Patent Prosecution Update

June 2015

A Change in What "Means" Means: The En Banc Federal Circuit Reverses Itself

The Federal Circuit panel deciding *Williamson v. Citrix Online, LLC*, 770 F.3d 1371 (Fed. Cir. 2014), in November 2014 overturned a district court claim construction that treated the term "distributed learning control module" as a means-plus-function expression under (pre-AIA) 35 U.S.C. § 112, ¶ 6. The patent-in-suit, U.S. Patent No. 6,155,840 ("the '840 patent"), describes methods and systems for distributed or distance learning, enabling presenters to connect to audiences via virtual classrooms. The patent owner conceded that the district court's construction rendered the relevant claims invalid as indefinite, and stipulated to final judgment, followed by an appeal. **More**

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A Change in What "Means" Means: The En Banc Federal Circuit Reverses Itself

by Eric P. Raciti

The Federal Circuit panel deciding *Williamson v. Citrix Online, LLC*, 770 F.3d 1371 (Fed. Cir. 2014), in November 2014 overturned a district court claim construction that treated the term "distributed learning control module" as a means-plus-function expression under (pre-AIA) 35 U.S.C. § 112, ¶ 6. The patent-in-suit, U.S. Patent No. 6,155,840 ("the '840 patent"), describes methods and systems for distributed or distance learning, enabling presenters to connect to audiences via virtual classrooms. The patent owner conceded that the district court's construction rendered the relevant claims invalid as indefinite, and stipulated to final judgment, followed by an appeal.

On appeal, the Federal Circuit panel held, in line with precedent existing since 2004, that because "distributed learning control module" did not use the word "means," there exists a strong rebuttable presumption that 35 U.S.C. § 112, ¶ 6 does not apply. To rebut the presumption, "it must be demonstrated that 'skilled artisans, after reading the patent, would conclude that [the] claim limitation is so devoid of structure that the drafter constructively engaged in means-plus-function claiming.'" *Id*. at 1378 (alteration in original) (quoting *Inventio AG v. ThyssenKrupp Elevator Ams. Corp.*, 649 F.3d 1350, 1357 (Fed. Cir. 2011)). In this case, the court found that the word "module" is not the equivalent of "means," because "module" is a structural term, and that the district court did not consider and give weight to the language of the entire claim.

Accordingly, the Federal Circuit vacated the district court's entry of final judgment against Williamson and remanded the case to the district court. On June 16, 2015, the Federal Circuit withdrew its opinion and substituted a new one, including an en banc section (Part II.C.1) addressing the means-plus-function issue. The en banc court reversed the precedent creating a "strong" presumption based on the presence or absence of the word "means." Instead, the court held that the standard is "whether the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure." *Williamson v. Citrix Online, LLC*, No. 2013-1130, slip op. at 14 (Fed. Cir. June 16, 2015).

As before, if the claim language does not meet the standard, § 112, ¶ 6 (now § 112(f)) applies. Whereas previously, the analysis appeared almost strictly literal, precedent nevertheless included the notion that the claims were to be analyzed by how they were understood by one of skill in the art. *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583 (Fed. Cir. 1996). The new standard removes the "strong" presumption and loosens the tethers of the means- and step-plus-function analysis from the absence of the word "means," relying only on the person of skill in the art's understanding by a preponderance of the evidence.

The Federal Circuit's decision, authored by Judge Linn, is not coy about the court's motivation for its reversal of precedent.

> Our consideration of this case has led us to conclude that such a heightened burden is unjustified and that we should abandon characterizing as "strong" the presumption that a limitation lacking the word "means" is not subject to § 112, para. 6. That characterization

> is unwarranted, is uncertain in meaning and application, and has the inappropriate practical effect of placing a thumb on what should otherwise be a balanced analytical scale. It has shifted the balance struck by Congress in passing § 112, para. 6 and has resulted in a proliferation of functional claiming untethered to § 112, para. 6 and free of the strictures set forth in the statute. Henceforth, we will apply the presumption . . . without requiring any heightened evidentiary showing and expressly overrule the characterization of that presumption as "strong." We also overrule the strict requirement of "a showing that the limitation essentially is devoid of anything that can be construed as structure."

