



IDEAS ON INTELLECTUAL PROPERTY LAW



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Whose idea was this?

Determination of patent inventorship issue requires trial

Amended trademark registration raises suspicion

Minimal creativity required to secure copyright protection

Dictionary finishes third in patent claim construction



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Whose idea was this?

Determination of patent inventorship issue requires trial

In patent law, the line between actual contributions to an invention and “more prosaic” contributions to the process can be difficult to draw. A recent ruling from the U.S. Court of Appeals for the Federal Circuit drives this home.

BOTTLES DO BATTLE

Plastipak Packaging Inc. owns 12 patents related to lightweight plastic bottles and plastic bottle preforms with a neck portion. (Preforms become fully formed bottles during manufacturing.)

The patents are generally directed to two embodiments:

- An X-dimension limitation, referring to the distance from the support flange to the top of the neck, and
- The discontinuous tamper-evident formation (TEF) limitation, which shows the bottle has been opened.

Seven of the patents have an X-dimension limitation in the claims; the other five include a discontinuous TEF limitation in the claims.

Each patent lists Richard Darr and Edward Morgan as inventors. When Plastipak sued Premium Waters Inc. for infringement, Premium Waters contended that the patents were invalid because they didn't

name a third co-inventor, Alessandro Falzoni, who allegedly contributed to the two limitations.

The trial court agreed with Premium Waters and granted its motion for summary judgment, dismissing the case without trial. Plastipak appealed.

FEDERAL CIRCUIT PROVIDES A REFRESHER

Summary judgment is proper only if the party requesting it shows there's no genuine dispute about any material fact. A genuine factual dispute exists if the evidence is such that a reasonable jury could find in favor of the opposing party. A factual dispute is material if, based on the underlying law, it's related to what a party must provide to prevail in its claim.

Importantly, a court assessing a motion for summary judgment considers all facts and draws all reasonable inferences in the light most favorable to the nonmoving party.

Because the application for the patents at issue was filed before March 16, 2013 — the date the Leahy-Smith America Invents Act (AIA) “first to file” provision took effect — pre-AIA law applied. Under pre-AIA law, a person isn't entitled to a patent if the person didn't invent the invention himself.



OVERWHELMING EVIDENCE NOT ENOUGH FOR SUMMARY JUDGMENT

Summary judgment is proper only if the party requesting it shows there's no genuine dispute about any material fact. The U.S. Court of Appeals for the Federal Circuit in the *Plastipak* case (see main article) conceded that the trial court may have been correct in finding that the defendant, Premium Waters, presented an overwhelming amount of evidence that Alessandro Falzoni was a joint inventor in its motion for summary judgment. However, this didn't mean the plaintiff, Plastipak, presented an insufficient amount of evidence for a reasonable factfinder to find that the patent at issue omitted a joint inventor.

The Federal Circuit also recognized that the trial court may have been understandably skeptical of Plastipak based on conflicting evidence and Plastipak's failure to timely disclose some unfavorable evidence. But even that evidence didn't erase Plastipak's evidence of its alleged independent invention from the record. Ultimately, unless the parties come to an agreement, a trial will be necessary so a jury can weigh all of the competing evidence and draw its own reasonable conclusion on inventorship.

To be a joint inventor, the person must:

- Contribute in a significant manner to the conception or reduction to practice (that is, the actual development) of the invention,
- Make a contribution to the invention that isn't insignificant in quality when measured against the full invention, and
- Do more than merely explain to the real inventors well-known concepts and/or the current state of the art.

If those criteria are satisfied, and the patent doesn't name the joint inventor, that patent may be invalid.

But a party seeking to invalidate a patent using summary judgment must submit such "clear and convincing evidence of the facts underlying invalidity that no reasonable jury could find otherwise." And, when alleging invalidity based on joint inventorship, alleged joint inventors must prove their contributions with more than their own testimony.

COURT POURS OVER THE EVIDENCE

The Federal Circuit ended up reversing the trial court. It found that Premium Waters failed to present evidence from which all reasonable factfinders would have to conclude that Falzoni contributed to either limitation.

Considering the inventorship of the TEF limitations, the court found that Plastipak submitted sufficient evidence — for example, prior patents that could be read as disclosing a discontinuous TEF and Falzoni's deposition testimony — for a factfinder to reasonably conclude such a TEF was well known and the state of the art. A trial was therefore necessary to determine whether his contribution was merely the state of the art, disqualifying him from joint inventorship.

