Preface to the 2018 Supplement

This 2018 Supplement is current through December 2017.

The 2018 Supplement to 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 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).

Chapter by chapter, new developments include the following:

**Chapter 1** discusses, in an issue of first impression, the Supreme Court’s ruling, in *Matal v. Tam*, that the federal government’s ban on offensive-trademark registrations violated the First Amendment. Chapter 1 also analyzes *Star Athletica, LLC v. Varsity Brands, Inc.*, where the Supreme Court, in a 6-2 vote, held that the decorative features of cheerleader uniforms were copyrightable.

**Chapter 2** examines the Federal Circuit decision in *Skedco, Inc. v. Strategic Operations, Inc.*, where the Federal Circuit held that claims are not generally limited to inventions looking like embodiments in the drawings. Also discussed is *In re: Smith International, Inc.*, where the Federal Circuit held that the correct inquiry when interpreting a claim term according to its broadest reasonable interpretation is not whether the specification excludes a specific meaning, but an interpretation that corresponds with what and how the specification describes the invention. Chapter 2 also explains the guidelines concerning how the Patent Office will handle ex parte reviews and reexaminations that are remanded back to the Board from the Federal Circuit.

**Chapter 3** discusses *Aylus 2 Networks, Inc. v. Apple Inc.*, where the Federal Circuit held that statements made by a patent owner during inter partes review can support a finding of prosecution disclaimer and narrow the scope of the claims. Chapter 3 also examines *Poly-America, L.P. v. API Industries, Inc.*, where the Federal Circuit held that a patent applicant’s reply to rejection based on the prior art’s lack of a specific feature disavowed from infringement an accused product without that same feature.
Chapter 4 looks at CardiAQ Valve Technologies, Inc. v. Neovasc Inc., where the Federal Circuit held that the mere contribution of public knowledge, which could have been easily obtained by the named inventor, does not make one a co-inventor.

Chapter 5 analyzes Perfect Surgical Techniques v. Olympus America, Inc., where the Federal Circuit clarified the requirements for diligence for patent applications filed before March 16, 2013, under the first-to-invent system. Specifically, the court held that to show diligence, the inventor need only prove there was reasonably continuous diligence.

Chapter 6 examines several Federal Circuit cases on patent eligible subject matter including: Amdocs (Israel) Limited v. Openet Telecom, Inc., where the Federal Circuit held a system for monitoring activity on computer networks and creating records of it, which network operators could use to get an accurate picture of usage to set prices or deploy new services, was patent eligible; Trading Technologies International, Inc. v. CQG, Inc., where the court held that patents claiming a trading system that uses a graphical user interface to dynamically display both a bid and asked prices were patent eligible; Thales Visionix Inc. v. United States, where the court held that a system for tracking the motion of an object relative to a moving reference frame was patent eligible, and Visual Memory LLC v. Nvidia Corp., where the court held that a more efficient and improved memory system configured to store a type of data in the cache memory, based on the type of processor connected to the memory system, was patent eligible.

Chapter 7 examines In re Chudik, where the Federal Circuit held that a prior art reference that must be distorted from its obvious design does not anticipate a patent claim. Chapter 7 also discusses Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc., where the Federal Circuit held that the on-sale bar under the Leahy-Smith America Invents Act (AIA) applies if the existence of the sale is public, even though the details of the invention are not publicly disclosed. In addition, the court clarified that clinical trials or regulatory approval is not required to show an invention was ready for patenting.

Chapter 8 reviews In re: Van Os, where the Federal Circuit held that it is not enough for the Patent Trial and Appeal Board (Board) to provide the conclusory statement that the claimed invention would have been “common sense” or “intuitive” as the reason to combine or modify the prior art. Chapter 8 also discusses Personal Web Technologies, LLC v. Apple, Inc., where the Federal Circuit held that the Board needed to provide a clear, evidence-supported description of the intended prior art workings to properly explain why one of ordinary skill would have been motivated to make the proposed combination with a reasonable expectation of success.

Chapter 9 analyzes Amgen Inc. v. Sanofi, Aventisub LLC, where the Federal Circuit held that although enablement of a claimed invention is evaluated at the priority date, post-priority-date evidence may be relevant to determine enablement and written description at the time of the priority date.
Chapter 10 looks at Ex parte McAward, where, in a precedential opinion, the Patent Trial and Appeal Board (Board) confirmed that, for an ex parte patent prosecution, it will not use the U.S. Supreme Court’s Nautilus Inc. v. Biosig Instruments Inc. standard, but instead will determine that a claim is indefinite if it uses words or phrases that are unclear. Chapter 10 also examines Sonix Technology Co. Ltd. v. Publications International, Ltd., where the Federal Circuit held that “visually negligible” was not a purely subjective term when the written description included specific examples, with points of comparison, and, together with the prosecution history, provided sufficient support to inform with reasonable certainty the scope of the invention. Chapter 10 also discusses such common claim terms as: “Seal/Prevent”; “Arranged To”; “In Fluid Communication”; and “Controller Connected To.”

Chapter 11 discusses Skky, Inc. v. Mindgeek, S.A.R.L., where the Federal Circuit held that the claim phrase “wireless device means” was not a means-plus-function element when the phrase signified structure, there was no function recited in connection with this phrase, and the claim was in method format. In addition, Chapter 11 looks at Cloud Farm Associates LP v. Volkswagen Group of America, Inc., where the Federal Circuit held that the claimed “sensing means within said steering column” was indefinite because there was no structure linked to the claimed function of sensing.

Chapter 12 examines Rembrandt Wireless Technologies LP v. Samsung Electronics Co., Ltd., where the Federal Circuit held that a disclaimer of a claim cannot serve to retroactively dissolve the marking requirement for a patentee to collect pre-notice damages under 35 U.S.C. §287(a).

Chapter 13 discusses the Supreme Court decision in Samsung Electronics Co., Ltd. v. Apple Inc., where the Court held that for a multicomponent product, the relevant “article of manufacture” for damages under 35 U.S.C. §289 can be a component of that product, even though consumers could not purchase that component separately from the end product.

Chapter 14 discusses several Federal Circuit decisions interpreting the America Invents Act (AIA), including: In re Aqua Products Inc., where the Federal Circuit, sitting en banc, issued a 6-5 vote with no single majority opinion. The Federal Circuit instructed the Board to issue a final decision assessing the patentability of the proposed substitute claims without placing the burden of persuasion on the patent owner; Unwired Planet, LLC v. Google Inc., where the Federal Circuit held that Covered Business Method (CBM) review was limited to the statutory definition of claims directed to the practice, administration, or management of a financial product or service and did not extend to claims incidental or complementary to financial activities, and Ultratec, Inc. v. Captioncall, LLC, where the court held that the Patent Trial and Appeal Board (Board) abused its discretion when it refused to consider trial testimony which, it was contended, conflicted with statements the expert made to the Board during an Inter Partes Review (IPR).

Chapter 15 examines the Supreme Court decision, SCA Hygiene Products AB v. First Quality Baby Products, LLC, where, in a 7-1 decision, the Court held that the equitable defense of laches could not be used as a
defense to claims for infringement occurring during the six-year statute of limitations period.

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 Law Books Division, 1801 South Bell Street, Arlington, VA 22202; or by e-mail at books@bloomberglaw.com.

My sincere appreciation is extended to Elizabeth Turqman, Wendy Leibowitz, and Catherine Kitchell of Bloomberg Law, Books Division. Special thanks are also extended to Joseph Dundin for editing this 2018 Supplement.

Irah H. Donner
New York, NY
May 2018