Williamson, No. 2013-1130, slip op. at 15-16. The implications of this decision will be felt for many years to come in patent litigation if Judge Linn is correct that there has been a "proliferation of functional claiming untethered to § 112, para. 6 and free of the strictures set forth in the statute." *Id.* The question to be answered is at what point in the intersection of functional and structural language the scale tips toward language invoking § 112's means- or step-plus-function. Pre-AIA § 112, ¶ 6 and post-AIA § 112(f) are identical and read as follows, with the strictures referred to by Judge Linn in italics:

> An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim *shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof*.

Squarely in the cross-hairs of the new paradigm[1] are recitations that do not use the word "means" but instead use "nonce" words, such as "module," in the case at hand. It is difficult to ignore the fact that the technology in the *Williamson* case is software, and the court's objection to "black box" claim elements will likely hit hardest in the software and electronics classes. Modern electronics structures are oftentimes quite secondary to their software coding for functionality, and even exact disclosure of the structure of an electronic component performing a function, such as a "processsor," may not satisfy a court or a patent examiner that adequate structure has been disclosed. The term "processor" could indeed be a "nonce" word just as "module" was found to be.

Once § 112 is invoked, the Federal Circuit restated the governing case law that structure disclosed in the specification qualifies as "corresponding structure" if the intrinsic evidence clearly links or associates that structure to the function recited in the claim, citing *Noah Systems, Inc. v. Intuit Inc.*, 675 F.3d 1302, 1311 (Fed. Cir. 2012) (citing *B. Braun Med., Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424 (Fed. Cir. 1997)). The court further restated that even if the specification discloses corresponding structure, the disclosure must be of "adequate" corresponding structure to achieve the claimed function. *Id*. at 1311-12 (citing *In re Donaldson Co.*, 16 F.3d 1189, 1195 (Fed. Cir. 1994) (en banc)).

With this decision, the en banc court increases the burden on patent prosecutors. As Judge Newman noted in her dissent, invoking means-plus-function treatment of a claim limitation used to be under the control of the patent draftsperson, resident in the choice to use the term "means for" (or "step for"), or not. Moving forward, under 35 U.S.C. § 112, ¶¶ 2 and 6, if a person of ordinary skill in the art would be unable to recognize the structure in the specification and associate it with the corresponding function in the claim, a means-plus-function clause is indefinite. *Id*. at 1312 (citing *AllVoice Computing PLC v. Nuance Commc'ns, Inc.*, 504 F.3d 1236, 1241 (Fed. Cir. 2007)).

If means-plus-function treatment is not desired, then specific structural claiming is required to support a functional recitation in the body of the claim. Further, to safeguard against invalidity due to indefiniteness in the event means-plus-function is invoked by a court, the specification should also contain detailed structural disclosure, clearly linked to the functions recited in the claims. For patents granted with claims using functional language unsupported by detailed specifications, the consequences of falling under § 112, ¶ 6 (now § 112(f)) are charted by the patentee in this case—death by indefiniteness for lack of definite structure.

[1] The "new" paradigm is essentially the state of the law before 2004, when the Federal Circuit established the "strong presumption" in a line of cases beginning with *Lighting World, Inc. v. Birchwood Lighting, Inc.*, 382 F.3d

1354 (Fed. Cir. 2004).

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Inter Partes Review: Indefinite Claims Can't Play

by Clara N. Jiménez

In a petition for inter partes review (IPR), the petitioner may challenge a patent claim only on grounds of anticipation or obviousness under 35 U.S.C. § 102 or 103, and using only patents and printed publications. 35 U.S.C. § 311(b). The statute does not allow IPR petitioners to challenge a patent claim for failure to comply with the requirements of § 112. Nevertheless, petitioners and patent owners that believe § 112 issues have no impact on whether an IPR is instituted are missing part of the picture. Decisions from the Patent Trial and Appeal Board (Board) illustrate that a claim's failure to comply at least with § 112's definiteness requirement has a substantial impact whether an IPR can be instituted and lead to a finding from the Board that could be used to challenge the patent in subsequent proceedings.

