IDEAS ON INTELLECTUAL PROPERTY LAW

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Watch your words

Patent infringement case fails because of redefined claim term

If there's ever a time to be careful about how you phrase things, it's when you're drafting a patent. One patent holder recently learned the hard way that words used in a specification can end up redefining ostensibly clear patent claim terms — and limiting the patent protection as a result.

HEART OF THE MATTER

Aortic Innovations LLC holds a patent for a device for transcatheter aortic valve replacement. The specification discloses two types of devices, including a transcatheter valve. A patent claim relating to the valve describes an assembly comprising an "outer frame" and an "inner frame." The specification also discloses two types of embodiments.

Aortic sued Edwards Lifesciences Corp. for infringement. In court, the parties disputed the meaning of the term "outer frame." Aortic argued the term should be given its plain and ordinary meaning of "positioned outside"; Edwards contended it should be interpreted to mean a "self-expanding frame" positioned outside the inner frame.

The trial court determined that the patentee had acted as his own "lexicographer" and redefined the term to be a self-expanding frame. It then entered a judgment of noninfringement because Edwards' allegedly infringing valve didn't include a frame.

LEXICOGRAPHY LESSON

Aortic appealed the finding of noninfringement to the U.S. Court of Appeals for the Federal Circuit, challenging the lower court's interpretation of "outer frame." It claimed that the court improperly excluded the term "outer" from the claim and improperly added a "self-expanding" limitation that wasn't present in the claim language.

> Consistent and clear interchangeable use of two terms in a patent can result in a definition that equates the two terms.

The appellate court began by noting that a patentee can choose to use a broad term in a patent claim and expect to obtain protection for the full scope of the term's plain and ordinary meaning. But a patentee may narrow that protection by clearly redefining the term — what's referred to as lexicography.

"DISAVOWAL" CAN CHANGE A CLAIM TERM'S MEANING, TOO

A patentee's lexicography (see main article) isn't the only exception whereby a broad patent claim term isn't given its "plain and ordinary" meaning. A patentee can also disavow claim scope.

When a patent specification makes clear that the invention doesn't include a particular feature, the feature is treated as outside the reach of the protected patent claims. That's the case even if the claim language — without reference to the specification — could be considered broad enough to cover the feature.

The patentee can demonstrate its intent to deviate from the ordinary meaning of a claim term by including in the specification expressions of manifest exclusion or restriction. Mere criticism of a particular embodiment encompassed in the ordinary meaning of a claim term doesn't constitute clear disavowal. Nor is it enough that the only embodiments contain a particular limitation. Rather, a skilled artisan would have to read the specification and conclude that the applicant has clearly disavowed claim scope.

The standard for this exception, the court said, is exacting. To act as one's own lexicographer, a patentee must clearly set forth a definition other than the claim term's plain and ordinary meaning.

That said, an explicit redefinition isn't necessary. The specification can redefine claim terms by implication so that the meaning may be found in or ascertained by a reading of the patent documents. Such an implied redefinition must be so clear that someone skilled in the relevant field (a "skilled artisan") would understand that it equates to an explicit redefinition. The court also explained that the consistent and clear, interchangeable use of two terms in a patent can result in a definition that equates the two terms.

LEXICOGRAPHY BLOCKS ASSERTED MEANING

Turning to the patent at issue, the Federal Circuit found plenty of evidence in the specification that the claimed term "outer frame" did indeed mean a "self-expanding frame." For example, the specification referred to the structures in both embodiments as an "outer frame," a "self-expanding frame" and a "self-expanding outer frame" several times. According to the court, this clearly indicated that the structures were outer frames that must self-expand.

The specification also consistently indicated that the claim's "outer frame" was a "self-expanding frame." Its summary section stated that the patent discloses a transcatheter valve that "includes a frame component having a balloon-expandable frame … and a self-expanding frame secured" to that frame.

Finally, the court pointed out that the specification repeatedly states that, in other embodiments, the self-expanding structures disclosed in the two embodiments may differ in features. It doesn't, however, indicate that the self-expanding nature of the structures is absent or modified in other embodiments.

The appeals court therefore concluded that the specification clearly and consistently conveyed that the self-expanding nature — and limitation — is present in all embodiments of those devices. And a skilled artisan reading the patent would understand that the very character of a transcatheter valve requires the limitation to be a part of every embodiment of it.

DON'T GET BEAT

You might think the meaning of a claim term is apparent, but a court could disagree. Carefully draft your patent applications to avoid costly missteps. □

Clarifying the "by another" standard under the pre-AIA Patent Act

Can an existing patent application invalidate subsequently filed patents if the application and the patents identify overlapping inventors? The U.S. Court of Appeals for the Federal Circuit, which hears all patent-related appeals, recently addressed this issue — and the result was bad news for the holder of the challenged patents.

