

UPDATE

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ONE SHOT AND YOU ARE OUT AT THE PTAB



BY SARAH A. KAGAN

Most judicial determinations come with a right to appeal, and indeed, we expect a right to appeal when we receive an unfavorable decision in any aspect of our lives. Yet the new trial proceedings at the United States Patent and Trademark Office set up by the America Invents Act (AIA) leave certain dissatisfied patent challengers without any effective recourse to appeal. Parties such as public interest organizations and hedge-fund operators are particularly affected, because they have a less direct interest in invalidating a patent than a classic patent challenger in federal court proceedings.

The AIA permits almost any party, whether or not the party has any relationship to a patent, to challenge the patent before the U.S. Patent and Trademark Office's Patent Trial and Appeal Board (PTAB). A challenger may employ procedures including post-grant reviews (PGR) and *inter partes* reviews (IPR). The AIA states that any party dissatisfied with the outcome of the PTAB trial can appeal to the U.S. Court of Appeals for the Federal Circuit. 35 U.S.C. § 319 and 35 U.S.C. § 329. These provisions are similar to those set up for pre-AIA *inter partes*

reexamination (IPRE). Pre-AIA 35 U.S.C. § 315(a), (b). Historically, appeals from the PTAB have been made to the Federal Circuit. However, the Federal Circuit cannot exercise its jurisdiction in an appeal of a PTAB decision if no case or controversy exists between the parties, according to Article III of the U.S. Constitution. The case or controversy must be actual or imminent, not conjectural or hypothetical. Thus, a third party may challenge a patent at the PTAB but may not necessarily be able to appeal an adverse decision at the Federal Circuit, despite the expansiveness of § 319 and § 329.

The Federal Circuit has already decided a handful of cases relating to permissible parties in appeals from the PTAB. It has heard oral arguments in other cases within the last few months that it will soon decide. These decisions will influence not only who will appeal PTAB decisions, but also who will bring the original actions in the PTAB, and when they will bring them.

DECIDED CASES

The handful of cases that the Federal Circuit has decided involve challengers who are not in direct competition with the patent holder.

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Such challengers have been non-profit organizations who do not themselves compete with the patent owner and a for-profit company that indirectly competed with the patent owner in the same business sector but did not compete over the same product.

NON-PRACTICING ENTITIES

Non-practicing entities are often termed “trolls” in the patent litigation context. These entities sue third parties for infringement of the non-practicing entities’ patent rights. Non-practicing entities have gotten a bad reputation because they do not commercially exploit their patent rights, but extract a royalty from parties that are commercially practicing. In the IPR context, non-practicing entities challenge others’ patents, either to clear commercial space for its members’ individual efforts, to manipulate stock prices, or to accomplish some political goal. So far, these reasons have been deemed too attenuated to permit appeal.

Consumer Watchdog v. Wisconsin Alumni Research Foundation

Consumer Watchdog tried to invalidate a patent of the Wisconsin Alumni Research Foundation using an *inter partes* reexamination. (753 F.3d 1258 (Fed. Cir. 2014)). Like the IPR statute, the reexamination statute “allowed” a third party requester to appeal adverse decisions. Nonetheless, the court found that Consumer Watchdog, a not-for-profit public charity, lacked a particularized, concrete stake in the outcome of the appeal, and thus had no Article III case or controversy with the patent owner. The court also found that the estoppel provision for *inter partes* reexaminations did not constitute injury in fact, as any injury that could result from estoppel was only conjectural or hypothetical for Consumer Watchdog as a non-practicing entity. However, the court

refrained from precluding future use of the estoppel provisions to show injury in an appropriate case.

Phigenix, Inc. v. Immunogen, Inc.

Phigenix, Inc. v. Immunogen, Inc. arose out of an IPR. (845 F.3d 1168 (Fed. Cir. 2017)). Phigenix was not a manufacturer of a product but a developer of an intellectual property portfolio. It argued that the PTAB’s failure to invalidate the patent-in-suit would increase Phigenix’s competition for licensing its own properties, constituting an actual economic injury. The appellate court held that Phigenix had not proved that it was subject to any actual or imminent injury. Moreover, it was not engaged in any activity that would give rise to a possible infringement suit, so the estoppel provision does not cause any foreseeable harm.

Personal Audio, LLC v. Electronic Frontier Foundation

The Federal Circuit in *Personal Audio, LLC v. Electronic Frontier Found.*, found that the non-practicing entity, Electronic Frontier Foundation (EFF), could participate in the appeal. (867 F.3d 1246 (Fed. Cir. 2017)). Even though EFF was a third party petitioner in an IPR, and a non-practicing entity, it was not the appellant but rather the appellee. Since the patent owner, Personal Audio, had appealed and had standing by virtue of the negative decision of the PTAB regarding its patent, Article III was satisfied. Once standing was satisfied for the party bringing the case to the court, the participation of EFF as the appellee did not offend Article III.

PRACTICING ENTITIES

Practicing entities are typically those that make, use, or sell a patented invention. If they do not own the patent at issue or have a license to it, then they are at risk of suit for

infringement. These are entities that could likely challenge a patent in district court; but because the PTAB provides a more economical and faster venue, they have chosen to use it as a venue. The questions around these parties seem to hang on just how close to qualifying as declaratory judgment plaintiffs these parties need to be.

PPG Industries, Inc. v. Valspar Sourcing, Inc. *PPG Industries, Inc. v. Valspar Sourcing, Inc.*, like *Consumer Watchdog*, arose out of an *inter partes* reexamination. (679 Fed.Appx. 1002 (Fed. Cir. 2017)). The Federal Circuit found that the third party reexamination petitioner fulfilled the Article III requirements to appeal, based on two types of evidence. First, PPG had launched a commercial enterprise (which arguably infringed the challenged patents). Second, a customer of PPG's informed it that Valspar intended to sue PPG for infringement based on that commercial enterprise. These two types of evidence provided a particularized, concrete stake in the outcome of the reexamination. The court also held that the stake was "enhanced" by the potential estoppel.¹

Altaire Pharmaceuticals, Inc. v. Paragon Biotech, Inc.

Altaire Pharmaceuticals, Inc. v. Paragon Biotech, Inc., arose as an appeal from a post grant review (PGR) decision of the PTAB. (889 F.3d 1274 (Fed. Cir. 2018)).