Determining whether the petitioner has established a reasonable likelihood of proving the unpatentability of the claims challenged in an IPR petition requires the Board to begin its analysis by construing the claims. Because in an IPR there is no presumption of validity, the Board does not apply a rule of construction with an aim to preserve the validity of the claims. *See RF Controls, LLC v. A-1 Packaging Solutions, Inc.*, IPR2015-00119, Paper 15 at 8-9 (Apr. 29, 2015). The Board must, therefore, necessarily consider whether the claim is definite, such that it makes itself amenable to construction. *Id.* Indeed, the Board has explicitly rejected requests from petitioners, arguing that the Board "may and should construe claim language to avoid interpretations which would invalidate the claims under § 112." *Id.* at 9. If the Board concludes that a challenged claim is indefinite, the Board will not institute IPR on that claim, as application of the prior art against a claim that fails to inform the scope of the claimed invention with reasonable certainty would be speculative. *See Actifio, Inc. v. Delphix Corp*., IPR2015-00014, Paper 13 at 41-42 (Apr. 16, 2015).

The indefiniteness analysis is even more important when one or more of the challenged claims in the IPR recites a means-plus-function term. The Board's rules require the petitioner to "identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function" in claims written in means-plus-function format, and the question of definiteness of means-plus-function terms is inherently part of the analysis undertaken by both the petitioner and the Board at the outset of the proceeding. *See* 37 C.F.R. § 42.104(b)(3). Thus, any acknowledgment by the petitioner that the specification fails to provide corresponding structure for a recited function or that the specification's discussion of the same is insufficient, may raise a red flag for the Board that an indefiniteness problem may exist. The Board recently addressed these issues in *Space Exploration Technologies Corp. v. Blue Origin LLC*, IPR2014-01378, Paper 6 (Mar. 3, 2015).

In *Space Exploration*, the petitioner sought to invalidate claims 14 and 15 of U.S. Patent No. 8,678,321 ("the '321 patent"). The challenged claims are directed to systems involved in the landing and recovering of reusable launch vehicles (RLV) used for space exploration. *See id.* at 2. Independent claim 14 recites:

> 14. A system for providing access to space, the system comprising:
>
> a space launch vehicle, wherein the space launch vehicle includes one or more rocket engines;

a launch site;

a sea going platform;

means for launching the launch vehicle from the launch site a first time, wherein the means for launching include *means for igniting the one or more rocket engines* and launching the vehicle in a nose-first orientation;

means for shutting off the one or more rocket engines;

means for reorienting the launch vehicle from the nose-first orientation to a tail-first orientation before landing;

means for reigniting at least one of the one or more rocket engines when the launch vehicle is in the tail-first orientation to decelerate the vehicle;

means for landing at least a portion of the launch vehicle on the sea going platform in a body of water, wherein the means for landing include means for landing in the tail-first orientation while the one or more rocket engines are thrusting; and

means for launching at least a portion of the launch vehicle from the launch site a second time.

(Emphases added.) In proposing its constructions for the means-plus-function limitations "means for igniting" and "means for shutting off," and presumably in an effort to preserve its § 112 arguments, the petitioner asserted that the specification of the '321 patent does not disclose corresponding structures for performing the claimed functions. *Space Exploration*, IPR2014-01378, Paper 1 at 18-19. Nevertheless, petitioner urged the Board to give these terms their broadest reasonable construction by finding that "any suitable structure" for performing the claimed function could be the corresponding structure. *Id.* The patent owner did not file a preliminary response.

In declining to adopt the petitioner's proposed construction, and denying institution of IPR of the challenged claims, the Board began by pointing to the specification's minimal discussion of the igniting, shutting off, and reigniting functions recited in claim 14. *Space Exploration*, IPR2014-01378, Paper 6 at 6. Looking to the figures in the '321 patent, the Board found that the figures did not "shed any light on the corresponding structure." *Id.* The Board also highlighted that in the specification, the patentee acknowledged that "several details describing structures and processes that are well-known and often-associated with launching and landing space launch vehicles are not set forth in the [written disclosure] to avoid *unnecessarily obscuring* the various embodiments of the disclosure." *Id.* at 8 n.5 (emphasis added). In light of this evidence, the Board declined to institute IPR, noting that "[a]ny comparison with the prior art asserted in the Petition would be speculative and futile." *Id.*

