Preface to the Tenth Edition

This Tenth Edition is current through December 2016.

The Tenth Edition of Patent Prosecution: Law, Practice, and Procedure addresses 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 relevant decisions and changes in the statutory and regulatory requirements. New material includes analyses of the decisions of the Supreme Court, the Federal Circuit, and the Patent Trial and Appeal Board (formerly the Board of Patent Appeals and Interferences). These include the Supreme Court’s decision in Cuozzo Speed Technologies v. Lee. The various changes made (and still to come) in patent law via the Leahy-Smith America Invents Act (AIA), particularly relating to contested proceedings, are discussed as well.

Chapter by chapter, new developments include the following:

**Chapter 1** discusses, in an issue of first impression, *Rosebud LMS Inc. v. Adobe Systems Inc.*, where the Federal Circuit held that the notice requirement under 35 U.S.C. §154(d) to trigger provisional protection does not require the patent applicant to directly inform the accused infringer of the patent application. It is enough if the accused infringer had actual knowledge of the published patent application. Chapter 1 also discusses *In re Tam* where the Federal Circuit held that the government cannot refuse to register disparaging marks because it disapproves of the expressive messages conveyed. On Sep 29, 2016, the Supreme Court granted certiorari to consider the question whether the disparagement provision of the Lanham Act, 15 U.S.C. 1052(a) is facially invalid under the Free Speech Clause of the First Amendment. A decision is expected sometime in 2017.

Also discussed in Chapter 1 is the Defend Trade Secrets Act (DTSA) which became law on May 11, 2016 and establishes a private cause of action for misappropriation of trade secrets under federal law, and permits the pursuit of an injunction against violations of trade secret theft as well as damages. The DTSA does not preempt state law, but provides authorization for ex parte seizure orders.

**Chapter 2** examines the Federal Circuit decision in *MCM Portfolio LLC v. Hewlett-Packard Co.*, where the Federal Circuit held that whether Patent Trial and Appeal Board (Board) properly instituted inter partes review
was not appealable or reviewable. The Federal Circuit also held that the *inter partes* review provisions did not violate Article III of the Constitution and also did not violate the Seventh Amendment’s right to a jury trial. Also discussed is *In re: Hill-Rom Services, Inc.* where the Federal Circuit re-affirmed the longstanding practice that a party that wishes to raise the claim that the Board has adopted a new ground of rejection must do so by filing a request for rehearing before the Board and failure to file a timely request will constitute a waiver of that a new ground was raised. Chapter 2 further discusses *ScriptPro, LLC v. Innovation Associates, Inc.* where the Federal Circuit held that a specification’s focus on one particular embodiment or purpose did not limit the described invention where the specification expressly includes other embodiments or purposes.

**Chapter 3** discusses *CSP Technologies, Inc. v. Süd-Chemie AG* where the Federal Circuit held that the disclosure-dedication doctrine, which bars a patentee from using the doctrine of equivalents to recapture claim scope disclosed but not literally included in the patent’s claims. Chapter 3 also discusses *Openwave Systems, Inc. v. Apple Inc.* where the Federal Circuit held that the standard for disavowal of claim scope requires that the specification make clear that the invention does not include a particular feature. To find disavowal of claim scope through disparagement, the specification must include repeated derogatory statements about a particular embodiment which reasonably may be viewed as a disavowal.

**Chapter 6** discusses *In re Distefano, III* where the Federal Circuit held that printed matter is given patentable weight if the claimed informational content has a functional or structural relation to the substrate. Chapter 6 also contains detailed analyses of various Federal Circuit cases on patent-eligible subject matter.

Chapter 6 also discusses a number of U.S. Patent Office memoranda and guidelines for examining application for patent eligibility including: new patent-eligibility life science claim examples published on May 4, 2016; guidance to examiners for computer related inventions following the Federal Circuit’s *Enfish v. Microsoft* decision published on May 19, 2016; memorandum to Examiners for when a claim is “directed to” a law of nature published on July 14, 2016; and memorandum to Examiners on recent Federal Circuit decisions published on November 2, 2016.

Chapter 6 also discusses several Federal Circuit cases on patent eligible subject matter including: *Enfish, LLC v. Microsoft Corporation*: self-referential table was a specific type of data structure designed to improve the way a computer stored and retrieved data in memory and patent eligible; *Rapid Litigation Management Ltd. v. CellzDirect, Inc.*: method of preparing frozen hepatocyte liver cells that could be thawed and refrozen at least twice while remaining viable was patent eligible; *Bascom Global Internet Services Inc. v. AT&T Mobility LLC*: installation of a filtering tool at a specific location, remote from the end-users, with customizable filtering features specific to each user was patent eligible; and *McRo, Inc. v. Bandai Namco Games America Inc.*: automatically animating the lip synchronization and facial expressions of three-dimensional animated characters was not an abstract idea and patent eligible.
Chapter 7 discusses Blue Calypso LLC v. Groupon Inc. where the Federal Circuit held that an online report on a personal website was not a printed publication where there was no indication that: the report was viewed or downloaded; one of ordinary skill was aware of the personal website or its web address; a query in an online search engine would have retrieved the report.