Altaire manufactures a phenylephrine ophthalmic solution, which Paragon exclusively markets and distributes under contract. The patent under review in the PGR, U.S. 8,859,623 ('623), issued from a patent application that was filed by Paragon. It claims a method of administering an ophthalmic composition having a certain initial chiral purity and stability, in which the ophthalmic composition is stored within a certain temperature range and has a certain chiral

purity when administered after storage. The PTAB found that Altaire had not sustained its burden to show that Paragon's patent was not patentable.

Altaire was not under immediate threat of suit by Paragon for infringement because it only sells to Paragon under the exclusive marketing and distribution contract. However, on appeal Altaire asserted that it had Article III standing based on four sources of harm: (1) its contract with Paragon expires in 2021, and may terminate even sooner if Paragon is successful in a separate district court suit, threatening Altaire's ongoing business; (2) it has concrete plans to submit an Abbreviated New Drug Application (ANDA) to the U.S. Food and Drug Administration (FDA), in response to which it expects Paragon to file suit against it for infringement; (3) if the PTAB decision is not reversed, Altaire will face potential estoppel from pursuing any claim against the '623 patent that it raised or could have raised in the PGR under 35 USC § 325(e); and (4) it suffers reputational harm because it (or one of its employees) is not named as an inventor on the '623 patent.

The Federal Circuit found Altaire had demonstrated injury based on reasons (1) and (2). The court found that the injury was imminent and not merely contingent on future possible events. It further found that estoppel (reason (3)) compounds the injury, even though estoppel on its own is not sufficient to create injury sufficient for standing.

CASE TO BE DECIDED

Momenta Pharmaceuticals, Inc. v. Bristol-Myers Squibb Co.

The Federal Circuit heard arguments on December 5 in *Momenta Pharmaceuticals, Inc. v. Bristol-Myers Squibb Co.* (No. 17-1694).

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Momenta used the IPR procedure to challenge Bristol-Myers Squibb's patent covering a formulation of ORIENCIA® (abatacept) for treating rheumatoid arthritis. Momenta failed to persuade the PTAB that Bristol-Myers Squibb's claims were obvious. Momenta appealed the decision to the Federal Circuit under 35 U.S.C. § 319.

In its Federal Circuit appeal, Momenta asserts that it suffers individualized, concrete harm sufficient to establish Article III injury in fact. It bases its position on costs incurred in developing its current drug candidate, costs it would incur should it need to alter its business plan to use a non-infringing alternative, and the estoppel provision (35 U.S.C. § 315(e)) for IPRs. Momenta urges that prior appeals from rulings of other administrative agencies found injury when an economic harm was reasonably probable or highly likely. It also cites cases where business competitors are presumed to be harmed if their competitors are benefited.

Bristol-Myers Squibb asserts that Momenta, like Consumer Watchdog and Phigenix, has not suffered a concrete and particularized injury from the PTAB's decision not to revoke the Bristol-Myers Squibb patent. Momenta has no product on the market, no product approved for the market by the FDA, and no product that has passed the three phases of clinical testing. Momenta is merely requesting an advisory opinion, Bristol-Myers Squibb asserts.

CONCLUSION

The issue of standing to appeal from a PTAB final written decision creates interesting procedural issues for the Federal Circuit. Usually the Federal Circuit functions solely as an appellate body, reviewing decisions of courts and agencies that have already weighed and sifted the evidence to determine the facts. However, appeals from the PTAB may raise issues of Article III standing that were not relevant below, and for which the record contains no evidence. The Federal Circuit must decide when the evidence will be submitted. It must also decide how and when it will consider the evidence. So far, the court has requested that challenges to standing be raised in the main brief of the party raising it, rather than holding a preliminary hearing or separate briefing.

Substantively, the court has decided two cases in which non-practicing entities failed to demonstrate standing to appeal. In two other cases, involving practicing entities, standing was found where the appellant submitted evidence of threat of suit. The case currently under consideration by the Federal Circuit will likely define whether the court will adopt a standard for PTAB appeals similar to that required for filing a declaratory judgment or perhaps some relaxed standard. ■

1. Ultimately, the appeal was dismissed as moot, and the PTAB decisions were vacated, because the patentee, Valspar, unilaterally gave PPG a Covenant Not to Sue.

BANNER & WITCOFF INTRODUCES **MYIPLAW**, AN ONLINE, INTERACTIVE OVERVIEW OF INTELLECTUAL PROPERTY LAW

As companies continue to spend valuable time and money developing new technologies and innovative products, Banner & Witcoff is offering a new online resource on how they can protect these assets.

Similar to previous hard-copy editions, MyIPLaw introduces the purpose and importance of procurement and enforcement of utility patents, design patents, trademarks, domain names, copyrights and trade secrets. These can be used alone or in combination to help companies gain an edge over their competitors, create a revenue source and enhance the value of their business.

Please visit myiplaw.com and create an account for complimentary access.

The image shows a screenshot of the MyIPLaw website interface. The website has a dark header with a menu icon, a search bar, and a 'DOWNLOAD BOOK' button. The main content area features the MyIPLaw logo and a description of the resource. Below the description are icons for various intellectual property topics: Utility Patents, Post Issuance Review, Design Patents, Trademarks, Domain Names, Copyrights, and Trade Secrets. To the right of the website screenshot is a vertical sidebar with colored boxes for each topic: Utility Patents (dark red), Post Issuance Review (red), Design Patents (orange), Trademarks (green), Domain Names (teal), Copyrights (purple), and Trade Secrets (dark purple). A circular callout points to the 'DOWNLOAD BOOK' button on the website screenshot.

UTILITY PATENTS

POST ISSUANCE REVIEW

DESIGN PATENTS

TRADEMARKS

DOMAIN NAMES

COPYRIGHTS

TRADE SECRETS

CHANGES IN THE DMCA: A GENERAL OVERVIEW



BY HEATHER R. SMITH-CARRA

Protecting online copyrighted content is critical in our increasingly digital world. The Digital Millennium Copyright

Act¹ (DMCA) was passed in 1998 to combat circumvention of technological measures put in place to protect copyrighted works. How? Through the DMCA's safe harbor provision.

The DMCA provides a "safe harbor" for service providers who, through no fault of their own, may infringe a copyrighted work, e.g., when a user uploads content, a server caches data, or a search engine includes your website.

The DMCA was created primarily as a solution for service providers, such as YouTube, that host content uploaded by third parties rather than create their own original content. How do you know if you're a service provider and can benefit from the DMCA? This article answers these questions and discusses cases where the DMCA has been applied recently.

AM I A SERVICE PROVIDER?

