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IP & TECHNOLOGY NEWSLETTER



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Edited by: Mark L Beloborodov



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NOTE FROM THE EDITOR

By: Mark Beloborodov¹

Dear Readers,

Welcome to the latest edition of Bond's IP & Technology Newsletter, reporting on a few interesting developments in the world of intellectual property in 2022, including not one or two, but three IP cases picked up for review in this term by the U.S. Supreme Court! Having published an internal IP blog while in-house at Philips in the past, I am thrilled to curate and coordinate the commentary on current intellectual property issues, as well as practical guidance, by my colleagues here at the firm.

I thank the contributors for their efforts and hope you will enjoy our newsletter. Bond's [intellectual property practice](#) will continue sharing our views on the happenings in the world of IP on a regular basis. If there is an IP topic or issue you would like our take on, please give us a shout at bsk.com/info/contact-us.

¹ Mark Beloborodov is a member of the firm's IP & technology practice based in Boston. He is a seasoned IP attorney with an extensive background in representing technology companies ranging from early-stage ventures to multinational conglomerates in IP matters, and supporting innovation in the healthcare, information technology, lighting, consumer goods and electronics sectors. He recently joined Bond after serving in various in-house leadership roles, including almost 15 years at Royal Philips.



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The Prince of Thieves: The Supreme Court Takes Up the Fairness of Andy Warhol's Silkscreen of Prince

By: George McGuire²

In October 2022, the Supreme Court heard arguments with respect to whether Andy Warhol's rather famous silkscreen of Prince Rogers Nelson, a legendary singer-songwriter, musician, and record producer commonly known as Prince was a fair use of a black-and-white photograph of him taken by photographer Lynn Goldsmith and upon which the silkscreen is admittedly based. Or was it thievery, or, in legal terms, a copyright infringement? At stake is the level of protection afforded an artist/creator when their work is used as the basis for subsequent work by another. A decision is expected early this year.



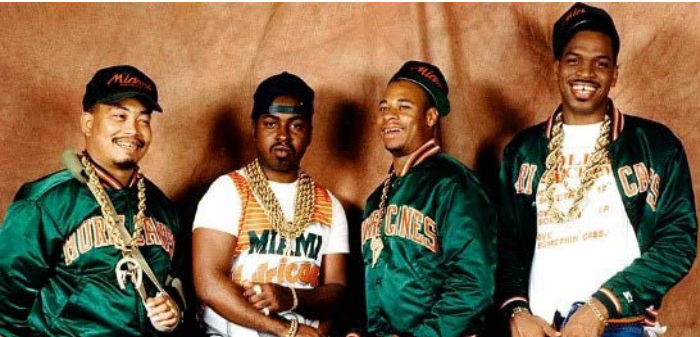
Introduction and Background

While this case concerns artistic works, the Court did hear and decide a fair use case just last year in *Google v. Oracle*, a case concerning copyright in functional computer code, which it decided in favor of fair use of Oracle code by Google, thereby lessening the scope of copyright protection afforded such works. For a fair use case involving artistic works, however, we need to travel all the way back to 1994 when the rap group 2 Live Crew was determined to have made fair use of Roy Orbison's song *Pretty Woman* in a rap that copied the opening bass riff and first line of lyrics and then

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used sampled the original melody with comical and taunting verses that commented upon life in the 1950's versus life in a ghetto in the 1980's, and, in doing so, satirized the Orbison's work.



Writing for the unanimous Court, Justice David Souter recognized that fair use is essential to a functional copyright law, to critical reflection, and to the inspiration of new creativity:

“[T]he goal of copyright, to promote science and the arts, is generally furthered by the creation of transformative works. Such works thus lie at the heart of the fair use doctrine’s guarantee of breathing space within the confines of copyright. . . .”

The 2 Live Crew case brought the concept of “transformative use” to the forefront of fair use analysis and has come to dominate fair use cases involving artistic works ever since. The Warhol case may reign fair use back to its original balancing test and lessen the sometimes-dispositive determination based upon how transformative a work is.

Lynn Goldsmith is a world-renowned celebrity photographer, especially known for her portraits of rock and roll artists and their album covers. In 1981, Newsweek commissioned her to photograph Prince, a relatively unknown musician who just began to break into the mainstream with his provocative performances. In her testimony from the trial court, she explained the painstaking and artistic process by which she photographed Prince

in regard to the lighting, backdrop, make-up, and manner of working with Prince during the shoot to get him more relaxed and capture his essence as a youngartist. While those photographs were not published at the time, three years later, in 1984, when Purple Rain album made Prince a global sensation, Vanity Fair magazine licensed one of Goldsmith’s portraits of Prince and commissioned Andy Warhol to create artwork for a featured story on Prince and his music.

The underlying artistic works at the heart of the case are reproduced here with Goldsmith’s photograph on the left and Andy Warhol’s silkscreen on the right:



Warhol actually took a progressive approach to creating the silkscreen and made several in sequence. His sequence of screens (the “Prince Series”) is shown in the comparison below:



There is no question that Mr. Warhol used Ms. Goldsmith's photos as models in creating his silkscreens. The issue is whether the artistic process and his artistic expression of Prince was an unauthorized derivative work based upon Ms. Goldsmith's photograph (i.e., an infringement), or whether the artistic expression was so transformative of the original as to be a fair use of the photograph (a fair use that is permitted under the Copyright Act). In other words, this case reexamines the threshold at which a new work transforms an old work enough to constitute its fair use rather than stepping on derivative rights. The outcome could shift the legal standards to afford more control to the original artist but doing that could also constrain subsequent content creators who build on existing work in everything from posters and memes to documentaries.

Copyright and Fair Use

The Copyright Act provides protection to an author of an original work of authorship. This protection provides the author (or owner) with a bundle of rights, namely, the exclusive right to: to control the reproduction of the work, to control the making of derivative works, to control the distribution of the work, to control the public performance of the work, to control the public display of the work, and to perform a sound recording publicly by means of digital audio transmission. To do any of these things requires the authorization of the owner of the copyrights to the work. Unless it doesn't!! Enter, Fair Use.

Fair use is a doctrine in United States law that permits limited use of copyrighted material without having to first acquire permission from the copyright holder. Fair use is one of the limitations to copyright intended to balance the interests of copyright holders with the public interest in the wider distribution and use of creative works by allowing as a defense to copyright infringement claims certain limited uses that might otherwise be considered infringement. More precisely, the statute provides: [t]he fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism,

comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include:

1. the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
2. the nature of the copyrighted work;
3. the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
4. the effect of the use upon the potential market for or value of the copyrighted work.