IS IT A JOINT PROJECT?

In 2002, Serono partnered with IVAX Corporation to develop oral cladribine to treat multiple sclerosis (MS). Employees of the two companies met and exchanged confidential information. (Merck acquired Serono in 2006.)

The applications for the patents at issue were filed in December 2004. They covered methods of treating MS by administering cladribine orally in accordance with a specified dosing regimen. The named inventors were four Serono employees involved in the development of the treatment.

> Any incongruity between the inventors of a disclosure and the inventors of a patent claim render the disclosure "by another."

Nine months earlier, two IVAX employees who participated in the collaboration had filed an international patent application (referred to as Bodor) for an oral dosing regimen of cladribine. It was for a different invention than Merck's patents, but the application shared a common disclosure regarding dosing regimens. The application, which named the IVAX employees as inventors, was published on October 14, 2004.

Hopewell Pharma Ventures Inc. filed inter partes review (IPR) challenges to Merck's patents. The Patent and Trademark Appeal Board (PTAB) found that Bodor and a 1998 medical journal article made Merck's inventions obvious and therefore unpatentable. Merck appealed.

Note: Because the priority date for the patents here was before March 16, 2013, when relevant provisions of the American Invents Act (AIA) took effect, the court applied the pre-AIA Patent Act.

WHO ARE THE JOINT INVENTORS?

Under pre-AIA law, a patent is invalid if "the invention was described in … a patent granted on an application for patent *by another* filed in the United States before the invention by the applicant for patent" (emphasis added). Conversely, one's own work generally isn't deemed disqualifying prior art — so a patent issued to the same "inventive entity" doesn't qualify as prior art that could make an invention obvious.

The PTAB found that, because Merck didn't present credible evidence that all four of its inventors were joint inventors of Bodor, Bodor wasn't "one's own work." On appeal, the question for the Federal Circuit was whether a disclosure in a prior reference invented by fewer than all the named inventors of a patent (that is, Bodor) can be treated as a disclosure "by another" and included in the prior art — or whether it should be treated as "one's own work" and excluded.

Merck argued that a reference's disclosure of the invention of a subset of inventors should be disqualified as prior art against the invention of all of the inventors. Hopewell countered that a prior disclosure is only excluded as the work of the patentee if there's "complete identity of inventive entity" between the inventors of the disclosure and the challenged patent.

The appellate court sided with Hopewell. When a patented invention is the work of joint inventors, it

said, an earlier disclosure can be excluded from prior art only if the parts to be excluded reflect the collective work of the same inventive entity identified in the patent.

It's not necessary that all of the inventors named in the patent be shown in the disclosure — but the disclosure must reveal the joint work of all of them. Any incongruity between the inventors of a disclosure and the inventors of a patent claim renders the disclosure "by another," regardless of whether inventors are added to or subtracted from the patent.

PRIOR ART FINDING PREVAILS

Applying this standard, the appellate court found that Bodor was prior art. The PTAB's ruling was affirmed, and the proper interpretation of "by another" for pre-AIA purposes was well illustrated. ◻

Trade secrets must be … secret

Trade secret misappropriation cases often involve an employer suing a former employee. The U.S. Court of Appeals for the Tenth Circuit heard a case last year that flipped the script — the former employee sued the employer over information he'd copied from yet another previous employer. Read on to learn how this unusual case shook out.

FIRED EMPLOYEE STRIKES BACK

John Snyder worked as a regional director for Guardian Life Insurance Co. for nearly 10 years. While employed there, he downloaded a national customer list to an Excel spreadsheet and sent it to his personal email account. Metadata showed that he made no meaningful changes to the information.

After Snyder was terminated by Guardian (for reasons unknown to the court), he remained unemployed for almost two years. When Beam Technologies hired him, Snyder claimed the company induced him to disclose the Guardian customer list by promising to pay him "off the books."

Snyder created three new, state-specific spreadsheets, using the list as a template. He intended to send them to different sets of Beam employees in the respective states. But he "accidentally" included the full Guardian list as a separate tab in all three of the new spreadsheets that he emailed, thereby disclosing

the complete list to every recipient. Moreover, Snyder told Beam's CEO that he purposefully shared the list with the recipients.

A few months later, he was terminated (again for unknown reasons). Two years later, among other claims, he sued Beam for trade secret misappropriation under the Defend Trade Secrets Act (DTSA). The trial court dismissed the DTSA claim before trial, finding that Snyder didn't establish that he owned the customer list.