To qualify for protection under the DMCA, you must be a "service provider." So are you? Quite possibly. Do you provide any sort of online or network services? Do you allow users to upload or post content? Do you provide a search engine, directory, or other information location tools? If you do any of these things, you may be a service provider. Service providers often need protection from liability in the event content uploaded to their site infringes another's copyrights. As a service provider, you can take advantage of the DMCA's safe harbor provisions if you take the necessary steps.

Websites that provide electronic storage, search engines, directories, and other

information can benefit from safe harbor protections. However, service providers seeking to benefit from DMCA protections must comply with certain provisions.

HOW CAN I TAKE ADVANTAGE OF THE DMCA SAFE HARBOR PROVISION?

The "safe harbor" provision remains one of the most important aspects of the DMCA. The DMCA provides a safe harbor from copyright infringement liability for online service providers who follow certain procedures as explained below.

1. DESIGNATE AN AGENT

To qualify for safe harbor protection, service providers must designate an agent to receive notifications of claimed copyright infringement and include certain disclosures on their website.

To designate an agent, a service provider must do two things: (1) make certain contact information for the agent available to the public on its website; and (2) provide the same information to the Copyright Office, which maintains a centralized online directory of designated agent contact information for public use. The service provider must also ensure that this information is up to date, and renew the registration every three years.

Recently the Copyright Office introduced a new online registration system and service provider agent directory. The new system transitions from the paper-based system to an electronic directory. The online directory contains contact information for all designated agents, which is useful for determining the appropriate party to contact in the event of a copyright infringement. Under the new online directory, agent designations made prior to December 1,

2016, expired after December 31, 2017. Service providers must submit new electronic agent designations through the DMCA website² to benefit from safe harbor protection.

2. IMPLEMENT NOTICE AND TAKEDOWN PROCEDURES

In addition to designating an agent, service providers must adopt, reasonably implement, and inform users of a policy that provides for the termination of users who are repeat copyright infringers in certain situations. Service providers are encouraged to establish notice and takedown procedures for removing infringing content. Companies allowing third parties to post content on their websites can especially benefit from implementing notice and takedown procedures.

Notice and takedown procedures are beneficial for ensuring that takedown notifications are timely and accurately addressed. Service providers may even escape monetary liability when infringing content is promptly blocked or removed from their sites. Under the notice and takedown procedure, once a service provider is made aware of infringing content, the DMCA requires the service provider to expeditiously remove the infringing content.

The DMCA also requires that providers immediately take down infringing content. If a service provider fails to remove infringing content after receiving multiple takedown notices, the copyright owner can bring a claim against the service provider for its failure to expeditiously remove the infringing content.

In addition to maintaining notice and takedown procedures, service providers are encouraged to put users on notice as to the ways the service providers handle copyright infringement. For example, companies should include information about their DMCA policies

on their websites in the Privacy Policy or Terms of Use sections.

3. AVOID POSTING THIRD PARTY CONTENT DIRECTLY ON YOUR SITE

Companies may receive a DMCA takedown notice in response to web content that is allegedly being used without permission of the copyright owner. By including copyright notices when displaying someone else's copyrighted material, companies can help protect against DMCA complaints. When in doubt, contact copyright owners to request permission to use their work on your site.

For companies with interactive websites, such as those with message boards, blogs, and comment sections, regular monitoring of posts is crucial. Content uploaded by third parties, including text, photographs, and multimedia, should be reviewed regularly to check for copyright infringement. Failure to monitor and take action against infringing content can expose a company to liability.

Instead of directly posting third party content, service providers may link to the original source or reference the original location of the content. DMCA's safe harbor provision Section 512(d) states that service providers will not be held liable for referring or linking users to a site containing infringing material. By providing a link to the original content instead of reposting that content, companies can avoid monetary damages.

ILLUSTRATIONS OF THE DMCA SAFE HARBOR PROVISION AT WORK

MICROSOFT FILES DMCA TAKEDOWN AGAINST HALO ONLINE MOD

Microsoft and 343 Industries, the developer of the popular Halo video game, recently filed DMCA takedown notices aimed against

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[CHANGES IN THE DMCA, FROM PAGE 7]

ElDewrito. ElDewrito is the online community-made modification (mod) for Halo Online, a Russian PC game based on Halo 3. Microsoft filed DMCA takedown notices against the Halo Online mod, claiming it violated Microsoft's intellectual property rights. Microsoft stated that the mod was built on Microsoft-owned assets without authorization. Instead of sending a cease and desist letter to ElDewrito, Microsoft chose to employ the DMCA to file takedown notices against sites, such as Twitch, that streamed Halo Online. It remains to be seen what the future holds for the Halo Online mod. In the meantime, the mod remains online but further developments are suspended.

VENTURA CONTENT, LTD. V. MOTHERLESS, INC., CASE NO. 13-56332 (9TH CIR. MAR. 14, 2018)

The Ninth Circuit recently decided that Motherless, Inc., a website allowing users to upload pornographic content, was able to benefit from the DMCA's safe harbor protections. Motherless is a website with more than 12 million photographs and videos, largely of pornographic nature, which are available to users. Users can view the content for free or choose to purchase a premium subscription that allows users to view content without advertisements. Motherless does not pay for the content and instead receives revenues largely from advertisements.

Motherless included notice and takedown procedures on its site and also warned users

each time users posted new videos or photographs. The warning told users to avoid posting illegal or copyrighted content. Motherless claimed to remove material in response to receiving DMCA takedown notices and that it also used software to prevent users from reposting the infringing content. While Motherless did not have a written repeat infringer policy, Motherless stated that it terminated more than 30,000 repeat infringer accounts over three years.

Ventura alleged that 33 of its video clips were posted to Motherless without permission. Ventura did not file a takedown notice with Motherless and instead filed a complaint for copyright infringement. Motherless removed the 33 clips after the complaint was filed, but only after requesting links to the video clips twice from Ventura. The court found that because users, not Motherless, were uploading the content, Motherless was able to benefit from the DMCA's safe harbor provision. In addition, despite its failure to have a formal written repeat infringer policy, the court found that Motherless' approach to terminating repeat infringers was sufficient for the small size of the company, which only included two employees. ■

Ross A. Dannenberg contributed to this article.

