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Judge Albright Swipes Right on Bumble's 'Original Patent' Requirement Defense

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On Tuesday, Judge Alan Albright, District Court Judge for the Western District of Texas, granted summary judgment in a patent infringement lawsuit brought against Bumble Trading LLC (Bumble), the dating app company, finding the patents asserted against it were invalid under the rarely-used "original patent" requirement of 35 U.S.C. § 251(a).

What is the "original patent" requirement?

Under certain circumstances, the United States Patent and Trademark Office (USPTO) is permitted to "reissue [a] patent for the invention disclosed in the original patent . . . for the unexpired part of the term of the original patent." 35 U.S.C. § 251(a). The key phrase in the analysis is whether the reissued claim limitations were part of "the invention disclosed in the original patent." As Judge Albright recognized, the Supreme Court and the Federal Circuit have interpreted this requirement narrowly, that is, "the 'particular combination' of reissue claim limitations must be disclosed in the original patent specification 'in an explicit and unequivocal manner.'" It is not enough that the reissued claim limitation might have been disclosed or suggested by the original patent.

How is the "original patent" requirement applied?

Judge Albright began his analysis by addressing the nuances of the analysis. The original patent requirement focuses on the original specification, not the original claims. While it is not sufficient that the original specification provide mere support for broadened reissued claims, the explicit disclosure for the invention may be "stitched together" by referring to various portions of the original specification, particularly where those disparate descriptions are tied together by an overview section.

How did the Court apply the "original patent" requirement?

As described by Judge Albright, the reissued patent claim asserted against Bumble was "a method for tracking a user with a GPS-enabled cell phone and sharing 'visited geographic location data' to friends." The focus of the Court's analysis was on whether the tracking and sharing of visited geographic location data was explicitly and unequivocally specified in the original patent specification. Although the original specification repeatedly mentioned "visit" and "location," this was not enough for the Court to find an explicit and unequivocal disclosure. As the Court stated, "[t]he question is not whether the words 'visit' or 'location' as used in the specification *might encompass* geographic location data; the question is whether that use of 'visit' or 'location' clearly and unequivocally does so." Because it did not, the Court invalidated the reissued patent claims and granted summary judgment in Bumble's favor.

If you have questions about patent reissuance, how the "original patent" requirement might impact your reissued patents, or need assistance assessing other patent prosecution issues, please contact your Vorys attorney for further assistance.