



ORANGE COUNTY INTELLECTUAL PROPERTY LAW ASSOCIATION

# NEWSLETTER

January/February 2021  
VOLUME 25 - ISSUE 1

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## FEDERAL CIRCUIT SUMMARIES

Contributors: Knobbe Martens

### Non-Disclosure Agreement Controls Ownership of Patents Arising From Confidential Information Received Thereunder

In [Sionyx LLC v. Hamamatsu Photonics K.K.](#), Appeal No. 19-2359, the Federal Circuit held that a party who discloses confidential information pursuant to an NDA may be entitled to ownership of U.S. and foreign patents filed by the receiving party when the patents arise from confidential information provided by the disclosing party, and the terms of the NDA provide that ownership of any patents arising from confidential information are owned by the disclosing party, even if employees of the receiving party contribute to the patented invention.

SiOnyx LLC was founded to commercialize a patented process for making silicon with new electronic properties. Hamamatsu entered into a Non-Disclosure Agreement ("NDA") with SiOnyx to discuss joint development of the technology and received confidential information. The NDA provided that ownership of all patent rights in or arising from confidential information would be owned by the disclosing party. Hamamatsu ultimately declined to use SiOnyx's proprietary process. However, Hamamatsu continued to develop pho-

todetector devices using SiOnyx's confidential information, devices that Hamamatsu patented in the U.S. and several other countries.

After Hamamatsu started commercializing products, SiOnyx sued Hamamatsu for breach of contract, unjust enrichment, patent infringement and correction of inventorship in Hamamatsu's U.S. patents. After trial, a jury found for SiOnyx, and in particular, found that Hamamatsu breached the NDA by using SiOnyx's confidential information and that one of SiOnyx's founders was a co-inventor of Hamamatsu's U.S. patents. In post-trial motions, SiOnyx sought a determination of sole-ownership of Hamamatsu's U.S. and foreign patents. The district court granted SiOnyx's motion regarding ownership of Hamamatsu's U.S. patents, but denied the motion with respect to its foreign patents.

On appeal, the Federal Circuit affirmed the district court's decision transferring ownership of the U.S. patents and reversed with respect to the foreign patents. The court found that, under the NDA, the disclosing party owned the patents arising from the disclosing party's confidential information exchanged under the agreement. Hamamatsu failed to show any evidence that it contributed confidential information to the patents

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# FEDERAL CIRCUIT CASE SUMMARIES

under the terms of the NDA, other than that which it appropriated from SiOnyx. Although the court noted that the jury's finding of co-inventorship might imply that Hamamatsu employees contributed to the claimed inventions, the court distinguished inventorship from ownership. Further, the court found that the employees' rights transferred to Hamamatsu, the contracting party in the NDA. The court held that modification of the claims based on contributions from Hamamatsu employees did not warrant denial of the equitable remedy. Regarding Hamamatsu's foreign patents, the Federal Circuit found that the evidence establishing SiOnyx's sole ownership of the U.S. patents also applied to ownership of the foreign patents, and that the district court could compel transfer of ownership of the foreign patents as an exercise of the court's authority over Hamamatsu.

cept or meaningful application of the abstract idea to save the claims. Thus, the claims were patent-ineligible.



## **No Simulating Alice Requirements: Application of Abstract Ideas Alone Cannot Transform Patent-Ineligible Subject Matter**

In [\*Simio, LLC v. Flexsim Software Products, Inc.\*](#), Appeal No. 20-1171, the Federal Circuit held that a claim whose only inventive concept is the application of an abstract idea using conventional and well-understood techniques is not sufficient to transform the claim into a patent-eligible idea.

Simio sued FlexSim Software Products ("FlexSim") for infringing its patent directed to creating object-oriented simulations using graphics instead of coding to allow the user to more easily build the simulations. FlexSim moved to dismiss the complaint for failure to state a claim, arguing that Simio's asserted claims were abstract ideas that were ineligible for patenting under § 101. The district court dismissed the complaint, finding that Simio's claims were not patent-eligible under Alice's two-step framework. Simio then filed a motion for reconsideration, which the district court denied. Simio appealed.

