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Patent Prosecution Update

January 2015

Adding Multiple, Routine Steps Does Not Transform an Abstract Idea into Patentable Subject Matter

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CardSoft: A Primer on Basic Claim Construction Principles

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Adding Multiple, Routine Steps Does Not Transform an Abstract Idea into Patentable Subject Matter

by Theresa M. Weisenberger

In *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709 (Fed. Cir. 2014), the Federal Circuit applied the Supreme Court's reasoning in *Alice Corp. v. CLS Bank International*, 134 S. Ct. 2347, 2355 (2014), to strike down software method claims under 35 U.S.C. § 101. The patent at issue claimed "a method for distributing copyrighted media products over the Internet where the consumer receives a copyrighted media product at no cost in exchange for viewing an advertisement," where "the advertiser pays for the copyrighted content." *Ultramercial*, 772 F.3d at 712. The Federal Circuit struck down the patent as being directed to the patent-ineligible abstract idea of using advertisements as currency. *Id.* at 714, 717.

The framework developed in *Alice* for evaluating a patent claim under 35 U.S.C. § 101 is a two-step test. *Id.* at 714 (citing *Alice*, 134 S. Ct. at 2355). First, the court determines whether the claims at issue are directed to one of the patent-ineligible concepts: laws of nature, natural phenomena, and abstract ideas. *Id.* If the patent does not claim one of the patent-ineligible concepts, the patent meets the requirements of § 101. If the claim is directed to a patent-ineligible concept, then the analysis requires determining whether the claims include "an element or combination of elements that is 'sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.'" *Id.* (alteration in original) (quoting *Alice*, 134 S. Ct. at 2355).

In applying the second step of the analysis, the *Ultramercial* court looked at each of the eleven limitations of the representative claim on its own. *Id.* at 715-16. After rejecting the steps of "receiving copyrighted media, selecting an ad, offering the media in exchange for watching the selected ad, displaying the ad, allowing the consumer access to the media, and receiving payment from the sponsor of the ad" as describing "an abstract idea, devoid of a concrete or tangible application," the court turned to the remaining claim limitations. *Id.* at 715.

The remaining claim limitations—updating an activity log, requiring a request from a consumer to view the ad, restricting public access, and using the Internet—are only conventional, routine steps that fail to transform the abstract idea of using an advertisement as an exchange or currency into patentable subject matter. *Id.* at 715-16. Specifically, the court found that consulting and updating an activity log constitute "insignificant 'data gathering steps.'" *Id.* at 716 (quoting *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011)). Restricting public access is "insignificant '[pre]-solution' activity," and the "invocation of the Internet" does not "save [the] otherwise abstract claim[]." *Id.* (alteration in original).

For patent drafters, *Ultramercial* is a good reminder that no matter how many claim limitations are present—the claim at issue had eleven steps—a claim can still fail to meet the requirements of § 101. This is true even if some of those limitations "were not previously employed" in the art. *Id.* If a drafter finds him- or herself adding limitations in the hopes of avoiding a § 101 rejection, the claims may deserve a second look to confirm that the claims are more than a "drafting effort designed to monopolize the [abstract idea] itself." *Id.* (alteration in original) (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1297 (2012)).

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CardSoft: A Primer on Basic Claim Construction Principles

by J. Derek McCorquindale

The U.S. Court of Appeals for the Federal Circuit recently reaffirmed basic claim construction principles in *CardSoft, LLC v. VeriFone, Inc.*, No. 2014-1135 (Fed. Cir. Oct. 17, 2014). The court applied a broad range of tools from the seminal *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), to arrive at its interpretation, reversing the trial court.

The asserted patents (including U.S. Patent No. 6,934,945 (“the ‘945 patent”)) describe software for controlling a payment terminal. The problem in the prior art was the variation in payment terminals, which used different hardware/software architectures. The variety of architectures required that each application program for a payment terminal be written expressly for the given terminal, meaning “[p]rogramming alterations are not ‘portable’ between different types of devices.” *CardSoft*, No. 2014-1135, slip op. at 3 (quoting ‘945 patent, col. 3 ll. 13-14). The patents-in-suit taught an improved “virtual machine” acting as an “interpreter” between an application program (like a merchant’s payment-processing software) and the terminal’s hardware systems. *Id.* “Instead of writing a payment processing application for a particular hardware configuration or operating system, a developer can write the application for the virtual machine,” making it portable across systems. *Id.* (citing ‘945 patent, col. 3 ll. 41-45). The improved “virtual machine” of the patents-in-suit included a specialized “virtual message processor” designed to optimize network communications, and a “virtual function processor” designed to optimize control of the payment terminal itself. *Id.* at 4.

CardSoft sued VeriFone and others for patent infringement in March 2008. *Id.* at 2. Having held a *Markman* hearing, the district court construed “virtual machine”—a term found in all the asserted claims—as “a computer programmed to emulate a hypothetical computer for applications relating to transport of data.” *Id.* at 6 (quoting *CardSoft, Inc. v. VeriFone Holdings, Inc.*, No. 2:08-cv-98, 2011 WL 4454940, at *8 (E.D. Tex. Sept. 29, 2011)). The trial court thus found that the claimed “virtual machine” need not run applications or instructions that are hardware or operating system independent.

Subsequent to trial in June 2012, the jury determined under the court’s construction that VeriFone infringed two valid claims of the patents-in-suit. VeriFone appealed the district court’s construction of “virtual machine,” arguing before the Federal Circuit that the trial court erred by not requiring the claimed “virtual machine” to include the limitation that “the applications it runs are not dependent on any specific underlying operating system or hardware.” *Id.* at 5.

The Federal Circuit panel, in an opinion authored by Circuit Judge Hughes, noted that the district court’s claim construction was “correct, but incomplete.” *Id.* at 6. “The district court improperly rejected the Appellants’ argument that the ‘virtual machine’ must ‘process[] instructions expressed in a hardware/operating system-independent language.” *Id.* (alteration in original) (quoting *CardSoft*, 2011 WL 4454940, at *7).

The court came to this conclusion by first noting that the problem in the prior art, as described by the specification, was that applications were hardware or operating system dependent. *Id.* at 7. The court found a “virtual machine” was taught to solve this problem that “creates a complete portable environment,” which “allows programs to operate independent of processor” and allows “[d]ifferent

arrangements of hardware [to] be controlled by the same application software.” *Id.* (alterations in original) (quoting ‘945 patent, col. 3 ll. 34-46; col. 10 ll. 5-7).

