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More Guidance on What Software is Patentable

Finjan owned patents for computer security. A jury awarded Finjan $40M for Blue Coat's infringement.

On review, the Federal Circuit noted that they concluded in another decision that virus scanning is well-known, an abstract idea, and not patentable.

But the Finjan patents operated differently than traditional virus scans that recognized previously-identified viruses. The Federal Circuit characterized the Finjan patents as using a "behavior-based" approach as compared to a "code-matching" approach of the past.

Finjan's technology enabled "more flexible and nuanced virus filtering" that allowed "administrators to craft security policies with highly granular rules and to alter those security policies in response to evolving threats."

The Federal Circuit found Finjan's inventions patentable because the patents "recite specific steps . . . that accomplish the desired result."

COMMENT:

What supported the finding of patentability was a unique result, not merely the recital of steps to get to the result.

US and Alibaba Clash on List of "Notorious Markets"

The Office of the US Trade Representative (USTR) released its annual list of Notorious Markets for 2017. It identifies online and physical marketplaces throughout the world where there is significant copyright piracy and trademark counterfeiting.

The List is not intended to be exhaustive and is "drawn from . . . many nominations." It does not "make findings of legal violations."

Some of the listed online platforms include China-based Taobao which is owned by Alibaba. The List describes Taobao as China's "largest mobile commerce destination and the third-most popular website in China."

Alibaba shot back with a written rebuttal to the List.

First, Alibaba stated that the List "proves nothing."

Next, Alibaba stated that "Alibaba is the biggest ecommerce platform in the world. It is not appropriate to compare platforms by simply counting complaints."

COMMENTS:

We will see if there is a formal USTR response. But it seems unlikely.

More Guidance on What Software is NOT Patentable

Litigation between the parties has been ongoing since 2007. Real Estate Alliance ("REA") owned patents for a method of searching for real estate on a computer. It sued realtor associations, brokers, listing services and others.

In the patents, a user identifies a geographic area of interest, and then designates the boundaries, within the geographic area, on a map. The user then zooms into the area within the boundaries for available properties.

The Federal Circuit began by explaining that a method of collecting information about available properties and displaying the information on a map is an "abstract idea." Moreover, the patents cover nothing more that the "use of a computer for a conventional business purpose."

In the Court's view, "[i]nstead of focusing on the technical implementation details of the zooming functionality, for example, [the patent] recites nothing more than the result of the zoom."

Importantly, the "claims are drawn to an abstract idea because they 'claim the function of the abstract idea, not a particular way of performing that function.'"

Moreover, according to the Federal Circuit, even though storing, selecting properties in a geographical area may be an improvement in identifying properties, it is not a "technical improvement" and, therefore, not patentable.

COMMENT;

The Court focused on whether there was a technical improvement to a computer, and not an improvement to how the result was accomplished - finding available properties. This seems contrary to the *Finjan* decision.

Soul Band "The Commodores" Successful in Keeping its Name

Thomas McClary was an original member of the band "The Commodores" that was formed in 1968. The band released over 40 albums and had several "top-ten hits."

In 1984, McClary "split from the band" to make it on his own. McClary formed bands called "The 2014 Commodores" and "The Commodores featuring Thomas McClary".

The original Commodores had a partnership agreement. It provided that a withdrawing partner would not have the right to individually use the Commodore name.

The Eleventh Circuit court found that the trademark "The Commodores" was jointly owned, and that McClary did not have a right to separately use the trademark.

COMMENTS;

The decision did not seem surprising in view of the partnership agreement.

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