object based on that design data. The computer stores a CAD model and communicates the design model to the programmable logic controller. The programmable logic controller then identifies and extracts information from the design model for

transmission to the manufacturing machine. The design model includes information such as “design specifications related to the structure or device” and “intersection and/or manufacturing parameters.”

#### Holding:

The Federal Circuit affirmed the conclusion of the district court that the claims are not eligible for patenting under 35 U.S.C. 101 because they are directed to “identifying, extracting, and transferring data from a design file for the purpose of manufacturing an object.”

#### Discussion:

To determine eligibility under 35 U.S.C. 101, the reviewing court applied the familiar Alice/Mayo two-step analysis framework. In step 1, the reviewing court evaluated “the focus of the claimed advance over the prior art to determine if the claim’s character as a whole is directed to excluded subject matter.” The reviewing court found that the focus of the claimed advance, as the patent specification indicates, is automating a previously manual process of transferring information from a CAD design model to a manufacturing machine. “Automating a previously manual process is not sufficient for patent eligibility. The ’719 patent is thus a “quintessential ‘do it on a computer’ patent.”

At step 2, the reviewing court determined that there is no inventive concept that transforms the claimed abstract idea into a patent-eligible invention. Beyond the abstract idea, representative claim 7 generically recites a programmable logic controller, a receiver, a database unit, a processor, a transmitter, and a manufacturing machine. The reviewing court explained that an inventive concept cannot simply be an instruction to implement or apply the abstract idea on a computer.

## RELATED GOODS AND MARK SIMILARITY IN TRADEMARK INFRINGEMENT

By [Josh Hauptman](#)

[Naterra Int’l Inc. v. Samah Bensalem](#), Appeal No. 2022-1872

(Fed. Cir., February 15, 2024, Moore, [Stoll](#), and Cunningham, precedential)

- Mark similarity, especially in identical lead words, weighs heavily in analyzing likelihood of confusion.
- 商標には、特に同一のリード語の中において、出所の混同の可能性を解析する際に重要な重きが置かれる。
- 상표의 유사성, 특히 동일한 선행어는 혼동 가능성을 분석할 때 중요한 가중치가 부여된다.
- 标记相似性, 尤其是相同的引导词, 在分析混淆可能性时起着重要作用。
- Evidence showing sales, under the same mark, of different goods, similar to goods being considered in analyzing likelihood of confusion of two marks, is pertinent to whether the goods under consideration are sufficiently related to contribute to likelihood of confusion.
- 同じ商標下で異なる商品の販売を示す証拠は、2つの商標の出所の混同の可能性を解析する際に考慮される商品と同様、考慮対象の商品が2つの商標の間で出所の混同の可能性に十分貢献しているかどうか、と関連している。
- 두 개의 상표사이의 혼동 가능성을 분석할 때 고려되는 상품과 유사한 다른 상품의 판매를 보여주는 증거는, 고려 중인 상품이 두 상표 간의 혼동을 일으키는 것에 충분히 관여하고 있는지 여부에 관련이 있습니다.

- 与分析两个商标混淆可能性所考虑的商品相似，在同一商标下销售不同商品的证据，与所考虑的商品是否足够相关以导致两个商标之间混淆的可能性相关。

Bensalem owns the registration for the standard character mark “BABIES’ MAGIC TEA” for medicated tea for babies that treats colic and gas. Naterra owns 4 registrations for the standard character mark “BABY MAGIC” covering toiletry goods. In June 2020, Naterra filed a Petition for Cancellation alleging that Bensalem’s “BABIES’ MAGIC TEA” mark in connection with its goods would likely “cause confusion, mistake, or deception”, thus violating the Lanham Act. The Trademark Trial and Appeal Board held that Naterra failed to show likelihood of confusion, denying the petition. The Board considered the 13 DuPont factors, finding factors 1-5, 6, 8, 10, and 12 relevant. The Board found Naterra’s presentation lacked probative evidence showing that the parties’ respective goods are sufficiently related, that Naterra’s “BABY MAGIC” mark was inherently weak, with no demonstration of commercial success (let alone fame) in similar trade channels. Accordingly, after weighing the DuPont factors, the Board found Naterra failed to show a likelihood of confusion.

On appeal, the Federal Circuit considered whether the consuming public perceives the respective goods and services of the parties as related enough to cause confusion about the source or origin of the goods and services. Naterra argued that the Board, in concluding the parties’ goods were not related, ignored pertinent evidence indicating that several companies sell baby ingestible products and baby skin care products under the same mark. In so finding, the Board had rejected Naterra’s “umbrella branding” and “natural zones of expansion” arguments seeking to demonstrate the parties’ goods are related, but ignored an admission by counsel for Bensalem that such evidence is “absolutely very relevant” to the inquiry. The court agreed that evidence of third-party companies selling both types of goods is pertinent to relatedness of goods and noted the admission. Because the record on appeal did not show whether the relevant evidence was properly evaluated by the Board, the court remanded the question under factor 2 to the Board.

