



IDEAS ON INTELLECTUAL PROPERTY LAW



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Fore!

Court takes swing at printed publications as bars to patentability

The Federal Patent Act prohibits the patenting of an invention that was described in a printed publication more than one year before its patent application is filed. But what qualifies as a “printed publication”? The U.S. Court of Appeals for the Federal Circuit recently considered this question in the case of *In re Lister*.



Teeing off

Richard Lister is a golfer who grew frustrated with the slow pace of the game. He developed a method of playing golf that allowed players to tee up every shot except those from designated hazard areas and putting greens. He described the method in a manuscript titled “Advanced Handicap Alternatives for Golf.”

Lister submitted the manuscript to the U.S. Copyright Office on July 4, 1994, and obtained a certificate of registration on July 18, 1994. He subsequently learned that he actually needed a patent, not a copyright. Lister filed a patent application on Aug. 5, 1996. After several rounds with the patent examiner and the Board of Patent Appeals and Interferences, the Board ultimately affirmed rejection of the application under Section 102(b) of the Patent Act.

To qualify as a printed publication, a reference to the invention must have been sufficiently accessible to the public interested in the invention.

Reviewing the rules

Sec. 102(b) bars patentability if the invention “was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.” To qualify as a printed publication, a reference to the invention must have been sufficiently accessible to the public interested in the invention. Such a publicly accessible reference can be located and examined by persons interested and ordinarily skilled in the subject matter exercising reasonable diligence.

On appeal, Lister argued that his manuscript wasn’t sufficiently available for inspection. He further argued that the manuscript did not qualify as a printed publication as of the critical date — one year

before the filing of his patent application — because no evidence indicated it was included in a catalog or index at that time that would have allowed an interested party to locate it.

Approaching the green

The court quickly concluded that Lister’s manuscript was indeed sufficiently publicly available for inspection at the Copyright Office, but availability did not end the inquiry. The court also considered whether anyone would have been able to learn of the manuscript’s existence and potential relevance before the critical date.

The manuscript was included in three databases — the Copyright Office’s automated catalog and two commercial databases. The latter, Westlaw and Dialog, obtain the automated catalog data and enter it into their own databases. The automated catalog wasn’t sorted by subject matter and was searchable only by the author’s last name (for example, “Lister”) or the first word of the work’s title (for instance, “Advanced”). Users of the commercial databases, however, could perform keyword searches of the titles, but not the full texts, of works.

Lister contended that none of the databases indexed or cataloged the manuscript in a “meaningful way” that would allow a researcher to locate it. The court, however, found that the question was not whether an individual, selecting terms from the patent claim language, could execute a single keyword search that would yield all relevant references. The proper inquiry was whether the reference at issue could be located by persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence.

The court determined that a reasonably diligent researcher would have conducted keyword searches for a combination of “golf” and “handicap,” making the manuscript publicly accessible as of the date it was included in either commercial database. The court, however, found that the government failed to meet its burden of showing that the manuscript was, in fact, in either database more than a year prior to the filing date of the patent application.

3 previous cases considered by the court

In the case of *In re Lister* (see main article), the U.S. Court of Appeals for the Federal Circuit considered three previous decisions that addressed whether references stored in libraries were publicly accessible:

1. *In re Hall*. In this case, the court held that a dissertation shelved in the stacks and indexed in the catalog at a university library was a printed publication.

2. *In re Bayer*. Here the court found that a thesis was not publicly accessible as of the critical date because it was uncataloged and unshelved.

3. *In re Cronyn*. In this decision, the court noted the discrepancy in accessibility between the references in *Hall* and *Bayer*. It considered a thesis housed in the main campus library and the chemistry department library at a college. Each library contained a collection of student theses and a set of index cards that listed only the title and author of each thesis. The court held the theses were not publicly accessible because they weren’t cataloged or indexed in a meaningful way.

Specifically, the government did not provide any evidence of the typical time that elapses between copyright registration, inclusion in the Copyright Office’s automated catalog and subsequent incorporation into the commercial databases.

