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Case Law Update on Obviousness: Common Sense and the “Simple” Invention

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District Court Decision in *Exelixis* Changes Calculation of “B Delay” Patent Term Adjustment

by Benjamin D. Bailey

On November 1, 2012, the U.S. District Court for the Eastern District of Virginia held that the U.S. Patent and Trademark Office (USPTO) has been incorrectly calculating patent term adjustments (PTAs) for patent applications in which a Request for Continuation (RCE) was first filed more than three years after the application’s filing date. In particular, the district court held that the USPTO’s interpretation of the patent term adjustment statute in 37 C.F.R. § 1.703(b)(1) contradicts the PTA statute, specifically 35 U.S.C. § 154(b)(1)(B), and such, is “not in accordance with law” and “in excess of [its] statutory . . . authority” under the Administrative Procedures Act.

Prior to 1995, U.S. patent terms were calculated as seventeen years from the date of issuance. In 1994, Congress passed, and President Clinton signed into law, the Uruguay Round Agreements Act (URAA), which brought U.S. patent law into conformity with international agreements now part of the World Trade Organization (WTO). As part of the URAA, U.S. patent terms were extended to twenty years but calculated from the application’s priority date. In 1999, Congress again amended U.S. patent law, allowing for RCEs during prosecution and setting forth how PTAs were to be calculated. The legislative history made clear that the purpose of the PTA statute was to restore to seventeen years the patent term of diligent applicants that they would have had before URAA. In particular, 35 U.S.C. § 154(b)(1)(B), entitled “Guarantee of no more than 3-year application pendency,” states:

[I]f the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including –

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

. . .

the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

The USPTO’s interpretation of this statutory language was the primary focus of the court in *Exelixis, Inc. v. Kappos*, No. 1:12-cv-96 (E.D. Va. Nov. 1, 2012). Specifically, at issue in the case was whether RCEs filed more than three years from the application’s U.S. filing date should be considered when assessing PTAs under § 154(b)(1)(B).

Exelixis, Inc. filed a PCT application designating the United States in the USPTO on January 15, 2008, which after entering the national phase eventually issued as U.S. Patent No. 7,989,622 (“the ‘622 patent”). The USPTO issued a Restriction Requirement on February 22, 2010. A first substantive nonfinal office action followed, and a final rejection issued March 9, 2011. In response to the final rejection, the patentee submitted an RCE along with claim amendments and arguments on April 11, 2011. On April 27, 2011, the USPTO mailed a Notice of Allowance, and the ‘622 patent issued on

August 2, 2011.

In calculating the PTA, the USPTO added eighty-five days of PTA for the USPTO's failure to issue a patent within three years of the application filing date. The eighty-five-day calculation was consistent with the USPTO's interpretation of 35 U.S.C. § 154(b)(1)(B), set forth in 37 C.F.R. § 1.703(b)(1):

(b) The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed . . . and ending on the date a patent was issued, but not including the sum of the following periods:

(1) The number of days, if any, in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued

The USPTO subtracted the period of time extending from the filing of the patentee's RCE (April 11, 2011) and the date the patent issued (August 2, 2011)—a total of 114 days—from the period of time extending from the expiration of the three-year statutory period (January 15, 2011) and the date the patent issued—a total of 199 days.

The court, however, rejected the USPTO's regulation, finding instead that any "continued examination" taking place *after* the three-year statutory period is not properly included in PTA calculations under § 154 (b)(1)(B)(i). In so holding, the court explained, "[T]he 'not including' portion of subparagraph (B), followed by (i), (ii), and (iii), clearly and unambiguously modifies and pertains to the three year period and does not apply to, or refer to, the day for day PTA remedy." The court concluded, "Put simply, RCE's have no impact on the PTA after the three year deadline has passed and subparagraph (B) clearly provides no basis for any RCE's to reduce PTA; instead, RCE's operate only to toll the three year guarantee deadline, if, and only if, they are filed within three years of the application filing date." Since the regulation was found to be inconsistent with the plain meaning of the statute, the court ordered the USPTO to award additional PTA to Exelixis's '622 patent.

The USPTO has appealed this decision to the Court of Appeals for the Federal Circuit.

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Case Law Update on Obviousness: Common Sense and the “Simple” Invention

by Elizabeth A. Doherty, Ph.D.

