SHIMOKAJI IP
INTELLECTUAL PROPERTY

April 2018

Shimokaji IP specializes in the strategic development of patent and trademark portfolios. We serve start-ups, Fortune 100 companies, government entities, and universities. Our expertise and representation extends across the US and throughout Asia.

Keep in touch! Email us ClientServices@shimokaji.com and explore www.shimokaji.com

Your Own Patents Will Be Used as Prior Art Against You

A USPTO roundtable explained its continuing efforts to improve prior art searching by examiners.

In particular, the USPTO wants to give examiners better searching capability of prior patent applications by the same patent owner. The prior patent applications include both US and foreign ones.

The technology is expected to enable faster searching for the same patent owner, but also for the same inventors. Automated uploading of prior art from related patent applications will be possible.

Importantly, the technology will identify similarities in disclosure among the current patent application and prior patent applications.

COMMENT:

This means that patent applications will get higher prior art scrutiny and the prior art will include the patent owner's prior patents that can be used to reject a current application.

Can You Create a User Interface that is Patentable?

Yes.

Core Wireless owned patents for display interfaces for small screens like in mobile phones. The invention provided an application summary window that displayed a "limited list of common functions and commonly accessed stored data which itself can be reached directly from the main menu listing some or all applications."

Core Wireless sued LG for infringement. LG defended on the grounds that the patents were invalid since they were mere abstract ideas.

The Federal Circuit explained that "[a]lthough the generic idea of summarizing information certainly existed prior to the invention, these claims are directed to a particular manner of summarizing and presenting information in electronic devices."

And, "[t]hese limitations disclose a specific manner of displaying a limited set of information to the user, rather than using conventional user interface methods to display a generic index on a computer."

The Federal Circuit further pointed to the patent description of the prior art. The "prior art interfaces had many deficits relating to the efficient functioning of the computer, requiring a user to 'scroll around and switch views many times to find the right data/functionality.'"

The patents were therefore valid.

COMMENT:

It was not merely a different user interface. Nor was it merely a different way of summarizing information. Rather, it was a user interface that improved usability of the device that made the interface patentable.

Google's Use of Oracle's Java API is Not Fair Use

Google used thirty seven Java application programming interfaces ("API packages") in Google's Android operating system.

The Java platform is software that enables computer programmers to write programming language that can run on different computers without different computer programs. The API packages are pre-written programs for different computer functions.

There was no dispute that Google copied the API packages and the copies went into Android phones.

The dispute was over whether Google's copying was fair use. That use applies for purposes such as criticism, comment, news reporting, teaching, or research. The foregoing is not an exhaustive list.

The Federal Circuit reiterated the four factors to determine fair use: 1) the purpose and character of the use, 2) the nature of the copyrighted work, 3) the amount and substantiality of the portion used, and 4) the effect on the market value of the work.

The court found that, even though Google gave away the API packages for free, it was of a commercial use that weighed against fair use. For the second factor, the API packages were based more on functional considerations, as opposed to creative ones, which weighed in favor of fair use. Google's use of the API packages did not transform them into something new, even though the packages were used in a new context - smart phones - which weighed against fair use.

Though Google copied more lines of software code than was "necessary" to write in Java language, the court determined the third factor to be neutral. Under the fourth factor, Android was used as a substitute for Java and had a direct market impact, which weighed against fair use.

The court found no fair use by Google.

COMMENT:

If the decision is not reversed upon further appeals, Google could be liable for very significant damages. Oracle sought almost $9 billion.

Musicians Williams and Thicke Infringe Marvin Gaye's Song

Pharrell Williams and Robin Thicke's song "Blurred Lines" infringed the copyright of Marvin Gaye's song "Got to Give it Up", according to the Ninth Circuit.

At trial, the Gaye's heirs were awarded $5M.The Ninth Circuit affirmed the award and used an "inverse-ratio rule". The greater the infringer's access to the copyrighted work, the less similarity is required to find infringement.

COMMENT;

Artists have expressed concern over the decision arguably providing copyright protection to a "musical style".

Contact Us

SHIMOKAJI IP
8911 Research Drive
Irvine California 92618 USA
www.shimokaji.com
ClientServices@shimokaji.com
949-788-9961