1. <https://www.copyright.gov/legislation/pl105-304.pdf>

2. <https://www.copyright.gov/dmca-directory/>

ARTICLE OF MANUFACTURE – DISTRICT COURT UPDATE



BY ERIK S.
MAURER AND
AUDRA C.
EIDEM HEINZE

In December 2016, the Supreme Court addressed the scope of the term “article of manufacture” under 35 U.S.C. § 289 for purposes of awarding a design patent infringer’s “total profit” from sales of “article[s] of manufacture” to which a patented design had been applied.¹ However, the Supreme Court did not identify the “article of manufacture” in the case before it.² Instead, the Court remanded, noting that the United States as *amicus curiae* suggested a test for making this determination.³

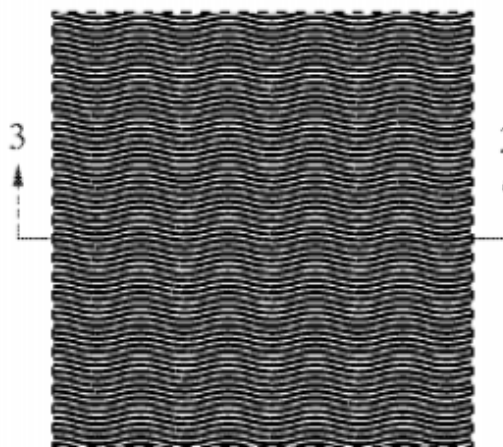
The United States identified four “considerations [] relevant to the inquiry:”⁴

1. The “scope of the design claimed in the plaintiff’s patent, including the drawing and written description.”
2. The “relative prominence of the design within the product as a whole.”
3. Whether “the design is conceptually distinct from the product as a whole.”
4. The “physical relationship between the patented design and the rest of the product.”

Here, we provide updates as to how district courts have addressed “article of manufacture” following the Supreme Court’s remand.

COLUMBIA SPORTSWEAR NORTH AMERICA, INC. V. SEIRUS INNOVATIVE ACCESSORIES, NO. 3:17-CV-01781 (S.D. CAL.)

Columbia Sportswear North America, Inc. v. Seirus Innovative Accessories was one of the first cases to set forth an article of manufacture test in the wake of the Supreme Court’s *Samsung* decision.⁵ Columbia accused Seirus of infringing its design patent titled “Heat Reflective Material,” including the claim figure below.⁶ Judge Hernandez entered judgment that Columbia’s claimed design was valid and infringed.⁷



“Heat Reflective Material”

Illustration 1: Figure from Columbia’s Asserted Design Patent

After the parties submitted competing proposals to identify the article of manufacture

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[ARTICLE OF MANUFACTURE, FROM PAGE 9]

under § 289, Judge Hernandez issued jury instructions that generally tracked the United States' proposed four-factor test.⁸ In particular, if "the product as sold to consumers is a single-component product then that product is the relevant article of manufacture."⁹ However, "[i]f the product as sold to consumer[s] is a multi-component product," then the court directed the jury to consider factors similar to those proposed by the United States' *amicus* brief in *Samsung*.¹⁰ Columbia bore the burden to show that Seirus applied the patented design to a product that was sold and to prove Seirus's total profit; it was up to Seirus to prove the "article of manufacture is something less than the entire product" and to prove any deductible expenses.¹¹

After trial, the jury awarded more than \$3 million, reflecting Seirus's "total profit from sales of the relevant article of manufacture that Columbia is entitled to receive for Seirus's infringement."¹² Judge Hernandez also

awarded Columbia pre-judgment interest over Seirus's objection.¹³ Seirus argued that prejudgment interest was unavailable because it can only be recovered under 35 U.S.C. § 284.¹⁴ Judge Hernandez found Seirus's position to be "without legal support and at odds with cases that have applied prejudgment interest" to awards under § 289.¹⁵

APPLE INC. V. SAMSUNG ELECTRONICS CO., NO. 11-CV-01846 (N.D. CAL.)

On remand from the Supreme Court and Federal Circuit, and less than two months after Judge Hernandez issued his jury instructions in *Columbia*, Judge Koh addressed article of manufacture in *Apple Inc. v. Samsung Electronics Co.*¹⁶ At issue were three Apple design patents infringed by Samsung titled "Electronic Device," "Electronic Device," and "Graphical User Interface for a Display Screen or Portion Thereof," including the claim figures below.¹⁷

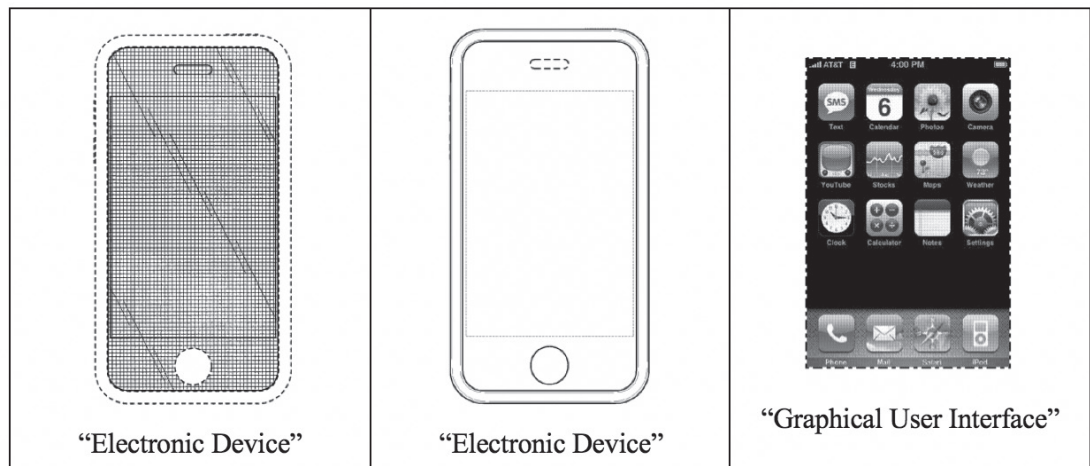


Illustration 2: Figure from Each of Apple's Asserted Design Patents

Judge Koh largely adopted the United States' proposed four-factor test, observing that both parties generally endorsed the United States' test before the Supreme Court, but advocated for different tests on remand.¹⁸ In granting a new trial and ruling on various *Daubert* motions, Judge Koh addressed the parties' arguments about how to identify the article of manufacture.¹⁹

Regarding the first factor, scope of the claimed design, Judge Koh agreed with Apple that the "relevant article of manufacture may extend beyond the scope of the claimed design," though she found that the scope of the design patent must be a consideration even though that "is not alone dispositive."²⁰ Regarding the second factor, relative prominence of the design, Judge Koh observed that the United States identified "two alternative approaches," likening it to the reasonable royalty context where the Federal Circuit has recognized there may be more than one reliable method.²¹ Here, she rejected Samsung's argument that inquiries into this factor "necessarily include a comparison to 'other components unaffected by the design,'" finding instead that "in some scenarios, a design may so dominate the product that comparison to other features of the product would add little value to the inquiry."²² Judge Koh ruled that evidence of "marketing . . . views of the iPhone that featured the patented designs, evidence of and opinions related to the iPhones' 'look and feel,' and evidence that consumers associated the patented designs with iPhones are relevant to the . . . prominence of the design within the

article as a whole."²³ She also found that "evidence of and opinions about copying are relevant" to determining the relative prominence of the design.²⁴

