

IP Musings with Learned Paw and Percy the Lizard

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Justin Timberlake and Britney Spears's attorney fees denied on appeal (October 2016).

In 2009, Large Audience Display Systems (LADS), a non-practicing entity (PAE), sued Justin Timberlake and Britney Spears, alleging that the singers infringed a patent on jumbo screen technology by using it in concerts. When the United States Patent and Trademark Office (USPTO) reexamined and invalidated the patent, the celebrities requested the California Central District court to allow them to collect their attorneys' fees from LADS. The District court granted the request.

On appeal, the Federal Circuit reversed the lower court's decision and remanded the case, denying temporarily at least Justin Timberlake and Britney Spears their attorney fees. The court explained that the invalidation of the claims by the USPTO did not support the lower court's finding of frivolousness. The court also pointed out that the defendants' attorneys may have padded their fees.

Poly-America, L.P. v. API Industries, Inc. (October 2016) The Federal Circuit further clarified how limiting terms can be read into claims based on the specifica-

tion and the prosecution history when the claim language does not explicitly include the limiting terms.

The specification for the patent in dispute described a draw-string trash bag with a narrowed opening. The specification showed how the narrowed opening makes fitting the bag to a trashcan easy - a particular problem unaddressed by prior art. Further, the specification did not describe any embodiments without the feature.

Given the above, the court read the narrowed opening into claim 10, stating that the specification *disavowed* the scope asserted by the patentee. The prosecution history supported the court's position, as it showed that the patentee overcame an examiner's rejection by distinguishing the claims from the prior art based on the narrowed-opening feature.

One takeaway from *Poly-America* is that when drafting a specification that includes a description of a technical problem and related solutions (e.g., in anticipation of *Alice* issues during prosecution, post-grant reviews, and litigation), the drafting agent must ensure that the description does not imply claim scope narrower than that defined by the claim language.

