

Media Techs. Licensing LLC v. Upper Deck Co.

No. 09-1022, Fed. Cir. (Mayer,* Lourie, Rader)

[Where the claims do not relate to presentation, which may involve] varying parameters (color, typefaces, layout, etc.) to produce distinctive products, [but rather, relate to content,] the finite number of available solutions were predictable.

On March 1, 2010, the Federal Circuit affirmed the district court's summary judgment that U.S. Patents No. 5,803,501 and No. 6,142,532, which related to memorabilia cards, were invalid for obviousness. The Federal Circuit stated:

A patent may not be obtained "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." An obviousness analysis is based on several factual inquiries. A court must examine the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the pertinent art. At that point, a court may consider secondary objective evidence of nonobviousness, such as commercial success, long felt but unsolved need, failure of others, and the like.

The prior art here includes: (a) a trading card with a picture of Marilyn Monroe and a diamond attached to the card ("Monroe"); (b) a piece of a sheet purportedly slept on by one of the Beatles attached to a copy of a letter on Whittier Hotel stationery declaring authenticity ("Whittier"); (c) a piece of fabric purportedly belonging to a Capuchin Friar named Stephen Eckert attached to paper stock including a picture of the friar ("Eckert"); and (d) a greeting card fashioned to look like a novelty item that ostensibly includes a piece of jeans material belonging to James Dean ("Dean"). . . .

Media Tech argues that Monroe differs from claim 1 of the '501 patent because Monroe's diamond is neither "a memorabilia item" nor "a piece," as recited by the claim. Based on the construction of "memorabilia," "an object valued for its connection with historical

events, culture or entertainment,” Monroe’s diamond is memorabilia. As for the “complete” vs. “piece” distinction, even if Monroe’s diamond is not a “piece,” Whittier, Eckert, and Dean teach using “a piece” of memorabilia. Media Tech maintains that claim 6 of the ’501 patent differs from Whittier because Whittier does not teach “a card.” Monroe, however, is a card. It also asserts that Dean differs from claim 24 of the ’532 patent because it does not teach using memorabilia. Dean does teach using memorabilia. It may fail to teach “authentic memorabilia,” but “authentic[ity]” is taught by Whittier and Eckert. Claims 23 and 25 through 29 of the ’532 patent would have been obvious for the same reasons presented for claim 24 because they differ only in their recitation of a specific type of memorabilia piece (e.g., baseball bat, baseball, etc.). Finally, because no reference teaches a “sports trading card,” the obviousness of claim 7 of the ’501 patent depends on whether a person of ordinary skill would apply the teachings of Whittier, Eckert, and Dean to a “sports trading card.” . . . Media Tech asserts that a person of ordinary skill would not have combined the references—or applied them to a sports card—based on: (1) an inability to predict that a trading card would convey memorabilia authenticity; and (2) the trading card field containing an infinite number of identified and unpredictable solutions.

The “inability to predict” argument alleges that “combin[ing] . . . trading cards with a piece of a memorabilia item . . . result[ed in] . . . consumers automatically accept[ing] as authentic a piece of otherwise unidentifiable material.” However, as Media Tech itself acknowledges, consumer acceptance comes from the credibility already associated with the 90-year old trading card industry. As such, Media Tech has not shown that the combination of memorabilia with a conventional trading card resulted, or would result, in consumers accepting authenticity. Regarding the infinite number of identified and unpredictable solutions, the presentation and content characteristics of trading cards are not infinite. These characteristics are limited by the cards’ physical characteristics. Moreover, while presentation involves varying parameters (color, typefaces, layout, etc.) to produce distinctive products, the asserted claims are unrelated to presentation. Instead, they relate to content. Content solutions are significantly limited by the theme and physical confines of the card, and the finite number of available solutions were predictable. Defendants need only show that it would have

been obvious to one skilled in the art to attach a sports-related item instead of those items attached in the prior art references. Defendants have met this burden, and Media Tech's assertion that a person of ordinary skill would not have combined the references—or applied them to a sports card—must fail.

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