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INTELLECTUAL PROPERTY

September 2017

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Is Your "Invention" Just Routine Testing or a Patentable Invention?

Honeywell owned a patent for a heat transfer composition used in air conditioning equipment. The composition included "HFO-1234yf" and a "PAG lubricant".

Mexichem Amanco initiated an inter partes reexamination to have the patent office determine the patent was invalid.

The patent office Board found that PAG lubricants were well known for use with "HFC-based refrigeration systems". Also, the Board found that a prior patent taught that "HFO-1234yf" does not have compatibility problems with lubricants.

Therefore, according to the Board, it would have been obvious to combine HFO-1234yf with a PAG lubricant through "routine testing". And the Board also concluded that the stability of HFO-1234yf with a PAG lubricant are "'inherent properties of an otherwise known refrigerant'".

On appeal, the Federal Circuit explained that "unexpected [inherent] properties may cause what may appear to be an obvious composition to be nonobvious". They further explained that "routine experimentation does not necessarily preclude patentability."

Thus, the Board erred in "dismissing properties of the claimed invention as merely inherent, without further consideration as to unpredictability and unexpectedness", according to the Federal Circuit.

COMMENT:

This decision give patent owners a weapon to argue against the frequent rejections by the patent office that something is inherent in the object or composition, or something is mere routine testing, and not a patentable invention.

Another Example of Routine Testing-Optimization Still Being Patentable

Stepan filed a patent application for an herbicidal formulation having a glyphosate salt and surfactant.

The application stated there was an unexpected result - a cloud point above 70 degrees C. The cloud point is the temperature at which a solution becomes cloudy.

A prior patent publication taught glyphosate compositions with surfactants and having a cloud point of at least 60 degrees C.

The patent Board found that Stepan "failed to provide evidence that it would not have been routine optimization for a skilled artisan to select and adjust the claimed surfactants to achieve a cloud point above at least 70 degrees C.

And the Board found that Stepan "failed to establish the criticality of its claimed range of surfactants."

The Federal Circuit disagreed, explaining that the "Board [not Stepan] failed to explain why it would have been 'routine optimization' to select and adjust the claimed surfactants and achieve a cloud point above at least 70 degrees C."

COMMENT:

Patent owners can add this case decision to their "quiver of arrows" when arguing for the patentability of their invention.

"Little Mermaid" is Merely Descriptive of Dolls Says the Trademark Board

The trademark laws provide that a term is "merely descriptive" if it "immediately conveys knowledge of a quality, feature, function, or characteristic of the goods." If merely descriptive, the mark cannot be registered.

United Trademark Holdings sought trademark registration of "Little Mermaid" for dolls.

Little Mermaid is a fairy tale by author Hans Christian Anderson. It was first published in 1837 and adapted numerous times, including as a Walt Disney film.

The trademark examiner rejected the application as being merely descriptive of dolls with the appearance of a young, partly human girl sea creature.

United did not disagree that "Little Mermaid" immediately describes a doll of a young mermaid. Instead, United argued that "Little Mermaid" conveys the impression of the "name of a particular fictional character in the public domain."

On appeal, the trademark Board agreed.

However, the Board explained that a "fictional public domain character like the Little Mermaid of the Hans Christian Anderson fairy tale is not necessarily linked to a specific commercial entity." Further, "other doll makers interested in marketing a doll that would depict the character have a competitive need to use that name to describe their products."

Thus, registration was denied.

COMMENT:

Though not articulated, perhaps the biggest hurdle to registration was that if registration was granted, others who made a little mermaid doll could not call it "Little Mermaid."

Studios Successfully Prevent "Ripping" of Their Movies

Studios produce and distribute copyrighted movies. The studios employ encryption to prevent unauthorized copying.

VidAngel purchases DVDs of the movies. It uses a software program to decrypt and rip the movie from DVD to a master file. VidAngel then tags segments of the movies for "inappropriate content." The movies are then made available for purchase by customers.

Customers select the inappropriate content to be filtered out. VidAngel then streams the filtered movie to the customer.

The studios sued for copyright infringement. VidAngel defended by arguing that was protected by the Family Movie Act (FMA).

The Ninth Circuit explained that the FMA authorized "imperceptible" filtering of a copyrighted work by a "private household" member. The filtering also had to be of an "authorized copy" of the work.

VidAngel did not use an "authorized copy" of the work, according to the Ninth Circuit, even though VidAngel purchased the DVDs.

The Ninth Circuit explained that "virtually all piracy of movies originate in some way from a legitimate copy. If the mere purchase of an authorized copy alone precluded infringement liability under the FMA, the statute would severely erode the commercial value."

The court enjoined VidAngel.

COMMENT:

The court was obviously not persuaded by VidAngel's literal reading of the statute.

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