As for the X dimension, the Federal Circuit agreed that Premium Waters presented sufficient evidence on which a reasonable factfinder *might* find that Falzoni was an inventor. But, at the summary judgment stage, the evidence must compel all reasonable factfinders to that conclusion. This high standard, the court found, wasn't met.

THE CAPPER

As this case makes clear, determining inventorship is often "bound up with material fact disputes," making summary judgment often inappropriate. To avoid unnecessary complications, patent applicants should determine from the outset who's involved in the invention. □

Amended trademark registration raises suspicion

Can a trademark holder facing a cancellation proceeding avoid judgment by simply deleting goods from its registration? The Trademark Trial and Appeal Board (TTAB) recently addressed this question for the first time — and the answer shouldn't surprise you.

GOODS DELETED

On August 30, 2021, Ruifei (Shenzhen) Smart Technology Co. filed a petition to cancel a trademark registered to Shenzhen Chengyan Science and Technology Co. The mark was registered for use with a variety of electronic goods — such as earphones and headphones, wearable electronic devices, and portable media players. Ruifei alleged that the mark should be canceled based on abandonment and fraud related to nonuse.

After the cancellation proceeding was initiated, Chengyan filed a Declaration of Use for the contested registration in connection with all the identified goods. It received notice that an audit was necessary to determine whether the mark was in fact in use in commerce on or in connection with the goods.

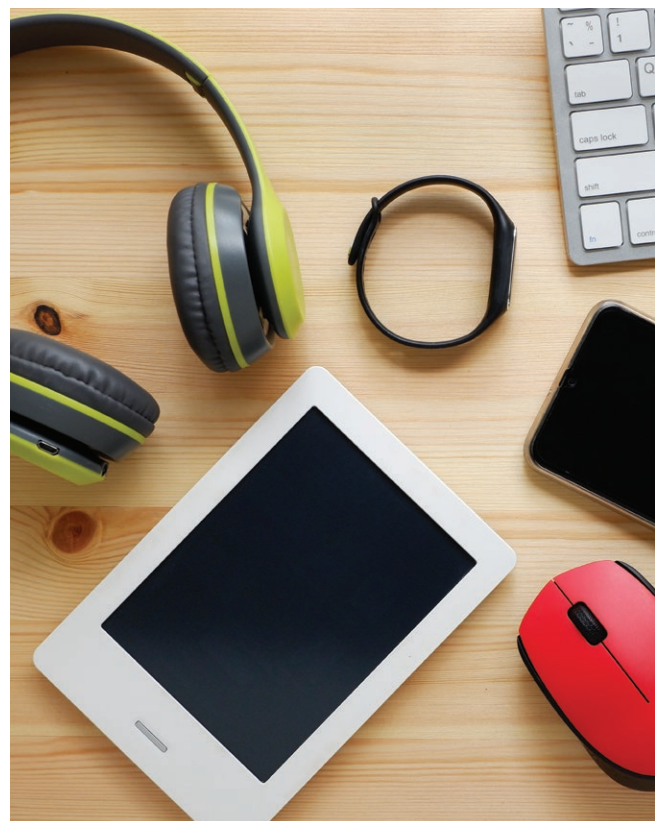
Chengyan was also required to submit verified specimens of certain goods or to delete the goods for which a specimen couldn't be provided, pay a deletion fee, and provide verified specimens for the remaining goods. In response, it deleted those goods and several others. It did submit verified specimens for additional goods, though. Chengyan eventually deleted all goods except earphones, headphones and MP3 players, submitting verified specimens for them and paying a deletion fee.

MOTIVE QUESTIONED

Ruifei sought approval to amend its cancellation petition to amplify the fraud allegations and also

filed a motion for partial summary judgment before trial on its fraud claim. In its motion, Ruifei referred to Chengyan's amendments to its registration.

The TTAB found that Chengyan's deletion of certain goods raised issues that had to be addressed before it could consider the motion for partial summary judgment. Specifically, the TTAB considered whether the deletion of goods as the result of an audit during cancellation proceedings triggered Trademark Rule 2.134. The rule is typically triggered when a respondent in a cancellation proceeding allows its registration to be cancelled during the proceeding.



Under the rule, the cancellation of goods or services from a registration subject to a pending cancellation action without the written consent

of the party seeking cancellation generally results in a judgment against the party in the cancellation proceeding. But respondents do get the opportunity to explain, or “show cause,” why judgment shouldn’t be entered against them. If a respondent can show that the cancellation or expiration was the result of an inadvertence or mistake, judgment won’t be entered against it.