Turning to the third factor, Judge Koh observed that there may be various ways "in which conceptual distinctness can be assessed."²⁵

Finally, in connection with the fourth factor, physical relationship between the patented design and the rest of the product, Judge Koh found that, although it rejected a *per se* rule, the Supreme Court did not prohibit consideration of "how the product is sold" in identifying the article of manufacture.²⁶ Accordingly, she concluded that consideration of this factor may include "whether the design pertains to a component that a user or seller can physically separate from the product as a whole, and whether the design is embodied in a component that is manufactured separately from the rest of the product, or if the component can be sold separately."²⁷

Analyzing the four factors, Judge Koh held that the plaintiff bears the burden of persuasion and the initial burden of production to identify the article of manufacture and total profits.²⁸ Then, "the burden of production shifts to the defendant to come forward with evidence to support any alternative article of manufacture and to prove any deductible expenses."²⁹ She also noted the parties' agreement that determining the relevant article of manufacture under § 289 "is a question of fact that a jury decides when there is a material factual dispute."³⁰

Judge Koh also found that there was no basis for importing the perspectives of a “designer of ordinary skill in the art” and an “ordinary observer”—used in the validity and infringement contexts—into the article of manufacture inquiry.³¹ However, Judge Koh allowed Apple’s experts to “offer their own perspectives as experts” on the article of manufacture, including “opinions on how a consumer would view and interact with the phones at issue.”³²

**NORDOCK, INC. V. SYSTEMS, INC.,
NO. 11-CV-118 (D. WIS.)**

Magistrate Judge Duffin addressed the article of manufacture issue on remand from the Supreme Court and the Federal Circuit in *Nordock, Inc. v. Systems, Inc.*, less than a month after Judge Koh set forth a test in *Apple*.³³ A jury found that Systems infringed Nordock’s asserted design patent titled “Lip and Hinge Plate for a Dock Leveler,” including the claim figure shown below.³⁴

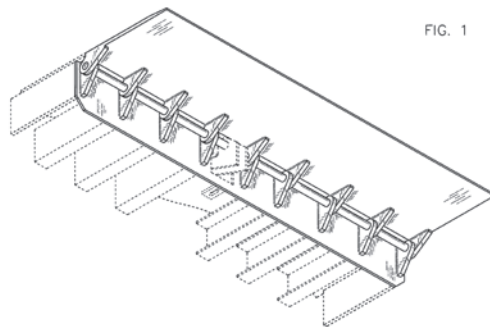


Illustration 3: Figure from Nordock’s Asserted Design Patent

In ruling on the parties’ competing summary judgment motions, Magistrate Judge Duffin found the United States’ four-factor test “appropriate, consistent with the relevant statutory law, and supported by the case law,”³⁵ further noting the four factors may not “always be the *only* factors relevant to determining the article of manufacture.”³⁶ To that end, he identified a fifth factor directed to “how a product is manufactured,” but acknowledged the United States may have intended this to be encompassed within its fourth factor.³⁷ After reviewing the evidence, Judge Duffin determined the issue was a jury question and denied summary judgment.³⁸

Judge Duffin also adopted Judge Koh’s approach to burdens of proof.³⁹ He rejected Nordock’s contention that the article of manufacture analysis “should begin with a presumption that the article of manufacture is the entire product sold by the infringer,” and that a factor-by-factor analysis should apply “only if certain threshold questions indicate that it is appropriate.”⁴⁰

Shortly after Judge Duffin denied Nordock’s request to certify for immediate appeal his article of manufacture decision,⁴¹ the parties settled the case.⁴²

CONCLUSION

The three decisions addressing “article of manufacture” under § 289 following the Supreme Court’s *Samsung* decision have generally followed the United States’ four-factor

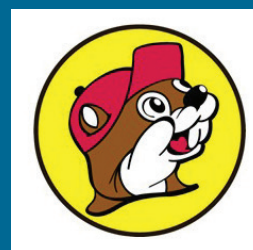
test. Nevertheless, with the relevant burdens and evidentiary proofs continuing to be fleshed out, it will be important to continue monitoring this aspect of design patent litigation. ■

1. *Samsung Electronics Co., Ltd. v. Apple Inc.*, 137 S. Ct. 429 (2016).
2. *Id.* at 436.
3. *Id.*
4. Brief for the United States as Amicus Curiae Supporting Neither Party at 27–29, *Samsung*, No. 15-777 (June 8, 2016).
5. Jury Instructions at 15–16, 3:17-cv-01781 (S.D. Cal. Sept. 9, 2017), ECF No. 378.
6. 202 F. Supp. 3d 1186 (D. Or. 2016); U.S. Patent No. D657,093.
7. Judgment of Validity of U.S. Patent D657,093, 3:17-cv-01781 (S.D. Cal. March 17, 2016), ECF No. 81; 202 F. Supp. 3d 1186 (summary judgment of infringement). Judge Hernandez transferred the Columbia case from the District of Oregon to the Southern District of California, 265 F. Supp. 3d 1196 (D. Or. 2017), but presided over the case through trial, 3:17-cv-01781 (S.D. Cal.), ECF No. 372.
8. Jury Instructions at 15–16, 3:17-cv-01781 (S.D. Cal.), ECF No. 378.
9. *Id.*
10. *Id.*
11. *Id.* at 15, 17.
12. Jury Verdict at 2, 3:17-cv-01781 (S.D. Cal. Sept. 29, 2017), ECF No. 377.
13. 3:17-cv-1781, 2018 WL 1805102, at *1 (S.D. Cal. Apr. 17, 2018).
14. *Id.* Section 284 of the Patent Act provides damages for infringement, in no event less than a reasonable royalty.
15. *Id.*
16. No. 11-cv-1846, 2017 WL 4776443 (N.D. Cal. Oct. 22, 2017).
17. *Id.* at *3–4; U.S. Patent Nos. D618,677, D593,087, D604,305.
18. 2017 WL 4776443, at *8, 11–12.
19. See generally *id.*; 2018 WL 1586276 (N.D. Cal. Apr. 2, 2018).
20. 2017 WL 4776443, at *10, *12. Judge Koh denied Samsung's motion to exclude the testimony of Apple's experts as to the first factor, concluding they did not misapply the law "insofar as they consider unclaimed subject matter in their analysis of the first factor." 2018 WL 1586276, at *5.
21. *Id.* at *6.
22. *Id.*
23. *Id.* at *12.
24. *Id.* at *10.
25. *Id.* at *8.
26. *Id.* at *9.
27. *Id.* at *4; 2017 WL 4776443, at *19.
28. 2017 WL 4776443, at *13–15.
29. *Id.* at *14–15.
30. *Id.* at *7 n.2.
31. 2018 WL 1586276, at *11–12.
32. *Id.* at *12.
33. No. 11-cv-118, 2017 WL 5633114 (E.D. Wis. Nov. 21, 2017).
34. *Id.* at *1; U.S. Patent No. D579,754.
35. 2017 WL 5633114, at *6.
36. *Id.*
37. *Id.* at *6–7.
38. *Id.* at *8.
39. *Id.* at *4.
40. *Id.*
41. Order, No. 11-cv-0118 (Dec. 19, 2017), ECF No. 277.
42. Stipulation for Dismissal Pursuant to Rule 41(a), No. 11-cv-0118 (Mar. 30, 2018), ECF No. 286.