The Federal Circuit affirmed, holding that the claims were directed to patent-ineligible subject matter. The Federal Circuit agreed that the claims were directed to the abstract idea of using graphics instead of programming to create object-oriented simulations, which had been used since the 1980s and 1990s. The Federal Circuit disagreed with Simio that the asserted claims improve the functionality of prior simulations because the claims improve the user experience, not the functionality of the computer itself. The Federal Circuit also held that the claims did not transform the abstract idea into patent-eligible inventions because the claims lacked any inventive con-

## DISTRICT COURT & PTAB HAPPENINGS

### Patent Owner Granted Leave in IPR to Seek Correction of Claims Held Indefinite in Parallel District Court Litigation

by Rubén H. Muñoz, Akin Gump Strauss Hauer & Feld LLP  
Patent Trial and Appeal Board, District Court, Inter Partes Review  
January 29, 2021

The Patent Trial and Appeal Board recently granted a patent owner's request to seek a certificate of correction for certain claims of a patent undergoing an inter partes review ("IPR"). In granting the request, the board ceded its exclusive jurisdiction to allow the patent owner to seek a certificate of correction from the Director under 35 U.S.C. § 255. In reaching its conclusion, the board answered in the affirmative the question of whether the patent owner had shown a sufficient basis that the mistake in the claims may be correctable. And as such, the board's ruling permits the Patent Office to potentially correct claims held indefinite by a district court in a parallel litigation.

The petitioner in this case sought IPR of some, but not all, claims of the patent under review. After considering the patent owner's preliminary response, the board instituted trial. Soon after institution, the patent owner filed its motion seeking leave to petition the Director for a certificate of correction related to certain claims not under review in the IPR. According to the patent owner, those claims included a mistake correctable under § 255. The petitioner filed an opposition and the patent owner subsequently filed a reply.

In analyzing the patent owner's motion, the board explained that the Federal Circuit in *Honeywell Int'l Inc. v. Arkema Inc.*, 939 F.3d 1345, 1349–50 (Fed. Cir. 2019) describes the three steps a patent owner must take when seeking a certificate of correction of a patent undergoing an IPR—namely: (1) seek authorization from the board to file a motion for leave; (2) if the board grants authorization, the patent owner must ask the board to cede its exclusive jurisdiction so that the patent owner can request a certificate of correction from the Director; and (3) if the board cedes its jurisdiction, the patent owner can then petition the Director for a certificate of correction.

In resolving the patent owner's motion, the board explained that it did not have the authority to decide whether the patent owner met the requirements of § 255. Instead, according to the board, it could determine only whether the patent owner had provided enough basis to support its position that the mistake may be correctable by the Patent Office.

The board explained that § 255 states that the director may correct "a mistake of a clerical or typographical nature, or of minor character," which "appears in a patent and a showing has been made that such mistake occurred in good faith." The patent owner contended that the claims for which it sought correction contained such a mistake because they contained words such as "absorption bands," which made no sense in the context of the patent, instead of the correct terminology, "diffraction peaks." Although the patent owner acknowledged that the claims for which it sought correction were held indefinite—by a district court in a related litigation—they were correctable through a certificate of correction. The patent owner argued that Federal Circuit precedent made clear that the Patent Office has broader authority than a district court to correct errors in a patent. In granting the motion for leave, the board ordered the patent owner to submit, along with its request for a certificate of correction to the Patent Office, the full briefing before the board as well as the board's decision.

**Practice Tip:** Patent owners facing a district court holding of indefiniteness should recognize that, under certain circumstances, they may seek a certificate of correction from the Patent Office, even if the patent is under review before the board. Critically, a patent owner facing such a situation must follow the proper procedural channels before the board to maximize its chances of success.

*Mylan Pharms. Inc. et al. v. Merck Sharp & Dohme Corp.*, IPR2020-00040, Paper 76 (PTAB Dec. 23, 2020)



# INTERNET SIGHTINGS

by Frederic M. Douglas and James E. Hawes

This column highlights some of the more notable recent online notices, newsletters, and blogs dealing with IP prosecution issues.

