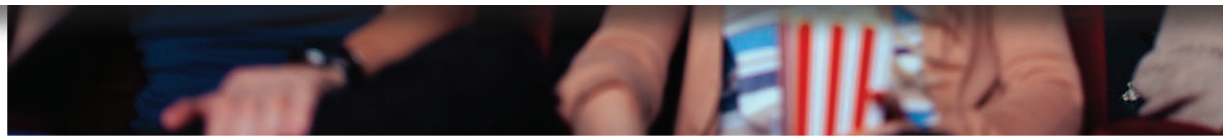
# IDEAS ON INTELLECTUAL PROPERTY LAW



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# "Top Gun" sequel flies clear of copyright infringement

The box office sensation "Top Gun: Maverick" didn't just help bring crowds back into movie theaters post-pandemic. It also spurred a copyright infringement lawsuit based on a magazine article published almost 40 years earlier. The case failed to take flight, though, based on the lack of sufficient similarities between the two works.

## PLAINTIFFS ATTACK

Ehud Yonay authored a 1983 magazine article about the United States Navy Fighter Weapons School, or "Top Gun." It discussed the history, culture and setting of the program and vividly described the experience of flying F-14 aircraft. Yonay focused on two lieutenants, describing their decisions to become fighter pilots and their experiences in naval aviation and the school.

Shortly after publication, Yonay granted Paramount Pictures Corp. all rights to the article for a fixed sum and the promise to credit him in any movies Paramount produced "substantially based upon or adapted from" the article. Paramount released the hit film "Top Gun" in 1986, noting in the credits that it was "suggested by" the article.

After his death in 2012, Yonay's family members became owners of the article's copyright. In 2020, they terminated the agreement with Paramount. Two years later, the studio released the sequel "Top Gun: Maverick."

The Yonays sued Paramount, alleging "Maverick" infringed their copyright. The trial court granted Paramount judgment before trial, and the plaintiffs appealed to the U.S. Court of Appeals for the Ninth Circuit.

> To establish copyright infringement, plaintiffs must show that the works in question share "substantial similarity in protectable expression."

## ARGUMENTS BOMB

To establish infringement, plaintiffs must show that the works in question share "substantial similarity in protectable expression." Plaintiffs generally demonstrate substantial similarity by satisfying both an extrinsic test and an intrinsic test. The extrinsic test looks at the objective similarities of

## BREACH OF CONTRACT CLAIM MISFIRES

The plaintiffs in the "Top Gun" case (see main article) also claimed that Paramount breached its initial agreement with the article author by not crediting him in the sequel. According to the U.S. Court of Appeals for the Ninth Circuit, the agreement required Paramount to credit him in a film if 1) the film was "produced by [Paramount] hereunder," and 2) the film substantially incorporated the plot, theme, characterizations, motive and treatment of the article or any version or adaptation of it.

The court found that Paramount didn't breach the agreement because the first condition wasn't satisfied. It interpreted "produced . . . hereunder" to mean "produced using the rights conferred by this agreement." Because the sequel didn't infringe the copyright in the article, the court reasoned, it followed that Paramount didn't use that copyright — which it received via the agreement — to produce the sequel. The second film, therefore, wasn't produced under the agreement.

the two works, while the intrinsic test is subjective and considers the similarity of expression from the standpoint of the ordinary reasonable observer. The intrinsic test is reserved exclusively for the trier of fact in a trial (typically a jury).

Because the appeals court was evaluating similarity at the summary judgment stage, before a full trial, only the extrinsic test was relevant. To apply that test, a judge must filter out and disregard the nonprotectable elements.

The judge instead focuses on articulable similarities between the plot, themes, dialogue, mood, setting, pace, characters and sequence of events. If none of the artistic elements in those categories are substantially similar, works nonetheless can be substantially similar if they share the elements' "selection and arrangement" — the particular way in which the artistic elements form a coherent pattern, synthesis or design.

When assessing similarity in the individual categories, the court highlighted a problem that "pervade[d]" the plaintiffs' arguments: Although the article contained much original, protected expression, none of it appeared in the film. The plaintiffs identified similarities only by describing both works at "such a high level of abstraction" that the similarities didn't involve protected expression. "Their claim of substantial similarity fails because what is protected is not similar, and what is similar is not protected," the court explained.

For example, the plaintiffs pointed to similarities in several facts related to the Top Gun fighter pilot school, such as grueling training and the design of F-14 wings. But factual elements aren't protected by copyright law. Generalized character traits such as "jocular," "competitive" or "men's men" also aren't protectable.

The plaintiffs' selection-and-arrangement claims failed, too. The Ninth Circuit found that the shared patterns they described weren't the original expression in the article but rather unprotectable abstract ideas (for example, pilots being fierce but playful). Giving characters contradictory traits had been done before.