Chapter 7 further discusses the en banc Federal Circuit decision The Medicines Co. v. Hospira reversing the prior panel opinion and holding that a contract manufacturer’s sale to the inventor of manufacturing services where neither title to the embodiments nor the right to market the same passes to the supplier did not constitute an invalidating sale. The court clarified that stockpiling by the purchaser of manufacturing services is not improper commercialization, but rejected a blanket supplier exception to what would otherwise constitute a commercial sale.

Chapter 8 examines Redline Detection, LLC v. Star Envirotech, Inc. where the Federal Circuit held the invention was nonobvious where there was no reason to substitute the use of inert gas, forced into the narrow compressed space for ambient air in a temperature-regulated chamber. Chapter 8 also discusses Arendi S.A.R.L. v. Apple Inc. where the Federal Circuit confirmed that common sense is typically invoked to provide a known motivation to combine, not to supply a missing claim limitation, but when used for such purpose, the reasoned basis for resort to common sense must be searching.

Chapter 9 analyzes Inphi Corp. v. Netlist, Inc. where the Federal Circuit held that negative claim limitations are adequately supported when the specification describes a reason to exclude the relevant claim limitation. Chapter 9 also discusses In re Morsa where the Federal Circuit held that “ordinary” computer programming skills enabled the claimed invention based on the knowledge of a skilled computer artisan who would readily know how to use and how to program the invention, and Cubist Pharmaceuticals, Inc. v. Hospira, Inc. where the court held the written description was adequate even though there was an error in structural diagram directed to an antibiotic compound, where the specification did not rely exclusively on the structural diagram and would have demonstrated that the inventors were in possession of the claimed invention.

Chapter 10 reviews Cox Communications, Inc. v. Sprint Communication Co. LP where the Federal Circuit held that claims are not per se indefinite merely because they contain functional language. Chapter 10 also discusses such common claim terms as: “Mobile Device/Wireless Mobile Telephone/Two-Way Communication Device”; “Means for Storing”; and “Logical Table.”

Chapter 11 discusses Driessen v. Sony Music Entertainment where the Federal Circuit held that a bare statement in the specification that known techniques or methods can be used did not disclose sufficient corresponding structure for the means for storing claim element. In addition, Chapter 11 discusses CSP Technologies, Inc. v. Süd-Chemie AG where the Federal Circuit held that the disclosure-dedication doctrine applies even if the
patentee later claimed the previous unclaimed subject matter in a later continuation application.

Chapter 12 discusses Immersion Corp. v. HTC Corp. where the Federal Circuit held that continuation applications may be properly filed on the issue date of the parent application.

Chapter 13 discusses U.S. Patent Office proposed general principles governing compliance with the written description requirement for design applications published on April 15, 2016.

Chapter 14 discusses the Supreme Court decision in Cuozzo Speed Technologies, LLC, where the Court held that review of the Board decision to institute an Inter Partes Review (IPR) is prohibited even after final decision, and that patent claims in an IPR are to be construed under the “broadest reasonable interpretation” standard, and not under the narrower standard that is applied in district court litigation.

Chapter 14 discusses several Federal Circuit decisions interpreting the America Invents act (AIA) statute, including: Redline Detection, LLC v. Star Envirotech, Inc. holding that the Board has discretion to reject the supplemental information including Declaration evidence if it could reasonably have been filed earlier with the petition; Nike, Inc. v. Adidas AG holding that a patent owner stating that its proposed new claims were patentable over prior art that it knew about was sufficient to satisfy the statutory requirement that the patent owner show that its proposed substitute claims are patentable over the prior art; Genzyme Therapeutic Products LP v. BioMarin Pharmaceutical Inc. holding that the submission of new evidence is to be expected in IPR trial proceedings, provided that the opposing party is provided notice and an opportunity to respond; and Blue Calypso LLC v. Groupon Inc. holding Covered Business Method (CBM) review was appropriate for patents related to peer-to-peer advertising system using mobile communication devices where the advertisers provided subsidies to subscribers, and the term “subsidy” meant financial assistance given by one to another.

In addition, Chapter 14 discusses final rules amending the rules relating to trial practice for contested trials under the AIA, published on April 1, 2016, which include allow new testimonial evidence to be submitted with a Patent Owner Preliminary Response. Chapter 14 further discusses Cubist Pharmaceuticals, Inc. v. Hospira, Inc. where the Federal Circuit held that the claims of a reissue patent were not invalid under the recapture rule where the reissued claims were narrower than the original claim, and the original claim was cancelled from the patent application because of an indefiniteness rejection and not to avoid prior art.

Chapter 15 discusses the consolidated cases of Stryker Corp. v. Zimmer, Inc. and Halo Electronics, Inc. v. Pulse Electronics, Inc., where the Supreme Court overturned the Federal Circuit’s strict test used to award enhanced damages. As a result, district courts will have more freedom to exercise discretion under 35 U.S.C. Section 284 of the Patent Act to increase damages up to three times the amount awarded for egregious cases of misconduct beyond typical infringement. Chapter 15 also discusses WBIP LLC v. Kohler Co. where the Federal Circuit held that timing matters
regarding a defense to willful infringement, and even reasonable arguments created during litigation, cannot be used as a defense.

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 and appreciated.

You may contact me in care of the Bloomberg BNA Editorial Offices, 1801 South Bell Street, Arlington, VA 22202; or by e-mail at books@bna.com.

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