**Patently-O** – a patent law blog – [Patently.com](http://Patently.com)

- On September 28, 2020, David Hricik discussed the USPTO's proposal for voluntary CLE for patent practitioners. Instead of charging a fee and providing a discount for patent-related CLE units, the proposal offers an online registry of patent practitioners who self-certify completion of patent-related CLE. (<https://patently.com/hricik/2020/09/voluntary-patent-attorneys.html>).
- On September 29, 2020, Prof. Dennis Crouch looked at a denied petition for en banc review in *Immunex and Roche v. Sandoz* (Fed. Cir. 2020) (<https://patently.com/media/2020/09/SandozEnBancPetition.pdf>) for the guidance on structuring assignments to avoid obviousness-type double patenting. (<https://patently.com/patent/2020/09/structuring-assignments-obviousness.html>).
- On October 15, 2020, Prof. Dennis Crouch discussed the principle of "Broadest Reasonable Interpretation" of a claim, which must be considered "in light of the specification." The case for this analysis was *St. Jude Medical, LLC v. Snyders Heart Valve LLC*, 2019-2108, 2019-2109, 2019-2140 (Fed. Cir., Oct. 15, 2020) ([http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/19-2108.OPINION.10-15-2020\\_1669672.pdf](http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/19-2108.OPINION.10-15-2020_1669672.pdf)). (<https://patently.com/patent/2020/10/reasonable-interpretation-specification.html>).
- In his October 10, 2020 post, Prof. Dennis Crouch the nonprecedential opinion, *Tenstreet, LLC v. DriverReach, LLC*, 2020-1101 (Fed. Cir., Oct. 19, 2020) ([http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/20-1101.OPINION.10-19-2020\\_1671364.pdf](http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/20-1101.OPINION.10-19-2020_1671364.pdf)) provides a discussion point regarding Section 101 patent eligibility. A patent claim's advantages over the prior art are not enough without meaningful technological improvements. In other words, "do it on a computer" is not sufficient for patent eligibility. (<https://patently.com/patent/2020/10/eligibility-technological-improvements.html>).

**IPWatchdog** – a patent law blog – [IPwatchdog.com](http://IPwatchdog.com)

- A September 22, 2020 post discussed the USPTO's recent policy retroactively permitting examiners to impose a First Action Final Rejection (FAFR) when the newly presented claims after a continuing application or Request for Continued Examination (RCE) are considered the "same invention" as previously presented claims. The policy was announced in the revised Manual of Patent Examination Procedure (MPEP) Section 706.07(b) (MPEP, E9R10.2019. Fed. Reg. Vol. 85, No. 133 page 41,571). (<https://www.uspto.gov/web/offices/pac/mpep/index.html>) (<https://www.ipwatchdog.com/2020/09/22/newly-created-first-action-final-rejection-policy-adds-needless-complications-patent-prosecution/id=125456/>).

**AIPLA** – the profession's national organization – see [AIPLA.org](http://AIPLA.org)

- AIPLA is planning on holding its Spring Meeting in Seattle, Washington on May 12-14, 2021. No Specification location is provided. Not a surprise. AIPLA has its annual meeting scheduled for October 28-30, 2021. They plan to hold it at the Gaylord National Harbor in Maryland. Information on this meeting and other AIPLA meetings is available at <https://www.aipla.org/events>. Check to make sure a meeting has not switched to a virtual format due to you-know-what.
- The Chisum Patent Academy was scheduled to hold one seminar in 2020, in Boston, Massachusetts on October 1-2, 2020. Instead, the Boston seminar is to be scheduled for a time in 2021, due to you-know-what. More information available at <https://chisum-patent-academy.com/>.

For more information about any of the patent topics mentioned consult *Patent Application Practice*. Trademark topics are discussed in *Trademark Registration Practice*. Both are published by West and updated twice a year. For patent prosecution or litigation questions, contact Fred Douglas at 949/293-0442 or by email at [fdouglas@cox.net](mailto:fdouglas@cox.net).



## OCIPLA RECENT EVENTS

### **September 24, 2020 Luncheon—Tips for Practice Before the EPO**

*James Gray, European Patent Attorney*



**OCIPLA**  
**VIRTUAL LUNCHEON**  
THURSDAY, SEPTEMBER 24, 2020  
12:00 PM - 1:00 PM  
**\*\*ONLINE ONLY\*\***  
  
THIS MONTH: TIPS FOR PRACTICE  
BEFORE THE EPO

### **October 22, 2020 Luncheon—Current Trends in Online Brand Enforcement**

*Morris Wilder, Corsearch*

*Lindy M. Herman, Rutan & Tucker, LLP*

*Jonathan Tudryn, Western Digital*



**OCIPLA**  
**OCTOBER LUNCHEON**  
THURSDAY, OCTOBER 22, 2020  
NOON - 1:00 P.M.  
ONLINE ONLY  
  
THIS MONTH:  
CURRENT TRENDS IN ONLINE  
BRAND ENFORCEMENT

ONLINE

# OCIPLA RECENT EVENTS

**November 19, 2020 Luncheon—Trials During the Pandemic: From Juries to Zoom!**

*Joseph R. Re, Knobbe Martens*



**Joe Re**  
**Knobbe Martens**

**OCIPLA**  
ORANGE COUNTY INTELLECTUAL PROPERTY LAW ASSOCIATION

**VIRTUAL LUNCHEON**

**THURSDAY, NOVEMBER 19, 2020**  
**12:00 PM - 1:00 PM**  
**\*\*ONLINE ONLY\*\***

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**THIS MONTH:**  
**TRIALS DURING THE**  
**PANDEMIC: FROM JURIES**  
**TO ZOOM!**

