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Table of Contents

Software Patent Eligibility At Summary Judgment	1
Sufficiency of Evidence to Prove Deceptive Intent	3
When Claim Limitations Pose Contradictions	5
Expectation of Success in Obviousness Analysis	6
Additional Information	8

SOFTWARE PATENT ELIGIBILITY AT SUMMARY JUDGMENT

By **Bobbie Wu**

[Chewy, Inc., v. International Business Machines Corp.](#), Appeal No. 2022-1756

(Fed. Cir., March 5, 2024, Moore, Stoll, Cunningham, precedential)

- A patentee may establish a genuine factual dispute by relying on documentary evidence such as user manuals, strategy documents or deposition testimony to support its infringement case at summary judgement stage, without necessarily identifying the precise location of the allegedly infringing code.
- 专利权人可以在简易判决阶段依靠用户手册、策略文件或证词等书面证据来支持其侵权案件，从而建立真实的事实争议，而不必识别涉嫌侵权代码的确切位置。
- 특허권자는 약식 재판 과정에서 침해 주장을 뒷받침하기 위해, 정확한 침해코드를 특정하지 않더라도 사용자 매뉴얼, 전략 문서 또는 증언록과 같은 증거서류에 의지하여 침해 사실에 관한 쟁점을 입증할 수 있습니다.
- 特許権利者は、必ずしも主張された侵害コードの正確な位置を特定していなくとも、簡易判決段階で侵害申し立てを裏付けるために使用説明書、戦略書類や証言録取などの証拠書類に依拠して真の事実争点を証明することができる。
- Software patent claims that do not specify how the recited concept is accomplished may be invalid under 35 U.S.C. § 101.

- 根据 35 U.S.C. § 101 · 未指定如何实现所述概念的软件专利权利要求可能无效 ·
- 실행 방법을 명시하지 않은 소프트웨어 특허 청구항은 35 U.S.C. § 101 조에 따라 무효일 수 있습니다.
- 記載された概念をどのように実現させるかについて特定していないソフトウェア特許クレームは、特許法第 101 条の下で無効となり得る。

Background:

IBM owns the 7,072,849 ('849) and 7,076,443 ('443) patents at issue, which generally relate to improvements in web-based advertising. The '849 patent discloses improved methods for presenting advertisements to a user of an interactive service. The '443 patent discloses improved systems and methods for targeting advertisements.

Chewy sued IBM seeking a declaratory judgment of noninfringement of the two IBM patents. In response, IBM filed counterclaims alleging Chewy's website and mobile applications infringing the patents. The district court granted summary judgment of noninfringement of claims 1, 2, 12, 14, and 18 of the '849 patent, and that claims 13, 15, 16, and 17 of the '443 patent are ineligible for patenting under 35 U.S.C. § 101.

Holding:

The Court of Appeals for the Federal Circuit affirmed the summary judgment of noninfringement of claims 1, 2, 14, and 18 of the '849 patent, and that claims 13, 15, 16, and 17 of the '443 patent are unpatentable, and reversed summary judgment of noninfringement regarding claim 12 of the '849 patent.

Discussion:

(A) '849 Patent: Claims 1, 2, 14, and 18

The Federal Circuit affirmed construction of the phrase “selectively storing advertising objects at a store established at the reception system” recited in claim 1 of the '849 patent as “retrieving advertising objects and storing at a store established at the reception system in anticipation of display concurrently with the applications.” The reviewing court reasoned that the intrinsic evidence (*e.g.*, written description and the prosecution history) supports the district court's construction, consistently describing the invention as including pre-fetching of advertising objects. IBM argued that Chewy's source code “prefetches” or “preloads” advertising objects such that “near of view images are preloaded lazily before they come into view,” and that this description proves the “pre-fetching” component of the district court's construction. The Federal Circuit rejected IBM's argument, explaining that Chewy's code retrieves advertising objects in response to a user requesting a page, and not in anticipation of the user requesting a page in connection with which they are to appear. The Federal Circuit thus concluded that there is no material factual dispute as to whether Chewy's code performs “pre-fetching.”

(B) '849 Patent: Claim 12

Claim 12 depends from claim 8, which recites a step of establishing characterizations for respective users based on the compiled data. CAFC agreed with IBM that there is a genuine dispute of

material fact as to whether Chewy “establish[es] characterizations for respective users.” CAFC reasoned that because Chewy’s privacy policy supports a finding that Chewy delivers advertisements based on the individual user’s interaction history, which creates a genuine issue of material fact regarding whether Chewy “establish[es] characterizations for respective users,” and Chewy’s internal document of “Currently Launched Strategies” shows Chewy uses individualized targeting criteria, which sufficiently describes the accused functionality to create a genuine dispute of fact. CAFC noted that IBM may establish a genuine factual dispute “by relying upon its documentary evidence, without necessarily identifying the precise location of the allegedly infringing code.”