The outcome of this petition can be contrasted with the petitioner's success in persuading the Board to institute IPR of other claims in the same patent challenged through a different petition. *Space Exploration Techs. Corp. v. Blue Origin LLC*, IPR2014-01376, Paper 7 (Mar. 3, 2015). The challenged claims in the second petition are directed to the methods of "operating a space launch vehicle" and methods for "transporting a payload to space," as illustrated by representative claim 1 below:

1. A method for operating a space launch vehicle, the method comprising:

launching the space launch vehicle from earth in a nose-first orientation, wherein launching the space launch vehicle includes igniting one or more rocket engines on the space launch vehicle;

reorienting the space launch vehicle to a tail-first orientation after launch;

positioning a landing structure in a body of water; and

vertically landing the space launch vehicle on the landing structure in the body of water in the tail-first orientation while providing thrust from at least one of the one or more rocket engines.

The two decisions in *Space Exploration* highlight valuable lessons for practitioners. For IPR petitioners, the decisions illustrate the need to carefully consider including statements related to potential § 112 arguments in the petition. If such statements are necessary, petitioners should only include clarifying, nonargumentative statements about potential issues with the claims. While the Board conducted its own analysis of the proper construction, it undoubtedly also placed weight on the petitioner's admission that the specification lacked disclosure of the corresponding structures. For patent owners considering asserting the challenged claims against potential infringers, these decisions raise the issue of the practical impact of a Board's finding of indefiniteness in a decision to institute IPR. While the patent claims still stand after a Board's denial of institution based on indefiniteness, a district court could give the Board's ruling persuasive weight during litigation and find the patent invalid for indefiniteness.

For patent drafters, the decisions highlight that any statements made in the specification may be understood as admissions by the patentee for different issues related to the patentability of the claims. Thus, care should be taken to ensure that the specification does not include statements that can negatively impact the breadth or patentability of the claims down the road. While the original intent of the statement "several details describing structures and processes that are well-known and often-associated with launching and landing space launch vehicles are not set forth in the [written disclosure] to avoid *unnecessarily obscuring* the various embodiments of the disclosure" was likely added to avoid limiting the claims, it inadvertently helped the Board reach a finding of indefiniteness. The decisions also illustrate the benefit of covering the invention using different types of claims. While the Board may have found that the system claims are indefinite—and in practice, the claims may be weak—the Board's finding does not invalidate the claims. For patent prosecutors, the decisions also reiterate the need to carefully examine the specification and prosecution history of an application before adding new claims or proposing claim amendments. In light of the specification, it may have been good to amend the claims to recite the system avoiding means-plus-function limitations or perhaps to avoid introducing the claims (if the claims were added later).

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IP5 Offices

Preparing an IP5-Compatible Patent Application: Disclosure Requirements

by Arpita Bhattacharyya, Ph.D.

The patent laws of the "IP5"[1] countries have set forth explicit patent disclosure requirements, which require the specification of every patent application to disclose the invention clearly and completely so that a person skilled in the art can practice the invention. This is one of the basic characteristics of the IP5 patent systems. Although the IP5 countries share this and many other common features of a patent application, there are slight differences in the patent disclosures and filing formalities of the IP5 countries. In the preceding IP5 article, we discussed the differences in the filing formalities in the IP5 countries. This article will cover the differences in the application parts and the ordering of the application in the IP5 countries.

China

Rule 17 of the Patent Law of China (incorporating original Rule 18) provides that the description of a patent application must include a title of the invention, and the following parts with a section heading preceding each part: (1) technical field; (2) background art; (3) contents of the invention; (4) description of figures; and (5) preferred mode of carrying out the invention. The description must not refer to the claims for the purpose of describing matters contained in the description. Rule 17 further provides that if an application contains disclosure of one or more nucleotide and/or amino acid sequences, the description must contain a sequence listing, and a copy of the said sequence listing in machine-readable form must be submitted to the State Intellectual Property Office (SIPO). Rule 18 requires that the drawings be numbered and arranged in numerical order. Rule 18 also requires that reference signs appearing in the text must appear in the drawings, and vice versa. Rules 19-22 describe the specific form the claims must take. Further, Rule 20 requires that an abstract consisting of a summary of the disclosure be provided with the application disclosure.