BANNER & WITCOFF ENFORCES BUC-EE'S FAMOUS LOGO WITH JURY VERDICT ON ALL COUNTS

Banner & Witcoff secured a jury verdict for client, Buc-ee's, against a chain of travel centers in Texas. The 12-person jury returned a unanimous verdict that Buc-ee's logo is famous and that the Defendants violated the law by using logos that were confusingly similar and likely to cause dilution of Buc-ee's famous logo. The Houston jury found in favor of Buc-ee's on all counts, including trademark infringement, trademark dilution, unfair competition, and unjust enrichment. The jury verdict was significant for Buc-ee's and all famous brands.

Buc-ee's and its popular Texas travel centers are represented by Joseph J. Berghammer, Janice V. Mitrius, Timothy J. Rechten, Eric J. Hamp, Katie Laatsch Fink, and Kevin Dam of Banner & Witcoff. The case is *Buc-ee's Ltd. v. Shepherd Retail, Inc., et al.*, case number 4:15-cv-03704, in the U.S. District Court for the Southern District of Texas.



Buc-ee's Famous Logo



Defendants' Infringing Logo

IS THERE A NEW “NEW NARRATIVE” TO BE TOLD ABOUT PATENTS?



BY CHARLES W. SHIFLEY

In the middle of the Twentieth Century, and before the existence of the Court of Appeals for the Federal Circuit, there was a “narrative” about patents—that wasn’t good. With more time and the creation of the Court, and for about 25 years, a new narrative reversed the old one—patents were good! Then an even newer narrative switched back—patents were bad! These days, the U.S. Patent and Trademark Office (PTO) has a new Director, and reflecting only on the recent “bad,” he calls for a “new narrative” about patents, one that emphasizes their benefit to society.¹ Is a new “new narrative” possible, at this time, and for the foreseeable future? One in which patents are good?

BEFORE THE FEDERAL CIRCUIT, THE NARRATIVE WASN’T GOOD

The law firm of Banner & Witcoff, Ltd. is pleased to carry the name “Banner,” choosing the name of its past partner, Donald W. Banner, for its first name. Don Banner was, before being with us, a Commissioner of the “Patent Office,” in 1978-79, a co-founder and President of the Intellectual Property Owners Association (IPO) (among many other IP groups), from 1972-1981, and “[a] key player in the development of the international IP system.”² He and others founded IPO because of the state of patent law at the time. As IPO’s Executive Director Herb Wamsley said on

retirement, patents “experienced a terribly difficult period starting from before World War II and continuing through the 1970s. Government antitrust policies and judicial hostility toward patents reduced the value of patents and restricted the ability to license.”³ As a participant in a conference of the Department of Commerce in 1973, Don Banner (and others) agreed that one of the main concerns at the time was the “deterioration of the regard held for the patent system.”⁴ An infamous vignette of the disregard was revealed in the *Underwater Devices* case.⁵ A corporate counsel wrote a corporate manager in 1974 that he should refuse to even discuss a royalty for needed patent rights, in part, because, “Courts, in recent years, have—in patent infringement cases—found the patents claimed to be infringed ... invalid in approximately 80% of the cases.”⁶ Patents were particularly disrespected in regional federal courts of appeal. As written by an early Federal Circuit Senior Judge, Marion Bennett, “[s]ome of the regional circuit courts, expressing strong feelings about the dangers of monopoly and having a low regard for the expertise of the Patent Office, tended not to give any deference to the administrative examination process and invalidated many patents.”⁷ This generated a “high-risk game of forum shopping.”⁸ The Department of Justice called it “a crisis for the courts ..., litigants who seek justice ... the rule of law, and ... the Nation.”⁹

WITH THE FEDERAL CIRCUIT AND NEW CIRCUMSTANCES, THE PATENT NARRATIVE WAS GOOD, FOR MANY YEARS

The country changed. The Federal Circuit became operational as a court of nationwide jurisdiction in 1982. President Reagan took office just earlier, in 1981; it was “morning again in America.”¹⁰ The personal computer market was spinning up; the Apple II computer, one of the first mass-produced personal computers, had started sales five years earlier.¹¹ Mass-market use of mobile cellular telephones was just ahead; the Motorola DynaTAC received Federal Communications Commission approval in 1983.¹² Broad uses of genetic engineering were ahead; Genentech microbes produced synthetic human insulin by 1978.¹³ In 1980, the Supreme Court decided in *Chakrabarty* (a Banner & Witcoff lawyers’ case) that living things were patentable.¹⁴ Across a broader period, China opened to foreign manufacturing investment. Wal-Mart was greatly expanding.¹⁵ Meanwhile, patent lawyers discovered juries.¹⁶

In the first ever Federal Circuit case, the first chief judge, Howard Markey, wrote for the Court and adopted an established body of law as precedent, to jump start its appeals processes.¹⁷ Gone was the jurisdiction of regional courts, and any of those courts’ hostility to patents. In less than a year, the Federal Circuit heard *Underwater Devices*, with its notorious vignette. The Court placed on potential patent infringers who knew of patents an affirmative duty to exercise due care to determine whether or not they were

infringing.¹⁸ The duty included a need to seek and obtain competent legal advice before starting any possible infringing activity.