Recognizing that it can also be appropriate to use extrinsic evidence to determine a term’s meaning, the court found that Sun Microsystems, Inc. released the Java “virtual machine” in 1996—well before the priority date of the patents-in-suit—and advertised it as allowing a developer to “write once, run anywhere.” *Id.* (quoting *Oracle Am., Inc. v. Google Inc.*, 750 F.3d 1339, 1348 (Fed. Cir. 2014)). During prosecution, the applicant explained that the asserted patents use the term “virtual machine” in the same way Sun did—the patents here further optimize the virtual machine for use on a payment terminal. *Id.* at 8.

The Federal Circuit rejected CardSoft’s arguments supporting the trial court’s construction. First, CardSoft argued that the structure of the claims dictates a broader meaning because they “include” certain “instructions” in the virtual machine, suggesting they can also be operating system or hardware dependent. *Id.* But, according to the court,

this conflates the virtual machine itself with applications (or instructions) running on the virtual machine. The defining characteristic of a virtual machine was, and is, that it acts as an interpreter between applications and the underlying hardware or operating system. That the claimed virtual machine “includes” applications, in the sense that it acts as an interpreter for applications, does not mean that the applications can be hardware or operating system dependent. Such a construction would leave “virtual machine” essentially meaningless.

Id.

Second, CardSoft argued that the principle of claim differentiation supports the broader construction, since dependent claims 7 and 8 state that instructions “do not require translation to the native software code of the microprocessor.” *Id.* at 8-9 (citing ‘945 patent, col. 51 ll. 29-31, 36-37). But the court reminded that claim differentiation is merely “a rule of thumb that does not trump the clear import of the specification.” *Id.* (quoting *Eon-Net LP v. Flagstar Bancorp*, 653 F.3d 1314, 1323 (Fed. Cir. 2011); *Marine Polymer Techs., Inc. v. HemCon, Inc.*, 672 F.3d 1350, 1359 (Fed. Cir. 2012) (en banc)). In this case, held the court, “[b]ecause the ordinary meaning of ‘virtual machine’ is clear in light of the specification and prosecution history, claim differentiation does not change its meaning.” *Id.* at 9.

Under this new construction, VeriFone contended in its Federal Circuit briefing that it was entitled to summary judgment of noninfringement, because the accused payment terminals run applications that depend on a specific underlying operating system or hardware. *See id.* The court granted summary judgment of noninfringement as a matter of law, finding that CardSoft failed to respond to the noninfringement argument. *Id.* at 10 (“By failing to respond to VeriFone’s argument in the briefing, CardSoft has effectively conceded that the accused devices run applications that depend on a specific underlying operating system or hardware. Consequently, we find that CardSoft has waived this argument, and we grant Appellants judgment of no infringement as a matter of law.”).

Practitioners should notice the heavy reliance by the court on the specification in its claim construction. It did not stray from the express purpose of the invention and other disclosure teachings, relying on the context of the entire patent, not just the claim itself. *Phillips*, 415 F.3d at 1312-13. In addition to the intrinsic evidence, including the prosecution history, less significant but very telling extrinsic evidence was cited to arrive at the ordinary and customary meaning of the disputed claim term as understood by a person of ordinary skill in the art. *Id.* at 1317.

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IP5 Offices

The IP5 Offices and the Growing Collaboration Between Them

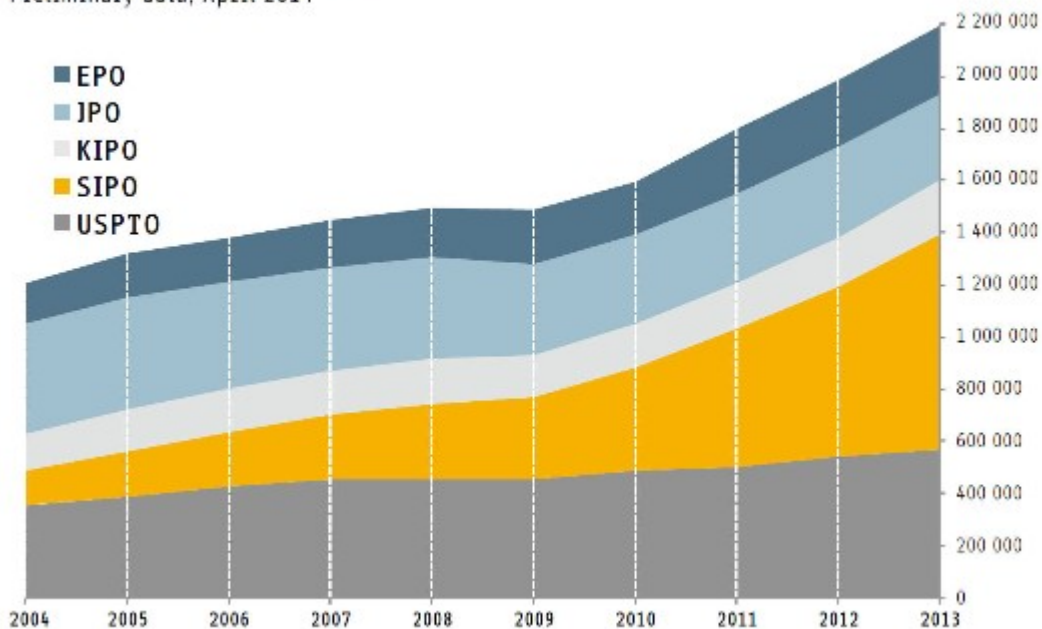
by Arpita Bhattacharyya, Ph.D.

Editor's Note: Beginning with this edition, we will be running a new column comparing the formal and legal requirements for filing and prosecuting applications in the IP5 patent offices. With each issue, readers will learn the differences between the offices on a single topic, with the intention that a truly international application can be drafted. In this inaugural column, we introduce the IP5 Offices and discuss their ongoing efforts toward harmonization.

The “Five IP Offices” (IP5 Offices) is a forum of the five largest intellectual property (IP) offices in the world—the European Patent Office (EPO), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the State Intellectual Property Office of the People's Republic of China (SIPO), and the United States Patent and Trademark Office (USPTO). Presently, the IP5 Offices together handle about 80% of the world's patent applications, and 95% of all work under the Patent Cooperation Treaty (PCT).¹ Patent filings in the IP5 Offices have also increased rapidly over the past few years. Nearly 1.9 million patent applications were filed at the IP5 Offices in 2012, representing a growth of 11% over 2011. And in 2013, a total of 2.2 million patent applications were filed in the IP5 Offices, which is an increase of 10.6% over 2012. Although the growth among these IP5 Offices has not been equal over the years, there is general movement towards greater patent filings worldwide. Preliminary data from the IP5 Offices show that while the number of patent filings in 2013 in the USPTO, the KIPO, and the EPO has increased moderately from 2012 (5.3%, 8.3%, and 2.8%, respectively), and the JPO essentially had a decrease in filings of 4.2%, the SIPO has had a whopping 26.4% growth over 2012. The chart below shows the continuous rise in global patent filings, especially Chinese applications.

