Preface to the Eighth Edition

The eighth edition of *Patent Prosecution: Law, Practice, and Procedure* addresses various significant changes in U.S. patent law resulting from recent decisions and statutory amendments. *Patent Prosecution* reflects a continuing effort to provide substantive treatment of all relevant decisions and changes in the statutory and regulatory requirements. New material in the eighth edition includes analyses of more than 45 decisions of the Supreme Court, the Federal Circuit, and the Board of Patent Appeals and Interferences. These include the Supreme Court decisions in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.* and *Kappos v. Hyatt.* The various changes made (and still to come) in the patent law via the Leahy-Smith America Invents Act (AIA) are discussed as well.

Chapter by chapter, new developments include the following:

**Chapter 1** discusses *Mettler-Toledo, Inc. v. B-Tek Scales, LLC,* where the Federal Circuit held that the Summary of the Invention section could be used to link the structure disclosed in the specification to the claimed function of the means-plus-function element. Chapter 1 also discusses *Alcon Research, Ltd. v. Apotex, Inc.*, where the Federal Circuit held that an independent claim that recited a general amount was interpreted to cover the specific range recited in a dependent claim that depended from it. Also discussed in Chapter 1 is *In re Beineke,* where the Federal Circuit held that the discovery of new and distinct mature oak trees found in the front yard of a home was not entitled to plant patent protection under 35 U.S.C. §161. The Federal Circuit noted that the patent system requires human activity in the creation of the subject matter sought to be patented, and the mere discovery without more was not sufficient.

**Chapter 2** discusses the Supreme Court’s decision in *Kappos v. Hyatt.* There, a unanimous Court held that in a civil action in district court under 35 U.S.C. §145 against the Director of the Patent Office to obtain a patent, there were no limitations on the patent applicant’s ability to introduce new evidence other than those set out in the Federal Rules of Evidence and the Federal Rules of Civil Procedure. Justice Sotomayor filed a concurring opinion, in which Justice Breyer joined, suggesting that a district court may refuse to allow an applicant to submit additional evidence if the applicant deliberately suppressed evidence.
Also discussed is *Thorner v. Sony Computer Entertainment, Inc.*, where the Federal Circuit held that for a term to be interpreted in a manner different from its ordinary meaning it is not enough for the patentee to simply refer to two terms as alternatives. “Implied” redefinition must be so clear that it equates to an explicit redefinition.

Chapter 2 also discusses the final rules for the preissuance submission by third parties of prior art in a pending application under the Leahy-Smith America Invents Act (AIA). The effective date of the rules is September 16, 2012. This provision of the AIA provides a mechanism for third parties to contribute to the quality of issued patents by submitting patents, published patent applications, or other printed publications for consideration in the record of a pending patent application.

**Chapter 3** discusses *HTC Corp. v. IPCom GmbH & Co.*, where the Federal Circuit held that an attorney’s single statement in an Office Action response was insufficient, when weighed against the plain language of the claims and the specification, to support a finding of disavowal. Chapter 3 also discusses *Sandisk Corp. v. Kingston Technology Co.*, where the Federal Circuit held that the disclosure-dedication rule did not apply to subject matter incorporated by reference when the specification did not sufficiently indicate that that subject matter was an alternative to the claim limitation.

**Chapter 4** discusses *Abbott Point of Care, Inc. v. Epocal, Inc.*, where the Federal Circuit held that a subsequent consulting agreement did not revive an expired employment agreement, and thus the employment agreement did not convey to the company all the inventor’s rights in the invention created by the consultant.

**Chapter 5** discusses *Falana v. Kent State University*, where the Federal Circuit held that a putative inventor who conceived of the structure of a novel genus of chemical compounds and contributed to the method of making that genus was a co-inventor to the conception of that genus.

**Chapter 6** contains, first and foremost, a detailed discussion of the Supreme Court’s decision in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.* There, the Court held that claims covering only unpatentable natural correlations between drug doses and toxin levels were not patent eligible. The patents effectively claimed the underlying laws of nature themselves and, apart from these natural laws, merely involved well-understood, routine, and conventional activity previously engaged in by researchers in the field. According to the Court:

The upshot is that the three steps simply tell doctors to gather data from which they may draw an inference in light of the correlations. To put the matter more succinctly, the claims inform a relevant audience about certain laws of nature; any additional steps consist of well-understood, routine, conventional activity already engaged in by the scientific community; and those steps, when viewed as a whole, add nothing significant beyond the sum of their parts taken separately. For these reasons we believe that the
steps are not sufficient to transform unpatentable natural correlations into patentable applications of those regularities.\(^1\)

Patent Office guidelines setting forth a new procedure for examining subject matter eligibility in light of Mayo are discussed as well.

