Preface to Ninth Edition

The Ninth 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 supplement 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 *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*. 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 *Limelight Networks, Inc. v. Akamai Technologies, Inc.* where the U.S. Supreme Court ruled unanimously that induced infringement can only be found when one party performs every step of a method claim. In addition, the Court found that the Federal Circuit was incorrect when it concluded that a finding of induced infringement does not need to be predicated on an act of direct infringement. Chapter 1 also discusses *Novartis AG et al. v. Lee*, where the Federal Circuit held that the time period after allowance of a continued examination counts toward the three year allotment provided to the Patent Office for processing a patent application for patent term Adjustment (PTA) purposes.

Also discussed in Chapter 1 is *Oracle America Inc. v. Google Inc.*, where the Federal Circuit, applying Ninth Circuit law, reversed the district court’s holding that Oracle Corp.’s Java software could not be copyrighted and reinstated the verdict that Google Inc.’s Android operating system infringed Oracle’s copyright in the Java software. The Federal Circuit, however, allowed Google to argue on remand that the Android operating system is protected by fair use.

**Chapter 2** discusses the Federal Circuit decision in *In re Biedermann*, where the Federal Circuit held that the Board issued a new ground of rejection when the Board found a new factual basis for the reason to combine, thereby changing the overall thrust of the rejection. Also discussed is *Ring & Pinion Service Inc. v. ARB Corp. Ltd.*, where the Federal Circuit held that the foreseeability of a possible equivalent invention does not bar infringement under the doctrine of equivalents.
Chapter 2 also discusses *Troy v. Samson Manufacturing Corp.*, where the Federal Circuit ruled that parties challenging a decision of the Patent Trial and Appeal Board (Board) in ex parte appeals and patent interference proceedings at the district court may introduce new evidence without regard to whether the issue was raised before the Board.

**Chapter 3** discusses *X2Y Attenuators, LLC v. International Trade Commission*, where the Federal Circuit held that statements in the specification that the presence of a common conductive pathway electrode positioned between opposite conductors was “universal to all the embodiments” and was “an essential element among all embodiments or connotations of the invention” constituted a clear and unmistakable disavowal of claim scope. In addition, *AstraZeneca AB v. Hanmi USA, Inc.* is discussed where the Federal Circuit held that written description described the invention clearly and narrowly as including only specific salts by defining “the present invention” as a particular set of “new” salts of enantiomers of omeprazole and therefore disclaimed other types of salts.

**Chapter 5** discusses *In re Enhanced Sec. Research, LLC* where the Federal Circuit held that the patentee failed to show diligence in reducing invention to practice where it took over five months to prepare the patent application, the attorney only had a few conversations with the inventor and billed for under 30 hours of work. Also discussed is the Patent Office notice entitled “Examination Guidelines for Implementing the First Inventor To File Provisions of the Leahy-Smith America Invents Act,” providing for the submission of affidavits or declarations to overcome prior art showing that: (1) A prior art disclosure upon which a claim rejection is based was by the inventor or joint inventor or by a party who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or (2) a prior art public disclosure was by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

**Chapter 6** contains, first and foremost, a detailed discussion of the Supreme Court’s unanimous decision in *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, that “[t]here is no dispute that ... many computer-implemented claims are formally addressed to patent-eligible subject matter.” However, the Court found that an abstract idea is not transformed into a patent eligible invention by merely implementing it on a computer. Specifically, the Supreme Court held that:

the claims at issue are drawn to the abstract idea of intermediated settlement, and that merely requiring generic computer implementation fails to transform that abstract idea into a patent-eligible invention.

Chapter 6 also discusses a number of Federal Circuit decisions relating to patent eligible subject matter. For example, Chapter 6 discusses *In re Roslin Institute (Edinburgh)* where the Federal Circuit held that the claimed live-born clone was not patent eligible because it was an exact genetic copy of its donor parent animal, and therefore, lacked markedly different characteristics from its parent donor found in nature. Chapter 6 further discusses the U.S. Patent Office examination guidance entitled
“2014 Interim Guidance on Patent Subject Matter Eligibility” on subject matter eligibility under § 101 in view of the U.S. Supreme Court’s recent decisions in Alice Corp., Myriad, and Mayo.

Chapter 7 discusses In re Enhanced Sec. Research, LLC, where the Federal Circuit held that a software manual was publicly-available prior art, where the title page of the manual was dated, the chief executive officer of the software company filed a declaration provided a date for the manual, and advertisements for the software were published consistent with manual being prior art. In addition, the Federal Circuit held that the software manual was prior art even though there were missing portions of the manual.