United States

A U.S. nonprovisional (utility) application must include the following: (1) utility patent application transmittal form or transmittal letter; (2) appropriate fees; (3) application data sheet (under 37 C.F.R. § 1.76); (4) specification (with at least one claim); (5) drawings (when necessary); (6) executed oath or declaration; (7) nucleotide and amino acid sequence listing (when necessary); and (8) large tables or computer listings (when necessary). Requirements for arrangement of the specification are provided under 37 C.F.R. § 1.77, and primarily include a title of the invention, cross-reference to related applications, a background section, brief summary of the invention, brief description of the several views of the drawings, detailed description of the invention, a claim or claims, abstract of the disclosure, and sequence listing. The description of the invention should also include the best mode for carrying out the invention, but failure to do so does not result in invalidity of the patent.

Japan

Article 36 of the Japan Patent Law provides that protection and utilization of an invention are promoted through a description, claims, and drawings, which serve both as a technical document disclosing technical details of an invention and as a document of title defining the technical scope of a patented invention accurately. Section 23 of the Regulation under the Japan Patent Law provides that a request for patent must be accompanied by a specification, any necessary drawings, and an abstract. The

specification must state: (1) the title of the invention; (2) a brief explanation of the drawings; (3) a detailed explanation of the invention; and (4) the patent claim(s). Article 36(4) further provides the requirements of the description, and requirements for the statement of the claims are provided under Article 36(5) and (6). Only an application that meets these requirements serves both as a technical document and as a document of title. Section 3.2.1 of Part I of the Examination Guidelines further requires applicants to disclose the best mode of carrying out the invention, although failure to disclose the best mode does not result in invalidity of the patent.

Korea

Pursuant to the revisions to the Korean Patents Act, which came into effect on January 1, 2015, requirements for a specification and claims when filing a patent application have been relaxed. Under revised Article 42, any forms of a description of an invention, such as a thesis, papers, or any other publications, may be accepted at the time of filing a patent application in Korea. A specification and claims that meet the formality requirements can be submitted within fourteen months of the earliest priority date. If they are not submitted within this period, the application will be deemed to be withdrawn.

Article 42(2) provides that a patent application must be accompanied by a specification stating the following, along with the necessary drawings and abstracts: (1) the title of the invention; (2) a brief description of the drawings; (3) detailed description of the invention; and (4) the scope of the claims. There is no best mode requirement under the Korean Patents Act.

EPO

Under Article 78(1) of the European Patent Convention (EPC), a European patent application has to contain: (1) a request for the grant of a European patent; (2) a description of the invention; (3) one or more claims; (4) any drawings referred to in the description or the claims; (5) an abstract. Rule 42 of the EPC provides details on the content of the description. In particular, Rule 42(1) provides that the description shall: (1) specify the technical field to which the invention relates; (2) indicate the background art; (3) disclose the invention, as claimed, in such terms that the technical problem, even if not expressly stated as such, and its solution can be understood, and state any advantageous effects; (4) briefly describe the figures in the drawings, if any; (5) describe in detail at least one way of carrying out the invention claimed; (6) indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is industrially applicable. The EPC does not have a best mode requirement.

[1] The five major intellectual property offices: the Korean Intellectual Property Office; European Patent Office; Japan Patent Office; State Intellectual Property Office of the People's Republic of China; and United States Patent and Trademark Office.

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Design Patents

Understanding the Hague: Should We Hug It or Hate It?

by Elizabeth D. Ferrill

Understanding the International Design Application: What it is and what it is NOT