The 2007 U.S. Supreme Court decision, *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007), significantly modified the test that courts employ to analyze the question of obviousness. The Supreme Court criticized the Court of Appeals for the Federal Circuit for too rigidly applying its “teaching-suggestion-motivation” test, for example, by often requiring that evidence of motivation to modify the prior art or to combine references must be found in published materials. *Id.* at 1741.

The Supreme Court explained that “[i]n many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends.” *Id.* The Supreme Court also noted that some new products or methods may simply be the result of common sense. For example, the Court explained that,

[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.

Id. at 1742. One reason why the lower courts had, prior to *KSR*, avoided relying upon common sense when considering obviousness was undoubtedly the fear that if they substituted their own judgment for that of skilled artisans who were working in the relevant field when the invention was made, they might fall prey to hindsight, and thus make the wrong decision. The Supreme Court recognized this risk, but it pointed out that “[r]igid preventative rules that deny factfinders recourse to common sense . . . are neither necessary under our case law nor consistent with it.” *Id.* at 1742-43. The Court also indicated that a lower court may permit or even require an evaluation of common sense and common knowledge in the art as part of its obviousness determination. *See id.* at 1743.

But when will a Federal Circuit judge feel comfortable relying upon common sense and perhaps also deciding that expert testimony is unnecessary to resolve a question of obviousness? Cases following *KSR* indicate that common sense may be relied upon when the claimed invention involves technology that judges consider to be simple to understand and/or familiar to a layperson, namely, certain mechanical components, consumer products, or business methods.

For example, *Cimline, Inc. v. Crafcro, Inc.*, 413 F. App’x 240, 2011 WL 715233 (Fed. Cir. 2011) (unpublished), dealt with the automation of a previously manually operated conveyer belt used for pouring material into cracks in a road surface. The Federal Circuit found that using a powered instead of a manual conveyer belt “requires nothing more than common sense to appreciate the resultant advantage.” *Id.* at 246. Consequently, the claims were found obvious without the need for expert testimony. *Id.* at 246-47. The Federal Circuit has also relied on common sense in cases involving methods for building concrete block walls, and locking and clamping devices. *Stone Strong, LLC v. Del Zotto Prods. of Fla., Inc.*, 455 F. App’x 964, 2011 WL 4913415 (Fed. Cir. 2011) (unpublished); *Wyers v.*

Master Lock Co., 616 F.3d 1231 (Fed. Cir. 2010); *Norgren Inc. v. Int'l Trade Comm'n*, 699 F.3d 1317 (Fed. Cir. 2012).

Similarly, the Federal Circuit has also relied upon common sense in cases involving products or services arguably familiar to a layperson. For example, *Odom v. Microsoft Corp.*, 429 F. App'x 967, 2011 WL 1666922 (Fed. Cir. 2011) (unpublished), involved the design of toolbars or pull-down menus in computer software programs. The case of *Western Union Co. v. Moneygram Payment Systems, Inc.*, 626 F.3d 1361 (Fed. Cir. 2010), involved replacement of a fax machine with an electronic keypad in a method of ordering a money wire. And *Meyer Intellectual Properties Ltd. v. Bodum, Inc.*, 690 F.3d 1354 (Fed. Cir. 2012), involved adding a milk-frothing mechanism to a French press coffee maker. In each of these cases, the Federal Circuit also found the differences between the claimed inventions and the prior art to be small and the success of the claimed modifications to be predictable in advance based on common sense.

Norgren, decided in November 2012, involved claims drawn to a clamp for connecting two fluid flow elements in a compressed air device. 699 F.3d 1317. The difference from the prior art was found to be the presence of a hinge on one side of the clamp. *Id.* at 1326. The International Trade Commission (ITC) had previously found that there was motivation to add the hinge in order to avoid a problem with loose parts, as well as for ease of use. *Id.* To support that argument, the ITC had noted that a prior art patent cited in *Norgren's* specification taught adding a hinge to a connection in a water pipe in order to solve a similar loose parts problem and to make the connection easier to use. *Id.* Considering the ITC's conclusions, the Federal Circuit commented that "[h]inges are a common mechanical component that would have been known to those of ordinary skill in the art to solve a loose parts problem." *Id.* Other evidence, such as expert testimony and the problems with the prior art described in the patent, also showed that there were only a finite number of ways to solve this problem and that those in the art would have expected addition of a hinge in this instance to succeed. *Id.* at 1327. Thus, based on all of these factors—the familiarity in the art with hinges, the few ways to solve the loose parts problem, and the expectation of success—the Federal Circuit agreed with the ITC that the claims were obvious. *Id.* at 1327-28. Furthermore, the Federal Circuit did not find *Norgren's* evidence of secondary considerations such as long-felt need and commercial success, to be persuasive. *Id.*

