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Cannot Always Use "Common Sense" To Render a Patent Obvious

In *Arendi v. Apple*, the patent involved the coordination between a first computer program that displays a document and a second computer program that searches an external information source for information of a type related to the document. Related information that is found can be inserted into the document.

The Patent Trial and Appeal Board determined that a prior art reference to Pandit rendered the patent obvious. Pandit taught recognizing classes of text in a document and providing suggestions based on it. Its program recognized a phone number as a class of text.

The Board found it would be "reasonable to presume, as a matter of common sense, that Pandit would search for duplicate phone numbers and information associated with such numbers."

The Federal Circuit explained that "common sense, common wisdom, and common knowledge" can be considered in analyzing whether a patent is obvious.

However, "common sense" can only be applied when: (1) it provides a known motivation to combine prior art, (2) a limitation missing in the prior art is "unusually simple and the technology particularly straightforward, and (3) not used as "wholesale substitute for reasoned analysis and evidentiary support."

The Federal Circuit concluded that it would not necessarily be common sense for the Pandit "Add to address book" function to operate by first searching for entries with the same phone number.

COMMENT:

The Board determined that it would have been obvious to search for duplicate phone entries in a database. That does not seem too far fetched.

Do You Ever Feel That Something is Lacking in Patent Examiners?

The Office of Investigations for the US Department of Commerce which oversees the US patent office recently published its report concerning the time and attendance of patent examiners.

The investigation covered the period of 2015 and examined more than 90% of all patent examiners.

The report concluded that a substantial number of patent examiners were involved in "time and attendance abuse". According to the report, over a period of a year, there was about 180,000 hours that were "unsupported".

According to the report, the unsupported hours in less than a year equates to almost \$9 million. This amount, according to the report, could have reduced the patent application backlog by 7,530 cases.

COMMENT

The Office of Investigations has not recommended a criminal investigation of the examiners found to have unsupported hours

Collecting and Monitoring Data Is Still Not Patentable

In *Electric Power v. Alstom*, the Federal Circuit described the patents as "performing real-time performance monitoring of an electric power grid by collecting data from multiple data sources, analyzing the data, and displaying the results." That description portended the court's decision.

The Federal Circuit reiterated those categories of abstract ideas that are not patentable. One, collecting information "which does not change its character as information." Two, analyzing information by "steps people go through in their minds, or by mathematical algorithms." Three, "presenting the results of abstract processes" without a particular tool for presentation.

According to the Federal Circuit, "merely selecting information, by content or source, for collection, analysis, and display does nothing significant to differentiate a process from ordinary mental processes."

The patents at issue "do not require an arguably inventive set of components or methods, such as measurement devices or techniques, that would generate new data. They do not invoke any assertedly inventive programming." They "do not require any nonconventional computer, network, or display components, or even a 'non-conventional and non-generic arrangement of known, or conventional pieces.'"

COMMENT

So much of new technology today involves the gathering of large amounts of data, analyzing it, and then making conclusions of what the data means. If this was not possible in the past, should it not be patentable now?

Trader Joe's in the US Can Sue Pirate Joe's in Canada for Infringement

Trader Joe's is a well known chain of food stores in the US. It does not operate in Canada. Pirate Joe's purchased Trader Joe's branded goods in the US, transported them to Canada, and then resold them. Pirate Joe's store mimics the look of Trader Joe's stores.

In *Trader Joe's v. Pirate Joe's*, the Ninth Circuit said that Trader Joe's could suffer a "tarnished reputation and resultant monetary harm" in the US from contaminated goods sold by Pirate Joe's in Canada.

Pirate Joe's attempt to pass itself off as an authorized Trader Joe's store could harm the latter's US reputation and diminish the value of its trademarks, according to the Ninth Circuit.

And, Pirate Joe's "infringing scheme" is partly executed in the US, according to the Ninth Circuit.

The Ninth Circuit concluded that Trader Joe's infringement claim under the US laws could reach Pirate Joe's.

COMMENT

Another fact was that the owner of Pirate Joe's was traveling to California to buy Trader Joe's goods, when the latter tried to prevent the owner from buying goods in Washington State. This fact probably did little to help Pirate Joe's appearance of an intentional infringer.

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