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INTELLECTUAL PROPERTY

April 2016

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Analyzing Diagnostic Data - Without Significantly More - Is Not Patentable

The Federal Circuit has again nixed a diagnostic software patent in *Genetic Technologies v. Merial.* The patent covered methods of detecting genetic variations. In particular, the patent detected a coding region of a gene by amplifying and analyzing a linked non-coding region of the same or a different gene.

The Federal Circuit first concluded that the patent was directed to a non-patentable law of nature because it was directed to the natural tendency of the non-coding region to be representative of the coding region. In other words, the patent "covers essentially all applications, via standard experimental procedures, of the law of linkage . . . to the problem of detecting coding sequences of DNA."

Further, according to the Federal Circuit, the patent is for a "newly discovered fact about human biology . . . , involves no creation or alteration of DNA sequences, and does not purport to identify novel detection techniques."

The patent did not provide significantly more than a law of nature because "amplifying" was "well known, routine, and conventional."

Similarly, "analyzing" the amplified information was well known and routine. Also, this involved a mental process of a "routine comparison". Importantly, it was a computational method which could be "performed *entirely* in the human mind"

COMMENT:

Patents for gathering and analyzing data continue to face hurdles for patentability. One way to potentially overcome the hurdle is by having a new technique for gathering the data or a new technique for analyzing the data. Another potential way is create something from the analyzed data.

Disparaging Your Competitor's Product Can Narrow Your Patent Protection

Patents are supposed to be advances over past product designs. Therefore, patents often criticize or disparage past designs.

In *Ultimate Pointer v. Nintendo*, plaintiff's patent was for a handheld pointing device to control a cursor on a projected computer screen for an audience. Defendant made the popular Wii game.

The patent described a direct-pointing system as "more natural to humans, allowing faster and more accurate pointing actions." An indirect-pointing system does "not provide the speed and intuitiveness afforded by direct-pointing systems."

The Federal Circuit noted that "repeated derogatory statements can indicate that the criticized technologies were not intended to be within the scope of the claims."

The court pointed out that the patent title referred to direct pointing, the patent described its handheld device as a direct pointing device, and the patent emphasized how direct pointing was "superior" to indirect pointing.

Finally, the court concluded that the "repeated extolling of the virtues of direct pointing, and the repeated criticism of indirect pointing clearly point to the conclusion" that the patent claims for a "handheld device" are limited to a direct-pointing device.

COMMENT

One might be better served by simply describing the prior art in a patent, and not describe the prior art disadvantages.

For Clint Eastwood Fans and Movie Buffs

Clint Eastwood starred in the movie "Trouble with the Curve." It was a father-daughter baseball story.

The copyright owners of a screenplay "Omaha" sued Warner Bros.

The Ninth Circuit explained that, to prove copyright infringement, there must be "copying of the constituent elements of the work that are original." Copying can be proven by defendant's access to the work and substantial similarity.

Substantial similarity may be determined by examining the plot, themes, dialogue, mood, setting, characters and sequence of events.

The Ninth Circuit began by noting that a father-daughter baseball story is not protectable by copyright. Further, the similar themes of "father-daughter reconciliation, the breaking down of emotional barriers, the importance of family, and pitting old school ways against new ones - are commonplace in father-daughter stories and in sports movies."

Because of the difference in setting mood, and dialogue, there was no copyright infringement.

COMMENT

The decision was non-precedential - meaning that it cannot be relied on as authoritative. But for Clint Eastwood fans, it was a great victory worth remembering.

Is Your Report Format Protectable as Trade Dress?

We all create reports and we often do so with a format we developed over time. Can the format be protected against copying?

In *Millennium v. Ameritox,* both companies provided urine-test reports. The reports enabled health care providers determine if a patient is taking pain medications as prescribed and whether the patient is taking non-prescribed drugs. The reports of both companies used side-by-side graphs to display the results.

The Ninth Circuit explained that trade dress can protect the design or packaging of a product that identifies the maker of the product. However, trade dress does not protect "functional features" of a product. The court pointed out that a feature is functional if it is "essential to the use or purpose of the article or if it affects the cost or quality of the article."

The court concluded that side-by-side graphs could be merely aesthetic in the minds of a jury. Also, a jury could find that alternative designs of graphs could be used. Further, the side-by-side format could be seen as a source identifier.

Therefore, according to the court, a jury could find plaintiff's report format to be non-functional and protectable trade dress.

COMMENT

Though not emphasized by the court, an important fact to finding the report format protectable as trade dress may have been that plaintiff's marketing department sought to distinguish its report from others and created the side-by-side format to do so. That could be important for others seeking to make their report format protectable.

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