Patent filings at IP5 Offices

Preliminary data, April 2014



The majority (85%) of the patent filings in the SIPO in 2013 came from applicants who are resident in China. In comparison, only 51% of patent applications filed in the USPTO are by U.S. applicants, and only 35% of patent filings in the EPO are by applicants who are resident of the EPO region. The increased filing in the SIPO is in line with the growing investment in research and development in China. Many of the patent applicants from China are also increasingly filing abroad—there was a 10.8% and 16.2% increase in patent filings in the USPTO and the EPO, respectively, in 2013 by applicants from China. Residents of the Republic of Korea are also increasingly filing abroad, with a 14.0% and 12.1% increase in patent filings in the EPO and the USPTO, respectively, in 2013 by applicants from Korea.

While the growing trend seeking greater IP protection creates new opportunities for innovation and development worldwide, the increase in patent filing has resulted in an ever-increasing backlog of patent applications in the IP5 Offices. The backlog largely results from innovators filing for patent applications on the same technology in multiple Offices in parallel to protect their IP in multiple markets. The large growth in patent filings in the IP5 Offices demonstrates the need for greater collaboration and work-sharing between the IP5 Offices to reduce redundancies in the international patent system. Over the past few years, the IP5 Offices have been cooperating progressively to improve efficiency and quality of examination, and to eliminate duplication of work at each Office. The creation of the Patent Prosecution Highway (PPH) is one example of the exchange of information among the Offices and increased collaboration between them. More cooperation in the form of shared search and examination work, better access to prior art documentation, and tools for sharing results is in the works to eliminate redundant work and to improve quality and efficiency of patent examination worldwide.

Each issue of the *Full Disclosure* newsletter will explore the current similarities and differences in the laws and filing requirements of the IP5 Offices, and the continuing efforts by the IP5 Offices to harmonize their laws and practices to more efficiently and effectively integrate the global patent system. Although the IP5 Offices are striving to harmonize the formal and legal requirements for applications filed in the individual offices, there are still differences that can be more easily accommodated with a little extra planning. See you next edition!

¹ The statistical data in this article are courtesy of the Five IP Offices (<http://www.fiveipoffices.org>).

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Design Patents

Selling Globally? Protect Locally – Strategic Planning for Design Rights Worldwide

by Elizabeth D. Ferrill

In today's worldwide marketplace, many companies hope to sell their products abroad. And many companies will certainly consider having their products manufactured in another country. So in this month's column, I'm going to take a closer look at the decision to file design patents (or design registrations as they are called in many parts of the world) outside your home nation. Many of these considerations will sound familiar to filers of utility patents across multiple jurisdictions, but the details are very different.

Design Protection Systems

Initially, it is important to understand that there are actually three broad types of systems for protecting design rights: (1) registration systems; (2) examination systems; and (3) hybrid systems.

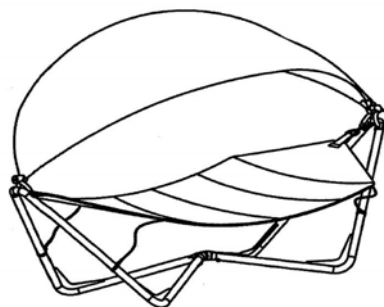
Registration Systems. In registration systems, typically the application is briefly reviewed for completeness (the application states it has five figures and five figures have been filed). Also, the figures are considered to determine if they all depict an article of the same class—meaning figures of a lamp are not mixed with figures of a coffee pot. China, Mexico, South Africa, Switzerland, and the European Union (through its Office for the Harmonization in the Internal Market (OHIM)) are all considered registration systems. Registration systems are usually quicker and have lower costs.

Examination Systems. In examination systems, design applications are reviewed for compliance with procedural matters (as in registration systems) as well as for novelty, obviousness, originality, and consistency between the figures, depending on local laws. In most examination systems, an examiner conducts a search for prior art and compares the results to the design shown in the application. The United States, Japan, India, and Taiwan have examination systems. In examination systems, typically it takes longer for the patent to issue than in registration systems, and the fees can be higher. Some examination systems (such as in the United States) offer an expedited examination process for an additional fee.

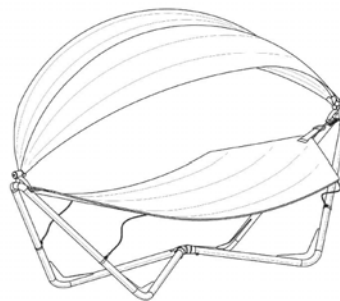
Hybrid Systems. Some countries have adopted systems that fall in between the registration and examination systems. For example, in Australia and Brazil, designs follow a registration process, but there is also an optional follow-on examination process required before a design can be enforced. This allows applicants to register a large number of designs (at a lower cost than with examination) and decide later which registrations to take through the examination process. The date of priority for prior art is the date when the registration was filed. Other countries, such as South Korea, have a nonsubstantive examination process for certain "short lifecycle" classes, such as food products, clothing and accessories, printed materials, computers, and screen icons. But South Korea requires substantive examinations for other classes such as household items and furnishings.

Timing of Filing

For utility patents, practitioners tend to think in twelve-month periods, because most foreign filings must be made within one year of the priority filing. For designs, this twelve-month period is shortened to six months. So, the decisions for foreign filing must be made in half the time. As a result, it is a good idea to think about this issue before you find the six-month deadline looming.



Original Priority Filing
CN 2012 3 0297809



U.S. Patent No. D706,054 -
Swing Bed with Canopy

Another difference is that design filings are typically made after the design is finalized, which is often shortly before the public announcement or first sale of the new product. So thinking about your strategy ahead of time is important, because your decision makers (and designers) will likely have many other things to worry about during this busy period.

Choosing Where to File for Protection

The biggest question is usually where to file. Of course, your final decisions will be dictated by business realities and budget constraints, but it is important to think broadly at first to build your prioritized list of countries. Some important considerations include:

1. **Where do you plan to sell the product?** First and foremost, you will want protection from your competitors and any potential counterfeiters in the markets where you plan to sell the design. Rank the markets by potential sales from most to least.
2. **Where did you invent the design?** Often, most of sales will be in your own backyard. But if you choose not to file in your home country, then you may need to consider foreign filing licenses, depending on your local laws.
3. **Where will you make the product?** Many have heard of suppliers making “extra” runs of a product afterhours or continuing to sell an older design to other retailers after you’ve moved on. Getting design rights in the countries where your suppliers operate combats this threat.
4. **Where will your competitors make their product?** Even if your company chooses to make your product locally, it is important to consider that your competitor may have the product made overseas. As noted below, one of the best enforcement tools can be to have any infringing designs stopped at the border of the exporting country before they ever get put on a ship.