Thus, when a particular constellation of factors is present—an invention that the judge, as a layperson, can understand, that involves elements known in the art, and that represents one of only a few solutions to a known problem in a predictable technology—a judge may well consider the claim obvious. As a result, patent drafters handling inventions in arguably familiar or simple technologies should be prepared to address these issues and to explain to the examiner that their claimed inventions were not predictably successful, address a problem that was not previously recognized, or create new and unforeseen benefits.

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Rule Review

Congress Attempts to “Correct” and “Improve” the AIA and Patent Law

by Elliot C. Cook

Congress has just revised the momentous Leahy-Smith America Invents Act (AIA), which upon enactment on September 16, 2011, began a multistage implementation process. On November 30, 2012, Representative Lamar Smith (R-Texas), one of the legislators for whom the law is named, introduced a bill “[t]o correct and improve certain provisions of the Leahy-Smith America Invents Act and title 35, United States Code.” That bill, H.R. 6621, passed the House of Representatives in a vote of 308-89 on December 18, 2012. On December 29, 2012, amid the fervor in Congress over the notorious “fiscal cliff” and the pressing need for legislation to address it, the Senate unanimously passed an amended version of H.R. 6621 (S. Amendment 3444) sponsored by Senator Patrick Leahy (D-Vermont), which the House then passed on January 1, 2013. The legislation was signed into law by President Obama on January 14, 2013, and changes several features of the AIA and other provisions of patent law relating to post-grant proceedings and patent prosecution.

With respect to the new post-grant review (PGR) and *inter partes* review (IPR) procedures created by the AIA, the new legislation eliminates the nine-month “dead zone,” during which certain patents were not available for PGR or IPR. In particular, the provisions of the AIA that changed U.S. patent law to a first-inventor-to-file (FITF) regime (rather than first-to-invent (FTI)) take effect on March 16, 2013. Prior to the revisions, patents that issued under the old FTI regime were ineligible for PGR (35 U.S.C. § 321(c)) and were not available for IPR until nine months from their issue date (35 U.S.C. § 311(c)). Congress addressed this nine-month limbo period by permitting IPR for FTI patents within nine months after their issuance. Of course, IPR continues to be available beyond the nine-month period for all patents, except where a PGR is in process.

The new legislation also changes patent term adjustment (PTA) rules in several respects. Currently, under 35 U.S.C. § 154(b)(1)(B), PTA can be granted when an application is pending for more than three years from “the actual filing date of the application in the United States.” Under the new law, the starting date for the three-year period is the actual U.S. filing date for applications filed under 35 U.S.C. § 111(a) or the commencement of the U.S. national stage under § 371 for international applications. National stage in the U.S. commences when thirty months from the priority date have passed, unless the applicant has requested an earlier commencement and the requirements of § 371(c) have been met, including, among other things, the filing of an oath or declaration. 35 U.S.C. § 371(b), (f). In addition, under the new law, notices of PTA will be sent no later than issuance of a patent, rather than the current practice of sending the notice of PTA together with the Notice of Allowance. The new law also provides that the exclusive remedy for challenging PTA determinations, following a request for reconsideration, is an appeal to the U.S. District Court for the Eastern District of Virginia.

The new law further changes the time period in which an inventor’s oath or declaration must be filed. Under the original AIA version of 35 U.S.C. § 115(f), such filings had to be made before a Notice of Allowance could issue. Under the new law, the filings may be made until the date on which the issue fee is paid.

In addition, the new law repeals 35 U.S.C. § 373, which provided that the U.S. Patent and Trademark Office (USPTO) could not accept an international application designating the United States if it was filed by someone who was not qualified to file a U.S. patent application under § 111 (i.e., someone other than an inventor). With 35 U.S.C. § 373 eliminated, more flexibility is provided to applicants in coordinating the filing of international applications in the United States.