Getting a mulligan

The court held that the record didn’t contain sufficient evidence that the manuscript was publicly accessible as of the critical date. It vacated the Board’s decision and remanded for further proceedings, providing Lister with another shot at a patent. ○

Who's your daddy?

Patent inventorship often turns on time of conception

The world of academic research sometimes seems like a soap opera — with researchers regularly forming, pursuing and ending relationships with various schools and projects. A recent case, *University of Pittsburgh v. Hedrick*, shows how researchers' interactions, like those in a soap opera, can lead to questions about conception.

A matter of biology

University of Pittsburgh researchers Adam Katz and Ramone Llull studied fat tissue. In 1997, they began exploring the idea that mature fat cells could be converted into bone, cartilage and muscle. They recorded their observations in laboratory notebooks, a January 1997 invention disclosure and a February 1997 document titled "What's So Great About Fat?"

Marc Hedrick joined the lab in July 1997 for a year-long fellowship. While Hedrick was at the lab, Katz

submitted a grant proposal. In the proposal other researchers were listed but Hedrick wasn't. Hedrick also was not listed in Katz's lab notebook — even though other researchers were. After his fellowship ended, Hedrick returned to the University of California-Los Angeles (UCLA) and worked with two colleagues on the same type of fat-derived stem cells being studied by Katz and Llull.

Following applications by the University of Pittsburgh, a patent was issued for a method of converting stem cells derived from fat into bone, fat, cartilage and muscle. The listed inventors included Katz and Llull as well as Hedrick and his colleagues. In October 2004, the University filed an action seeking removal of all inventors except Katz and Llull, arguing that Katz and Llull had completed conception of the invention before the other researchers contributed their efforts.



The conception question

The U.S. Court of Appeals for the Federal Circuit explained that the inventors named in a patent are presumed correct. A party seeking the removal of inventors must show that those inventors did not contribute to the invention of any of the patent claims.

Conception is the “touchstone” of invention. The court defined conception as “the formation in the mind of the inventor of a definite and permanent idea of the complete operative invention, as it is hereafter to be applied in practice.” The test for conception is whether the inventor’s idea was definite and permanent enough that one skilled in the art could understand the invention. An inventor must establish his or her conception by corroborating evidence, preferably in the form of contemporaneous disclosures.

The court emphasized that, to accomplish conception, an inventor isn’t required to know that his or her invention will work. It is sufficient that the inventor has the complete mental picture and could describe it with particularity.

An ill-conceived argument

The UCLA researchers argued that Katz and Llull’s research was inconclusive until they added their efforts. They asserted that Katz and Llull were required to know that the invention contained every limitation of each patent claim at the time of conception.

The court disagreed. It concluded that Katz and Llull conceived each patent claim through contemporaneous corroboration before Hedrick arrived in Pittsburgh in July 1997. Specifically, the court stated, “[B]ecause ... Katz and Llull had formed a definite and permanent idea of the cells’ inventive qualities, and had in fact observed them, it is immaterial that their knowledge was not scientifically certain and that the [UCLA] researchers helped them gain such scientific certainty.”

All contributions aren’t equal

The court’s decision makes clear that not every contribution to an invention is equal. Therefore, not every contributor will qualify as an inventor — even if scientific certainty did not exist before his or her contributions. ○