Chapter 8 discusses In re Chagant where the Federal Circuit held that common sense can provide the reason to combine the prior art. However, the court cautioned that such reasons must be clearly articulated; merely using the circular reasoning that it would have been obvious to one of ordinary skill is not sufficient. Chapter 8 also discusses In re Giannelli where the Federal Circuit held that physical capability alone did not render obvious an exercise machine having handles adapted to be pulled. Specifically, the Federal Circuit held it was not obvious to modify a machine with handles designed to be pushed to one with handles adapted to be pulled; a chest press machine did not render obvious a rowing machine.

Chapter 9 discusses EnOcean GmbH v. Face International Corp where the Federal Circuit held the claimed “means for receiving” and “receiver” limitations for a self-powered switch was adequately supported by the written description found in prior foreign applications for purposes of claiming priority. Chapter 9 also discusses Tobinick v. Olmarker where the Federal Circuit held that the patent specification satisfied the written description requirement because it described administering an inhibitor to an epidural space adjacent to a herniated disc, which was a location where the nucleus pulposus caused nerve injury.

Chapter 10 discusses significantly the Nautilus, Inc. v. Biosig Instruments, Inc. where the Supreme Court held that definiteness under § 112, ¶ 2 requires that a patent’s claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty. The Court also explained that the overall test for reasonable clarity for indefiniteness includes the following:

1. First, definiteness is to be evaluated from the viewpoint of one skilled in the art;
2. Second, claims are interpreted in view of the specification and prosecution history;
3. Third, definiteness is measured at the time the patent was filed.

Chapter 10 also discusses Ibormeith IP, LLC v. Mercedes-Benz USA, LLC where the Federal Circuit held the claimed “computational means” was indefinite when the specification only disclosed a general algorithm to determine driver sleepiness and failed to describe how the values listed in a table used in the algorithm were calculated, combined or weighted.
Chapter 10 also discusses such common claim terms as “volatile memory,” “non-volatile memory,” “program,” “adapted to,” and “and/or.”

Chapter 11 discusses *Otto Bock HealthCare LP v. Ossur HF* where the Federal Circuit held that while non-patent publication cannot be used to incorporate by reference structure for a means-plus-function claim, a U.S. patent application or U.S. patent can be used to incorporate by reference to define structure for the purpose of 35 U.S.C. § 112, ¶ 6. In addition, Chapter 11 discusses *EnOcean GmbH v. Face International Corp.* where the Federal Circuit held the claimed “receiver for receiving a…signal” element was not a means-plus-function element because the claimed “receiver” was reasonably well understood in the art as a name for a structure which performed the recited function.

Chapter 12 discusses *Medtronic CoreValve LLC v. Edwards Lifesciences Corp.* where the Federal Circuit held that Medtronic’s patent was not entitled to the priority date of an earlier filed patent application because the priority claim did not precisely specify the earlier filed application using the correct application number (i.e., the series code and serial number). Chapter 12 also discusses *Gilead Sciences Inc. et al. v. Natco Pharma Ltd.* where the Federal Circuit held that a later-issued, but earlier-expiring patent could qualify as double patenting reference to invalidate an earlier-issued, but later expiring patent, even where the earlier and later patents were subject to the requirement of common ownership.

Chapter 13 discusses *Pacific Coast Marine Windshields Ltd. v. Malibu Boats* where the Federal Circuit held that that prosecution history estoppel applies in the context of design patents. In addition, Chapter 13 discusses *Munchkin, Inc. v. Luv N’ Care, Ltd.* where the Patent Trial and Appeal Board held the scope of a design claim is defined by the drawings.

Chapter 14 discusses three precedential orders *St. Jude Medical Cardiology Division Inc. v. Volcano Corp.*, *In re Dominion Dealer Solutions LLC* and *In re Procter & Gamble Co.* where the Federal Circuit held that under the America Invents act (AIA), it does not have authority to hear appeals of the Patent Office’s decisions on whether to institute an inter partes review. The Federal Circuit ruled that under the AIA, a party may seek an appeal of an inter partes review only after the Patent Office’s Patent Trial and Appeal Board (Board) has instituted the review and issued a determination. Chapter 14 further discusses *In re Dinsmore* where the Federal Circuit held that the voluntary and intentional filing of a terminal disclaimer to overcome a non-statutory obviousness-type double patenting rejection during prosecution of the original patent was not an error correctible by reissue.

Chapter 15 discusses *Commil USA LLC v. Cisco Sys. Inc.* where the Federal Circuit held that a finding of inducement requires both knowledge of the existence of the patent and knowledge that the induced acts constitute patent infringement and extended the defense to induced infringement to a reasonable basis that the patent was invalid. The Supreme Court has granted certiorari and will review the Federal Circuit’s decision in the 2015-16 term. In addition, Chapter 15 also discusses *University of Pennsylvania v. Varian* where the Federal Circuit reversed the district court’s
determination of willfulness when the infringer’s invalidity defense was not objectively unreasonable.

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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