

## The IP Beacon, April 2018

---

April 17, 2018 David Bell, Jason Bloom, Suzie Trigg, Jeffrey Wolfson, Tiffany Cooke, Tiffany Ferris, Stephanie Sivinski

---

**PRACTICES** Mechanical, Patent Litigation, Patent Office Trials, Patents, Trademark and Advertising, Advertising, Marketing and Promotional Law, Copyright, Intellectual Property

---

[View the PDF version of the April 2018 IP Beacon.](#)

### Are Works Generated by AI Subject to IP Protection?

When Philip Dick wrote the 1968 novel "Do Androids Dream of Electric Sheep?," the inspiration for the 1982 film "Blade Runner," artificial intelligence was more fiction than science. Fifty years later, the *Harvard Business Review* predicts that AI will be the single biggest technological development of our era, as transformative as the steam engine or electricity. AI's hallmark is machine learning, a machine's ability to improve its performance on a given task without additional human instruction. While businesses have yet to harness AI's full potential, many have incorporated AI capabilities in customer service chat bots and online ad optimization. Cutting-edge uses include analysis of medical images to improve diagnostics and financial data to prevent money laundering. AI has also crept into our daily lives. Everything from digital assistants like Amazon's Alexa to Facebook's facial recognition technology to Google Translate use AI.

[Read more](#)

### What's in a Name? Sometimes, a Claim

*Why Marketers Need Trademark and Regulatory Counsel at the Naming Stage*

Savvy marketers know that a product name is important. It is part of what sets your product apart from a host of others on the market. In "trademark speak," it is your source identifier. Perhaps because they are so important, product names often undergo "clearance" by trademark counsel, who analyze the name's suitability as a source identifier vis-à-vis third parties and the United States Patent and Trademark Office (USPTO). A "clear" name might next undergo prosecution in an attempt to obtain a federal registration. This clearance and prosecution process often happens without any input from regulatory counsel. This approach is both problematic and costly. Product names can be more than source identifiers. They can and often do make claims about a product's attributes. Such claims may make marketers the target of enforcement actions from federal agencies like the Food and Drug Administration (FDA).

[Read more](#)

### PTAB Goes Off-Road with Commercial Success and Teaching Away Analysis

In *Polaris Industries, Inc., v. Arctic Cat, Inc.*, No. 2016-1807, 2016-2280 (Fed. Cir. Feb. 9, 2018), the Court of Appeals for the Federal Circuit (Federal Circuit) overturned a Patent Trial and Appeal Board (Board) decision that all claims of a patent directed to a side-by-side all-terrain vehicle (ATV) were unpatentable as obvious in a first *inter partes* review (IPR), while affirming the Board's decision that the claims of the same patent were not unpatentable in view of a different combination of references in a second IPR. Specifically, the Federal Circuit found that the Board failed to conduct a proper teaching away analysis and failed to weigh Polaris's argument of commercial

success when determining certain claims were obvious.

[Read more](#)

## Patent Owners See ITC as Alternate Venue

Venue rose to the forefront of patent litigation law when the U.S. Supreme Court issued its decision in *TC Heartland v. Kraft Foods Group Brands LLC* and the Federal Circuit issued its decision in *In re Cray Inc.* Both decisions narrowed a long-standing interpretation of 28 U.S.C. § 1400(b), the guiding venue statute for patent infringement litigation. Based on these new cases, patent owners who elect to enforce their rights in district court may find themselves forced to litigate in a defendant's home venue. This often undesirable result may have patent owners looking for alternative forums to assert their rights. One such forum patent owners may turn to is the U.S. International Trade Commission. While the ITC presents its own challenges, it offers a broad range of benefits to both patent owners and accused infringers. These benefits in conjunction with recent case law could result in an increase in Section 337 filings at the ITC.

[Read more](#)

## New Law: Federal Circuit Finds Ban on Scandalous/Immoral Trademarks Unconstitutional

As part of a now-infamous 1972 monologue, comedian George Carlin listed the “Seven Words You Can Never Say on Television,” colorfully repeating each throughout his routine. While many of those words remain unacceptable for the airwaves, they may now be suitable for federal trademark registration, thanks to a recent decision from the Federal Circuit Court of Appeals.

[Read more](#)

## Federal Circuit Ruling on Patent 863

The U.S. Court of Appeals for the Federal Circuit found in *Exmark Manufacturing Co. Inc. v. Briggs & Stratton Power Products Group LLC*, No. 2016-2197 (Fed. Cir. Jan. 12, 2018), that a district court did not err in denying summary judgment for indefiniteness. Specifically, the Federal Circuit determined that the claim language and specification of U.S. Patent No. 5,987,863 (the '863 patent) provided reasonable certainty on how to determine whether a lawn mower baffle portion was long enough and straight enough to be considered “elongated and substantially straight” (claim 1 of the '863 patent) for the purposes of determining infringement.

[Read more](#)

## Federal Circuit Flips – *Wi-Fi One v. Broadcom* Holds That PTAB's Time-Bar Determinations Are Appealable

On January 8, 2018, the U.S. Court of Appeals for the Federal Circuit issued its en banc decision in *Wi-Fi One, LLC v. Broadcom Corp.*, Appeal 2015-1944 (Fed. Cir. Jan. 8, 2018) (*en banc*) holding that Patent Trial and Appeal Board (PTAB) time-bar determinations under 35 U.S.C. § 315(b) in an *inter partes* review (IPR) proceeding are appealable. The *en banc* decision overrules a panel's earlier decision in *Achates Reference Publishing Inc. v. Apple Inc.* 803 F.3d, 652 (Fed. Cir. 2015), *cert. dismissed*, 136 S. Ct. 998 (2016).

[Read more](#)