So, on balance of these factors, does Mr. Warhol's silkscreens tip in favor of fair use, or is it merely an unauthorized derivative work of the original photograph? It is worth mentioning that the Supreme Court does not typically take a case to simply decide the merits of that one particular case in favor of one of the parties, but rather chooses to intervene when it recognizes an opportunity to look beyond the specific fact pattern and espouse the policy choice underlying the legal heart of the action (and, perhaps, resolve a split of authority amongst the lower level appellate courts.)

The Record

The Supreme Court is the highest court in the land, the last stop in the judicial process so to speak. Thus, there is a record established in the lower courts and the parties in the Supreme Court are limited in their arguments to that judicial record.

1. Trial Court

In this case, the trial level court determined, on summary judgment, that Mr. Warhol's work was indeed a fair use of Ms. Goldsmith's photograph. As to the first fair use factor, the purpose and character of the work, the court reasoned that works are per se transformative "[i]f looking at the works side-by-side, the secondary work has a different character, a new expression, and

employs new aesthetics with [distinct] creative and communicative results.” Applying that bright-line rule, the court concluded that Warhol could “reasonably be perceived to have transformed Prince from a vulnerable, uncomfortable person to an iconic, larger-than-life figure.”

The court further held that the second factor, “the nature of the copyrighted work,” favored neither party. The court reasoned that the third factor, “the amount and substantiality of the portion used,” favored Warhol because Warhol altered Goldsmith’s photograph in some ways, despite “cop[ying]” “the pose and angle of Prince’s head.” As to the fourth and final factor, the court deemed the effect “upon the potential market for or value of” Goldsmith’s original photograph minimal on the theory that Warhol’s commercial-licensing activities did not act as market substitutes for Goldsmith’s photograph.

2. Second Circuit Opinion

The Second Circuit reversed, holding that all four fair-use factors as a matter of law favored Goldsmith and considered holistically, precluded any finding of fair use. 992 F.3d 99 (2d Cir. 2021). As to the first factor—one component of which assesses whether Warhol’s Prince Series is “transformative”—the Second Circuit asked whether the work “adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message.” The appeals court explained that this inquiry is fact- and context-specific and necessitates a close look at the meaning, message, and purpose of the works at issue. Whether a work is transformative cannot turn “merely” on the artist’s “stated or perceived intent” or “the meaning or impression” that a patron, critic or a judge subsequently draws from it, the court said — otherwise, “any alteration” could be recognized as transformative under the law.

The court thus rejected the notion that “any secondary work that adds a new aesthetic or new expression to its source material is necessarily transformative.” Instead, the court observed, some secondary works are non-transformative even if

they add novel elements — like a film adaptation of a novel, a quintessential derivative work. *Id.* at 111-12. And, because under the Copyright Act, the copyright holder retains the right to all derivative works, the court expressed concern that an overly loose test for “transformativeness” would cut into a core statutory right of copyright holders. Conversely, the court observed, some secondary works are transformative even if the artist expressly disavows trying to create a new meaning or message — for instance, works by the artist Richard Prince that copied another artist’s copyrighted photographs but juxtaposed and altered them alongside others. Those secondary works therefore transformed the original work “in the creation of new information, new aesthetics, new insights and understanding.”

Applying that context-specific approach, the Second Circuit held that Warhol’s Prince Series was not transformative even though the works include some visual differences from Goldsmith’s portrait. The court explained that the Prince Series “retains the essential elements of the Goldsmith Photograph without significantly adding to or altering those elements.” Further, the two works shared a common, highly specific purpose — functioning as an artistic portrait of the artist Prince.

The court held that the second factor, the nature of the copyrighted work, also favored Goldsmith because her photograph is both unpublished and creative. The third factor, “the amount and substantiality of the portion used,” also favored Goldsmith. Goldsmith’s composition centered on Prince’s face; Warhol copied her image of Prince’s face wholesale, and there was no evidence that Warhol “required Goldsmith’s photograph,” as opposed to a stock photo, to create the Prince Series.

Finally, as to the fourth factor, the court held that Warhol’s commercial licensing of the Prince Series to magazines traded off with the market for Goldsmith’s portrait, because both functioned as artistic portraits of the same person. The court thus found the potential for substantial harm to Goldsmith in the licensing market.

3. Supreme Court

The question presented to the Supreme Court is: Whether a work of art is “transformative” when it conveys a different meaning or message from its source material (as the Supreme Court, U.S. Court of Appeals for the 9th Circuit, and other courts of appeals have held), or whether a court is forbidden from considering the meaning of the accused work where it “recognizably deriv[es] from” its source material (as the U.S. Court of Appeals for the 2nd Circuit has held).

Oral argument was held before the Court in October with a decision expected sometime in the first half of this year. During arguments, the Justices asked questions that would suggest that the majority leans towards affirming the Second Circuit’s decision, with a primary point of concern being whether the images produced by Warhol were “fair” with respect to Goldsmith’s photograph that Warhol’s successors can license them for commercial gain without attribution to, permission of, or compensation to Goldsmith.

Counsel for Warhol (actually, for Andy Warhol’s Foundation which controls the intellectual property of the late artist) argued that Warhol’s work was so transformative that continuing exploitation of Prince Series after the death of Prince owed nothing to the photograph on which Warhol based those images. The principal reaction of the justices to this argument was to pose a series of hypotheticals, all of which seemed to the questioning Justices plainly to require permission from the owner of the underlying copyright, but none of which seemed distinguishable from the foundation’s position that any new “message” or “meaning” is enough to free a follow-on work from any obligation to the creator of the original work.

Justice Kagan made the following point:

there may be nothing left to the original author for derivative works. ... [I]ndeed, we expect Hollywood, when it takes a book and makes a movie, to pay the author of the book. But I think moviemakers might be surprised by the notion that what they do [isn’t] transformative.

I mean, mostly movies are tons of new dialogue, sometimes new plot points, new settings, new characters, new themes. You would think [that amounts to] new meaning and message [under the test you propose]. So why is it that we, you know, can’t imagine that Hollywood could just take a book and make a movie out of it without paying?

Following this, Justice Barrett asked under the rule preferred by Warhol’s counsel, why then would the Peter Jackson movies about the Lord of the Rings need to pay a royalty to Tolkien’s estate. Counsel started his reply by suggesting that the movies had not added much of substance to Tolkien’s works but then quickly backed down, confessing a lack of familiarity.