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The rule is intended to prevent respondents from avoiding judgment by cancelling certain goods and services to render the cancellation action moot. In this case, though, the deletion of goods didn’t moot the proceeding because Ruifei sought to cancel the registration in its entirety, and the goods that weren’t deleted remained subject to cancellation.

Nonetheless, the TTAB found that the abandonment and fraud claims related to nonuse relied in part on nonuse of the mark on the deleted goods. For that reason, it said, the policies underlying Rule 2.134 applied. In other words, Chengyan couldn’t moot the proceeding and avoid judgment as to the deleted goods by deleting certain goods subject to the cancellation without the written consent of Ruifei.

PROCEEDINGS PAUSED

The TTAB ordered Chengyan to file a response showing cause why its deletion of goods shouldn’t result in a judgment against it on the abandonment claim for those goods. Chengyan responded by asking that the TTAB deny cancellation of the entire class of goods for which it sought registration and permit cancellation only for those goods that it had discontinued. Ruifei’s motion for partial summary judgment on the fraud claim was deferred pending resolution of the abandonment issue. □

Minimal creativity required to secure copyright protection

A dispute between two testing companies in *ACT, Inc. v. Worldwide Interactive Network, Inc.*, is the latest example of the bar for how much creativity is necessary to secure copyright protection. Here’s what you need to know.

COPYRIGHT CLAIMS

The testing company ACT partnered for many years with Worldwide Interactive Network (WIN) to develop career-readiness assessments. After their relationship soured, WIN began marketing its own career-readiness assessments.

WIN’s assessments claimed to test various “learning objectives,” which are descriptions of workplace skills. ACT sued WIN, alleging its competitor infringed ACT’s copyright in its “skill definitions” — descriptions of the various workplace skills ACT tests with its assessments.

The trial court granted partial summary judgment to ACT on its infringement claims before trial. WIN then tried to salvage its learning objectives by revising them.



After COVID-19 delayed trial on the remaining issues, including whether the revised learning objectives were infringing, the court issued a preliminary injunction restraining WIN from continued infringement. WIN appealed the injunction.

PASSING GRADE

To determine whether an injunction was appropriate, the U.S. Court of Appeals for the Sixth Circuit largely focused on ACT's likelihood of success in its infringement claim. In particular, it considered WIN's argument that ACT's selection, description and arrangement of the skill definitions weren't creative and therefore weren't copyrightable.

The appellate court found that ACT's mere selection of its three skills to test — locating information, reading for information and applied mathematics — was likely unprotectable. It explained that copyright protects only an author's expression of a system, not the system itself. The short labels given the skills also didn't warrant protection, as they were noncreative descriptions of the relevant fields.

But all wasn't lost. According to the appellate court, ACT's descriptions of the skills, which compiled all of the various "subskills" tested to assess competency in the overarching skill, probably were protectable. As the U.S. Supreme Court has noted, the requisite level of creativity to secure a copyright is low. The decision to compile specific subskills into a skill definition

wasn't inevitable; different collective descriptions of the skills were possible. The court concluded that ACT's creative choices in compiling the various subskills merited copyright protection.

ACT's arrangement of subskills across skill levels in the skill definitions was also sufficiently creative to warrant protection. For example, the court said, ACT made the nonobvious, and not inevitable, decision to place the "Use the reading material to figure out the meaning of words that are not defined" subskill in Level 4 of the "reading for information" skill definition, rather than in Level 5. Its arrangement didn't follow some "blindingly obvious scheme (like alphabetization)" that would have vitiated copyright protection."

The Sixth Circuit thus found that WIN's learning objectives were likely to infringe at least ACT's description and arrangement of its skills and subskills, as the objectives were virtually identical copies of ACT's skill definitions. As for WIN's revisions, the court said they represented only "immaterial variations" that couldn't insulate them from infringement.

CHALLENGE FAILS

The Sixth Circuit also found that WIN's infringement threatened irreparable harm to ACT and that the balance of the equities and public interest favored an injunction. It therefore affirmed the lower court. ■

Dictionary finishes third in patent claim construction

Dictionaries have their place, but when it comes to interpreting the meaning of patent terms, that place generally isn't first. In *Grace Instrument Indus., LLC v. Chandler Instruments Co., LLC*, the U.S. Court of Appeals for the Federal Circuit laid out just when the dictionary may play a role in such "claim construction."