Regarding factor 3, whether similarity or dissimilarity of established, likely-to-continue trade channels might lead to likelihood of confusion, Naterra argued the Board ignored an admission by counsel for Bensalem that the parties’ goods are sold in similar trade channels, so the Board’s finding that similarity and nature of the goods and trade channels disfavor likelihood of confusion is not supported by substantial evidence. The Board had addressed other evidence of trade channels but had ignored the admission by Bensalem. The court concluded the evidence ignored by the Board was relevant to the factor 3 inquiry and remanded the question to the Board.

Regarding similarity of the marks (DuPont factor 1), Naterra argued the Board should have given more weight to the similarity of the marks. The court agreed, pointing to the nearly identical lead words of the marks, and to the holding in *In re Detroit Athletic Co.*, 903 F.3d 1297 (Fed. Cir. 2018) that mark similarity weighs heavily in confusion analysis, and remanded this question to the Board.

Regarding alleged fame of the “BABY MAGIC” mark, the Board found no evidence regarding sales or advertising expenditures in connection with Naterra’s trademark; no evidence regarding critical assessments or notice taken by independent sources of the products identified by the mark; and no evidence regarding the general reputation of Naterra’s trademark. The Board also found that Naterra’s foreign registrations did not aid in the determination on fame in the U.S. The Board, thus, did not find the “BABY MAGIC” mark “commercially strong, let alone famous.” Naterra did not dispute these

findings on appeal, arguing only that the Board gave too little weight to the question of fame. The court thus affirmed this finding by the Board.

The Federal Circuit thus concluded that the Board erred in weighing the first DuPont factor and failed to address relevant evidence regarding the third DuPont factor. The court also could not discern from the record whether the Board approached the inquiry under the second DuPont factor. Accordingly, the Federal Circuit vacated the Board's decision, and remanded.

## SPECIFICATION SUPPORT FOR PATENT CLAIM CONSTRUCTION

By [David Lynch](#)

[Promptu Sys. Corp. v. Comcast Corp.](#), Appeal No. 2022-1939

(Fed. Cir., February 16, 2024, Moore, Prost, and [Taranto](#))

- Claim construction is reviewed de novo, but the Federal Circuit must accept any underlying fact findings unless those findings are clearly erroneous.
- クレーム解釈は初めから検討されるが、連邦高裁は、基礎となるいかなる事実認定を、それら認定が明らかな誤りでない限り、認容しなければならない。
- 청구항 해석은 처음부터 검토되지만, 연방고등법원은 기초가 되는 사실이 명백한 오류가 아닌 한, 그 사실을 인정해야 한다.
- 权利要求的解释的审查是重新审理的，但联邦巡回法院必须接受任何潜在的事实调查结果，除非这些调查结果明显错误。
- Particular features recited in a patent specification as aspects of embodiments, and not identifying requirements of the invention, do not necessarily narrow a claim term that is otherwise broader in its ordinary meaning.
- 特許明細書において実施例の観点として記載されている特定の特徴が、本発明の必須要素と同定していない場合、通常の意味において広く解釈され得るクレームの要件を、必然的に狭くするものではない。
- 특히 명세서에서 실시예로 기재된 특정 특징이 본 발명의 필수 요소로 식별되지 않은 경우, 통상적인 의미에서 넓게 해석될 수 있는 청구항의 요건을 필연적으로 좁게 해석할 필요는 없다.
- 在专利说明书中作为实施方式的方面引用的特定特征，而不是确定发明的要求，并不一定会缩小权利要求术语的范围，否则权利要求术语在其通常意义上更广泛。
- Modifiers of a patent claim term should not be read from the specification into the claims.
- 特許クレーム要件の変形が、明細書からそのクレームへ読み込まれるべきではない。
- 특히 청구항 용어의 한정어는 명세서를 바탕으로 그 청구항을 해석해서는 안 된다.
- 专利权利要求术语的修饰词不应从说明书中解读到权利要求中。

### Background:

Promptu filed a complaint against Comcast for infringement of three patents (7,047,196, 7,260,538, and RE44,326). After the district court issued claim construction orders, Promptu and

Comcast jointly stipulated to dismissal of the '326 patent-infringement claim. Promptu moved for entry of a final judgment of no infringement of the '196 and '538 patents. The district court granted Promptu's request and entered final judgment. Promptu then appealed.