(C) ’443 Patent: Claims 13, 15, 16 and 17

The Federal Circuit observed that these claims broadly recite correlating advertisements with search results using a generic process, and found the recited process to be a type of targeted advertising considered abstract under step one of the Alice patent eligibility framework. The reviewing court reasoned that the claims are not directed to any challenges unique to computer networks, or to any specific improvements to the functionality of the computer itself. The claims merely recite the concept of identifying advertisements based on search results, without any specificity as to how this is accomplished.

At Alice test step two, the Federal Circuit concluded that none of the recited elements, individually or as an ordered combination, constitute a sufficient inventive concept to render identifying advertisements based on search results, as recited in these claims, into patent-eligible subject matter. The reviewing court reasoned that the claims recite a generic process of obtaining search results from a search query and using the search results to identify advertisements, but do not recite any specific implementation of the abstract concept.

SUFFICIENCY OF EVIDENCE TO PROVE DECEPTIVE INTENT

By [Michael McComas](#)

[Freshub, Inc., v. Amazon.com, Inc.](#), Appeal No. 2022-1391

(Fed. Cir., February 26, 2024, Reyna, [Taranto](#), Chen, precedential)

- Where, to obtain revival of a patent application, counsel for the applicant falsely states that the applicant did not intentionally abandon the application, that statement by itself is insufficient to establish specific intent to deceive the United States Patent Office, on the part of counsel or applicant, as the single most reasonable inference.
- 如果为了恢复专利申请，申请人的律师错误地声称申请人没有故意放弃申请，那么该声明本身不足以证明律师或申请人有欺骗美国专利局的具体意图，作为唯一最合理的推论。
- 특허 출원 부활을 위해 출원인 변호인이 출원인이 의도적으로 출원을 포기하지 않았다고 거짓 진술을 하는 경우, 이 진술만으로는 변호인이나 출원인이 미국 특허청을 기만하려는 특별한 의도를 입증하기에는 불충분합니다.

- ▶ 特許出願を復活させるため、出願人の弁護士が、出願人はその出願を意図的に放棄したのではないと虚偽の陳述を行った場合、その陳述がそれ自体として、弁護士あるいは出願人側において、単一の最も合理的な推論として合衆国特許庁を欺く明確な意図があったことを立証するには不十分である。

Background:

In 2005, Freshub’s parent company, Ikan Holdings, filed a patent application directed to using voice processing to automatically update shopping lists. In January 2012, the United States Patent and Trademark Office (“PTO”) sent a notice of abandonment to counsel for Ikan Holdings’ subsidiary, Ikan Technologies, after receiving no response to a Final Office Action.

In January 2017, five years after the notice of abandonment, Ikan’s counsel successfully petitioned the PTO to revive the application, signing the PTO’s pre-printed statement indicating that the “entire delay... was unintentional.” The first patent of an eventual family of voice-processing patents based on the application issued in November 2017.

Subsequently, Freshub sued Amazon in the U.S. District Court for the Western District of Texas for infringement of three of the patents. In 2021, a jury found that Amazon did not infringe, and the district court held that Amazon had failed to prove its affirmative defense asserting that Freshub committed inequitable conduct that rendered the patents unenforceable. The district court also denied Freshub’s motion for judgment as a matter of law, after which Freshub appealed and Amazon cross-appealed.

Holding:

With respect to infringement, the U.S. Court of Appeals for the Federal Circuit (“CAFC”) agreed with the district court that substantial evidence supported the jury’s non-infringement finding, holding that Amazon Echo’s Alexa shopping list feature lacked a limitation requiring an intermediate step to “identify an item corresponding to the text” and “add the identified item to the list.” The CAFC also held that Amazon had not shown clear error in the district court’s factual findings or abuse of discretion in its ultimate decision regarding Amazon’s attempt to prove inequitable conduct.

Discussion:

To support its holding with respect to inequitable conduct, CAFC referred to *Therasense, Inc. v. Becton, Dickinson and Co.*, 649 F.3d 1276, 1290 (Fed. Cir. 2011) (en banc), stating that “Amazon had not offered clear and convincing evidence that the ‘single most reasonable inference’ from the evidence... was that either Ikan or its attorney had specifically intended to deceive the PTO with the STATEMENT in the petition to revive the application in 2017.”