**December 16, 2020—OCIPLA’s 2020 Holiday Party and Trivia Contest**



**OCIPLA**

**2020 Holiday Party**  
**and Trivia Contest**

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**WEDNESDAY**  
**DECEMBER 16, 2020**  
**5:30 PM - 6:30 PM**  
**\*\*ONLINE ONLY\*\***

## OCIPLA RECENT EVENTS

### **January 21, 2021 Luncheon—Patent Law Year in Review**

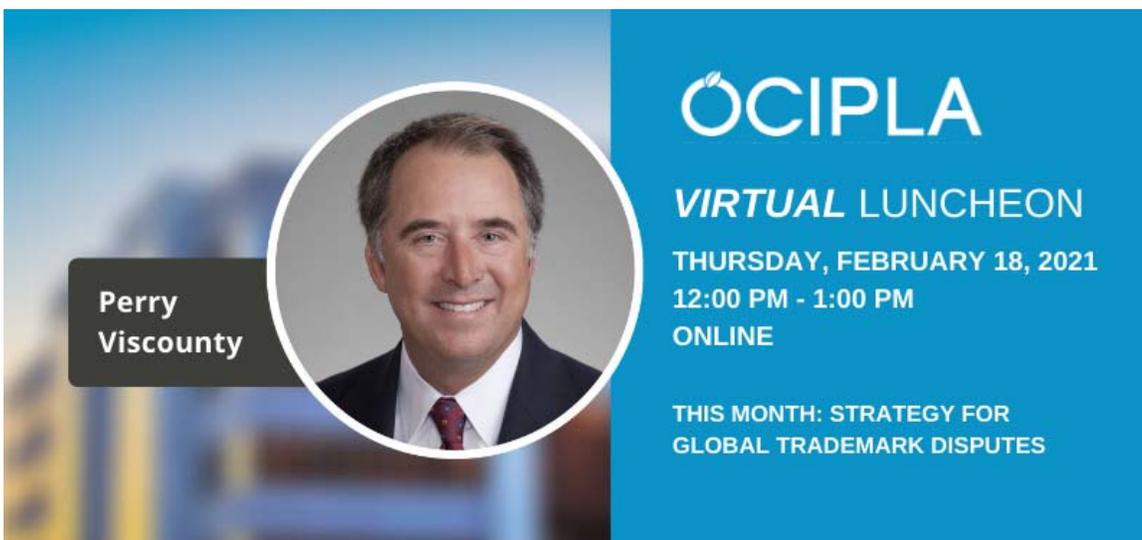
*William C. Rooklidge, Gibson, Dunn & Crutcher LLP*



A promotional graphic for an OCIPLA virtual luncheon. On the left, a circular portrait of William C. Rooklidge is shown against a blurred background of a building. Below the portrait, a dark grey box contains the text "William C. Rooklidge" in white. To the right of the portrait, the OCIPLA logo is displayed in white on a dark grey background. Below the logo, the text "VIRTUAL LUNCHEON" is written in white, followed by "THURSDAY, JANUARY 21, 2021", "12:00 PM - 1:00 PM", and "\*\*ONLINE ONLY\*\*". At the bottom, it says "THIS MONTH: PATENT LAW YEAR IN REVIEW".

### **February 18, 2021 Luncheon—Strategy for Global Trademark Disputes**

*Perry J. Viscouny, Latham & Watkins LLP*



A promotional graphic for an OCIPLA virtual luncheon. On the left, a circular portrait of Perry J. Viscouny is shown against a blurred background of a building. Below the portrait, a dark grey box contains the text "Perry Viscouny" in white. To the right of the portrait, the OCIPLA logo is displayed in white on a blue background. Below the logo, the text "VIRTUAL LUNCHEON" is written in white, followed by "THURSDAY, FEBRUARY 18, 2021", "12:00 PM - 1:00 PM", and "ONLINE". At the bottom, it says "THIS MONTH: STRATEGY FOR GLOBAL TRADEMARK DISPUTES".



# JOIN AN OCIPLA COMMITTEE!

## **AMICUS COMMITTEE**

This committee shall: a) scrutinize judicial decisions which involve significant issues of law or practice which affect intellectual property, (b) recommend to the Board of Directors that amicus curiae briefs be filed in appropriate cases, and (c) draft OCIPLA amicus curiae briefs.

## **PROFESSIONAL PROGRAMS COMMITTEE**

This committee shall identify and recommend curricula to the Board of Directors and assist in coordinating educational programs to be conducted during regular monthly meetings or at other times on topics which: (1) are of interest and benefit to the OCIPLA members; or (2) pertain to the professional activities of OCIPLA members and are of interest to others. The Committee will also assist the Board of Directors in obtaining speakers and otherwise preparing for the presentation of approved educational programs. The Professional Programs Committee shall include a litigation and prosecution subcommittees.