Connecting the dot-coms in a trademark dispute

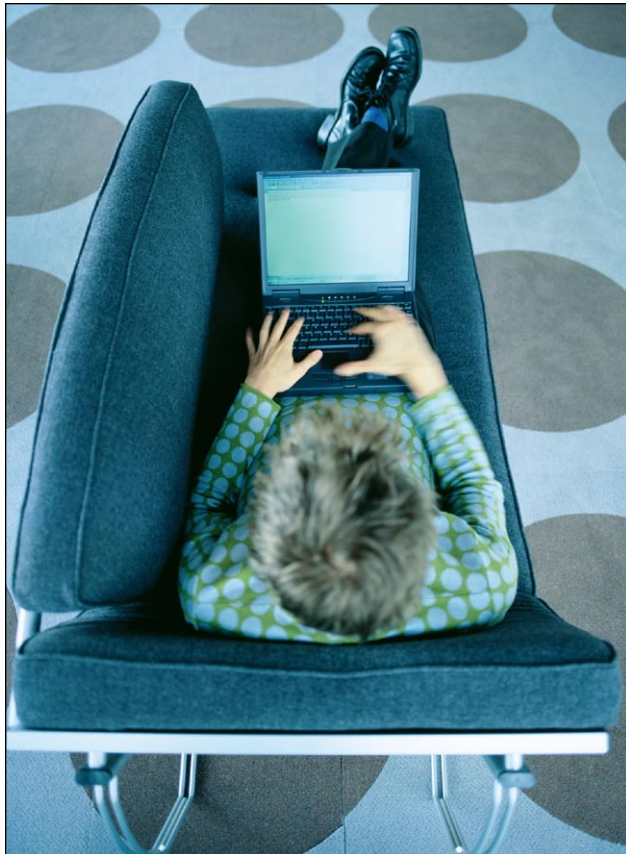
It’s well established that generic terms aren’t eligible for protection as trademarks or service marks. Some marketers, however, might try to bypass that problem by adding the suffix “.com” to an otherwise generic term in hopes of transforming it into a protectable brand name. The U.S. Court of Appeals for the Federal Circuit squared off with such a party in the case *In re HOTELS.COM*.

The complaint is lodged

Hotels.com LP applied to register the mark “HOTELS.COM” for the services of “providing information for others about temporary lodging [and] travel agency

services, namely making reservations and bookings for temporary lodging for others by means of telephone and the global computer network.” The Trademark Trial and Appeal Board affirmed the refusal to register the mark on the ground that the mark is a generic term for hotel information and reservations.

On appeal, the applicant claimed that the dot-com component of the mark negates the generic nature of the word “hotels.” Viewed in its entirety, the applicant urged, the mark isn’t a generic name but a source indicator of the applicant’s services.



The Board's reservations

The Board pointed to various other Web sites that provide information about hotels and reservations to show that such sites are referred to as "hotel information sites" and "hotel reservation sites."

It listed several sites that combine "hotels" and ".com," such as all-hotels.com ("hotels, travel, discount hotels — reservations and lodgings") and web-hotels.com ("hotel reservations and bookings"). In the Board's view, this evidence demonstrated a competitive need for others to use the terms as part of their own domain names and trademarks, supporting the finding that "hotels" indicates the generic genus of hotel information and reservation services.

In the context of *HOTELS.COM*, the Board found that the word "hotels" names a key aspect of the applicant's services and concluded that "HOTELS.COM" is properly seen in the same way and as having the same meaning as "hotels" alone. The combination "HOTELS.COM," it said, "communicates no more than the common meanings of the individual components; that is, that the applicant operates

a commercial Web site via the Internet, that provides information about hotels, but adds nothing as an indication of source."

The court checks in

The Federal Circuit held that the Board didn't err in evaluating the generic nature of "hotels" separate from ".com." It agreed that, for the mark at issue, the generic term "hotels" didn't shed its generic character merely by inclusion of the .COM component. The applicant presented rebuttal evidence intended to show "HOTELS.COM" is perceived as a brand indicating a single source. In a survey, for instance, 76% of respondents regarded the mark as a brand name.

The Federal Circuit, though, found that the Board could reasonably have given controlling weight to the large number of similar usages of "hotels" with ".com," as well as the common meaning and dictionary definition of "hotels" and the standard usage of ".com." Thus, ultimately, the court ruled that the Board's finding that "HOTELS.COM" is generic was supported by substantial evidence.

The Federal Circuit looked into whether, for the mark at issue, the generic term "hotels" shed its generic character merely by inclusion of the .COM component.

Future results

This case shows that trademark protection can't be obtained for an inherently generic mark — even when evidence shows that the mark is commonly perceived as a brand. And the result in *HOTELS.COM* is likely to be the same for future attempts to trademark the combination of a generic word and ".com." ○

Court tackles tricky issue of tacking trademark rights

When trademark rights are contested, a party might turn to “tacking” to establish that it made first use of the mark and thereby has senior rights to that mark. Tacking allows a trademark owner to claim priority in a mark based on the first use date of a similar, but technically distinct, mark.

