

The Court of Appeals for the Federal Circuit remanded a case to the patent office to determine whether the addition of computers or communication devices to an otherwise “unpatentable mental process” would be patentable. Comiskey, the patentee, claimed an invention directed to an arbitration system performed through a computer or communication device. The patent office rejected the invention as obvious. The appellate court noted that though pure mental processes (the arbitration system) are not patentable, if those processes are combined with machines, patentable subject matter *may* result. The patentable subject matter must still be non-obvious, however. The court warned that the “routine addition of modern electronics to an otherwise unpatentable invention typically creates a prima facie case of obviousness.” But that the prima facie case might be overcome if evidence of long-felt need for the *combination* of the mental process *and* a communication device or computer existed. Evidence of long-felt need for the mental process alone is not enough. **In re Comisky, 2007 U.S. App. LEXIS 22414, 2006-1286 (Fed. Cir. 09/20/07).**

Judge Schiltz dismissed Swift’s patent invalidity defense based on the doctrine of assignor estoppel. Superior sued Swift for infringement of a patent covering a new axel. The two inventors of the patented axel, Murphy and Schmidgall, had earlier assigned the patent to Superior. At the time of the assignment, Murphy was the founder of Swift. After being sued, Swift asserted that the patent was invalid for naming Schmidgall as an inventor, because allegedly Schmidgall merely oversaw development of the axel. Superior responded that Swift’s invalidity defense should be barred under the assignor estoppel doctrine because Murphy had assigned the patent to Superior. Under the doctrine, one who assigns a patent cannot later challenge its validity. The court agreed finding that Murphy’s privity with Swift barred its invalidity defense. The court also rejected Swift’s argument that assignor estoppel should not apply when invalidity is based on incorrect inventorship. **Superior Indus., LLC v. Swift Mfg. Co., 2007 U.S. Dist. LEXIS 71124, 05-CV-2167 (D. Minn. 09/24/07).**

Judge Montgomery overruled Equifax’s objections to Magistrate Judge Mayeron’s order granting Fair Isaac’s motion to compel production of an algorithm trade secret. Fair Isaac sued Equifax for unfair competition and false advertising after Equifax developed a competing algorithm that calculates consumer credit scores. Equifax objected to an order compelling production of the algorithm and proposed that the court adopt a new standard for analyzing trade secret discovery disputes. Equifax argued that a new standard would increase the plaintiff’s burden by requiring it to show a “substantial factual basis” for the claims before obtaining discovery of the trade secret. Judge Montgomery expressed doubt that the factual basis requirement was necessary under the old test and agreed with Judge Mayeron’s conclusion that even if a substantial factual basis was required under the test, Fair Isaac fulfilled it. As a result, in the future, the court may include the substantial factual basis factor in its analysis of trade secret discovery disputes. **Fair Isaac Corp. v. Equifax, Inc., 2007 U.S. Dist. LEXIS 71187, 06-4112 (D. Minn. 9/25/07).**