

FEDERAL CIRCUIT SUMMARY FOR WEEK ENDING FEBRUARY 28, 2020**Collabo Innovations, Inc. v. Sony Corp., Nos. 2019-1152 and 2019-1154 (February 25, 2020) (nonprecedential); Patent No. 7,023,034****Key point(s):**

- Arguments are waived on appeal when not timely raised before the trial court; it is untimely to contest claim construction for the first time at trial when the contested construction is used to institute proceedings
- An illustration, combined with expert testimony, can be substantial evidence showing that a claim limitation is taught even if the claim limitation is not explicitly described in the specification

Facts/Background: Collabo owns U.S. Patent No. 7,023,034, which is directed to solid state imaging devices in which light sensitive elements are arranged in a matrix form. The '034 patent describes and claims a pair of "reflecting walls" that exist over each light sensitive element to partition these light sensitive elements and redirect light hitting a light sensitive element at an oblique angle to a photodiode rather than a neighboring photodiode. Sony filed two IPR petitions alleging that the '034 patent was anticipated by *Tomoda*, obvious over *Tomoda* and *Abe*, and obvious over *Takahashi* and *Abe*. The Board instituted trial on both petitions, adopting a claim construction Sony had advanced in its petition. Collabo did not object to this claim construction in its Response and only objected to this claim construction at oral arguments. The Board's Final Written Decision found the claims of the '034 patent unpatentable. The Board found that *Abe* disclosed a contested claim limitation "wherein a vertical cross section of the reflecting wall is a trapezoid whose upper base is longer than a lower base" recited in claims 3 and 12, though one APJ dissented from this finding. This appeal followed, alleging (1) that the Board's claim construction was in error; and (2) that the Board's decision with respect to claims 3 and 12 was in error because the Board's finding that *Abe* disclosed the contested claim limitation was not supported by substantial evidence.

Holding: Affirmed. The Federal Circuit held that Collabo waived its claim construction argument because the argument was not timely raised. Decisions related to compliance with Board procedure is reviewed for an abuse of discretion, and it was not an abuse of discretion for the Board to deem a claim construction argument waived when the first time the argument was made was during oral arguments, even though the contested claim construction was included in the IPR petition and adopted in the institution decision. The Federal Circuit held the Board's finding that claims 3 and 12 were unpatentable was supported by substantial evidence. The *Abe* reference, as annotated by Sony, illustrated a trapezoidal shape for the vertical cross section of a reflecting wall, and expert evidence supported Sony's argument that the lateral faces of a light shielding film, the bottom surface of a light shielding film, and the top surface of an insulating film formed a trapezoid. One judge dissented from the decision regarding claims 3 and 12, arguing that the cup-shaped film of *Abe* did not teach or suggest a trapezoidal reflecting wall.

In re JC Hospitality LLC, Nos. 2018-2048, 2018-2049 (February 28, 2020) (nonprecedential); Trademark Application Serial Nos. 86/525,425 and 86/525,431

Key point(s):

- A word that is a double entendre but does not bear any relationship to the good or services applied for is likely generic and not registrable
- A showing of distinctiveness needs more evidence than sales and marketing figures for the applicant's businesses in isolation

Facts/Background: JC Hospitality owns two trademark applications seeking to register the mark "THE JOINT" in standard characters. These trademark applications sought coverage in Class 41 (entertainment services) and Class 43 (restaurant, bar and catering services). During prosecution, registration was denied in both applications as (1) generic for both classes of services or, in the alternative, (2) descriptive of the services. After the refusals to register became final, and following reconsideration, the Board affirmed the examining attorney's decision to deny registration of the mark. This appeal followed.

Holding: Affirmed. The Federal Circuit affirmed the Board's finding that the mark was generic based on evidence showing the common use of the term "joint." This evidence included a number of dictionary definitions submitted during prosecution (*e.g.*, from the Oxford English Dictionary), news excerpts using the term "the joint," and other news excerpts using the term "joint" without the definite article "the." Further, while the term "joint" is a slang term for prison, the mark was not registrable as a double entendre because the double entendre does not have significance to the applied-for goods or services. The Federal Circuit affirmed the Board's findings that JC Hospitality had not shown the marks had acquired distinctiveness. JC Hospitality relied on declarations that demonstrated revenue, advertising and marketing expenses, and press and consumer recognition to claim that the marks had acquired distinctiveness. However, because the evidence was limited to a single venue and the sales and marketing figures did not include context comparing the sales and marketing figures for JC Hospitality to similar establishments, the evidence was unpersuasive of distinctiveness. Additionally, the marks often appeared in connection with other marks (*e.g.*, with the mark "Hard Rock Hotel & Casino"), and no evidence was provided demonstrating which mark had attracted public attention.