Courts, however, don’t always buy into this strategy; tacking is allowed in only extremely narrow instances. The Ninth U.S. Circuit Court of Appeals recently tackled the tricky issue of tacking in *One Industries, LLC v. Jim O’Neal Distributing, Inc.*

Revvng their engines

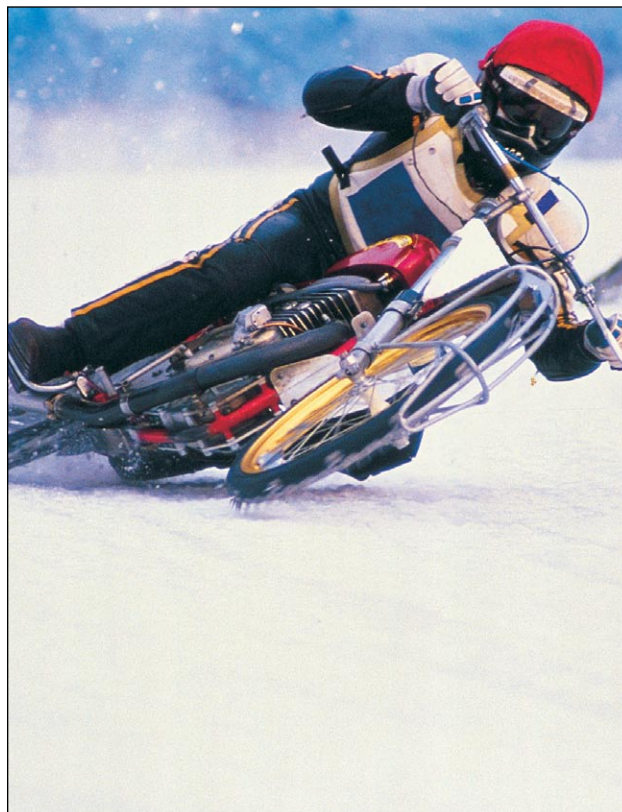
O’Neal, a leader in the motocross racing industry, began using a stylized “O” as a mark in 1991 and experimented with additional versions in 1992, 1993, 1997 and 2003. In 1999, its competitor One Industries developed and registered the “One Icon,” comprising two interlacing number “1”s that form an “O.”

When O’Neal accused One Industries of infringing its 2003 mark, One Industries countered that the One Icon, registered in 1999, was senior to the 2003 mark. On appeal, O’Neal argued that its 2003 mark should have been tacked back to an earlier version, which would establish priority.

Driving toward a decision

Because the One Icon was first used in 1999, the court focused on the O’Neal marks that were developed in 1997 (the “Rounded O’ mark”) and 2003 (the “Angular O’ mark”). The court noted that tacking is allowed only in narrow circumstances in which the marks create the “same, continuing commercial impression, and the later mark [does] not materially differ from or alter the character of the mark attempted to be tacked.” Here it found that O’Neal’s two marks did not satisfy the standard for tacking, because they differed in several material respects.

For example, though both consisted of a stylized “O” followed by an apostrophe, the apostrophes were markedly different. In the 1997 mark, the apostrophe was entirely separate from the “O” and appeared as a standard apostrophe. In the 2003 mark, the apostrophe was connected to the main image and looked like a triangle. In addition, while the 1997 mark was boxy, the 2003 mark looked like the outline of a lemon.



Crossing the finish line

The court cited cases from other circuits and from the Trademark Trial and Appeal Board confirming that tacking is allowed only if the marks are virtually identical. As the Ninth Circuit drove home, the standard for tacking is “exceedingly strict.” ○

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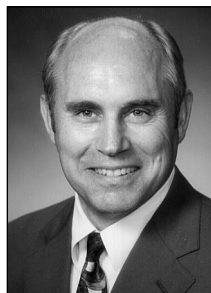
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