Chapter 6 discusses *CLS Bank International v. Alice Corporation Pty. Ltd.* There, the Federal Circuit held that a computerized trading platform for exchanging obligations, wherein a trusted third party settles obligations between a first and a second party so as to eliminate settlement risk, was patent eligible. Judge Prost dissented, and was of the view that the Supreme Court’s decision in *Mayo Collaborative Services v. Prometheus Laboratories* required the claims to include an inventive concept in order to be patent eligible. On October 9, 2012, the Federal Circuit granted the petition of CLS Bank for rehearing en banc. The Federal Circuit has ordered the parties to brief the following questions:

a. What test should the court adopt to determine whether a computer-implemented invention is a patent-ineligible “abstract idea”; and when, if ever, does the presence of a computer in a claim lend patent eligibility to an otherwise patent-ineligible idea?

b. In assessing patent eligibility of a computer-implemented invention under 35 U.S.C. §101, should it matter whether the invention is claimed as a method, a system, or a storage medium; and should such claims at times be considered equivalent for Section 101 purposes?

Chapter 6 also discusses *Association for Molecular Pathology v. U.S. Patent & Trademark Office,* specifically, the Federal Circuit’s decision on remand from the Supreme Court, where the Federal Circuit once again held that the composition claims at issue, directed to isolated deoxyribonucleic acid (DNA) molecules, were patent-eligible subject matter under 35 U.S.C. §101 whether limited to complementary DNAs (cDNAs) or not. On November 30, 2012, the Supreme Court granted certiori and vacated the Federal Circuit’s decision. The Supreme Court is expected to decide the case in the 2013–14 term. In addition, the Supreme Court vacated judgment in *Ultramercial, LLC V. Hulu, LLC,* and remanded the case to the Federal Circuit for further consideration in light of *Mayo Collaborative Services v. Prometheus Laboratories.*

**Chapter 7** discusses *Plasmart, Inc. v. Kappos,* where the Federal Circuit held that drawings can be used as prior art, without referring to the surrounding description, when the prior art features are clearly disclosed by the drawings. In addition, Chapter 7 discusses *In re Antor Media Corp.,* where the Federal Circuit held that a prior art printed publication cited by an Examiner is presumptively enabling barring any showing to the contrary by a patent applicant or patentee.

Chapter 7 also discusses *Voter Verified, Inc. v. Premier Election Solutions, Inc.,* where the Federal Circuit held that an online Internet posting of an article, while not shown to have been indexed, was nevertheless a printed

publication under 35 U.S.C. §102(b) because the article could be located by searching based on subject matter.

**Chapter 8** discusses *Ex parte Nakhamkin*, where the Board of Patent Appeals and Interferences held that an Examiner’s reliance solely on a per se rule of obviousness is improper. Chapter 8 also discusses *Otsuka Pharmaceutical Co. v. Sandoz, Inc.*, where the Federal Circuit further addressed the suitability of using a lead compound analysis when determining whether a chemical compound would have been obvious.

In addition, Chapter 8 discusses *Mintz v. Dietz & Watson, Inc.*, where the Federal Circuit found clear error in a district court’s unsubstantiated reliance on “a common sense view” or “common sense approach” in holding that it would have been “obvious to try” a locking engagement in connection with a meat encasement netting invention.

**Chapter 9** discusses *Cummins-Allison Corp. v. SBM Co.*, where the Federal Circuit held that drawings alone may provide an adequate written description under 35 U.S.C. §112 if they describe what is claimed and convey to those of skill in the art that the patentee actually invented what is claimed. Chapter 9 also discusses *In re Antor Media Corp.*, where the Federal Circuit held that the use of forward-looking language (e.g., terms like “should”) can constitute a disclosure to satisfy the enablement requirement even if the language is only precatory and does not indicate that the invention was actually made or performed.

Chapter 9 also discusses *Magsil Corp. v. Hitachi Global Storage Technologies*, where the Federal Circuit held that a claim reciting a device switch causing “a change in resistance by at least 10%” was invalid for lack of enablement because the specification enabled a change of 11.8% at most, but did not enable resistive changes even as high as 20%, let alone the 600% resistive change of the accused device. Chapter 9 further discusses *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litigation*, in which the Federal Circuit held that the best mode requirement was not violated where skilled artisans could readily obtain the optimal dew points to practice the invention from the disclosure.