KARMA KICKS IN

On appeal, though, the Tenth Circuit didn't focus on the ownership issue. Instead, it turned its attention to whether, as required by the DTSA, Snyder took "reasonable measures or efforts of secrecy" to maintain the trade secret's protected status. The court emphasized that "reasonableness" depends on the specific facts involved but always requires a higher level of diligence than normal business precautions.

Snyder claimed that he took the necessary measures by saving the list on his personal computer, a USB drive and his password-protected work laptop — actions the appellate court described as "relatively benign." Standing on its own, the court said, saving the list on the employer's laptop without a password or marking it as a trade secret or confidential was unreasonable.

> Disclosure of a trade secret doesn't automatically defeat trade secret protection.

The court noted other unreasonable measures as well. For example, he didn't label the state-specific lists as confidential, password-protect them or require any Beam employees to sign a confidentiality agreement. By openly sharing the list with multiple Beam employees without any restrictions or notice that it was a trade secret, he failed to take reasonable measures or efforts of secrecy under federal law (as well as the applicable state trade secret law). And Snyder amplified his accidental disclosure by failing to recall the list, notify Beam employees of the mistake, or mark any of the spreadsheets as trade secrets before sharing them.

MITIGATION IS A MUST

Although disclosure of a trade secret doesn't automatically defeat trade secret protection, a plaintiff must take subsequent affirmative action to safeguard the information and mitigate the scope of the disclosure. Snyder not only failed to do that, he also affirmatively ratified his disclosure by telling the CEO it was intentional. ◻

How to fail at a sound recording copyright infringement

Different types of copyrights convey different kinds and amounts of rights to the holder. One recent infringement case highlighted the distinction between a sound recording copyright and a musical composition copyright — and how a sound recording copyright holder can show infringement.

HIP HOP BATTLE LAUNCHES

In 2012, Eddie Richardson uploaded a hip-hop beat he created to a music-sharing website widely used by music producers and artists. Months later, he recognized the beat in a French Montana song that became a chart-topping hit. (Montana's real name is Karim Kharbouch.) The next day, he registered a sound recording copyright on the beat. Importantly, he didn't register a musical composition copyright for it.

Richardson sued Kharbouch in 2019 for copyright infringement. A federal district court ruled for Kharbouch before trial, and Richardson appealed.

PLAINTIFF GETS BEAT

The appeal was the first time the U.S. Court of Appeals for the Seventh Circuit considered the types of evidence necessary to establish a claim for infringement of a sound recording copyright. As the court noted, infringement claimants must present evidence of copying that's appropriate for the type of copyright at issue.

The court went on to contrast musical composition copyrights with sound recording copyrights. The former, it said, grant "rather expansive rights," including the exclusive rights to reproduce, distribute and publicly perform the work. The latter protect only those sounds that "directly or indirectly recapture the actual sounds fixed in the recording" from copying.

With that in mind, the appellate court held that a sound recording copyright holder must submit evidence that the alleged infringer duplicated the specific digital sounds used in the copyrighted material. Evidence that the works include the same generic sounds may suffice to show infringement of a musical composition copyright — even without specific facts about those sounds. But that's not enough for a sound recording copyright. As long as there was no actual copying of the work, a band could play and record its own version in a way that sounded very similar to the work without infringing.

To the naked ear, the court said, Richardson's beat seemed indistinguishable from the beat in Montana's song. But Richardson failed to present any evidence that Montana copied his beat. He didn't conduct depositions to gather evidence of duplication or provide expert testimony suggesting sampling occurred. He also didn't present indirect evidence of copying by showing Montana had access and opportunity to duplicate the beat. Nor did he provide substantial similarity evidence that supported an inference of sampling.

ONE MORE NOTE

It's worth noting that the Seventh Circuit didn't address whether any amount of digital sampling would be sufficient to establish an infringement claim. It declined to consider the issue because Richardson had presented no evidence of digital sampling. □

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INTELLECTUAL PROPERTY LAW

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Did You Know?

Reising is growing! The firm recently welcomed a number of attorneys who joined the firm. We are happy to have **Julie Greenberg** and **John Guenther** as shareholders as well as Benjamin Becker and Gregory Bussell as associate attorneys.

Rick Hoffmann recently spoke at the **IAM Auto IP event** held in Detroit at the Book Cadillac hotel. Rick moderated a panel discussion on driving IP strategy through tariff turbulence and market shifts. **Corey Beaubien**, **Colin Cicotte**, and **Shannon Smith** also attended the conference.

Shannon Smith is coaching the University of Detroit Mercy team in this year's National Patent Application Drafting Competition put on by the US Patent and Trademark Office. Shannon has previously taken two teams to the national finals hosted at the USPTO headquarters in Alexandria, VA.