Economic confidence rose, including confidence in inventing and patenting—whether by virtue of Reagan rhetoric and tax and regulation cutting, the blossoming of technologies that had already budded, Chinese manufacturing and container shipment of new, inexpensive products to Wal-Mart and the United States, national uniformity in patent law, required due care for patents, or juries in patent infringement cases (or all of this combined). Relatively stagnant patent filing volumes rose and continued rising.¹⁹ Patent damages awards also rose in size.²⁰

WITH FURTHER DEVELOPMENTS, THE PATENT NARRATIVE WENT BACK TO BAD

Twenty years passed with the Federal Circuit, along with some economic downturns such as the Savings and Loan Crisis in 1989, factories and jobs leaving for China, and a variety of new happenings in patent law. The narrative surrounding patents swung back to bad.

Not to call it out as most problematic, the U. S. District Court for the Eastern District of Texas decided to jump into handling IP cases.²¹ Depending on point of view, with its patent-friendly juries, and overheated, “rocket docket” patent infringement cases, it became too easy for patent owners to win—and win big. About the same time, the Federal Circuit reached a significant decision, *In re Alappat*.²² On the strength of the Supreme Court’s statement that

[NEW NARRATIVE, FROM PAGE 15]

patenting extended to “anything under the sun that is made by man” in *Chakrabarty*,²³ *Alapatt* resolved that those patents with means-plus-function limitations directed to digital electrical circuits, that performed mathematical calculations, had patent-eligible subject matter. To the Electronic Frontier Foundation (EFF), the Court had held that an algorithm implemented on a general purpose computer was patentable.²⁴ That, it said—to much dispute from others—“opened the floodgates for software patents,” patents of “very low” quality, with claims “often vague and overbroad—giving unscrupulous patent owners the ability to claim that their patent covers a wide range of technology.”²⁵ The EFF also thought that “patent trolls” rose, their number of patent infringement lawsuits “skyrocket[ing],” starting in 2005.²⁶ To many companies reliant on software, pleased with *Alapatt*, its wide scope of patentability, and of the opinion that software patents were no part of “floodgates,” “low” quality, vagueness or overbreadth, only positive came with *Alapatt*. But with strong opinions such as those of the EFF, patents gained a new, bad reputation.

CAN THERE BE A NEW “NEW NARRATIVE”?

So back to the introduction. With a whipsawing through bad-to-good and good-to-bad again, and with a new PTO Director calling for a “new narrative” about patents, is a new “new narrative” possible? Can there be a new “morning in America” for patents?

Of course, only time will tell. But consider what caused the earlier change from bad-to-

good. First, bad led to the adoption of new law, the law that created the Federal Circuit, and the law it created of due care for patent rights. Fast-forward, in the period since the rise of patent enforcement entities, there has certainly been new law. The prime example is the America Invents Act (AIA), with its creation of *inter partes* reviews (IPRs), and similar post-grant proceedings, to reconsider issued patents. The AIA and IPRs passed a major test in recent months, surviving a constitutional challenge in the *Oil States* case.²⁷

Companion changes of law are abundant, and more are on the horizon. The Supreme Court has taken something like 30 patent cases since about year 2000. It has upended patent law, with a much greater restriction on patents, toward fewer patents, confined in scope, more susceptible to challenge, in less patent-friendly venues, with more confined remedies for infringement.²⁸ By cases including *Alice*, the Court confined patent-eligibility.²⁹ It confined non-obviousness against more obvious inventions in *KSR*.³⁰ It limited good patents to only those more definite than indefinite, in *Nautilus*.³¹ It made understanding patent claim scope more structured, in *Markman*.³² It narrowed inducement law in *Limelight*.³³ It changed venue law in *TC Heartland*, moving suits away from the Eastern District of Texas.³⁴ It reduced the prospects of injunctions against infringement in *eBay*.³⁵ It curbed design patent damages in *Samsung*.³⁶ It clipped off post-sale limits on product uses through patent law, in *Impression*.³⁷ It bucked up IPRs in *Cuozzo*.³⁸ As well, legislative proposals to work on patent eligibility are abundant.³⁹

Second, and beyond second, the earliest bad narrative ended in the surroundings of tax and government regulation cuts. We have a new tax cut, and new cuts to regulations. Now as in the early 1980s, technologies already budded are blossoming, or already blossomed. We live on wireless devices and the Internet. Shopping is by Internet and home delivery. New business models such as app-based ride sharing services are disrupting industries. We get our news from social media. Cars are going electric, and driverless. Solar cells are moving us all at least partially off the electric grid. Wind farms are abundant. GPS location and satellite imaging are getting remarkable new uses in locating vehicles, people, exploring, and finding resources. Virtual reality is letting us travel without leaving home. Robots and drones are on their way. Animals are cloned. Rockets are privately owned and land themselves on recovery pads. Patent law is arguably as uniform as it has ever been. Loose standards for awards of enhanced damages and attorneys' fees impose and heighten, over and above past risks, the need to take due care for patents. Juries remain in cases.

A "flying geese" theory holds that as leading countries have their factories move to follower countries, the managements of the businesses of the countries "move up the technology curve," to more complex products and inventions.⁴⁰ China is gearing up Africa to be the world's next great manufacturing center.⁴¹ China has also moved up. We have moved up, through Apple, Google, and all our inventive tech industry giants and others.

Trolls are much less a scourge. The Supreme Court and Federal Circuit case lessons over patent eligibility are being applied at the PTO with increasingly refined directions for examiners to follow, to grant patents on wheat, while denying them, more carefully, on chaff.

We are experiencing U.S. patent filings at incredibly high levels from inventors all over the world. The "fuel of interest" continues to drive "the fire of genius."⁴²

It seems, perhaps more to optimists than others, that on reflection over the example of bad-to-good in the 1980s, and our great recent progress, we can go from bad-to-good again. Perhaps for reasons he did not even have in mind, our new Director may be on to something. ■