DISTRICT COURT BLOWS A HOLE IN PATENT

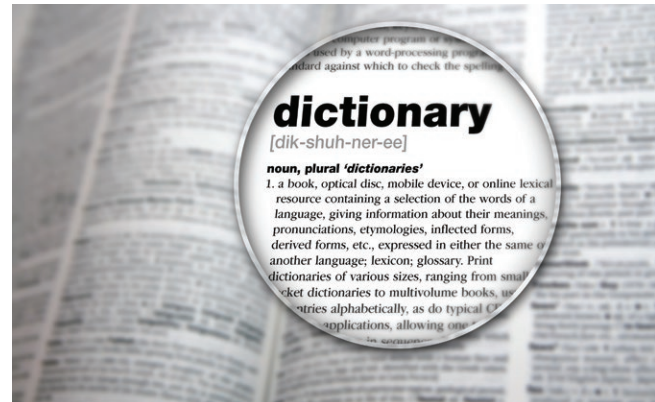
The patent at issue was for a liquid pressurized viscometer used to measure drilling fluid viscosity when drilling oil wells. The viscometer is designed to eliminate measuring errors found in other methods through the use of an "enlarged chamber."

Grace Instrument Industries, the patent holder, sued Chandler Instruments for infringement. The district court ruled for Chandler, finding that the term "enlarged chamber" was indefinite, rendering the patent invalid. Because the term was a "term of degree," the court said, it must be compared against something objective. Grace appealed to the Federal Circuit for relief.

APPELLATE COURT DRILLS DOWN

When interpreting patent claim terms, courts must determine how a skilled artisan in the relevant field would understand the term in the context of the entire patent, including the specification (which includes a written description of the claimed inventions). The Federal Circuit has stated that the specification is the single best guide to a disputed term's meaning. Courts consider a patent's prosecution history, too.

The patent's claims, specification and prosecution history are referred to as "intrinsic evidence." A court also can rely on a dictionary definition, a type of "extrinsic evidence," if it doesn't contradict any definition found in or ascertained from a reading of the patent documents.



If a term's meaning is clear from the intrinsic evidence, though, there's no need to resort to extrinsic evidence. Such was the case here, the Federal Circuit said.

The intrinsic record informed a skilled artisan the "enlarged chamber" is large enough to contain enough sample fluid that it doesn't fall into the viscometer's testing section — so that measurement errors common to earlier viscometers won't occur. Thus, in the context of the patent, "enlarged chamber" didn't require the chamber to be *larger than* some baseline object but instead *large enough* to accomplish a particular function.

The Federal Circuit found both the specification and the prosecution history supported this understanding. Yet the trial court relied on dictionary definitions that contradicted the scope and meaning of the term that a skilled artisan would ascertain by reading the intrinsic record.

MORE DIGGING REQUIRED

The Federal Circuit vacated the lower court's determination that "enlarged chamber" was indefinite and the related invalidity determination. It then returned the case to the trial court for further proceedings. ▣



REISING ETHINGTON

Intellectual Property Law

Since its founding in 1865, Reising has specialized solely in the practice of intellectual property (IP) law. Our clients range from Fortune 500 corporations to entrepreneurs. Our expertise includes:

Automotive	Patents	Prosecution	Electrical
Aerospace	Trademarks	Litigation	Mechanical
Medical Devices	Trade Dress	Portfolio Management	Chemical
Industrial Equipment	Trade Secrets	Post-Grant Proceedings	Computer Science
Universities	IP Due Diligence	Legal Opinions	Manufacturing

Did You Know?

Reising professionals made a strong showing at the Midwest Regional round of the 2023 National Patent Application Drafting Competition, hosted by the USPTO on March 4, 2023. Shareholder **Shannon Smith** coached the University of Detroit Mercy team to victory, and a team from Wayne State University including Reising intern **Alaina Norrito** was the runner-up. Shareholder **Scott Hogan** was also on hand to help judge the competition.

Corey M. Beaubien was a guest lecturer at the Michigan State University College of Law for its Intellectual Property Practice course in March. He discussed subject matter eligibility under 35 U.S.C. § 101, the origins of the two-step framework, and recent caselaw involving eligibility.

Shannon Smith has been hired as an adjunct professor by University of Detroit Mercy School of Law. She will be teaching a course in Patent Drafting next year.

Reising welcomes two new interns this summer. **Allyson Curran** will enter her second year at Wayne State Law School this fall. Allyson earned a B.S.E. in Chemical Engineering with honors from the University of Michigan Ann Arbor. **Briyhan Martin** joins us as she plans to begin her second year at the University of Detroit Mercy School of Law this fall. Briyhan also attended the University of Michigan Ann Arbor earning a B.S. in Pharmaceutical Sciences. We are excited to have these great students join our team.