Even if it hadn't, the court said, the plaintiffs couldn't claim an exclusive right to ideas or concepts at that level of generality, whether individually or in combination. Granting such exclusivity would remove the ideas or concepts from the "stock of materials" available to others and squelch creativity, contrary to the goal of copyright.

### CRASH AND BURN

To prevail on summary judgment, the plaintiffs needed to establish that the expression in "Maverick" was substantially similar to the original expression in the article. For the reasons outlined above, the Ninth Circuit found that it wasn't and thus affirmed the district court. ☐

# Reading tea leaves

## *Court revives trademark application for generic tea term*

If you've had a trademark application rejected by an examiner from the U.S. Patent and Trademark Office (PTO), don't lose hope. Examiners make reversible mistakes — as evidenced by a recent case where the U.S. Court of Appeals for the Federal Circuit rejected the multiple reasons an examiner cited when denying an application.

### A BREWING CONTROVERSY

Bayou Grande Coffee Roasting Company filed to register the mark KAHWA for cafés and coffee shops. The examiner initially found the mark generic or merely descriptive of cafés and coffee shops. The examiner also relied on the doctrine of foreign equivalents, asserting that, because KAHWA means "coffee" in Arabic, Bayou was required to submit an English translation.

> Under the doctrine of foreign equivalents, foreign words used as a mark are translated into English before being tested for genericness and descriptiveness.

Bayou argued that the term doesn't translate to "coffee" in Arabic. It further argued that the doctrine of foreign equivalents didn't apply because the term has an alternative English-language meaning as a specific type of Kashmiri green tea from Central Asia. But the examiner maintained the prior refusals and added a new reason for refusal — that the tea meaning made the term generic or merely descriptive, too.

Bayou subsequently appealed to the Trademark Trial and Appeal Board (TTAB), which affirmed the examiner's refusals based on the green tea meaning of KAHWA. It found that the mark was generic because the relevant consuming public views KAHWA as a type of green tea beverage and thus a key aspect of the genus of cafés and coffee shops, which serve a variety of tea beverages. The board said the mark also was merely descriptive of cafés and coffee shops because it refers to a type of tea, and those businesses sell tea.

The board acknowledged Bayou's argument that the doctrine of foreign equivalents didn't apply but declined to address the issue. Bayou appealed.

### GROUNDS FOR THE APPELLATE RULING

The Federal Circuit agreed with Bayou that the TTAB's genericness finding wasn't supported by substantial evidence. There is no evidence on the record of any café or coffee shop in the United States ever selling kahwa. The lack of evidence that kahwa sales represent a key aspect of café and coffee shop services meant the mark couldn't be generic for such businesses. The fact that relevant customers understood KAHWA to refer to a specific type of tea wasn't enough to establish genericness for cafés and coffee shops selling coffee and other kinds of tea.

The appellate court similarly found no substantial evidence to support the TTAB's mere descriptiveness ruling. The lack of evidence of any U.S. café or coffee shop ever having sold kahwa necessarily meant there was no evidence that selling the tea is a characteristic of cafés or coffee shops — or that relevant customers would immediately know selling kahwa was a characteristic of cafés and coffee shops.

Bayou also argued on appeal that the PTO shouldn't be allowed to rely on the doctrine of foreign equivalents in future proceedings because the TTAB's decision admitted that KAHWA has a well-established alternative English meaning (Kashmiri green tea). Under the doctrine, foreign words used as a mark are translated into English before being tested for genericness and descriptiveness.

An exception applies, though, when ordinary customers wouldn't stop to translate the mark, even if they're familiar with the foreign language. In such circumstances, the doctrine doesn't require the applicant to provide an English translation.

Given that the parties in this case agreed that the term had a well-established alternative English meaning, the court held, the doctrine of foreign equivalents didn't apply. And no translation was necessary.

### IN THE BAG

The Federal Circuit ultimately ruled in Bayou's favor, concluding that none of the TTAB's refusals were viable. It therefore reversed the board's determination that KAHWA wasn't registrable. ◻

## Patent law's indefiniteness standards for "language of degree"

Technology and other patents often employ qualitative terms such as "best" or "optimal" — what courts call "language of degree." As one patentee learned the hard way from the U.S. Court of Appeals for the Federal Circuit, this language can leave a patent vulnerable to being invalidated if objective boundaries for determining what's "best" or "optimal" aren't provided.

### INVALID CLAIM LIMITATIONS

MediaPointe Inc. owned two patents for efficiently routing streamed media content over the Internet. Each described an "intelligent distribution network" that centrally manages requests for streamed media from many geographically dispersed users to mitigate bandwidth problems inherent in transmitting large volumes of data. Several of the patent claims described determining "best" or "optimal" devices or routes.