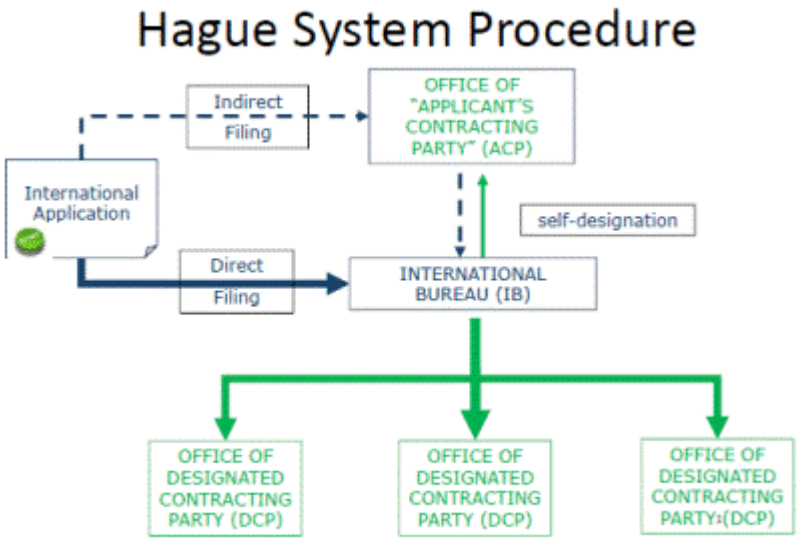
On May 13, 2015, the United States officially became a Contracting Party to the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs. This mouthful is typically summarized as: the United States joined the Hague Agreement.

This is a long-awaited step towards international harmonization of U.S. design patent procedures, but what does it really mean? And how can you know if you should file a national U.S. design patent application or an application under the Hague Agreement, known as an International Design Application or IDA.

What Is the Hague?

The Hague system is largely sold as simplifying the filing and maintenance of international applications—a "one-stop shop" for filing a single application in any of the member countries.

An international application is filed either directly with the International Bureau (part of the World Intellectual Property Office (WIPO)) or indirectly with the applicant's home office. The WIPO registers the application, checks the application for certain formalities, publishes the application, and then forwards the application to the other members that the applicant has selected, known as Designated Contracting Parties. Each Designated Contracting Party may choose to substantively examine the international application, but if the Designated Contracting Party does not issue a refusal in a designated period (either six or twelve months), the international registration has the effect of that member's grant of protection.[1]



April 29, 2015

Some important procedural points:

- **Hague is a "members only" club.** The Hague has over sixty-four member territories, including Japan, South Korea, and the European Union (EU). Click here for a full list. Only applicants who have a connection to a member territory can use the Hague system, and applicants can only file applications directed to countries in the Hague. Notably absent from the list are China, Canada, Australia, Brazil, and Argentina, although at least China, Canada, and Australia appear to be making plans to join the Hague in the near future.

- **Applications can be filed directly with the WIPO or at the U.S. Patent and Trademark Office (USPTO).** As noted above, Hague filers can choose to file directly with the WIPO. But, the USPTO will also serve as an office of indirect filing, allowing Hague filings directly through EFS-Web, the USPTO's electronic filing system. Filers who choose to file through the USPTO can pay for all filing fees, for filing in any country, in U.S. dollars; the WIPO system only accepts Swiss francs. Filers who choose to file through the USPTO will not be required to apply for a separate foreign filing license.

- **Applications may include up to 100 different designs.** Under the Hague Agreement, filers will enjoy the convenience of electronic filing up to 100 different designs (provided they are in the same "Locarno class," e.g., "articles of clothing and haberdashery" or "medical and laboratory equipment") in a single initial application. Still, over 90% of Hague applications have ten or less designs, and nearly 40% have only one design.[2]

- **Although the filing is centralized, the design right will be examined (or not) according to the laws of each individual member.** After following its examination or registration procedures, each Contracting Party (e.g., country) will issue its own design right (either registration or patent), which will be enforceable in that jurisdiction. However, under the Hague, every Contracting Party has agreed to accept figures with broken lines to designate unclaimed subject matter, even if its own laws had not permitted such a convention before.

Few Changes to U.S. Law Under the Hague

Despite the hubbub, joining the Hague changes few substantive U.S. design laws. But there are two changes in U.S. law worth noting:

Term of U.S. Design Patents Lengthened to Fifteen Years. As part of joining the Hague, the United States agreed to lengthen the effective term of a design patent from fourteen years of the date of the issue to fifteen years. This new term will apply to all issued design patents, whether they are filed through the Hague system or through the traditional U.S. filing system.

Provisional Rights Possible with WIPO Publication Under the Hague . . . . U.S. design patent applications are not published until the patent issues and, thus, until the adoption of the Hague, it was not possible to have provisional rights under 35 U.S.C. § 154(d). Section 154(d) confers the right to obtain a reasonable royalty from a party that infringes the invention "as claimed in the published patent application," from the time the patent application is published until the patent issues, provided the party had actual notice of the published patent application. With the adoption of the Hague, the publication of the International Design Application will qualify the underlying publication for provisional rights. Design patent applications filed under the standard U.S. system will still not be published and thus not qualify for provisional rights.