Of course, these are just some of the questions. Other important issues include filing in places that will have a large impact (such as filing at OHIM and getting protection in all the European Union countries at once) and in places with a large customer base. The courts of some countries have greater or lesser respect for design rights and that is reflected in the damages amounts and the ease of getting injunctive relief. Japan, Switzerland, and OHIM will permit infringing designs to be stopped at the border, and in the case of a change in EU law, in some cases, the infringing product can be destroyed by Customs officials.

Don't Forget the Differences in Design Law

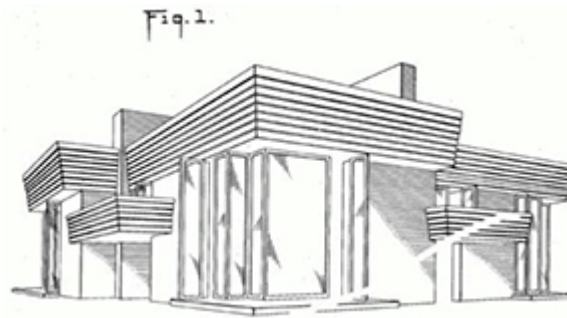
Prior Public Disclosure or Sale. Another important consideration is whether you’ve disclosed the design before filing. Some countries require “absolute novelty” for design registrations, while others have grace periods. Some grace periods, like for the OHIM, are more generous than in places like the United States, which recently limited its grace period; the exact bounds of the U.S. grace period are still to be determined. Other countries will permit certain types of limited disclosure in connection with

government or university activities.

Publication of Design. Smart companies file for design rights before public disclosure, but may still wish to keep the design secret for a bit longer after filing. In countries like the United States, designs are kept secret until they issue (typically fifteen to eighteen months after filing). But in other places, like OHIM, the design will be registered almost immediately and become publicly available shortly thereafter. Therefore, it is important to consider if you would like to defer registration (possible in OHIM) or ask that the design right be kept secret (possible in South Korea under certain circumstances).

Differing Definitions of Protectable

Subject Matter. Many countries differ on what designs are deserving of protection. For instance, China and South Korea put limits on protectable designs for buildings. The United States does not have this limitation. A more modern difference is found in the protectability of graphical user interfaces (GUIs). Some countries do not protect GUIs at all, while others require that the underlying display device also be claimed.



U.S. Patent No. D114,204 to
Frank Lloyd Wright - Dwelling

Preparing the Application

In preparing your priority application for filing, it is helpful to make decisions that will make your foreign filing easier and less expensive. Some places will permit you to file computer-generated graphics (such as OHIM), which can be easily created from most CAD or e-drawing programs, but these graphics may present issues when filing elsewhere. The United States Patent and Trademark Office, for instance, strongly prefers line drawings. This is usually in the interest of the applicant as well, because line drawings permit the applicant to disclaim the unimportant details of the design. Commissioning line drawings is an additional expense, but usually any changes that need to be made for the different jurisdictions can be made quickly and at little additional cost.



Original Priority Filing
CN 2012 3 0297809

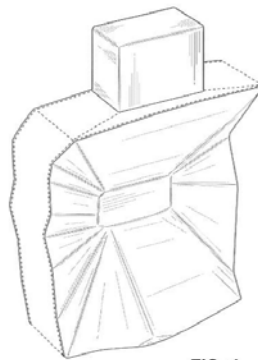


FIG. 1

US Patent No. D675529 -
Container for a Fragrance

Comparison of OHIM and US Design Filings

It is also important to think about the types of disclosure (meaning what views—top, bottom, right, left, etc.) you plan to include in your application. For instance, OHIM limits a single design to seven views. On the other hand, the United States has no limit, but requires that there be “sufficient views” to completely show the design. Some countries encourage multiple views from different perspectives (e.g., a top, front, right perspective view and a bottom, rear, left perspective view) over more elevation (i.e.,

“straight on”) views. Other countries will permit a limited number of perspective views in addition to the six traditional elevation views. In other words, it is important to think ahead to make sure that all of these masters can be served and that your priority application will support all later applications.

Using the Hague System for International Registration

In the United States, there has been much discussion about the Hague System for International Design Registration. There are currently sixty-two members of the Hague Agreement, including OHIM, the

African Intellectual Property Organization, and as of July 2014, South Korea. The United States is expected to complete the Hague process in the first half of 2015 and begin accepting applications shortly thereafter. Notably, China, Japan, Australia, Brazil, and Canada are not currently members.

Simply put, the Hague System allows a single point of deposit for design applications that may be destined for any other member country. For Hague filers, there will be one electronic filing system and all fees can be paid in a single currency at the same time. (The fees, however, will not be lower and the accepting country's office will charge a fee for sending the applications to the other countries.)

But the Hague System will not necessarily simplify the overall process. The local laws of each country still govern registration—including local drawing rules and disclosure requirements of known prior art (such as in the United States). And all objections or rejections to applications must be dealt with directly at the national offices. In some cases (such as in the United States), this requires that the applicant retain a local representative who is admitted to deal with that country's office. Generally, it will be important to consult foreign local counsel before filing your application through the Hague System.

Retaining Skilled Local Counsel

The above discussion has hopefully convinced you that it is paramount to rely on skilled local counsel in each jurisdiction. Local counsel can be invaluable for providing prefiling advice to get applications through registration or examination more quickly and for interpreting the local examiner's idiosyncrasies. Finally, as design and design rights gain recognition throughout the world, many countries are reforming their local laws and competent local counsel can keep you informed about any changes.