## **CORPORATE PRACTICE COMMITTEE**

This committee shall develop and disseminate information that is particularly useful to in-house attorneys, and promote efficient exchanges of best practices among in-house attorneys. *Co-chairs:*

- **MICHAEL KLINE**,  
*michaelkline@clevelandgolf.com*
- **MARK KERTZ**, *mark.kertz@medtronic.com*

## **MEMBERSHIP COMMITTEE**

This committee shall focus on expanding and diversifying the membership of OCIPLA, and shall work closely with other Committees and the Board of Directors to provide insights as to what IP practitioners in our IP community want from a legal organization and how OCIPLA can better the local IP community.

## **NEW LAWYERS COMMITTEE**

This committee shall focus on members in their first ten years of practice. The Committee shall provide educational and networking opportunities to new lawyers at OCIPLA. In addition, the Committee shall work closely with other Committees to provide new lawyers with opportunities to become more involved in the association, including participating in planning for OCIPLA meetings, coordinating networking events and other social activities for OCIPLA, assisting in research & writing projects, and developing educational materials.

***OCIPLA seeks volunteers to serve on Association Committees, whose respective missions are set forth on this page. If you have a few hours a month, we invite you to contact a member of our Board of Directors or the Committee Chairs (identified below) to discuss opportunities to help strengthen the OCIPLA community.***

# MAKE OCIPLA EVEN BETTER!

## **LAW STUDENT COMMITTEE**

This committee shall serve the law students in the local community, with particular focus on communicating their concerns to the Board of Directors and to welcome more law students to join the association as active members. The Committee shall also work closely with other Committees to provide law students with opportunities to become more involved in the association, including participating in planning for OCIPLA meetings, coordinating networking events and other social activities for OCIPLA, assisting in research & writing projects, and developing educational materials.

## **NEWSLETTER COMMITTEE**

This committee shall identify, recommend to the Board of Directors and prepare high quality, educational material for the OCIPLA Newsletter. Co-Chairs:

- **BROCK WILSON**, [bfwilson@akingump.com](mailto:bfwilson@akingump.com)
- **CLARK GORDON**, [cgordon@akingump.com](mailto:cgordon@akingump.com)

## **TRADEMARK PRACTICE COMMITTEE**

This committee shall consider all aspects of the practice of trademark law before the United States Patent and Trademark Office, aid in the institution of improvements in the administration of the trademark laws by the USPTO; monitor proposed changes in the USPTO Rules of Practice relating to trademark law and, with the advice and consent of the Board of Directors, inform the USPTO as to the position of the Association regarding such proposed changes; receive and coordinate views of members in connection with any existing problems or suggestions for improvements in the USPTO administration, and with the advice and consent of the Board of Directors, forward these views to the USPTO, and make recommendations to the Board of Directors regarding these duties.

## **COPYRIGHT PRACTICE COMMITTEE**

This committee shall consider all aspects of the practice of copyright law before the Copyright Office of the Library of Congress, and to make recommendations to the Board of Directors regarding same.

## **FORMER PRESIDENT'S COMMITTEE**

- **EHAB SAMUEL**,  
[esamuel@mannatt.com](mailto:esamuel@mannatt.com)
- **MATT LAPPLE**,  
[matt@lappellubell.com](mailto:matt@lappellubell.com)
- **LAUREN KELLER KATZENELLENBOGEN**, [lauren.katzenellenbogen@knobbe.com](mailto:lauren.katzenellenbogen@knobbe.com)
- **NATE CAMUTI**,  
[nate@camutilaw.com](mailto:nate@camutilaw.com)

## **WOMEN IN IP COMMITTEE**

This committee shall promote the role of women in IP law practice in and around Orange County. Membership and participation are open to men as well.

All committees shall consist of members appointed by the Board of Directors for a two-year term.



**OCIPLA seeks volunteers to serve on Association Committees, whose respective missions are set forth on this page. If you have a few hours a month, we invite you to contact a member of our Board of Directors or the Committee Chairs (identified below) to discuss opportunities to help strengthen the OCIPLA community.**

# OCIPLA 2021 Board of Directors

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## OCIPLA Newsletter

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We hope that the Newsletter is informative, entertaining, and interesting. Comments, ideas, announcements, proposed articles, suggestions and any other communications concerning the content, form or other aspect of this Newsletter may be directed to:

Meredith Williams  
2021 OCIPLA Newsletter Editor

