

SHIMOKAJI INTELLECTUAL PROPERTY NEWS

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First to File Patent Application Rule Subject to First to Invent Rule

An applicant who is not the first to file a patent application may challenge the person who was the first to file a patent application. That is done through a derivation petition filed with the USPTO.

The petition claims that the person who first filed derived the invention from the petitioner. The petitioner must be an applicant for a patent application, and the petition must be filed by the earlier of 1) one year from the grant of the derived patent or 2) one year from publication of the derived patent application.

The petitioner must show that the petitioner's patent application includes at least one claim that is substantially similar to the derived patent claims or substantially the same as the invention disclosed by the petitioner to the deriver.

In *Catapult v. Adidas*, the Patent Trial and Appeal Board explained that the petitioner must prove "prior conception of the claimed subject matter and communication of that conception to an inventor of the other party." The communication must enable those skilled in the art to make the invention. Moreover, the petitioner has to establish corroborated conception of the invention, as well as corroborated communication of the conception.

COMMENT:

Since corroboration of the communication of the invention from the petitioner to first filer is required, a petitioner should strive to ensure those communications are in writing or at least supplemented in writing. Further, a petitioner will be in a better position for a derivation proceeding if third party witnesses participate in the communications.

Can you Determine the Patent Meaning of - "Unobtrusive Manner that Does not Distract a User"

Without knowing more about the patent, most readers would likely conclude that the phrase is too vague or indefinite to figure out the meaning.

That is what the Federal Circuit concluded in *Interval Licensing v. AOL*, where the patents related to acquiring data from a content provider, scheduling the display of the content data, generating images from the content data, and then displaying the images on a device like a mobile phone. "Pop-up" notifications were alleged to infringe.

The Federal Circuit noted that terms of degree are not necessarily indefinite. But "'unobtrusive manner' . . . is highly subjective and, on its face, provides little guidance to one of skill in the art." There was a "lack of objective boundaries" for its meaning, and the phrase was "purely subjective". Moreover, there was only a "hazy relationship" between the claim language and the specification.

COMMENT:

Specific examples of how a claim term can be interpreted may help define the phrase. A disadvantage of relying on examples to define a claim phrase is that the scope of the phrase may then be limited to what is found in the examples.

Why You Should Avoid Describing Preferred Embodiments in Your Patent

Drafters of patents have historically described inventions in the context of preferred embodiments, which has been intended to mean that the invention could encompass other embodiments. That intention is not always recognized by the trial court.

Luckily for the patent holder in *EGOS v. Pegasus*, the Federal Circuit did not limit the scope of the claims to preferred embodiments. In one instance, the Federal Circuit did not limit the phrase "writing implement" to a conventional writing implement, which was a preferred embodiment. Similarly, a "marking implement" was not limited to a preferred embodiment with a "marker tip".

COMMENT:

To avoid the incorporation of a limitation from a preferred embodiment into a claim phrase, an embodiment might be described in the specification as an exemplary embodiment. That might better convey that, indeed, the embodiment is only an example, and not the only way the invention can be implemented.