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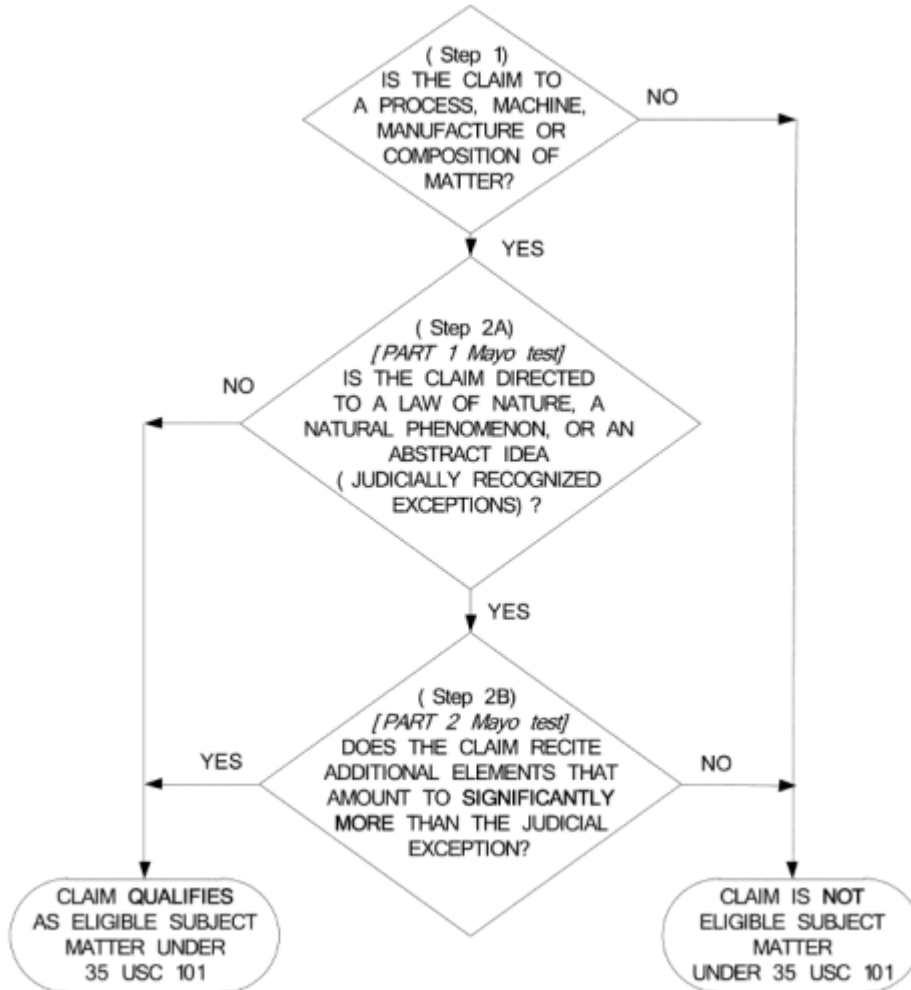
Rule Review

New Subject Matter Eligibility Interim Guidance After Alice, Mayo, and Myriad

by Amanda L. Lutz

Following three years of evolving law under 35 U.S.C. § 101, the U.S Patent and Trademark Office (USPTO) has published comprehensive guidance for assessing patent subject matter eligibility under 35 U.S.C. § 101. The [“2014 Interim Guidance on Patent Subject Matter Eligibility”](#) (Interim Guidance) encompasses the USPTO’s guidance for subject matter eligibility following the Supreme Court’s opinions in *Alice Corp. v. CLS Bank International*, 134 (2014); *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107 (2013); and *Mayo Collaborative Services v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (2012). It supplements the June 25, 2014, [“Preliminary Examination Instructions in view of the Supreme Court Decision in *Alice Corporation Pty. Ltd. v. CLS Bank International, et al.*”](#) and supersedes the March 4, 2014, [“Guidance for Determining Subject Matter Eligibility of Claims Reciting or Involving Laws of Nature, Natural Phenomena, and Natural Products”](#) (March 2014 Guidance).¹

The Interim Guidance generally follows the organization of MPEP § 2106 and includes a flowchart to assist with the analysis. Beginning with the two-step analysis for subject matter eligibility identified in MPEP § 2106, the Interim Guidance focuses on applying the two-part *Mayo/Alice* test for claims directed to laws of nature, natural phenomena, and abstract ideas.² In addition, the Interim Guidance establishes a streamlined eligibility analysis for certain claims that clearly do not attempt to preempt use of the judicial exception. The Interim Guidance flowchart, which differs slightly from the flowchart in the March 2014 Guidance, is reproduced below³:



Step 2A: Determine Whether the Claim as a Whole Is Directed to a Judicial Exception

After determining that the claim recites statutory subject matter under Step 1, the Interim Guidance instructs examiners to determine whether the examined claim as a whole is directed to a judicial exception.⁴ This first requires determining what the claim is “directed to.”⁵ The USPTO defines a claim as directed to a judicial exception if “a law of nature, a natural phenomenon, or an abstract idea is *recited*” (*i.e.*, set forth or described) in the claim.”⁶

In most circumstances, a claim directed to a judicial exception will require further analysis under Step 2B of the *Mayo/Alice* test to determine if it qualifies as eligible subject matter. According to the Interim Guidance, this closer scrutiny is warranted because there is a risk that a claim directed to a judicial exception may “tie up” the excepted subject matter.⁷ Like the courts, examiners should “tread carefully” when considering these types of claims “because at some level all inventions embody, use, reflect, rest upon, or apply a law of nature, natural phenomenon, or abstract idea.”⁸ For claims that clearly do not seek to preempt use of the judicial exception, the Interim Guidance provides a streamlined eligibility analysis that sidesteps the *Mayo/Alice* test, discussed below.⁹ This includes nature-based products that clearly do not seek to preempt the judicial exception, which may bypass the “markedly different characteristics” analysis normally required by the Interim Guidance.¹⁰

The Interim Guidance broadened the “markedly different characteristics” analysis of claims that recite nature-based products. Unlike the March 2014 Guidance’s emphasis on structural differences to satisfy the markedly different analysis, the Interim Guidance recognizes that “[m]arkedly different characteristics can be expressed as the product’s structure, *function*, and/or *other properties*.”¹¹

In conjunction with the publication of the Interim Guidance, the USPTO released [Nature-Based Product Examples](#) that exemplify the “nature-based products” analysis. The Examples overlap in part with those in the March 2014 Guidance in addition to presenting and analyzing new examples. The USPTO is expected to release Abstract Idea Examples soon.

Streamlined Eligibility Analysis

Certain claims that recite a judicial exception but “clearly do not seek to tie up the judicial exception” may bypass the *Mayo/Alice* test and use a streamlined eligibility analysis.¹² According to the USPTO, these claims need not proceed through the standard eligibility analysis “as their eligibility will be self-evident.”¹³

While the Interim Guidance does not provide concrete details on the specific types of claims eligible for the streamlined eligibility analysis, it does provide several examples of claims eligible for this analysis. These examples are:

- a robotic arm assembly having a control system that operates using certain mathematical relationships;
- an artificial hip prosthesis coated with a naturally occurring mineral;
- a cellphone with an electrical contact made of gold; or
- a plastic chair with wood trim.¹⁴

Step 2B: Determine Whether the Claim Recites Significantly More Than the Judicial Exception

Once the examiner determines that the claim is directed to a judicial exception, the claim must be analyzed to determine if the elements of the claim “amount[] to significantly more than the exception itself.”¹⁵ This search for inventive concept in the claim proceeds by considering the elements individually and in ordered combination.¹⁶ Requiring the claims to recite “significantly more” ensures that the claim describes a process or product that “applies the exception in a meaningful way.”¹⁷