In a shout out to Syracuse University, Justice Thomas asked Warhol’s counsel to imagine him at a Syracuse football game with a large poster bearing a blown-up image of “Orange Prince” (the image of Prince at issue on the cover of Vogue was indeed orange in color) with a “Go Orange” caption at the bottom. The problem for Warhol’s counsel, of course, is that the “Go Orange” phrase plainly adds a new message to the work of Prince, but it is also generally accepted that a license fee would be owed to the creator of the original image; a position that is difficult to square with his argument.

Counsel for Goldsmith’s argument, by contrast, centered on the meaning of the fair use statute with respect to the terms “purpose” and “character” of the use. With respect to the “purpose” of use, Goldsmith argues that the purpose of both works is commercial licensing for publication in magazines in stories about Prince. However, also plausible is that the Goldsmith’s photograph was intended as a representation of how Prince looked, while Warhol’s images were of profoundly non-representation intention.

Justice Roberts homed in on this latter point, commenting that “Warhol sends a message about the depersonalization of modern culture and celebrity status.” Thus, he suggests, “it’s not just a different style. It’s a different purpose. One

is the commentary on modern society. The other is to show what Prince looks like.” With regard to the non-representation portrayal in Warhol’s work, he further noted that “if you really wanted to know what Prince looks like, ... [h]e doesn’t have one eye that’s blacker than the other [and] his head doesn’t float in the air as it does in Warhol’s but not in Goldsmith’s.”

With Justice Roberts point being well taken, the majority of the Justices did seem pointedly concerned with coming up with sufficiently useful language to reject Warhol’s fair use claim. While an affirmance of the Second Circuit’s opinion with clarifying language might be most beneficial and provide the most guidance with regard to the fair use doctrine, it is also possible the Court remands to the lower court with instructions to reconsider in light of the Court’s position which would likely prove less satisfying in regard to providing definite guidance around fair use. Until a decision is handed down, an outright reversal of the Second Circuit is also a possibility, albeit one that seems quite slight in view of the questions and comments of the justices.

Ramifications of Decision

Supreme Court decisions concerning fair use of a copyright greatly impact the scope of such intellectual property rights. A decision in favor of fair use weakens such rights/lessens the scope afforded, while a decision in favor of the rights holder strengthens such rights. After decisions curbing the rights of copyright holders, this decision appears to be heading towards enhancing copyright protection for the creators, reversing the trend of the Court in this arena of broadening fair use and lessening copyrights.



TRADEMARKS

Message on a (Famous) Bottle or Barking up the Wrong Tree: *Jack Daniel’s Properties, Inc., v. VIP Products LLC* (Case No. 22-148)

By: Terria Jenkins³

What do you do as a trademark owner when your mark is used by someone else as “comic relief” at your expense, when others make fun of your beloved brand for their commercial gain? Do you take a high road when those jesters don’t actually compete with you in the marketplace? Or do you instinctively cry foul and ask your lawyer to send them a strongly worded letter and go to court, if they don’t cease and desist? How likely are you to succeed with such a forceful legal response? The United States Supreme Court will soon weigh in.

In a case involving poop (the dog variety of course), parody and protection of trademark rights, the U.S. Supreme Court has, in the words of Reuters, “agreed to referee a dog fight”⁴. In the case of *Jack Daniel’s Properties, Inc. v. VIP Products LLC*, the Court will consider the scope of the First Amendment free speech protections against a party’s right to protect and enforce its trademark rights. The specific questions before the Court are:

1. Whether humorous use of another’s trademark as one’s own on a commercial product is subject to the Lanham Act’s traditional likelihood-of-confusion analysis, or instead receives heightened First Amendment protection from trademark-infringement claims.
2. Whether humorous use of another’s mark as one’s own on a commercial product is “noncommercial” under 15 U.S.C. § 1125(c)

³ Terria is a seasoned trademark and copyright intellectual property attorney who works closely with her clients to optimize, protect and leverage their brands and expand their impact in the market. She has an exceptional range and wealth of knowledge in trademark portfolio development, strategic brand management, brand counseling and brand licensing, having overseen large multinational trademark and copyright portfolios.

⁴ Reuters, Nov. 21, 2022 4:43 pm “U.S. Supreme Court takes up Jack Daniel’s Dog Toy Trademark Rumpus”

(3)(C), thus barring as a matter of law a claim of dilution by tarnishment under the 2006 Trademark Dilution Revision Act.

By way of background, VIP Products LLC makes and sells “Silly Squeakers” dog chew toys shaped like bottles of popular beverage brands with irreverent naming that plays on those brands. VIP’s stated goal in marketing these toys is to “reflect” on “the humanization of the dog in our lives” and to poke fun at “corporations that take themselves very seriously.” Over a million Silly Squeakers were sold from 2007 to 2017.

In July of 2013, VIP introduced a dog toy affectionately known as “Bad Spaniels” which mimics the size, shape, design and trade dress of Jack Daniel’s iconic Old No. 7 Black Label Tennessee Whiskey bottle and has an image of a spaniel over the “Bad Spaniels” stylized label. VIP included humorous wording on the bottle with phrases such as “The Old No. 2 on your Tennessee Carpet,” “43% Poo by Vol.” and “100% Smelly”. Notably, a tag affixed to the Bad Spaniels toy indicates that the “product is not affiliated with Jack Daniel’s Distillery.”



In response to a cease-and-desist letter from Jack Daniel’s attorneys, VIP responded boldly by filing a declaratory judgment action requesting a ruling from an Arizona federal court that its products did



Image credit: NYP Holdings, Inc. (November 21, 2022)

not infringe Jack Daniel’s trademark rights. VIP went as far as seeking cancellation of the USPTO registration for Jack Daniel’s bottle design. VIP further asserted fair use of the those marks and First Amendment free speech defenses. The District Court ruled in favor of Jack Daniel’s, finding that VIP had infringed Jack Daniel’s trademarks and diluted marks by tarnishing the brand’s image. The court permanently enjoined VIP “from ... selling or distributing the Bad Spaniels dog toy.”

Upon VIP’s appeal, the Ninth Circuit Court of Appeals reversed in part, holding the dog toy to be a creative or expressive work entitled to First Amendment protection and remanded the claim of infringement back to the lower court. Jack Daniel’s sought review by the U.S. Supreme Court in August of 2022, asserting in its petition for certiorari that the Ninth Circuit ruling “departs from the decision of every other circuit to decide this question” and had the potential to “unleash mass confusion in the marketplace.” Jack Daniel’s attorney noted that “to be sure, everyone likes a good joke. But VIP’s profit-motivated ‘joke’ confuses consumers by taking advantage of Jack Daniel’s hard-earned goodwill”. On November 21, 2022, the Supreme Court agreed to get involved.