1. See https://www.law360.com/ip/articles/1035965/uspto-chief-pushes-new-narrative-of-patent-benefits?nl_pk=9df83f8b-7d20-40e1-891e-e4e5f4e93630&utm_source=newsletter&utm_medium=email&utm_campaign=ip
2. https://www.iphalloffame.com/don_banner/ and <http://www.legacy.com/obituaries/washingtonpost/obituary.aspx?n=donald-w-banner&pid=17022138>
3. Herbert C. Wamsley, Keynote Address, IPO Annual Meeting, September 29, 2015 at 3.
4. Proceedings of a conference held in Monterey, California, June 11-14, 1973, U.S. Department of Commerce, at https://books.google.com/books?id=S18ggISFR28C&pg=PA192&lpg=PA192&dq=donald+banner+borg+warner&source=bl&ots=K19YvzQ9Et&sig=W1m6bnPO-KeZiUDzZWKDkk_N7Gw&hl=en&sa=X&ved=0ahUKEwiyz9nApNPaaAhWvVt8KHfLMAbc4ChDoAQgoMAA#v=onepage&q=donald%20banner%20borg%20warner&f=false
5. *Underwater Devices Inc. v. Morrison-Knudsen Co.*, 717 F.2d 1380, 1385 (Fed. Cir. 1983).
6. *Id.*
7. Marion Bennett, Senior Circuit Judge, The United States Court of Appeals for the Federal Circuit—Origins, at 10, within The United States Court of Appeals for the Federal Circuit, A History 1982-1990.
8. *Id.*
9. *Id.*, citing H.R. Rep. No. 312, 97th Cong., 1st Sess. 17 (1981), itself quoting Report of the Dept. of Justice Comm. On Revision of the Federal Judicial System 1 (1977).
10. <https://www.youtube.com/watch?v=EU-IBF8nwSY>

[NEW NARRATIVE, FROM PAGE 17]

11. https://en.wikipedia.org/wiki/Apple_II
12. https://en.wikipedia.org/wiki/Motorola_DynaTAC
13. https://en.wikipedia.org/wiki/History_of_biotechnology
14. *Diamond v. Chakrabarty*, 447 U.S. 303 (1980)(Banner & Witcoff lawyers Ed McKie and Dale Hoscheit won for Chakrabarty and General Electric).
15. https://en.wikipedia.org/wiki/History_of_Walmart
16. <https://economics.indiana.edu/home/about-us/events/conferences-and-workshops/files/2011-04-22-01.pdf> at page 15.
17. *South Corp. v. United States*, 690 F.2d 1368 (Fed. Cir. 1982) (adopting the law of the Court of Customs and Patent Appeals).
18. *Underwater Devices*, 717 F.2d at 1379-80.
19. https://www.uspto.gov/web/offices/ac/ido/oeip/taf/us_stat.pdf
20. See the article of endnote xiii at 15.
21. <https://www.dallasnews.com/business/technology/2017/05/24/east-texas-supreme-court-ruling-setback-towns-final-verdict-locals-say>
22. 33 F.3d 1526 (Fed. Cir. 1994).
23. *Diamond v. Chakrabarty*, 477 U.S. 303, 309 (1980)
24. <https://www.eff.org/deeplinks/2013/02/deep-dive-software-patents-and-rise-patent-trolls>
25. *Id.*
26. *Id.*
27. *Oil States Energy Services, LLC v. Greene's Energy Group, LLC*, No. 16-712 (April 24, 2018).
28. The Court admittedly maintained clear and convincing evidence to prove obviousness, in *Microsoft Corp. v. i4i Ltd. Partnership*, 131 S.Ct. 2238 (2011). It opened equivalent infringement against an absolute bar of estoppel in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002). It opened up willfulness and attorneys' fees awards in *Highmark Inc. v. Allcare Mgmt.*, 134 S.Ct. 1744 (2014) and *Octane Fitness v. Icon Health & Fitness*, 134 S.Ct. 1749 (2014). It blocked laches, in *SCA Hygiene v. First Quality Baby Products*, 137 S.Ct. 954 (2017). It cut back antitrust liability associated with patents in *Illinois Tool Works Inc. v. Independent Ink, Inc.*, 547 U.S. 28 (2006).
29. *Alice Corp. Pty., Ltd. v. CLS Bank Int'l*, 134 S.Ct. 2347 (2014).
30. *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).
31. *Nautilus, Inc. v. Biosig Inst's., Inc.*, 134 S.Ct. 2120 (2014).
32. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996).
33. *Limelight Networks v. Akamai*, 134 S.Ct. 2111 (2014). It accepted broadened inducement to include willful blindness in *Global-Tech Appliances, Inc. v. SEB SA*, 131 S.Ct. 2060 (2011). It held a belief of invalidity was not a defense to induced infringement in *Commil USA, LLC v. Cisco Sys'ts., Inc.*, 135 S.Ct. 1920 (2015).
34. *TC Heartland v. Kraft Foods Group Brands*, 137 S.Ct. 1514 (2017). The Court narrowed Federal Circuit jurisdiction in *Holmes Group, Inc. v. Vornado Air Circulation Sys'ts., Inc.*, 535 U.S. 826 (2002), but Congress added that jurisdiction back in the AIA. The Court broadened declaratory judgment jurisdiction to license-holding patent challengers in *Medimmune, Inc. v. Genentech, Inc.*, 549 U.S. 118 (2007).
35. *eBay Inc. v. Mercexchange*, 547 U.S. 388 (2006).
36. *Samsung Elec's. Co. v. Apple Inc.*, 137 S.Ct. 429 (2016).
37. *Impression Products v. Lexmark Intern.*, 137 S.Ct. 1523 (2017).
38. *Cuozzo Speed Techs. LLC v. Lee*, 136 S.Ct. 2131 (2016).
39. <http://www.ipwatchdog.com/2017/07/25/patent-bar-groups-propose-legislation-fix-patent-subject-matter-eligibility-problems/id=86015/>
40. *Id.*
41. <https://hbr.org/2017/05/the-worlds-next-great-manufacturing-center>
42. Attributed to Abraham Lincoln.

NORTH SHORE CORPORATE IP ROUNDTABLE CELEBRATES FIRST YEAR

The North Shore Corporate IP Roundtable will soon complete its first successful year of bringing in-house intellectual property counsel who live or work in the North Shore suburbs together to share ideas and best practices. The group meets every other month in Northbrook and discusses such topics as building and monetizing patent assets, setting IP budgets, and extracting IP value.

"We provide relevant, meaningful CLE content with practical takeaways for in-house counsel in an environment that encourages discussion and sharing of best practices," said Binal J. Patel, a principal shareholder at Banner & Witcoff and the organizer of the group. "We are excited to have created a program that resonates so well with its members and look forward to seeing it grow in the future."

For more information on the North Shore Corporate IP Roundtable, please e-mail info@bannerwitcoff.com.



OUR CHICAGO OFFICE IS MOVING!

We are excited to announce that our Chicago office will relocate to 71 S. Wacker Dr. this fall. We will announce more details soon about our new space and our move date. We look forward to hosting our clients and friends in this new, modern space.



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