

The IP Beacon, October 2016

October 31, 2016 Adam Fowles, Gavin George, Jason Whitney

PRACTICES AI and Technology, Mechanical, Patent Litigation, Patent Office Trials, Patents, Trademark and Advertising, Intellectual Property

[View the October 2016 IP Beacon PDF.](#)

The Few, The Proud, The Patent-Eligible Software Claims

By [Adam Fowles](#), Joseph Mencher and [Gavin George](#)

It is no secret that it is difficult for software technology patent claims to be deemed subject matter eligible under 35 U.S.C. § 101 on appeal, as only a handful of cases involving software technology have passed § 101 scrutiny by the Federal Circuit since the Supreme Court's decision in *Alice v. CLS Bank*. Until recently, there have been only three such cases: *DDR Holdings, LLC v. Hotels.com, L.P.*, *Enfish LLC v. Microsoft Corp.*, and *BASCOM Global Internet Services, Inc. v. AT&T Mobility LLC*. However, now a fourth case may be added to those ranks. On September 13, 2016, the Federal Circuit decided *McRO, Inc. v. Bandai Namco Games America Inc.*, ruling that claims directed to automating part of a preexisting 3-D animation method were patent-eligible under § 101. This article provides a review of the McRO case facts, the legal reasoning of the Federal Circuit in reaching its conclusion, and some new practical takeaways for claim drafting and prosecution before the U.S. Patent Office.

[Read more.](#)

Five Things Inventors May Not Realize About the Patent Process

By Daniel Tsai

Whether you are a garage tinkerer or an engineer at a technology company, you probably have considered obtaining a patent to protect one of your ideas or innovations. There is an allure to a government issued document declaring that you are the inventor of a patent that grants you exclusive right to your innovation. However, the next time that light bulb goes off above your head, here are five things you should consider before calling your patent lawyers.

[Read more.](#)

Changes Coming to Trademark Trial and Appeal Board Rules of Practice

By [Jason Whitney](#) and Michael Goodman

The United States Patent and Trademark Office has published its first major update to the rules for trademark trials and appeals in nearly a decade.

The final changes to the Trademark Trial and Appeal Board "TTAB" Rules of Practice appear in the October 7, 2016 Federal Register (81 Fed. Reg. 69950) and are scheduled to go into effect on January 14, 2017. Unlike substantive rule changes that generally apply only to future proceedings, the procedural TTAB rule changes will apply to all active proceedings as of January 14, 2017, whether pending on or filed after the effective date.

[Read more.](#)

The Federal Circuit Reins in the Law of Nature Doctrine

By Robert Mazzola

Last month, the Court of Appeals for the Federal Circuit (CAFC) in *Rapid Litigation Management Ltd. v. CellzDirect, Inc.*, No. 15-1570 (Fed. Cir. July 5, 2016) overturned a lower court's finding of invalidity under the law of nature doctrine of 35 U.S.C. § 101 for a patented process involving re-freezing hepatocytes. The question before the court was whether the claims of U.S. Patent No. 7,604,929 (the "929 patent") recited patent eligible subject under 35 U.S.C. § 101 when analyzed using the two-part test articulated in *Alice Corp. v. CLS Bank Int'l*. The CAFC held that the patented process was not "directed to a patent-ineligible law of nature," but rather a "new and improved way of preserving hepatocyte cells for later use." *Id.* at 2 and 9.

[Read more.](#)

Audi, Others Can't Escape IP Suit Over Fuel Use Technology

By James Shimota, Howard Levin and Aaron Taggart

An Illinois federal judge ruled Wednesday that Audi, Chrysler and Mercedes-Benz must face allegations brought by a company that claims to hold the patent for technology that alerts drivers when they are burning too much fuel...

The judge issued a series of rulings Wednesday both denying summary judgment to three major automotive companies and outlining how he defined the patent claims. Because of the rulings, Audi of America Inc., Mercedes-Benz USA LLC and Fiat Chrysler, or FCA USA LLC, will have to face the lawsuits.

[Read more.](#)