The Jack Daniel’s case raises issues of particular importance to brand owners, industry players,

trade organizations and others because of the potential impact on commerce, economic interests and, most notably, the ability to protect and enforce valuable trademark rights. Both First Amendment rights and intellectual property rights are vitally important so a proper balance is critical to serving both interests. Free speech must be protected and trademark owners must have the ability to enforce their trademark rights against third parties, which like VIP, may be seeking to unfairly trade on the goodwill of their brand under the guise of protected speech. If such actions are analyzed under the heightened scrutiny of First Amendment, it will be virtually impossible for a trademark owner to protect and enforce its trademark rights.

Over the past few weeks, several notable brands and trade organizations including Nike, Inc., Levi Strauss & Co., Patagonia, Campbell Soup Company, Constellation Brands, Inc., International Trademark Association (INTA), American Intellectual Property Law Association (AIPLA), the Motion Picture Association, U.S. Chamber of Commerce, and other industry, trade organizations, scholars and notable parties have filed amicus curiae briefs in support of Jack Daniel's position. The Biden Administration, through its Solicitor General, weighed in to support Jack Daniel's position, as well.

The vast majority of the parties filing amicus briefs in this case agree that the Ninth Circuit misapplied and unduly expanded the longstanding Rogers v. Grimaldi, 875 F.2d 994 (2d Cir. 1989) test for application of the First Amendment in the context of a trademark infringement. The Rogers test requires a plaintiff to demonstrate that defendant's use of the mark either (1) is not artistically relevant to the underlying work, or (2) explicitly misleads consumers as to the source and content of the work. The Rogers test has historically been applied to artistic works only rather than commercially sold products, which is the critical distinction in this case. INTA's amicus brief aptly sums up the impact of this expansion indicating "[t]he Ninth Circuit's decision threatens a trademark infringement framework that has been intact and applied for nearly a century." INTA further indicates that "applying the Rogers test to ordinary commercial products will

potentially allow parties to avoid trademark liability merely by claiming their product contains some expression, thereby enabling them to confuse consumers and trade on the goodwill of trademark owners." Both Levi Strauss and Patagonia argued that it is important for brand owners to express their values, explaining that the Ninth Circuit's decision "threatens an enormous burden for trademark owners to preserve their own ability to communicate clearly with the public through their brands and the public's ability to know what they stand for (and just as importantly, what they may not stand for)."

We look forward to the Court's decision expected in the next few months and will update you on the ruling and potential implications for your brands. The decision may limit the reach of the Rogers test, as well as to clarify the interpretation of "dilution by tarnishment" in the context of commercial vs noncommercial use of trademarks.

Bond, Schoeneck & King PLLC offers an exceptional range of legal services through its trademark practice including strategic brand counseling, trademark portfolio maintenance, trademark enforcement and a range of related trademark and copyright services. We would welcome to opportunity to partner with you as you build, leverage and protect your trademarks.



PATENTS

Incorporate with Caution: Federal Circuit Minimizes Impact of “Incorporation by Reference” in Child Patents Related to Anti- Virus Software

By: Jessica Copeland⁵

Information Technology systems, and the cybersecurity frameworks and solutions designed to protect those systems are advancing at a speed of Mach 1, so it is not surprising that patent attorneys are challenged to draft specifications and claim terms that can evolve with the technology they are intending to protect. In a recent decision by the Federal Circuit, that juxtaposition/challenge was brought to a head, and while the patent owner in this case is extremely lucky for the decision, it should be a wake-up call to patent drafters to be careful using those magic words “incorporated by reference.”

By way of background, Inventors and their patent attorneys often employ incorporation by reference as a tool to bolster the specification with additional useful disclosure materials to rely upon during prosecution of their patent application or enforcement of the resulting patent, if needed. However, such materials become part of the record in their entirety and any potentially limiting statements or inconsistent terminology contained therein can be used to limit the claim scope or challenge patentability or validity of the claims altogether later on.

A recent Federal Circuit case, *Finjan LLC v. ESET LLC et al.*, involving a district court’s construction of the term “downloadable” illustrates this scenario. In 2017, Finjan held multiple patents claiming systems and methods for detecting computer viruses in a “downloadable” security profile. At the time, anti-virus software was utilized as a cybersecurity tool. While that technology

is not outdated, several advanced methods of cybersecurity controls, beyond anti-virus, are considered industry standard, such as EDR and SIEM. However, technology advancements tend to outpace the progression of civil litigation, therefore this recent decision relates to earlier iterations of cybersecurity tools.

Finjan asserted five of those patents against ESET, all of which are derived from a common parent patent. Each of the patents within the family used extensive incorporation by reference, such that every patent provided a different definition of the term “downloadable.” The accused infringer, ESET was founded in 1992 in present-day Slovakia to develop and commercialize anti-virus software, called NOD. Before Finjan was even founded, ESET’s NOD anti-virus program used heuristic algorithms⁶ to conduct behavioral analysis of files in search of potentially malicious software.

In 1997, when Finjan first filed its patent application, the application defined “downloadables” as applets or other small downloadable programs. As technology advanced and downloadables became larger, subsequent patent applications in the family tree no longer defined “downloadables” as small programs.

After assessing how a skilled artisan, reading the asserted Finjan patents, would have understood the term downloadable, the district court concluded that a “downloadable” is “a small executable or interpretable application program which is downloaded from a source computer and run on a destination computer.”

Finjan challenged the district court’s narrow construction of “downloadable” as limited to small downloadables. Finjan argued the first incorporated patent should not restrict the meaning of the disputed term to the remaining patent family. Accordingly, Finjan sought to correct the district court construction restricting downloadables to small programs.

⁵ Jessica advises her clients in all aspects of business counsel and disputes, with a particular focus on data privacy, cybersecurity and intellectual property. Jessica is chair of the firm’s cybersecurity and data privacy practice and a Certified Information Privacy Professional/United States (CIPP/US) through the ANSI-accredited International Association of Privacy Professionals.

⁶ Heuristic algorithms are procedures designed to solve a problem faster, more efficiently than traditional methods by sacrificing accuracy, precision, or completeness for speed.