Finally, it is important to note one aspect of patent law that Representative Smith's proposed bill would have changed but will remain unchanged by virtue of Senator Leahy's amendment. According to H.R. 6621, the term of patents issuing from applications filed before June 8, 1995, that were still pending one year after the enactment of the proposed bill would be twenty years from their earliest filing date. That would have meant a significant reduction in patent term for such applications compared to the current law, which provides for a term that is the greater of twenty years from the earliest filing date or seventeen years from issuance. These provisions of H.R. 6621 were removed by the Senate and are not part of the new law.

The changes in the new legislation have several important implications for practitioners. For those seeking to challenge newly issued FTI patents, not only is *ex parte* reexamination an option, but IPR is available as well. An increase in IPR filings may be expected as a result. Applicants also have more flexibility in filing oaths or declarations later in the application process, including as late as payment of the issue fee. Nevertheless, if applicants want to commence the national stage early and start the clock that allows for PTA based on more than three years of USPTO delay, the oath or declaration should be filed as soon as possible. It also remains advisable to obtain and file such papers early, since inventors can become difficult to contact and less cooperative over time. In addition, with the elimination of 35 U.S.C. § 373, practitioners have more freedom filing international applications in the United States without the constraints regarding who files the application. Of course, international applications still must comply with 35 U.S.C. § 371, which specifies the requirements for an international application to enter the national stage in the United States.

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EPO Practice

Registered EU Designs: an Overview of a Valuable Tool to Protect IP in Europe

by Martin D. Hyden and Clara N. Jimenez

As intellectual property (IP) continues to strengthen its position as one of the most valuable assets, and perhaps the most valuable asset, of businesses today, the importance of developing a strong IP protection strategy that safeguards all valuable aspects of the business' IP has never been more important. A strong IP portfolio often brings to mind patents, trademarks, and copyrights. However, the recent smart phone and tablet IP disputes making their way through courts across the world have highlighted once again that protected product designs can be a very useful tool in the enforcement and protection of a product. A community design under the European Community Design Regulation (CDR) provides a single right giving uniform protection for designs throughout the entire territory of the European Union (EU). While protection of designs in the EU can be obtained through registered or unregistered national or Community design rights, this article focuses on registered Community designs (RCDs) administered through the Office for Harmonization in the Internal Market (OHIM).

An RCD confers on the design protection for five years from the filing date and can be renewed in blocks of five years up to a maximum of twenty-five years. An advantage of registration is that it provides a presumption of entitlement to the RCD and a prima facie basis of the design's entitlement to protection.

An RCD provides absolute protection against use of the design, irrespective of whether or not there has been copying.

Requirements for Protection

As defined in Art. 3 CDR, a design is the outward appearance of a product or part of it, resulting from the lines, contours, colors, shape, texture, materials, and/or its ornamentation. Designs are not protectable when their appearance is wholly determined by their technical function, or by the need to interconnect with other products to perform a technical function. Protectable designs must also be novel and have individual character. A design is novel if no identical design, or one that differs only in immaterial details, has been made available to the public before the priority date of the application for registration. A design is deemed to have individual character if the overall impression it produces on the informed user (i.e., someone who is not a designer or a technical expert but knows the various designs that exist in the sector concerned, possesses a certain degree of knowledge with regard to the features that those designs normally include, and, as a result of his interest in the products concerned, shows a relatively high degree of attention when he uses them) differs from the overall impression produced on such a user by any other design that was publicly available before the priority date of the application for registration.

Public availability depends on whether or not a design has been published, exhibited, used in trade, or otherwise disclosed, before the date of filing the application, in a manner in which the design would reasonably have become known, in the normal course of business, to the circles specialized in the sector concerned, operating within the EU. Consequently, disclosure, including sale or offer for sale, to a third person under explicit or implicit conditions of confidentiality does not amount to public availability.

Unauthorized public disclosure of a design resulting from an abuse in relation to the designer or the

design's owner will not destroy the novelty of an application either.

The CDR also provides a grace period that permits the designer or the owner of the design to publicly disclose the product during the twelve months prior to the date of filing of a design application without destroying its novelty. This grace period can be useful for applicants with budgetary constraints that may be hesitant to incur the expense associated with registering designs before determining their success on the market.