The Interim Guidance provides several examples of claim limitations that “may be enough to qualify as ‘significantly more’ when recited in a claim with a judicial exception” in Sections I.B.1 and III.¹⁸ For example, the Interim Guidance identifies adding a specific limitation other than what is well understood, routine, and conventional in the field as a type of limitation that may meet the “significantly more” requirement.¹⁹ On the other hand, generally linking the use of the judicial exception to a particular technological environment or field of use was found not to qualify as “significantly more.”²⁰

Although the Interim Guidance does not specifically identify it as such, the Federal Circuit’s recent opinion in *DDR Holdings, LLC v. Hotels.com, L.P.*, No. 2013-1505 (Fed. Cir. Dec. 5, 2014), is the first example after *Alice* where software-based claims satisfied the “significantly more” requirement of Step 2B.²¹ The claims at issue in *DDR Holdings* provide a solution to retaining website visitors on a host’s website after visitors activate an advertiser’s hyperlink.²² Without more than a summary of the Federal Circuit’s holding in *DDR Holdings*, the Interim Guidance provides little actual guidance to what makes software-based claims directed to an abstract idea patent eligible.²³ Perhaps the USPTO will address how the claims in *DDR Holdings* satisfied Step 2B where the claims in *Alice* and its progeny failed when it releases the forthcoming Abstract Ideas Examples.

As with the March 2014 Guidance, the Interim Guidance took effect immediately upon publication on December 16, 2014, and applies to all applications filed before, on, or after that date. The Interim Guidance has already started to impact the examination of applications for examiners and patent applicants. The USPTO is seeking public comment on the Interim Guidance and anticipates that the examination guidance will periodically be supplemented based on developing jurisprudence and public comment. More information about the Interim Guidance is available at the USPTO’s [Examination Guidance and Training Materials](#) page, and a summary of this Interim Guidance is available in a [2014 Interim Eligibility Quick Reference Sheet](#).

¹ 79 Fed. Reg. 74,619 (Dec. 16, 2014).

² *Id.* at 74,621-22.

³ *Id.* at 74,621.

⁴ *Id.* at 74,622.

⁵ *Id.*

⁶ *Id.* (emphasis added).

⁷ *Id.*

⁸ *Id.*

⁹ *Id.*

¹⁰ *Id.* at 74,623.

¹¹ *Id.* (emphases added).

¹² *Id.* at 74,622, 74,625.

¹³ *Id.* at 74,625.

¹⁴ *Id.*

¹⁵ *Id.* at 74,624.

¹⁶ *Id.*

¹⁷ *Id.*

¹⁸ *Id.*

¹⁹ *Id.*

²⁰ *Id.*

²¹ *Id.* at 74,632; *DRR Holdings*, No. 2013-1505, slip op. at 19-20.

²² 79 Fed. Reg. at 74,632.

²³ *Id.*

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EPO Practice

Oral Proceedings at the European Patent Office

by Philip L. Cupitt, Ph.D.

A distinctive feature of European Patent Office (EPO) practice is the prevalence of hearings during examination. At the EPO, the guiding principle of the examination procedure is to grant a patent or refuse the application in as few actions as possible.¹ Thus, it is common for the EPO to appoint hearings at an early stage in the examination procedure before applicants have had a sufficient opportunity (or, in some cases, any opportunity) to respond in writing to the objections raised by the examiner.

This article answers some of the most frequently asked questions regarding hearings during examination at the EPO. Whilst there are many similarities between hearings during the examination procedure and those during opposition or appeal procedures, hearings during the latter procedures have a few fundamental differences that are not discussed here.

What are Oral Proceedings?

“Oral proceedings” is the name given to a hearing at the EPO.² The aim of oral proceedings during examination is to decide whether to grant a patent or to refuse the application.

Oral proceedings take place before a panel of examiners known as an Examining Division.³ An Examining Division has three members⁴: the Chairman, who is responsible for the conduct of the hearing; the First Examiner, who is usually the same examiner that handled the written phase of the examination procedure; and the Second Examiner, who takes the minutes of the hearing. All three members vote on whether to grant or refuse the application, and the fate of the application is decided by a majority vote.

Oral proceedings are held at the EPO's premises in Munich, The Hague, or Berlin. The venue of the oral proceedings is dictated by the city in which the Examining Division is based and, as such, applicants cannot choose the venue.^{5, 6} Applicants may request that oral proceedings be held by video conference.⁷

What Should Be Done upon Receiving a Summons?

The EPO notifies applicants that oral proceedings will take place by issuing a communication entitled “Summons to attend oral proceedings pursuant to Rule 115(1) EPC” (“Summons”). The Summons states the date of the oral proceedings, together with a deadline for making written submissions and/or amendments.

It is important to realize that the issuance of a Summons indicates that the First Examiner is inclined to refuse the application.⁸ As such, the issuance of a Summons marks the point in the examination procedure where applicants and their attorneys must focus their efforts on overcoming all of the Examining Division's objections. Applicants should consider what amendments might be necessary to overcome those objections and whether the resulting claim scope would have commercial value. If it seems unlikely that an acceptable claim scope could be achieved in view of the Examining Division's objections, or if there is little likelihood of overcoming the objections at all, applicants should consider the alternatives to attending oral proceedings discussed below.

The deadline for filing amendments that is set in the Summons must be observed. The deadline cannot

be extended without the agreement of the Examining Division, and amendments filed after the deadline might be disregarded.⁹

How Can the Claims Be Amended?

It is common to file several different sets of claims when responding to a Summons to allow a number of alternative amendments to be discussed with the Examining Division.

When filing several sets of claims, the applicant ranks each set of claims according to its desirability. The set of claims that the applicant most desires to be granted is called the “Main Request.” The remaining sets of claims are typically called the “First Auxiliary Request,” “Second Auxiliary Request,” “Third Auxiliary Request,” and so on. In general, the independent claims of the various Requests have a progressively narrower scope, with the independent claims of the Main Request having the broadest scope and those of the lowest-ranking Auxiliary Request having the narrowest scope. The Requests will be examined in turn until the Examining Division finds a set of claims it considers to be allowable, or until all of the sets of claims have been refused.

The usual considerations for claim amendments apply to the Main and Auxiliary Requests. In particular, the amendments must be directly and unambiguously derivable from the content of the application as originally filed,¹⁰ and the amended claims must relate to subject matter that has been searched.¹¹ If amendments are filed after the deadline set in the Summons, there is an additional requirement that the amended claims should not diverge from the claims already filed.¹² That is, any late-filed Auxiliary Requests should focus upon a single invention, and should not branch out in different directions.

There is no formal limit on the number of Auxiliary Requests that may be filed. Between one and four Auxiliary Requests is usually a good number, depending on the complexity of the application. The filing of a large number of Auxiliary Requests may be regarded as an abuse of procedure.