On appeal, the Federal Circuit agreed with *Finjan*, stating “the use of a restrictive term in an earlier application does not reinstate that term in a later patent that purposely deletes the term, even if the earlier patent is incorporated by reference.” The Court further noted that the later patents, not containing a size requirement, can refer to application programs of all sizes, including, but not limited to “small” programs. As such, the Court found “[T]hese two definitions can exist in harmony within the patent family.”

As a result, The Federal Circuit reversed the district court construction and determined that “downloadable” should be defined as “an executable or interpretable application program, which is downloaded from a source computer and run on a destination computer.” The Federal Circuit then remanded the case for further proceedings consistent with such definition

The *Finjan* case highlights the need for consistent use and understanding of the scope of relevant technical terms in an evolving, technologically advanced sector like information technology in general, and cybersecurity and data privacy in particular. More generally, this case reminds us that while incorporation by reference is a valuable and efficient drafting tool, it should only be used with caution and understanding of what is being so incorporated. In fact, oftentimes it is sufficient to explicitly include just a relevant portion of the supporting prior document in question without the wholesale incorporation

Certainly, the patent holder was fortunate that the Federal Circuit did not restrict the definition of downloadable to only include “small downloadables” but that was a risk avoided, and one to keep in mind when drafting patent applications in this fast-paced cybersecurity arena. This issue is of particular focus for our intellectual property and technology attorneys working in Bond’s [cybersecurity and data privacy practice](#). We know the terminology and therefore have the ability to properly protect the inventions in this space.



PATENTS

Revisiting the Quid Pro Quo Bargain of the U.S.

Patent System: *Amgen Inc. v Sanofi* (Docket No. 21-757; cert. granted on November 3, 2022)

By: *Amanda Rosenfield Lippes*⁷

Background and History

Amgen’s patents relate to treatment of high cholesterol and focus on antibodies that bind to a naturally occurring protein, namely, the proprotein convertase subtilisin/kexin type 9 (PCSK9) protein. This binding prevents PCSK9 from binding to LDL receptors and in effect allows LDL receptors to continue regulating the amount of circulating LDL cholesterol in the blood stream. If left unblocked, the PCSK9 protein interacts with LDL receptors and prevents LDL receptors from clearing the bad cholesterol that can lead to heart disease and strokes. When Amgen attempted to enforce these patents against competitors, the District Court found them invalid, and the Court of Appeals for the Federal Circuit (Federal Circuit) affirmed. Amgen appealed to the Supreme Court and the Justices agreed to intervene.

At the heart of the review by the Supreme Court is the enablement requirement, which comes from 35 U.S.C. §112(a) prescribing that a patent’s specification contains “a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.” It has long been established that this statutory requirement dictates that a specification contain sufficient disclosure to “teach a skilled person how to make and use the full scope of the claimed invention without undue experimentation.” *Genentech, Inc.*

⁷ Amanda is a registered U.S. Patent and Trademark attorney. She represents clients, from startups to multinational corporations, in all phases of patent and trademark prosecution. Amanda also assists clients with patentability assessment, validity/freedom-to-operate analysis and portfolio management.

v. Novo Nordisk A/S, 108 F.3d 1361, 1365 (Fed. Cir. 1997) and, up until this case, this requirement has been reviewed by the Supreme Court only once in the current law's 70-year history.

It is the essence of the quid pro quo bargain between the inventor and the government where a temporary right to exclude others from making or using the invention is granted to the inventor in exchange for the enabling description of their invention. The enablement requirement naturally impacts how an application is drafted yet it can also affect the validity of an already issued patent. This is what happened in this case.

Sanofi and Regeneron (collectively Sanofi) developed and pursued one type of PCSK9 inhibitors and Amgen independently developed and pursued different PCSK9 inhibitors around the same time. After Amgen obtained two patents covering their cholesterol medication Repatha®, they sued Sanofi in 2014, alleging that Sanofi's competing PCSK9 antibody product infringed Amgen's patents. Crucially, the claims of Amgen's patents define their PCSK9 inhibitor antibodies by their functions (i.e., binding to sites (residues) on the PCSK9 protein and blocking the PCSK9/LDLR interaction) rather than the structures of the antibodies⁸. Amgen's patent applications support the claims by describing the structures of 26 example antibodies that perform the claimed functions. Their applications also provide guidance on how to make the antibodies using anchor antibodies and well-known screening techniques.

Before reaching the Supreme Court, the *Amgen v. Sanofi* case had a long litigation history, including two jury trials and two appeals to the Federal Circuit. After the second trial, the jury once again found that Amgen's claims were not invalid for lack of enablement and insufficient written description. But, in a post-trial decision, the district court judge granted Sanofi's motion for

judgment as a matter of law (JMOL), finding the patents invalid for a lack of enablement, and the Federal Circuit affirmed.

The Federal Circuit Decision on Appeal to the Supreme Court

"To prove that a claim is invalid for lack of enablement, a challenger must show by clear and convincing evidence that a person of ordinary skill in the art would not be able to practice the claimed invention without 'undue experimentation.'" (*Alcon Research*, 745 F.3d at 1188 (quoting *In re Wands*, 858 F.2d 731, 736-37 (Fed. Cir. 1988)). *In re Wands* sets out the eight (8) factors that a court may consider when determining whether the amount of experimentation is either "undue" or sufficiently routine such that an ordinarily skilled person in the art would reasonably be expected to carry it out.⁹

In its decision, the Federal Circuit focused on four (4) of the *Wands* factors, namely, *Breadth of the Claims*, *Predictability or Unpredictability of the Art*, *Amount of Direction or Guidance Presented*, and *Quantity of Experimentation Necessary* as further described below.

Breadth of the Claims – The Federal Circuit agreed with the District Court that the scope of the claims was "indisputably broad" focusing on the "functional diversity" of the claims rather than the exact number of embodiments.

Predictability or Unpredictability of the Art – The Federal Circuit agreed with the District Court that the claimed invention is in an unpredictable field of science "with respect to satisfying the full scope of the functional limitations." Specifically, the Federal Circuit focused on the concession of one of Amgen's experts that "substitutions in the amino acid sequence of an antibody can affect the antibody's function, and testing would be required to ensure that a substitution does not alter the binding and blocking functions [claimed]."

⁸ The representative claims at issue recite the following functional limitations:

1. An isolated monoclonal antibody, wherein, when bound to PCSK9, the monoclonal antibody binds to at least one of the following residues [a list of 15 amino acid residues], and wherein the monoclonal antibody blocks binding of PCSK9 to [LDL receptors]

⁹ *Wands* factors include: (1) Quantity of Experimentation Necessary; (2) Amount of Direction or Guidance Presented; (3) Presence or Absence of Working Examples; (4) Nature of the Invention; (5) State of the Prior Art; (6) Relative Skill of Those in the Art; (7) Predictability or Unpredictability of the Art; and (8) Breadth of the Claims.

