

# IP Musings

with **Learned Paw** and **Percy the Lizard**

October 2016, Issue No. 2

by Jiyong David Chung



**50th Anniversary of Star Trek (September 2016).** Trekkies flocked to New York to celebrate the 50th anniversary of the original Star Trek series. The first episode had aired on September 8, 1966. The series and its subsequent spin-offs foreshadowed many technological innovations, such as smart phones ("communicator"), virtual reality devices ("holodeck"), health monitoring devices ("tricorder"), speech processors, thin displays, etc.

Percy the Lizard asks, can you guess which of the original Star Trek episodes features an alien lizard? (Answer: "Arena")

**Arendi S.A.R.L. v. Microsoft** (September 2016). In *Arendi S.A.R.L.*, the Federal Circuit sided with the patentee and ruled that, in establishing obviousness of a claim under 35 U.S.C. 103, the challenger cannot rely solely on a "common sense" argument to avoid having to demonstrate that prior art discloses each of the significant claim limitations.

This case indicates the court's unwillingness to further expand the scope of *KSR International*,

which had set forth the following: to establish obviousness of a claim, the challenger is not required to provide evidentiary support to show a *motivation to combine* prior art references that disclose or suggest each limitation of the claim.

**McRO, Inc. v. BANDAI NAMCO Games America Inc. et al.** (September 2016). The Federal Circuit reversed the lower court decision that the claims were patent ineligible under *Alice*. Importantly, the court cautioned against oversimplifying claims and failing to account for specific requirements of the claims. This reinforces the position set forth in *Enfish* against describing claims at too high a level of abstraction. Essentially, *McRO, Inc.* and *Enfish* proscribe, when applying the first prong of the *Alice* test, arbitrary characterization of the claims as abstract, by disregarding their limitations.

Unlike other cases in which the Federal Circuit sided with patentees, in *McRO, Inc.*, the court analyzed the claim mainly based on its breadth. That is, the court based a significant portion of its opinion on the preemptive effect that the claimed subject matter would have on innovation.

