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IP Newsflash



06.20.14

FEDERAL CIRCUIT CASES

Federal Circuit Reinforces the Requirement to Disclose the Corresponding Algorithm for a Computer-Implemented Means-Plus-Function Term

On June 13, 2014, the Federal Circuit affirmed the Western District of Washington's decision that the claims in U.S. Patent No. 5,181,181 were invalid for indefiniteness. The '181 patent disclosed a method and apparatus for a user communicating with a computer by moving an input device in three-dimensional space. The claims included general means-plus-function terms, such as an "integrator means," meant to be performed on a computer. Under Federal Circuit precedent, "if the function is performed by a general purpose computer or microprocessor, then the specification must also disclose the algorithm that the computer performs to accomplish that function." The '181 patent failed to disclose any specific algorithm or specialized computer that performed the integrating function for the "integrator means." Appellant pointed to the disclosure of "numerical integration" in the patent's specification as the sufficient disclosure of the algorithm. The Federal Circuit rejected this argument, finding that while "numerical integration" is technically a broad class of algorithms, the patent fails to disclose the specific algorithm—i.e., a "step-by-step procedure"—for the claimed "integrator means." The Federal Circuit reinforced that the "failure to disclose the corresponding algorithm for a computer-implemented means-plus-function term renders the claim indefinite." Because the Appellant failed to disclose an algorithm that performed the integrating function, the asserted claims were upheld as indefinite.

Triton Tech of Texas, LLC, v. Nintendo of America, Inc., Case No. 2013-1476 (Fed. Cir. June 13, 2014) [Moore (opinion), Reyna, and Hughes]

- Author: [James Duncan](#)

DISTRICT COURT CASES

Lady Gaga's "Judas" No "Juda"

In 2011, Rebecca Francescatti (Francescatti) filed suit in the Northern District of Illinois, Eastern Division against five defendants, including Stephani Joanne Germanotta (Lady Gaga) for copyright infringement. According to Francescatti's allegations, Lady Gaga's song "Judas" infringed Francescatti's copyrighted song "Juda." Lady Gaga and the other defendants filed a joint motion for summary judgment seeking dismissal of Francescatti's case for failing to establish that "(1) [d]efendants had access to and actually copied the protectable expression embodied in Francescatti's song, and (2) Gaga's song sounds substantially similar to Francescatti's." The court found in favor of Francescatti on access but granted summary judgment for Lady Gaga on the basis that a reasonable juror could not find the two songs substantially similar.

Following 9th Circuit precedent, the court held that summary judgment, although not favored in determining the question of substantial similarity, "is appropriate where no reasonable trier of fact could find substantial similarity in the protected expression of the disputed works." However, the court rejected Lady Gaga's request that it apply the "inverse ration rule," which requires a higher standard of proof on the issue of "substantial similarity" when the Plaintiff's evidence of "access" is weak. Rather, the court favored an analysis that looks at "access" and "substantial similarity" independently of each other. The court noted that "substantial similarity" is "one of the most difficult questions in copyright law" because the party must demonstrate both copying and that the copying "extends to the [party's] protectable expression." Francescatti had to demonstrate that Lady Gaga copied the work and "that the two works shared enough unique features to give rise to a breach of duty [on the part of Lady Gaga] not to copy [Francescatti's] work."

On the issue of substantial similarity, Lady Gaga argued that the court should rely on the "ordinary observer test," i.e.; a side-by-side comparison of the two songs. Because of computer generated enhancing associated with the songs, Francescatti argued for application of the "extrinsic-intrinsic test," which relies on expert testimony to identify the protectable elements that were copied. Given the complexity of the songs, the court allowed expert testimony, but it did not abandon the "ordinary observer test" in favor of the "more discerning observer test" (i.e.; the difference between a lay person and a choral director for example). Applying the extrinsic-intrinsic and ordinary observer tests, the court found three similarities between the two songs: 1) the titles; 2) the repetitive use of the titles in the songs; and 3) a similarity in the use of four 16th notes in the breakdown sections. However, this was not enough to find copyright infringement because Francescatti did not establish a similarity between the songs as a whole and because the three elements – title, repetition and breakdown sections – were not protectable individually or as a unique combination.

Francescatti v. Germanotta, No. 11-cv-5270 (N.D. Ill. June 17, 2014) [Aspen, M.]

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Redskins' Trademarks are Cancelled

In a landmark decision by the Trademark Trial and Appeal Board, the panel cancelled six of the team's trademarks ruling that the name is disparaging to Native Americans pursuant to Section 2(a), 15 U.S.C. § 1052(a) which prevents the registration of marks which "may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." The Board's ruling addressed six uses of the name REDSKINS during the time period of 1967 to 1990. Although the decision only addresses the statutory right to register the trademarks rather than the actual use of the trademarks, it may create serious impediments to enforcing trademark protection in a commercial context. The owner of the trademarks, Pro-Football, Inc., attempted to argue laches and lack of substantial evidence of disparagement. The Board rebuffed Pro-Football's laches defense based primarily upon public policy issues and determined that a finding of disparagement requires a two-step inquiry from the date of registration of the involved marks:

- a. What is the meaning of the matter in question, as it appears in the marks and as those marks are used in the connection of goods and services?
- b. Is the meaning of the marks one that may disparage Native Americans?"

In establishing disparagement, the Board ruled the first prong of the test met as the term REDSKINS within the registered mark [at the time of registration] did refer to Native Americans. Second, the Board found the term REDSKINS to be disparaging during the relevant time period upon reviewing evidence presented by Petitioners, including linguistic analysis of the word and views of the referenced group. Therefore, a cancellation of the trademarks was appropriate.

Amanda Blackhorse, Marcus Briggs-Cloud, Phillip Gover, Jillian Pappan and Courtney Tsotigh v. Pro-Football, Inc., Cancellation No. 92046185 (TTAB June 18, 2014) [Kuhlke (opinion), Cataldo and Bergsman]

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