Amount of Direction or Guidance Presented –

The Federal Circuit also agreed with the District Court that “[a]fter considering the disclosed roadmap in light of the unpredictability of the art, any reasonable factfinder would conclude that the patent does not provide significant guidance or direction to a person of ordinary skill in the art for the full scope of the claims.”

Quantity of Experimentation Necessary –

The Federal Circuit also agreed with the District Court that the required experimentation “would take a substantial amount of time and effort” noting that the only ways for a person of ordinary skill in the art to discover undisclosed claimed embodiments would be through “trial and error, by making changes to the disclosed antibodies and then screening those antibodies for the desired binding and blocking properties’ or else ‘by discovering the antibodies *de novo*”.

The Federal Circuit found that the District Court did not err in finding that undue experimentation would be required to practice the full scope of the claims since “[t]he functional limitations are broad, the disclosed examples and guidance are narrow, and no reasonable jury could conclude under these facts that anything but ‘substantial time and effort’ would be required to reach the full scope of [the] claimed embodiments.”

Notably, in its reasoning the Federal Circuit paid specific attention to footnote 2 in the *McRO* case¹⁰ which provides: “[i]n cases involving claims that state certain structural requirements and also require performance of some function...we have explained that undue experimentation can include undue experimentation in identifying, from among the many concretely identified compounds that meet the structural requirements, the compounds that satisfy the functional requirement.”

Conclusion

The Supreme Court’s decision later this year is expected to clarify the enablement standard as it applies to genus claims with functional limitations,

namely

- whether enablement is governed by the statutory requirement that the specification teach those skilled in the art to “make and use” the claimed invention, or whether it must instead enable those skilled in the art “to reach the full scope of claimed embodiments” without undue experimentation—i.e., to cumulatively identify and make all or nearly all embodiments of the invention without substantial “time and effort.”

The crux of the issue is the balance between the scope of genus claims and their blocking effect and the patentee’s requirement to properly enable others to make and use the claimed invention. Some believe if the Federal Circuit’s opinion is affirmed, such a heightened “full scope of the claimed embodiments” standard would place a difficult, if not unworkable, burden on applicants when drafting patent applications not only in life sciences field, but also in other technological areas. Such full scope enablement of genus claims would require applicants to identify and describe every embodiment that falls within the scope of the claims, thus requiring to disclose and enable the entire claimed genus. A contrary view is that the heightened standard may appropriately invalidate patents with improper overbroad claiming. According to this viewpoint, in this case, Amgen impermissibly claims an entire genus via functional limitations when the specification only supports a narrower scope of antibodies within the genus.

Until further clarification is provided from the Supreme Court, we offer the following take-aways:

1. When drafting claims, their scope must be matched by the scope of the specification and, if feasible, some subgenus claims and species claims with sufficient degree of enablement should be included.
2. Be sure to evaluate whether the claim scope as supported by the specification is worth pursuing before divulging the details necessary for the *quid pro quo* of the patent system.

¹⁰ *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 959 F.3d 1091, 1100 (Fed. Cir. 2020)

3. When claiming inventions with functional limitations, stay within the bounds of § 112(f). In that context, broad functional limitations are interpreted to cover only those means that are equivalent to the actual means shown and/or described in the specification. While narrower in scope, these claim limitations avoid the risk of invalidation which is present for functional claim limitations outside the boundaries of § 112(f).



PATENTS

Subject Matter Eligibility Updates: The Federal Circuit Continues to Offer Insight Into Crafting Patent Applications

By: *Brendan Goodwine*¹¹

Since the Supreme Court decided *Alice Corp. v. CLS Bank Int'l* in 2014, concerns surrounding the patentability of software and related information technologies have plagued applicants and patent practitioners alike. In its immediate aftermath, legal experts questioned whether certain computer-related inventions would ever been considered patentable again. The framework established by *Alice* certainly imposed a stricter standard for determining patent eligibility for these inventions and made it more challenging for some inventors to obtain or successfully enforce patents for their computer-related inventions. However, over the past next nine years, we have seen the U.S. Patent and Trademark Office issue informative guidance on subject matter eligibility and have even gained some significant guidepost decisions from the Court of Appeals for the Federal Circuit (e.g., *DDR Holdings, LLC v. Hotels.com*, *Enfish, LLC v. Microsoft Corp.*, *Bascom Global Internet Servs, Inc. v. AT&T Mobility LLC*, *McRO, Inc. v. Bandai Namco Games America Inc.*, etc.).

In 2022, we continued to see the Court of Appeals for the Federal Circuit take up questions related to subject matter eligibility and provide insight into crafting patent claims that avoid the pitfalls created in the wake of the *Alice* decision. In the cases discussed here, the Federal Circuit found two more inventions that have survived the § 101 analysis under the framework established by *Alice*.

Cooperative Entertainment, Inc. v. Kollektive Tech., Inc.

Our first case is *Cooperative Entertainment, Inc. v. Kollektive Tech., Inc.*, which came to the Federal Circuit from the Northern District of California where Cooperative Entertainment, Inc. (“Cooperative”) sued Kollektive Technology, Inc. (“Kollektive”) over U.S. Patent No. 9,432,452 entitled “Systems and Methods for Dynamic Networked Peer-to-Peer Content Distribution.” The ’452 patent was originally filed as a U.S. provisional application on September 10, 2012. At the time, Netflix and other early streaming services were expanding across the global, and the inventors of the ’452 patent recognized that cheaply and seamlessly delivering digital content was becoming increasingly difficult with the explosion of devices that consume such content. While some peer-to-peer (P2P) file sharing solutions had already been developed, these P2P networks were static that received content from a centralized content delivery network hub and could not handle file sizes necessary for video streaming, for example.

As a result, the inventors of the ’452 patent developed dynamic P2P networks that exist outside of the “top down,” static, controlled structure of a content delivery network. According to Cooperative, the inventive solution of the ’452 patent “more fully opens network capacity by offloading digital content distribution to the decentralized P2P network” where “digital content could be seamlessly distributed in full” among peers.