Holding:

The Federal Circuit vacated the final judgment, and reversed in part and affirmed in part the claim constructions and remanded.

Discussion:

On appeal, the Federal Circuit found that the term “back channel” was construed too narrowly by the district court, limiting the meaning of the term to “a fixed band of frequencies or time slots.” The reviewing court found that nothing in the claim language or the specification suggested the limitation to a fixed band of frequencies or time slots. The parties also disputed the meaning of the term “channel”, but the reviewing court left that for further consideration by the district court on remand.

The Federal Circuit rejected the district court's construction of the phrase “multiplicity of received identified speech channels” because that construction was premised on its erroneous construction of “back channel” requiring that “each channel” be “assigned to a particular user site.” The reviewing court found no justification for requiring “each channel” to be “assigned to a particular user site.”

Next, the Federal Circuit held that the terms “speech recognition system,” “coupled to,” and “wireline node” were improperly constrained without support in the patent specification. The reviewing court construed the second and third terms, while leaving a proper construction of the first term for further development at the district court.

Finally, the Federal Circuit rejected the district court's construction of the phrase “centralized processing station” as requiring both a location requirement and a function requirement. The district court had held that a “centralized processing station” must be located at a cable-TV network head-end unit” (location requirement) and the “centralized processing station” itself “performs voice recognition on voice commands” (function requirement). The Federal Circuit found that reading a location requirement into the term (i.e., that it must be “at a cable-TV network head-end unit”) was improper.

## WRITTEN DESCRIPTION SUPPORT FOR RANGES

By [Subaru R. Kanosaka](#)

[Rai Strategic Holdings, Inc. v. Philip Morris Prod. S.A.](#), Appeal No. 2022-1862  
(Fed. Cir., February 9, 2024, Chen, Stoll, and Cunningham, precedential)

- The level of detail required to satisfy the written description requirement is based on the context of the technology at issue and the knowledge gained by a person of ordinary skill in the art reading the specification.
- 記述要件を満足するために要求される詳述度のレベルは、対象となる技術の状況およびその明細書を読んだ当業者が得る知識に基づいている。
- 명세서 기재요건을 충족하기 위해 요구되는 상세한 정도는 대상 기술의 상황과 명세서를 읽은 당업자가 얻을 수 있는 지식을 기반으로 한다.

- 满足书面描述要求所需的详细程度应基于所讨论技术的上下文以及阅读说明书的本领域普通技术人员所获得的知识。

#### Background:

RAI Strategic Holdings, Inc. (hereinafter “RAI”) owns US Patent No. 10,492,542 (‘542 patent), which is directed to electrically powered smoking articles. Philip Morris Products, S.A. (hereinafter “Philip Morris”) filed a petition to institute a post-grant review (PGR) of claims 1–30 of the ‘542 patent. The Board found that (1) claims 10 and 27, reciting a length ratio of “about 75% to about 85%,” are unpatentable for lack of adequate written description because no disclosed range contains an upper limit of about 85% making it “‘less clear’ that the inventors contemplated a range of ‘about 75% to about 85%’ as part of the invention;” and (2) claims 1–9, 11, 12, 18–26, and 28–30 are unpatentable as obvious. RAI appealed.

#### Holding:

The Federal Circuit concluded that the substantial evidence (1) does not support the Board’s finding that certain claims lack written description support, but (2) supports the Board’s obviousness finding.

#### Discussion:

The Federal Circuit held that while the ‘542 patent specification does not disclose the claimed range itself, both endpoints are expressly disclosed. The court looked to the context of the technology at issue and the knowledge gained by a person of ordinary skill in the art reading the specification. The court assessed that, given the predictability of electro-mechanical inventions and the lack of complexity of the particular claim limitation at issue—i.e., reciting the length of a heating member—“a lower level of detail is required to satisfy the written description requirement than for unpredictable arts.” Further, nothing in the specification indicates that changing the length of the heating member changes the invention.

The Federal Circuit also considered obviousness over teachings of prior art references Robinson and Greim. The court observed that Robinson teaches “the size and shape of [its] heating element 72 can be altered” and the “[s]election of the power source and resistance heating elements can be a matter of design choice, and will be readily apparent to one skilled in the art.” The court also noted that Greim teaches its heater configuration with “the necessary electronics, wiring and connections . . . incorporated on the same electrically insulating substrate as the heater” has many potential advantages over other heaters, including being “manufactured more straightforwardly and cost effectively.” The court concluded that a person of ordinary skill in the art would have been motivated to replace Robinson’s heating element with the heating element taught by Greim making the challenged claims obvious.

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