Applicants should ensure that the Requests collectively include every set of claims that they may wish to pursue on appeal, should the application be refused. It may be difficult to introduce entirely new sets of claims during appeal proceedings, if those claims were not considered by the Examining Division.¹³

Thus, if the applicant wishes to pursue on appeal claims that were filed earlier in the examination procedure, but later withdrawn (including the claims of the application as originally filed), such claims should be included in one of the Requests.

Is It Necessary for Written Submissions to Contain Detailed Arguments?

The level of detail contained in the written submissions is a matter of personal preference. Some attorneys prefer to make few arguments in the written submissions and reserve detailed arguments for the oral proceedings. Other attorneys prefer to include detailed arguments in the written submissions.

The author’s preference is for written submissions to contain a similar level of detail as would be included in a response to an office action during the written phase of examination. This approach often allows many of the Examining Division’s objections to be overcome in advance of the oral proceedings and, in some cases, can avoid the need for oral proceedings to take place.

Is It Worth Attending Oral Proceedings?

There is no obligation to attend oral proceedings. Oral proceedings can sometimes provide a good opportunity to overcome objections that have been raised during examination, or to present arguments that cannot easily be expressed in writing or that might create an estoppel in other jurisdictions if made in writing. Oral proceedings can also allow attorneys to explore the allowability of various amendments with the Examining Division.

In many cases, however, the Examining Division’s objections are so entrenched that they cannot be overcome at oral proceedings. In such cases, attendance at oral proceedings is futile. It is advisable for an applicant’s attorney to telephone the First Examiner after filing the written submissions in order to find out whether any objections remain and to gauge the likelihood of success at oral proceedings.

What Are the Alternatives to Attending?

One alternative to attending oral proceedings is to request a written decision on the claims that are currently on file. Such a decision will typically be a decision to refuse the application. The advantage of requesting a written decision is that it can be appealed in the same way as a decision pronounced during oral proceedings, but the costs of attending oral proceedings are not incurred.

Another alternative is to withdraw the application. This course of action will avoid a decision to refuse the application being taken, which may be advantageous when the European application has counterparts in other jurisdictions.

A third alternative is to file a divisional application. Filing a divisional application may be necessary where the only way to overcome the Examining Division's objections would be to amend the claims in such a manner that they are directed to subject matter that has not been searched, or if there is a desire to pursue claims that were considered to lack unity of invention with the claims that are currently under examination. This option can also allow applicants to have another go at prosecution, although the EPO regards the filing of divisionals for this purpose as an abuse of procedure.

What Happens at Oral Proceedings?

Oral proceedings involve a detailed discussion about the Examining Division's objections to the application. It is common for new objections to be raised during the course of discussion, and it is even known for new prior art to be cited for the first time at oral proceedings. Likewise, it is common for new amendments to be filed during the oral proceedings, either in response to new objections or to existing objections being better articulated. Hence, it is vital for applicants' attorneys to prepare their cases thoroughly in order that they can respond to whatever objections are raised.

The manner in which oral proceedings are conducted depends upon the personalities of the members of the Examining Division and the strength of the applicant's case. In some cases, the Examining Division will collaborate with the applicant's attorney to find an allowable set of claims. In other cases, the Examining Division will allow the applicant its right to be heard,¹⁴ but its members will already have made up their minds to refuse the application.

Oral proceedings conclude with the Examining Division indicating its intention to grant a patent or pronouncing a decision to refuse the application. If the Examining Division intends to grant the application, a written communication ("Communication under Rule 71(3) EPC") will be issued. On the other hand, if the Examining Division decides to refuse the application, a written decision containing the reasons for refusal will be issued.

Should the Inventors or In-House Counsel Attend?

Oral proceedings are usually attended by the applicant's European patent attorney alone. There is generally no need for the inventors, in-house counsel, or other representatives of the applicant to attend. If the inventor or any other person accompanying the European patent attorney intends to make submissions during oral proceedings, the Examining Division's permission should be sought in advance.

One instance where it may be helpful for the inventor to attend oral proceedings is in cases involving particularly complex technology or where the common general knowledge of the skilled person is at issue.

What Happens If the Application Is Refused?

There are two options if the Examining Division decides to refuse the application: appeal the decision, or take no further action. If the decision is appealed, it will be reviewed by a Board of Appeal¹⁵. It is quite common for the Boards of Appeal to set aside decisions of the Examining Divisions¹⁶. However, a large backlog of cases before the Boards of Appeal means that it typically takes at least three years before an appeal is considered.

¹ “How to get a European patent” (EPO, 14th ed., Oct. 2013, ¶ 162). See also Guidelines for Examination in the European Patent Office (Nov. 2014, Part C, Chapter IV-3).

² Art. 116 EPC.

³ Art. 18 EPC.

⁴ In rare cases, a legally qualified examiner may supplement the three technically qualified examiners that normally make up the Examining Division.

⁵ See, e.g., Board of Appeal Decision T 1012/03.

⁶ In the early days of the EPO, oral proceedings took place only in Munich. However, the number of hearings held in The Hague and Berlin is now comparable to the number of hearings held in Munich. Thus, there is no advantage in selecting European counsel based solely upon their proximity to a particular city in which the EPO is based.

⁷ Official Journal of the EPO (May 2012, p. 354); Guidelines for Examination in the European Patent Office (Nov. 2014, Part E, Chapter II-11).

⁸ Although a Summons is issued by the Examining Division as a whole, the Chairman and Second Examiner often do not consider the case in detail until shortly before oral proceedings.

⁹ Rule 116(1) EPC.

¹⁰ Art. 123(2) EPC.

¹¹ Rule 137(5) EPC.

¹² Guidelines for Examination in the European Patent Office (Nov. 2014, Part H, Chapter III-3.3.1.2).

¹³ See, e.g., Board of Appeal Decision T 569/08.

¹⁴ Art. 113 EPC.

¹⁵ Art. 21 EPC.

¹⁶ According to the EPO’s Annual Report for 2013, the Boards of Appeal allowed 288 appeals against Examining Divisions’ decisions and dismissed 302 such appeals, whilst a further 423 such appeals were otherwise settled.

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At the Federal Circuit

Location Matters: Nonpreamble Use of “Comprising” Leads to Finding of Lack of Enablement

by Clara N. Jiménez

In *Promega Corp. v. Life Technologies Corp.*, Nos. 13-1011, -1029, -1376 (Fed. Cir. Dec. 15, 2014), the Federal Circuit reversed the district court's denial of summary judgment on invalidity, finding that the asserted claims, which used open-ended claim language, were not enabled by the specification. The court closely examined how the use of the term “comprising” in the body of the claims—not the preamble—affected the scope of the claims. This case also presents an interesting analysis of the impact of the level of predictability of the art in the enablement analysis.