CAFC explained that “Amazon focuses entirely on the intent of Ikan’s counsel, which it then attributes to Ikan, rather than on any intent on Ikan’s part separate from that of its counsel.” To “disturb the district court’s rejection of the inequitable-conduct defense,” the CAFC needed to conclude that “the evidence required the district court to find that Amazon proved, clearly and convincingly, that... Ikan’s counsel, when making his 2017 statement to the PTO, in fact believed that Ikan had intentionally abandoned the ’291 application for the 2012–17 period of nonresponse to the PTO.”

After reviewing the evidence, CAFC concluded that the district court could reasonably have concluded that deceptive intent had not been proven under the governing legal standard, citing a thin record based in part on Freshub’s assertions of attorney-client privilege that were not challenged on appeal.

PTO practice now requires an additional statement if a petition is directed to a delay of more than two years (*Clarification of the Practice for Requiring Additional Information in Petitions Filed in Patent Applications and Patents Based on Unintentional Delay*, 85 FR 12222-24 (March 2, 2020)).

WHEN CLAIM LIMITATIONS POSE CONTRADICTIONS

By [Nick Fan](#)

[Maxell, Ltd. v. Amperex Tech. Ltd.](#), Appeal No. 2023-1194

(Fed. Cir., March 6, 2024, Prost, [Taranto](#), and Chen, precedential)

- Claim limitations do not grant options. They state requirements—conditions that must be met for a product or process ... to come within the claim’s protected zone of exclusivity. If there are two requirements, and it is possible to meet both, the requirements are not contradictory.
- 权利要求限制并不授予选择权。它们规定了要求——产品或工艺必须满足一定的条件...才能进入权利要求的独家保护范围。如果有两个要求，并且有可能同时满足这两个要求，则这两个要求并不矛盾。
- 청구항 용어는 옵션을 부여하지 않습니다. 청구항 용어는 제품이나 공정이 청구항의 보호 범위 내에 들어오기 위한 필수 조건을 명시합니다. 만약 두 가지 요건이 있고 두 가지 모두 충족할 수 있다면, 이 요건들은 서로 모순되지 않습니다.
- クレーム限定は選択肢を認めるものではない。その限定には、クレームの排他領域に入り込むために製品あるいは製法が満足してはならない条件...を要件としている。もし2つの要件があるなら、そしてその両方とも満足することが可能であるなら、その要件同士は矛盾しない。

Background:

Maxell, Ltd. owns U.S. Patent No. 9,077,035. Amperex Technology Limited is a manufacturer of lithium-ion batteries. Maxell asserted infringement, and Amperex challenged the validity of claims of the '035 patent. The '035 patent’s claims recite at least two lithium-containing transition metal oxides, represented by a formula that includes a variable, M^1 , representing a transition metal element. Two limitations of claim 1 recite characteristics of the transition metal element M^1 . The first limitation recites that the transition metal element is “selected from Co, Ni, and Mn.” The second limitation recites a composition range for “content of Co in the transition metal M^1 .” The district court held the language of claim 1 defining M^1 to be indefinite on grounds that the two limitations contradict each other.

Holding:

The Federal Circuit concludes that there is no contradiction and therefore no indefiniteness, and reversed and remanded the case.

Discussion:

The district court reasoned that the plain language of the claim is contradictory, because the first limitation does not require the presence of cobalt, so cobalt is “optional,” whereas the second limitation requires cobalt. The Federal Circuit agreed that a contradiction in a claim can render the claim indefinite, but disagreed with the district court in this case, finding no contradiction in the claim at issue.

The Federal Circuit emphasized that claim interpretation requires reading all the text of the claim together, in its entirety, to discern the meaning of the claim and terms within the claim. In this case, the placement and relationship of the two limitations does not create a contradiction. Claim limitations do not express options. They state requirements—conditions that must be met for a product or process (as the case may be) to come within the claim’s protected zone of exclusivity. If there are two requirements, and it is possible to meet both, there is no contradiction. If a limitation that merely narrows an earlier limitation were understood as creating an invalidating contradiction, the ordinary operation of dependent claims would be upended. Here, where the first limitation does not require cobalt, but the second limitation requires cobalt, the scope of the claim is understood as requiring cobalt, without contradiction, because the second limitation expresses the requirement.