Claim 1 of the ’452 patent was identified as being representative:

1. A system for virtualized computing peer-based content sharing comprising:

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- at least one content delivery server computer constructed and configured for electrical connection and communication via at least one communications network; and
- at least one peer-to-peer (P2P) dynamic network including a multiplicity of peer nodes, wherein the multiplicity of peer nodes consume the same content within a predetermined time, wherein the multiplicity of peer nodes are constructed and configured for electronic communication over the at least one P2P dynamic network, wherein the at least one P2P dynamic network is based on at least one trace route; wherein the multiplicity of peer nodes is distributed outside controlled networks and/or content distribution networks (CDNs) that are included within the at least one communications network;
- wherein the at least one content delivery server computer is operable to store viewer information, check content request, use the trace route to segment requested content, find peers, and return client-block pairs;
- wherein distribution of P2P content delivery over the at least one P2P dynamic network is based on content segmentation;
- wherein content segmentation is based on CDN address resolution, trace route to CDN and P2P server manager, dynamic feedback from peers reporting traffic rates between individual peer and its neighbors, round-robin and other server side scheduling/resource allocation techniques.

Unsurprisingly, Kollektive challenged the patent eligibility of the '452 patent, arguing that the claims of the '452 patent were not directed to patent eligible subject matter. The district court agreed with Kollektive, but Cooperative appealed to the Federal Circuit. The Federal Circuit took Cooperative's side and decided (for now) to revive the '452 patent and Cooperative's patent infringement lawsuit against Kollektive.

For the Federal Circuit, what saved Cooperative and the '452 patent was two potential inventive concepts that were outlined in the infringement complaint and supported by the specification:

At Alice step two, the district court characterized the '452 patent as “merely implement[ing] the abstract idea of preparing and transmitting data over a computer network with generic computer components using conventional technology.” Kollektive, 544 F. Supp. 3d at 900. Cooperative argues the district court erred because, inter alia, its amended complaint plausibly alleges that the '452 patent claims recite inventive concepts at Alice step two, precluding dismissal. See Appellant's Br. 3-17, 38-46. **We**

agree. Claim 1 contains several alleged inventive concepts which the specification touts as specific improvements in the distribution of data compared to the prior art. The amended complaint plausibly alleges these inventive concepts, and this should have defeated Kollektive's Rule 12(b)(6) motion in this case.

Cooperative Entertainment, 50 F.4th 127, 131 (Fed. Cir. 2022)

The first inventive concept highlighted by Cooperative and the Federal Circuit is “the required dynamic P2P network wherein multiple peer nodes consume the same content and are configured to communicate outside the CDNs.” The second inventive concept highlighted by Cooperative and the Federal Circuit “requires trace routes be used in content segmentation.” According to Cooperative, these are features of a specific technical solution that improves the performance of the content delivery network with **reductions in cost** and **improvements in several aspects of system performance**. These allegations were supported by the written description of the '452 patent, which explains how the specific network structure is arranged and how it provides the alleged benefits. These features were also identified in the examiner's statement of reason of allowance during prosecution.

Thus, with support in the intrinsic record and the proper allegations in the patent infringement complaint, the Federal Circuit found it possible that the claims of the '452 patent recited patent eligible subject matter.

TAKEAWAY

While inventors should feel some optimism about pursuing computer-related patent applications, they should take care to carefully consider what features may be considered an “inventive concept.” They should collaborate with their patent counsel to consider how best to articulate these inventive concepts in the written description, including whether to discuss any differences with the prior art.

Weisner v. Google LLC

Our second case is *Weisner v. Google LLC*, which came to the Federal Circuit from the Southern District of New York where Sholem Weisner (Mr. Weisner)—a named inventor of U.S. Patent Nos. 10,380,202, 10,642,910, 10,394,905, and 10,642,911—sued Google LLC (Google) for patent infringement. These patents share a common specification that dates back all the way to March and June of 2007, which Mr. Weisner describes as a time when “the internet was growing explosively” and “[m]obile phones were increasingly popular, but the modern smart phone was not yet commercialized.” According to Mr. Weisner, search engines did a poor job of tailoring search results to the individual performing the search, often ranking results based on the website’s popularity. In contrast, the inventors of the patents-at-issue sought to “ensure that an individual’s cyber-search would be informed by both that individual’s real-world experience and the real-world experiences of others, not just internet clicks.” Thus, according to Mr. Weisner, the problem addressed by the patents is how to pair digital and real-world interactions (e.g., visiting a business or meeting another person).

Of course, Google challenged the patent eligibility of the patents-at-issue, arguing that the various claims were not directed to patent eligible subject matter. The district court agreed, and Mr. Weisner appealed to the Federal Circuit. Interestingly, the Federal Circuit agreed with Google on two of the patents-at-issue (the ’202 patent and the ’910 patent), but then sided with Mr. Weisner on the other two patents-at-issue (the ’905 patent and the ’911 patent).

Claim 1 of the ’202 patent was identified as being representative of the patents-at-issue covering **ineligible** subject matter:

1. A method of creating and/or using physical location histories, comprising:
 - maintaining a processing system that is connected to a telecommunications *1078 network and configured to provide an account to an individual member and to a stationary vendor member of a member network;
 - providing an application that configures a handheld mobile communication device of each individual member of a

member network to, upon instances of a physical encounter between the individual member and the stationary vendor member of a plurality of stationary vendor members of the member network at a physical premises of the stationary vendor member, a location of the physical encounter determined by a positioning system in communication with either the handheld mobile communication device or a communication device of the stationary vendor member, and upon acceptance by the handheld mobile communication device of the individual member of an automatic proposal from the stationary vendor member, transmit a URL of the stationary vendor member and a URL of the individual member to the processing system automatically, thereby generating a location history entry, in at least the account of the individual member, that includes (i) the URL of, and a location of, the stationary vendor member, (ii) a time and date of the physical encounter, and (iii) an identity or the account of the individual member and of the stationary vendor member,

- the URL of the individual member associated with the individual member before the physical encounter between the individual member and the stationary vendor member;
- the application maintaining a viewable physical encounter history on the handheld mobile communication device that includes URLs from multiple stationary vendor members and is searchable from the handheld mobile communication device (i) by URL of the individual member and of the stationary vendor member, (ii) by geographic location, and (iii) by time of the physical encounter,
- maintaining, using the processing system, a database of physical encounter histories of members of the member network whose accounts received the location history entry that was generated during the physical encounters, the individual member’s account having data transfer privileges that allow the physical encounter history to be accumulated through transmission of location history entries from multiple handheld mobile communication devices of the individual member over time; and
- wherein the physical encounter history of a particular individual member includes at least one visual timeline of physical encounters of the particular individual member.