At issue in the case were five patents that claim methods or kits for carrying out a technique of forensic DNA identification known as “short tandem repeat” (STR) profiling. *Id.*, slip op. at 5. In particular, the claims related to multiplex amplification of STR loci, which allows the generation of a detectable amount of DNA that can be used to provide a DNA “fingerprint” unique to each individual. *Id.* Promega owned four patents (“Promega patents”) and licensed the fifth (“the Tautz patent”). *Id.* The accused products are genetic testing kits used by law enforcement agencies for forensic identification, and by clinical and research institutions for, for example, analyzing cancer cells, that use the claimed STR profiling technique. *Id.* at 8-9.

Promega entered into a nonexclusive cross-license agreement with Applied Biosystems (AB)—now a wholly owned subsidiary of Life Technologies (LifeTech)—in 2006. *Id.* at 9. Under the license, AB had the right to use the claimed inventions in the Promega and Tautz patents for “Forensic and Human Identity Applications.” *Id.* Promega later sued LifeTech for infringement of the Promega and Tautz patents, alleging that LifeTech sold testing kits not covered by the cross-license. *Id.* LifeTech responded that it was licensed to practice all of the patents-in-suit and filed counterclaims alleging that the Promega patents were invalid. *Id.* at 9-10. LifeTech did not challenge the validity of the Tautz patent. *Id.* at 10.

Among other things, the district court denied LifeTech's summary judgment motion that the Promega patents were invalid due to lack of enablement and obviousness. *Id.* The Federal Circuit reversed, finding that the claims were not enabled by the specification, and did not address the issue of obviousness. *Id.* at 20-21.

Each of the asserted claims includes a limitation that recites the phrase “a set of . . . loci” followed by a list of particular STR loci multiplexes of varying complexity. *Id.* at 5-6. Some of the asserted claims included closed transitional language (“a set of . . . loci . . . consisting of . . .”), while others included open transitional language (“a set of . . . loci . . . comprising . . .”). *Id.* at 6-7 (emphases added) (citation omitted). As expected, the district court construed the open loci claims not to be restricted to “products that use no loci other than those listed in the claims,” and therefore allowing the claims to cover unrecited loci. *Id.* at 6, 14. The open loci claims were at the center of the lack of enablement challenge by LifeTech.

The enablement requirement requires a specification to contain a written description of the invention that would enable a person skilled in the art to which it pertains to make and use the same without undue experimentation. See *Ortho-McNeil Pharm., Inc. v. Mylan Labs., Inc.*, 520 F.3d 1358, 1365 (Fed. Cir.

2008). The guidance needed to enable the invention is generally inversely related to the knowledge in the state of the art and the predictability in the art. *In re Fisher*, 427 F.2d 833, 839 (CCPA 1970). The Federal Circuit determined that the technology at issue in *Promega* was highly unpredictable. To illustrate its point, the Court relied on several allegations made by *Promega* during the prosecution of the patents describing the highly unpredictable nature of the technology field. For example, *Promega* had alleged that its claims were patentable because the prior art did not disclose “methods for selecting, co-amplifying, and evaluating the *specific* sets of . . . loci” recited in the claims. *Promega*, No. 13-1011, slip op. at 15 (citation omitted). *Promega* characterized this lack of disclosure as *critical*, as the state of the art did not disclose or suggest that any arbitrary combination of loci can be co-amplified without undue experimentation. *Id.* *Promega* had also alleged during prosecution that “the addition of *even a single* locus to an existing loci combination rendered that new combination patentable” and that “‘the disclosure of some of the individual loci in the various [recited] sets of loci co-amplified’ was insufficient to render a claim unpatentable.” *Id.* at 15-16 (alteration in original) (emphasis added) (citation omitted).

Despite the overwhelming evidence that adding a single locus to an existing loci combination can fundamentally transform the character of the resulting multiplex reaction, *Promega* alleged that the accused kits infringe its claims because “*any and all* co-amplifying loci combinations that include the STR loci recited in the claims are encompassed by the claims.” *Id.* at 17. The enablement requirement ensures that “the public knowledge is enriched by the patent specification to a degree at least commensurate with the scope of the claims.” *Id.* at 14 (quoting *Nat’l Recovery Techs., Inc. v. Magnetic Separation Sys., Inc.*, 166 F.3d 1190, 1195-96 (Fed. Cir. 1999)). The court found that, like in *MagSil Corp. v. Hitachi Global Storage Technologies, Inc.*, 687 F.3d 1377, 1381 (Fed. Cir. 2012), instead of tying the key claim limitation to what the specification enabled, *Promega* sought to extend its scope advances in this unpredictable art by drafting claims that could cover thousands of undisclosed loci combinations. See *Promega*, No. 13-1011, slip op. at 20-21. The Court also found that, like in *Wyeth & Cordis Corp. v. Abbott Laboratories.*, 720 F.3d 1380 (Fed. Cir. 2013), one of ordinary skill in the art would have to engage in undue experimentation to practice the claims because, while the *Promega* patents provide a starting point, they fail to provide disclosure that would have allowed a skilled artisan, absent laborious testing, to add any new loci to these recited loci combinations with a reasonable expectation that it would still successfully co-amplify. See *Promega*, No. 13-1011, slip op. at 18-19.

Promega argued that if the Court found its claims to lack enablement, “every claim using the transitional phrase ‘comprising’ would be invalidated.” *Id.* at 20. The Court dispelled these fears by explaining that, while the term “comprising” in a claim preamble may create a presumption that a list of claim elements is nonexclusive, it does not reach into each limitation to render every word and phrase therein open-ended. *Id.* *Promega*’s claims differ from such customary open-ended claims because its inclusion of “comprising” in its “open loci set” limitation, as construed, expands the claims at a key limitation, rather than in the preamble, to cover what are the identified advances in the art. *Id.* at 20-21. As drafted, the open loci claims cover potentially thousands of undisclosed embodiments in an unpredictable field. *Id.* at 20. Since the *Promega* patents do not enable a skilled artisan to practice the full breadth of the scope of its claims without undue experimentation, the Court held the claims invalid.

In the wake of *Promega*, strategic and careful drafting of a patent application continues to be the best method for satisfying the enablement requirement. Such drafting must include a clear understanding of the level of knowledge available in the prior art, determining where that knowledge may fill any gaps in the disclosure, and providing numerous examples of varying scope for practicing the claimed invention. It must also include a careful selection of every word that is added to the claims—not just of the technical terms used to substantively describe the invention—and a clear understanding on how each word may affect the claim. In addition, *Promega* serves as yet another reminder to practitioners that every statement made during prosecution of a patent application can significantly affect the ability to successfully enforce the patent. A careful practitioner should evaluate how arguments and statements made to overcome prior art may affect the claim’s ability to withstand § 112 challenges or limit its scope for infringement purposes.

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