**Chapter 10** discusses *Dow Chemical Co. v. Nova Chemicals Corp. (Canada)*, where the Federal Circuit held that the claim language “a slope of strain hardening coefficient greater than or equal to 1.3” was definite even though the detailed description inadvertently failed to include a patent drawing illustrating a stress/strain curve that could be used to measure the slope. Since the stress/strain curve was shown to be well known to a person of ordinary skill in the art, the mere fact that Figure 1 was missing from the patents-in-suit did not render the claim language indefinite. Chapter 10 also discusses *Ergo Licensing LLC v. Carefusion 303, Inc.*, where the Federal Circuit held that the mere disclosure of the words “control device” was insufficient to provide the corresponding structure for the means-plus-function element “control means for controlling the adjusting means.”

Chapter 10 also discusses such common claim terms as “communications medium,” “routing,” “attached,” “plurality of network service providers” and “payload platform.”
Chapter 11 discusses Noah Systems, Inc. v. Intuit, Inc. There, the Federal Circuit held that where a means-plus-function claim recites multiple identifiable functions and the specification discloses an algorithm for only one, or less than all, of those functions, the disclosure is analyzed as if no algorithm is disclosed. Chapter 11 also discusses HTC Corp. v. IPCom GmbH & Co., where the Federal Circuit held that the corresponding structure of the claimed means-plus-function element “arrangement for receiving” included a processor and transceiver even though they were not literally disclosed in the specification.

In addition, Chapter 11 discusses Voter Verified, Inc. v. Premier Election Solutions, Inc., where the Federal Circuit stated that a human being cannot constitute a “means” within the scope of 35 U.S.C. §112, para. 6. Chapter 11 further discusses Automated Transactions, LLC v. IYG Holding Co., where the Federal Circuit held that a connection to a private network was substantially different from a connection to the Internet because the two differ dramatically with respect to considerations such as security and simplicity of remote access.

Chapter 12 discusses Otsuka Pharmaceutical Co. v. Sandoz, Inc., where the Federal Circuit held that when analyzing obviousness-type double patenting for chemical compounds, the question whether the two claimed compounds are patentably distinct in the chemical context requires identifying some reason that would have led a chemist to modify the earlier compound to make the later compound with a reasonable expectation of success. In addition, Chapter 12 discusses Hollmer v. Harari. There, the Federal Circuit held that the proper standard for evaluating the sufficiency of incorporation-by-reference language in intervening patent applications, in order to determine whether a subsequent application is entitled to the benefit of the filing date of an earlier application, is whether the identity of the patent application that is incorporated by reference would be clear to a person of ordinary skill in the art.

Chapter 13 discusses Apple, Inc. v. Samsung Electronics Co., where the Federal Circuit held that in assessing a claim of obviousness, a two-step process is used to determine whether one of ordinary skill would have combined teachings of the prior art to create the same overall visual appearance as the claimed design. First, there must be a single primary prior art reference having design characteristics that are basically the same as the claimed design. Second, a secondary prior art reference may be used to modify the primary prior art reference to create a design that had the same overall visual appearance as the claimed design.

Chapter 14 discusses In re Staats, where the Federal Circuit held that a broadening reissue application filed outside the two-year period was timely if it claimed priority to an earlier broadening reissue application filed within the two-year period. Chapter 14 also discusses In re Youman, where the Federal Circuit held that the recapture rule permits broader reissue claims of a scope between the original claim filed in the patent application and the issued patent claim.

Chapter 14 further discusses In re Baxter International, Inc., where the Federal Circuit held that a Patent Office reexamination proceeding need
not defer to a prior court judgment over the same prior art. In addition, Chapter 14 discusses Belkin International, Inc. v. Kappos, where the Federal Circuit held that prior art that has been determined by the Director not to raise a substantial new question of patentability cannot later be considered during inter partes reexamination.

Chapter 15 discusses Bard Peripheral Vascular, Inc. v. W.L. Gore & Associates, Inc. There, the Federal Circuit held that determinations of whether there was an objective risk of infringement should always be made by a judge rather than a jury, and that such determinations are subject to no deference on appeal. The Federal Circuit also held that the ultimate legal question of whether a reasonable person would have considered there to be a high likelihood of patent infringement should always be decided as a matter of law by the court.

This book can greatly benefit from the comments of those who use it. I therefore ask for your help as a reader. If any text is incorrect, incomplete or misleading, I would very much like to hear about it. If relevant subject matter has been omitted or needs to be treated in greater depth, I would also like to hear about it. All suggestions for improvements in this book are welcome.

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