Claim 1 of the ’911 patent was identified as being representative of the ’911 patent and covering patent **eligible** subject matter:

1. A computer-implemented method of enhancing digital search results for a business in a target geographic area using URLs of location histories, comprising:
 - providing, by at least one processing system in communication with a positioning system, an account to (i) an individual member and (ii) a stationary vendor member, of a member network, the account associated with a URL, the individual member’s account associated with a mobile communication device or multiple mobile communication devices,
 - maintaining a communication link between the mobile communication device and the at least one processing system or the positioning system such that the mobile communication device is configured to accumulate a location history on a database maintained by the at least

one processing system from physical encounters by the individual member at multiple stationary vendor members upon the mobile communication device being set to enter instances of a physical encounter between the individual member carrying the mobile communication device and the stationary vendor member at a physical premises of the stationary vendor member, the positioning system determining a location of the individual member at the physical premises;

- for each individual member having a location history who sends a search query to a search engine of the at least one processing system, the search query targeting a geographic area:
 - » (1) searching, by the search engine, the database for URLs of stationary vendor members in the location history, the location history also identifying time and geographic place of the physical encounters therein, and
 - » (2) assigning a priority, by the at least one processing system, in a search result ranking based on an appearance of one of the stationary vendor member URLs in the location history of the individual member, wherein that one of the URLs is of a particular stationary vendor member located in the target geographic area.

Claim 1 of the '905 patent was identified as being representative of the '905 patent and covering patent eligible subject matter:

1. A method of combining enhanced computerized searching for a target business with use of humans as physical encounter links, comprising:
 - maintaining a processing system connected to a telecommunications network;
 - providing an application that allows a handheld mobile communication device of each individual member of a member network, the device in communication with a—positioning system, upon a physical encounter between the individual member and a stationary vendor member of a plurality *1080 of stationary vendor members of the member network at a physical premises of the stationary vendor member, to transmit key data of the stationary vendor member and of the individual member to the processing system automatically as a result of the physical encounter, a location of each individual member's device determined by the positioning system, the key data being a URL or an identifier associated with the URL;
 - maintaining, using the processing system, a database of physical location histories of members of the member network whose key data was transmitted to the processing system during the physical encounters,
 - determining, by the processing system, a physical location relationship recorded in the database between a searching person who is a member of the member network, a reference individual member of the member network and a first stationary vendor member of the plurality of stationary vendor members, upon the searching person making a search query on a search engine having access to the processing system; and
 - responding to the search query by generating a computerized search result that increases a ranking of the first stationary

vendor member based on the physical location relationship wherein the relationship is as follows:

- » (a) the reference individual member's physical location history includes key data of the first stationary vendor member; and
- » (b) the searching person's physical location history and the reference individual member's physical location history each include key data of a second stationary vendor member of the plurality of stationary vendor members,
- wherein the searching person's physical location relationship to the first stationary vendor member is such that the searching person has a physical location relationship with the second stationary vendor member who has a physical location relationship with the reference individual member who has a physical location relationship with the first stationary vendor member.

Although the patents share a common specification, the Federal Circuit noted that the claims of the patents were “meaningfully different in their focus.” In this case, what saved the '905 patent and the '911 patent was “the claims’ specificity as to the mechanism through which they achieve improved search results (through a ‘location relationship’ with a ‘reference individual’ for the '905 patent or through the ‘location history of the individual member’ who is running the search in a targeted ‘geographic area’ for the '911 patent).”

Because the claims recited “more than just the concept of improving a web search using location history” because they describe “a specific implementation of that concept” which “is also alleged to solve a problem particular to the Internet.” Mr. Weiner’s complaint asserts these features and explains how it provides an improvement over the conventional method. These features are also supported by the specification, which “emphasizes that conventional web searches have a problem of returning voluminous, generic, non-personalized search results” and that “[t]he solution, according to the specification, is an ‘improved method of searching the world wide web . . . that makes use of digital histories.’” Thus, the Federal Circuit concluded that “the record supports that the claims plausibly provide a solution to an Internet-centric problem regarding web searches, allowing for more personalized search results than conventional methods.

In contrast, what doomed the claims of the '202 patent and the '910 patent was the lack of a

specific application of the use of digital histories. For example, the Federal Circuit noted that the claims on their face were “directed to creating a digital travel log” which was commonly done by humans using pen and paper. The Federal Circuit reaffirmed that “[a]utomation or digitization of a conventional method of organizing human activity like the creation of a travel log on a computer does not bring the claimed out of the realm of abstractness.” Although Mr. Weiner had argued that the claims of these two patents provided certain technological advantages that improve the integrity of the information collected and avoids an inundation of data, the Federal Circuit determined these advantages to be mere attorney arguments because they were missing from the complaint and the intrinsic record (i.e., the specification).

Thus, the *Weisner* case provides an interesting example of where a common specification supported the eligibility of the claims of the '905 and the '911 patents but failed to support the eligibility of the claims of the '202 and the '910 patent.

PRACTICE TIP

When drafting new patent applications, patent practitioners should consider whether the claims arguably recite automating an allegedly conventional human activity. As the Federal Circuit reaffirmed, the “[a]utomation or digitization of a conventional method of organizing human activity like the creation of a travel long on a computer does not bring the claims out of the realm of abstractness.”

TAKEAWAY

When evaluating invention disclosures for potential new patent filings, applicants should be aware that inventions involving collecting information for later use is likely to be problematic under § 101 in light of at least *Weisner v. Google*. However, this case may be useful support if your claims include steps or features that incorporating using the information to address a specific technical problem in a meaningful way.

Conclusion

The *Cooperative* case illustrates the need for a clear and consistent rationale linking the inventive concepts of a patent with a complaint alleging patent infringement. Without building those links between the intrinsic record and the complaint, the entire patent infringement lawsuit may be at-risk to an early challenge to the eligibility of the asserted claims.

The *Weisner* case highlights how essential it is for patent practitioners to carefully consider the level of specificity included in the claims and the written description, especially if those features relate to an inventive concept of the subject matter. If § 101 is a potential concern given the pertinent technical field of a new application, patent practitioners are justified in introducing additional specificity in order to craft patent claims that can survive an early challenge to the eligibility of the claims.

Bond attorneys regularly assist and advise clients on an array of intellectual property matters and are skilled in navigating the nuances of drafting patent applications and litigating patents in a variety of technical fields. If you have any questions about the information presented in this article, please contact the author or any attorney in Bond's [intellectual property practice](#).

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