Registration Overview

For those applicants familiar with the delays and complexities associated with the filing and prosecution of patents at the European Patent Office (EPO), the design registration process will appear to be remarkably uncomplicated. The applicant files an application with basic requirements, e.g., identifying the name and address of the applicant, the first and second language of proceedings, at least one visual representation of the design, the indication of the type of product designed, and the relevant fees. An application can claim priority on the basis of a previous design application filed within six months prior to the date of filing in any state that is party to the Paris Convention or a member of the World Trade Organization. If an application claims priority, requirements related to the priority document are also submitted with the application.

Applications can be filed directly with OHIM or through any of the Industrial Property Offices of the EU Member States.

There is no substantive examination of applications for an RCD. Substantive requirements for protection, such as novelty and individual character, are not examined by OHIM. These requirements are examined only in case of a legal dispute through a request for declaration of invalidity of a registered Community design filed directly at OHIM or by way of a counterclaim in infringement proceedings before a court. Accordingly, after filing the application, OHIM examines whether or not the application contains formal defects. If the application does not meet the formal requirements, OHIM will raise an objection and provide the applicant with the ability to correct the issues, typically within two months. If all formal requirements are met, OHIM checks whether or not the design applied for corresponds with the definition of a design according to Art. 3 CDR and verifies that the design is not contrary to public policy or morality (Art. 9 CDR). If these requirements are fulfilled, the design will be registered and published in the Community Designs Bulletin, and OHIM will issue the registration certificate. The first five-year term of protection starts from the date of filing of the application.

Applicants have the option of deferring publication for up to thirty months, allowing the design to remain confidential. The request for deferment must be made at the time the application is filed. Once the design has been registered, the design owner can request the publication of the design at any time within twenty-seven months after the filing date of the application. If the applicant chooses not to publish the design at all, the registration will lapse after the thirty-month period.

Enforcement

The RCD grants its owner an exclusive right to prevent an unauthorized third party from making, offering, marketing, importing, exporting, or using a product in which the design is incorporated or to which it is applied, or holding stock of such a product for those purposes.

The owner of an RCD can seek to enforce its rights through a court action brought to Community Design Courts established by the regulations. Because an RCD is valid in the EU as a whole, i.e., it is not possible to limit the geographic scope of protection to certain Member States, a finding of infringement of an RCD applies to the entire territory of the EU. The design owner may also seek to enforce its rights before the national courts of a Member State (i.e., a court not designated as a Community Design Court).

In this case, the competence of the court, and any relief granted, is limited to the territory of that Member State.

The design owner can also seek relief through administrative action by requesting the customs authorities of EU Member States to retain suspected counterfeit goods while under their control.

Invalidity

A third party may apply for a declaration of invalidity by commencing invalidation proceedings at OHIM or by submitting a counterclaim in infringement proceedings before a Community Design Court.

For commencing invalidity proceedings at OHIM, the opposing party submits an application for a declaration of invalidity. Parties who are not domiciled or who do not have their principal place of business in the EU must appoint a legal representative within the EU. The application for declaration of invalidity generally must include the grounds, facts, and evidence on which the application for a declaration of invalidity is based. Grounds on which an RCD can be invalidated are outlined in Art. 25 CDR. The following are the principal grounds alleged in most cases:

- the contested design does not correspond to the definition of a Community design (Art. 3 CDR);
- the contested design does not fulfill the requirements of novelty and individual character (Arts. 5 and 6 CDR); and
- the holder of the contested design is not entitled to it by virtue of a court decision settling a dispute over ownership of the right (Art. 14 CDR).

Other grounds of invalidity relate to the use of a work protected by copyright law of a Member State, and improper use of items protected under Art. 6ter of the Paris Convention or of public interest in an EU Member State. OHIM will not admit an application for a declaration of invalidity relating to the same subject matter and cause of action, involving the same parties, that has been adjudicated by a Community Design Court and acquired the authority of a final decision.

The invalidity process at OHIM is an *inter partes* proceeding, and as such, the design owner of the contested RCD will be given at least one opportunity to comment before OHIM issues a decision on the validity of the design. The decision can be appealed to the Board of Appeals within two months of the date of the notification of the decision.

If there is already an infringement action pending in one of the Community Design Courts, the accused infringer may be able to bring a counterclaim there for a declaration of invalidity. A decision of a Community Design Court to declare an RCD invalid is applicable throughout the EU.

While undoubtedly there are additional complexities to the registration and use of RCDs, the process of registration is remarkably simple and cost efficient, and may provide the necessary tools to gain early protection of IP, and merits serious consideration when assessing the needs of IP protection in a business.

