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IP Newsflash

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FEDERAL CIRCUIT CASES

Subjective Term Not Indefinite when Intrinsic Record Provides Reasonably Certain Scope

On remand from the Supreme Court, on April 27, 2015, the Federal Circuit reassessed whether Biosig's claims were indefinite, this time under the "reasonable certainty" test, and once again found the claims not indefinite under 35 U.S.C. § 112 ¶ 2.

Claims of the asserted patent are directed to a heart rate monitor that measures bioelectrical signals from two electrodes that are in "spaced relationship" with each other. The issue of indefiniteness, as framed by the court, hinged on whether the intrinsic record provided "some standard for measuring [the] degree" of "space relationship," such that a person of ordinary skill in the art would be informed, with reasonable certainty, of its scope. Turing to the specification, the court found that the relationship could be "neither infinitesimally small nor greater than the width of a user's hands." The court then examined arguments made during prosecution – where the applicant argued that the spaced relationship must allow for "substantial removal of [a first particular signal type] from [another]" – and reasoned that a skilled artisan would be able to determine such a relationship by "calculating the point in which the [first] signals are substantially removed." Thus, the could held, "a skilled artisan would understand the inherent parameters of the invention as provided in the intrinsic evidence," reasoning "the term 'spaced relationship' does not run afoul of 'the innovation-discouraging zone of uncertainty against which [the Supreme Court] has warned,' and to the contrary, informs a skilled artisan with reasonable certainty of the scope of the claim."

Biosig Instruments, Inc. v. Nautilus, Inc. No. 2012-1289 (Fed. Cir. April 27, 2015)(J. Wallach).

- *Author*: Brock Wilson

Federal Circuit Decides Sua Sponte To Consider En Banc Whether The Bar On Registration Of Disparaging Trademarks Violates The First Amendment

On April 27, 2015, the Federal Circuit issued a precedential order vacating its recent panel opinion in *In re Tam*, reinstating the appeal, and ordering the case be heard en banc.

In 2010 and 2011, Mr. Tam sought to register the trademark "THE SLANTS" for performances of his Asian-American dance rock band, The Slants. Pursuant to 15 U.S.C. § 1052(a), the examining attorney refused to register Mr. Tam's mark because it was disparaging to people of Asian descent. The Trademark Trial and Appeal Board (TTAB) affirmed and Mr. Tam appealed to the Federal Circuit, arguing that the term "slants" has many meanings and was not disparaging. Mr. Tam also argued that the statute is unconstitutional under, inter alia, the First Amendment, because it conditions a benefit (trademark registration) on relinquishment of speech. The Federal Circuit applied its two-part test from *In re Geller*, 751 F.3d 1355 (Fed. Cir. 2014), and found substantial evidence, based largely on Mr. Tam's own submissions, that the term "slants" in this case likely referred to people of Asian descent, and the mark is disparaging to a substantial composite of people of Asian descent. The court rejected Mr. Tam's First Amendment challenge based on the court's precedent stemming from *In re McGinley*, 660 F.2d 481 (CCPA 1981). Bound by its precedent, the panel affirmed the TTAB's refusal to register Mr. Tam's mark. Judge Moore, the author of the panel opinion, also authored "additional views," further analyzing the First Amendment issue and questioning the continuing propriety of *McGinley*.

One week after the panel opinion, the full court ordered the case to be heard en banc. The court requested that the parties file new briefs addressing a single question: whether the bar on registration of disparaging marks in 15 U.S.C. § 1052(a) violates the First Amendment. The Federal Circuit will entertain amicus briefs, and will likely hear oral argument later this year or early next year.

In re Tam, No. 2014-1203 (Fed. Cir. Apr. 27, 2015) (per curiam Order).

- Author: Jason Weil

DISTRICT COURT CASES

District Court Grants Motion for Summary Judgment of No Willful Infringement

On April 23, 2015, Chief Judge Stark, in the district of Delaware, granted plaintiffs' motion for summary judgment of no willful infringement of the patents asserted in defendant's counterclaims, finding that the first prong of *In re Seagate* cannot be satisfied.

Defendant/counter plaintiff had asserted the same patents against the same parties in an earlier litigation, in which plaintiffs/counter defendants were found to be willful infringers. The products at issue in this case were based on the products in the earlier case, but they were redesigned consistent with previous statements by defendant indicating non-infringing alternatives. Defendant/counter plaintiff admitted that the products in the current case were not identical to those in the earlier case, but claimed that the products were "essentially unchanged." The court found that plaintiff/counter defendants had credible, reasonable non-infringement theories based on the redesign, which was based on defendant/counter plaintiff's previous statements, as well as the fact that the litigation positions regarding the asserted patents had changed from the earlier litigation. As a result, defendant/counter plaintiff could not prove by clear and convincing evidence that plaintiffs/counter defendants acted despite an objectively high likelihood that their actions constituted infringement of a valid patent.

F*airchild Semiconductor Corporation, et. al. v. Power Integrations Inc.,* Civ. No. 1:12-cv-00540-LPS (D. Del.).

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