EXPECTATION OF SUCCESS IN OBVIOUSNESS ANALYSIS

By Reina Kakimoto

[*Pfizer Inc. v. Sanofi Pasteur Inc.*](#), Appeal No. 2019-1871

(Fed. Cir., March 5, 2024, Lourie, Bryson, Stark, precedential)

- A patent claim can be obvious where a person of ordinary skill in the art would have been motivated, with a reasonable expectation of success, to bridge any gaps in the prior art to arrive at a claimed invention.
- 如果本领域的普通技术人员有动机在合理的成功预期下弥补现有技术中的任何差距以达到所要求保护的发明，则专利权利要求是显而易见的。
- 당업자가 성공에 대한 합리적인 기대를 가지고 선행 기술 간의 차이를 연결하여 청구된 발명에 도달할 동기를 가졌다면 특허 청구항은 자명할 수 있습니다.
- 当業者が、合理的な成功の期待をもって先行技術のギャップを橋渡ししてクレームされた発明に到達することを動機付けされた場合、特許クレームは自明とされ得る。
- The expectation of success in obviousness analysis need only be reasonable, not certain, and lack of working examples in the prior art does not demonstrate lack of reasonable expectation of success where the technology described is otherwise known to be effective.

- 显而易见性分析中的成功预期仅需合理，而不必确定，且现有技术中缺乏工作实例并不表明在所描述的技术被已知是有效的情况下缺乏合理的成功预期。
- 자명성 분석에서 성공에 대한 기대는 단지 합리적이면 되지 반드시 확실해야 할 필요는 없으며, 선행 기술에 실시예가 없는 것은 기술 자체의 효과가 이미 알려져 있는 경우 성공에 대한 합리적인 기대가 없음을 입증하지 못합니다.
- 自明性解析において成功の期待が、確信ではなく、合理的であることのみを要するのであって、記載された技術が効果的と知られている場合は、先行技術において動作する実例の欠如が成功の合理的な期待の欠如の立証とはならない。

Background:

Sanofi Pasteur, Inc. (Sanofi) challenged the validity of a vaccine patent owned by Pfizer Inc. (Pfizer) in several inter partes review (IPR) proceedings. Pfizer’s patent in suit, 9,492,559 (‘559 patent), is directed to immunogenic compositions that include glycoconjugates (*i.e.*, a sugar molecule attached to a carrier such as a protein) of various *Streptococcus pneumoniae* serotypes for use in pneumococcal vaccines. Claim 1 of the ‘559 patent recites “an immunogenic composition *comprising Streptococcus pneumoniae* serotype 22F glycoconjugate, wherein the glycoconjugate has a molecular weight of between 1000 kDa and 12500 kDa.”

In the IPR, Sanofi brought prior art references GSK-711 and MERCK-086. GSK-711 describes multivalent *S. pneumoniae* vaccines, where the sugar molecules are derived from at least 10 serotypes of *S. pneumoniae*. MERCK-086 also describes multivalent *S. pneumoniae* vaccines, including 22F serotypes of *S. pneumoniae*. However, neither GSK-711 nor MERCK-086 disclose any specific molecular weight of glycoconjugate. The Patent Trial and Appeals Board (“PTAB”) agreed with Sanofi, finding that a person of ordinary skill in the art would have been motivated to find an optimal molecular weight for a glycoconjugate to provide good stability and immune response, molecular weight being a “result effective variable.”

Holding:

The Court of Appeals for the Federal Circuit (“CAFC”) affirmed, holding that, according to the result-effective variable doctrine, prior art that discloses the general conditions of a claim will create a presumption of obviousness if the particular workable ranges are identifiable through routine experimentation.

Discussion:

In this case, CAFC found that the evidence supports PTAB’s conclusion that “conjugate size is a result-effective variable associated with improved stability of conjugates and good immune response, limited only by filter size, thereby rendering ‘optimization within the grasp of one of ordinary skill in the art.’” Explaining that a routine optimization analysis “generally requires consideration whether a person of ordinary skill in the art would have been motivated, with a reasonable expectation of success, to bridge any gaps in the prior art to arrive at a claimed invention,” the reviewing court adopted the PTAB’s observation that the references teach glycoconjugate examples with molecular weights in a

range that overlaps with the claimed range, and that saccharide conjugate vaccines with larger saccharides provide good immune response, along with other evidence showing an effect of size.

The CAFC rejected Pfizer's argument that the conclusion of reasonable expectation of success was not supported by substantial evidence because no prior art reference in the record discloses that any of the claimed glycoconjugates were actually made or tested in a highly unpredictable art. The reviewing court explained that a prior art reference is not limited to its specific working examples, and the expectation of success need only be reasonable, not certain. The court explained that the PTAB conclusion that expectation of success was reasonable is not erroneous because expert testimony revealed that, because the claimed serotypes had already been included in commercial multivalent vaccines as "free" (unconjugated) polysaccharides, and multivalent glycoconjugate vaccines were generally known to be effective, it would have been reasonable to expect the claimed glycoconjugates to be successfully incorporated into an immunogenic vaccine.

ADDITIONAL INFORMATION

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