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At the Federal Circuit

Incorporation by Reference, the Doctrine of Equivalents, and the Disclosure-Dedication Rule

by Adam M. Breier, Ph.D.

For the disclosure-dedication rule to bar infringement under the doctrine of equivalents (DOE), where the purportedly dedicated subject matter resides in a document incorporated by reference into a host patent, the host patent must provide sufficient notice that the incorporated document contains an alternative to a claim limitation. *SanDisk Corp. v. Kingston Tech. Co.*, 695 F.3d 1348 (Fed. Cir. 2012). The DOE provides a basis for establishing infringement if an accused product or process does not literally meet a claim limitation but contains a feature equivalent to what is claimed. Several limitations restrict what can qualify as an infringing equivalent, including the disclosure-dedication rule. Under this rule, subject matter disclosed but not claimed by the patent is dedicated to the public, but only if the unclaimed subject matter was “identified by the patentee as an alternative to a claim limitation.” *Pfizer, Inc. v. Teva Pharms., USA, Inc.*, 429 F.3d 1364, 1379 (Fed. Cir. 2005). In *SanDisk*, the Federal Circuit addressed the application of the disclosure-dedication rule when the purportedly dedicated subject matter is not in the actual patent’s text or drawings, but in another document incorporated by reference into the patent.

SanDisk appealed from summary judgment of noninfringement, contending that Kingston infringed a claim in U.S. Patent No. 6,149,316 to a computer memory system comprising, as relevant here, an array of memory cells and a controller connected to the array, wherein the controller comprises data reading and writing circuits. The parties did not dispute that the accused system contained data reading and writing circuits located not on the controller chip, but on a separate chip. A lack of any evidence that the circuits were somehow part of the controller despite this separation resulted in a finding of no literal infringement and turned the focus of the arguments to the DOE.

SanDisk asserted that the two chips in Kingston’s system (the controller and the separate chip with the data circuits) together constituted an equivalent of a single controller chip with data circuits. Kingston countered that the disclosure-dedication rule prevented infringement under the DOE. Specifically, the patent-in-suit incorporated U.S. Patent No. 5,172,338 (“the ‘338 patent”) by reference, and the ‘338 patent discloses the separate-chip arrangement employed by Kingston. Kingston therefore urged that the separate-chip arrangement was disclosed as an equivalent by the patent-in-suit but not claimed, barring application of the DOE to the separate-chip arrangement.

The court rejected Kingston’s argument. It acknowledged the possibility that subject matter in an incorporated document could be dedicated to the public for purposes of the host patent, but held that for dedication to occur, “the host patent must sufficiently inform one of ordinary skill that the incorporated document contains subject matter that is an alternative to a claim limitation.” *SanDisk*, 695 F.3d at 1366.

The court found that the host patent-in-suit did not identify the ‘338 patent as containing an alternative to the recited controller. Specifically, the host patent only discussed the ‘338 patent generally in two sentences regarding optimized erase implementations and optimized implementations of write operations for certain memory devices. The court held that this brief discussion did not provide sufficient notice that

the '338 patent contains an alternative to the recited controller. Therefore, the court vacated the district court's summary judgment of no infringement under the DOE and remanded the case.

The *SanDisk* holding reduces the risk of undesired consequences from incorporating a document by reference into a patent specification. A contrary result may well have deterred incorporating documents by reference in many cases because the incorporated disclosure would have frequently foreclosed reliance on the DOE. Instead, the effect of incorporation on the DOE remains under the drafter's control to a greater extent—the disclosure-dedication rule will likely not be triggered unless the host patent is written so as to identify alternatives in the incorporated document or otherwise provide notice that alternatives can be found there.

Although constructive notice seems unlikely as long as discussion of the incorporated document remains general, as demonstrated in *SanDisk*, the possibility that some form of constructive notice of alternatives could be recognized still merits caution when incorporating documents by reference. And, of course, drafters who find themselves identifying alternatives to a claim limitation may also wish to consider describing and claiming the alternatives literally in the text of the specification to avoid the litigation of DOE issues. Additionally, if a specification will be prosecuted internationally, describing the alternatives in the actual text and claiming them literally becomes more important because incorporation by reference and the DOE may not be available at all in foreign jurisdictions.

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