Akamai Technologies Inc. sued MediaPointe, seeking a declaratory judgment of noninfringement of the patents. MediaPointe countersued for infringement, and then Akamai counterclaimed for a declaratory judgment that the patents were invalid.

The trial court found that claim limitations using optimal or best language were invalid for indefiniteness. MediaPointe appealed to the Federal Circuit.


## THE COURT'S MEASURED APPROACH

Patent claims generally must inform people skilled in the relevant art (known as skilled artisans) about the invention's scope with a reasonable certainty. If they don't, the patent can be invalidated as indefinite.

A court won't find a term of degree definite simply because the specification describes some standard for measuring the term's scope. Rather, language of degree is indefinite unless, when read in light of the patent specification and the prosecution history, it provides objective boundaries for skilled artisans.

> When multiple methods for determining whether a claim limitation is met lead to different results without guidance about which to use, the claim is indefinite.

MediaPointe argued that the claims defined an objective standard for measuring what's optimal or best because each included language requiring the use of "trace route results." These results indicate 1) hops, or how many steps between adjacent devices (such as routers) a data stream must pass through to reach a client, and 2) latency, the time it takes for a message to reach a device from a starting point and for a response to return. The "best" route depends on hops, latency and reliability.

The appeals court found this claim requirement insufficient because it didn't provide a reasonably clear and exclusive definition of optimal/best or provide an objective boundary. As to exclusivity, the claims required considering at least, but not only, trace route results. The claims didn't say that the results were the only factors in determining what's best or optimal.

The specification confirmed the absence of such a restriction. For example, it disclosed a "preferred embodiment" in which the best-performing devices could be determined with reference to "various factors" not limited to trace route results.

The court also found that the requirement to rely on trace route results wasn't "reasonably clear." Even if a claim term refers to certain objective measures, it said, the term is indefinite if 1) it might mean several different things, and 2) no "informed and confident choice" is available among the contending definitions.

The specification showed that hops and latency could indicate different "best" routes in a given case. But the patent provided no guidance about which measure, or combination of measures, should be relied on when they diverge.

## THE ROUTE TO INVALIDITY

The Federal Circuit has repeatedly held that, when multiple methods for determining whether a claim limitation is met lead to different results without guidance about which to use, the claim is indefinite. Finding that was the case here, it affirmed the trial court. ☐

# When may courts correct language in a patent claim?

It's rare for courts to correct errors in patent claims — but it does happen. Read on to learn about the kind of circumstances that might compel a court to act.

## MISTAKES HAPPEN

Canatex Completion Solutions Inc. owns a patent for a two-part device used in oil and gas wells. Wellmatics LLC challenged the patent, arguing that certain patent claims were indefinite due to the lack of an antecedent basis for the phrase "the connection profile of the second part." Canatex countered that a "relevant artisan" in the applicable field would clearly understand that the intended meaning was "the connection profile of the first part."

It asked the trial court to interpret the phrase to reflect a correction of "second" to "first." The court rejected that request and found the claims invalid for indefiniteness. Canatex appealed.

## COURT CORRECTION

The U.S. Court of Appeals for the Federal Circuit has repeatedly held that judicial correction of errors in patents is proper only in narrow circumstances. As such, it noted, the standards for judicial correction of a claim term are "very demanding." Specifically:

- The error must be obvious from the face of the patent,
- The correction must not be subject to reasonable debate based on the claim language, specification or prosecution history, and
- The error must be a minor clerical or typographical error.

Applying those requirements, the appeals court held that Canatex was entitled to judicial correction.


Specifically, the court found that a relevant artisan would immediately see that, as written, the claim language had an error. The phrase at issue ("*the* connection profile of the second part") plainly requires an antecedent — but no "connection profile of the second part" had previously been mentioned in the claim. Moreover, the error was evident on the face of the specification, where nothing in the figures or their descriptions showed a "connection profile" in the second part of the device. And the prosecution history didn't suggest any other construction of the disputed language.

The appellate court concluded, too, that the proper correction wasn't subject to reasonable debate. The only reasonable correction, it said, was to change "second" to "first." Both the claim language as a whole and the specification showed this correction was what "the very character of the invention requires."

Finally, the Federal Circuit found that the correction from "second" to "first" was simple as a textual matter. It followed that the error was properly characterized as a minor clerical or typographical error.

## DON'T COUNT ON IT

As the Federal Circuit's ruling emphasizes, it's no small task to obtain a judicial correction. Rather than hoping to satisfy the exacting standards, patent applicants should take care to ensure their claim language is unambiguous and error free. ◻

# Protect What's Yours

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