. . . But, Provisional Rights Under the Hague Are Limited. Restriction practice is much more common with single-claim U.S. design patents, and the USPTO plans to continue to apply these same rules to the international design applications. As noted above, international design applications may contain as many as 100 different designs. It is important to note that any provisional rights will attach only to the first embodiment elected in a multidesign international design application. These provisional rights will not transfer to any later-filed divisional applications that claim priority to the international design application.

Therefore, when planning a Hague filing strategy, if provisional rights are of concern and multiple designs are disclosed, then the applicant must take care in picking which design will enjoy those U.S. provisional rights (or else file multiple applications).

The Hague Has Some Important Caveats

The Hague is not a cure-all for the intricacies of foreign filing for design protection. There are five important caveats to understand:

1. **International Applications Are Published.** While this publication may be deferred, it is not possible to keep an application away from public view until the design patent issues, as is possible if an applicant files a U.S. design patent application. This difference is important for companies that prefer to keep their designs secret (but still apply for protection) before a product launches.
2. **Substantive Examination Procedures Remain the Same.** First, filing under the Hague does not change the substantive examination procedures of any member country. The Hague only centralizes the filing, formalities examination, and annuity fees (in those countries that require them). For instance, the United States will still require applicants to identify the inventor of the design, include a claim, and submit an oath or declaration from the inventor. In Japan, applicants will still be required to submit the proper certification if they wish to take advantage of the grace period for prefiling public disclosures.
3. **Filing Through the Hague Won't Save Tons of Money.** Filing through the Hague does not generally save filers money in terms of government fees—in fact, there is an additional processing fee for filing through the USPTO. Although filers may save money in translation costs (which generally aren't required, provided the application is filed in English, French, or Spanish) and potentially in foreign counsel filing costs, depending on the quality of the application that is originally filed, the overall costs might not be lower. For instance, only if a particular country grants the application as-filed would applicants probably avoid having to retain local counsel. If, however, a particular granting authority refuses to allow the application as filed, then the applicant would likely need to address any outstanding issues via local counsel.
4. **Enforcement Will Stay the Same.** Filing under the Hague does not change the substantive rules governing enforcement of the resulting design rights. So if an application includes broken lines as a method of indicating that certain subject matter is not claimed, then these broken lines would still be subject to the local interpretation at the time of enforcement. As we learned from the *Apple v. Samsung* cases, the meaning of broken lines may be different in the EU than in the United States. Filing though the Hague would not change this situation.
5. **No "Universal Drawing Standard" Is Applied Throughout the Countries Participating in the Hague.** Crafting a single set of figures for an international design application for Hague filings that satisfy all the participating countries will likely be difficult. Those who regularly file for design rights in many parts of the world know that different jurisdictions have different rules and practices. For instance, although the EU permits multiple designs in a single registration, each design is limited to only seven "views" (or figures). In the United States, on the other hand, the rule is that a design must contain a "sufficient number of views to constitute a complete disclosure." So there may be some designs that need more than seven views to be deemed completely disclosed by the USPTO. Other differences include preferences regarding shading of line drawings, the acceptance of photographs and computer-generated figures, and the number of perspective views versus orthographic ("straight on at eye level") views that may be permitted. These are just some examples of the differences in drawing standards and disclosure requirements in different countries, and the corresponding difficulties that applicants may encounter.

Bottom Line? The Hague Is a Good First Step

Implementation of the Hague Agreement in the United States represents the largest change to U.S. design patent prosecution practice in recent memory. In the future, the Hague could have a substantial impact on the U.S. design patent practice. In 2014, 14,441 designs were filed through the Hague system,

as compared to 23,657 U.S. design patents issued during that same year. In the short term, all U.S. design patent applicants will benefit from a slightly longer term for their newly issued design patents. Applicants who desire provisional rights can file through the Hague and designate their application back to the United States. In the long term, if drawings standards are harmonized between participating countries, then having the Hague system in place would be immensely helpful to filers who wish to file for worldwide rights. As more countries join the Hague, there will likely be increased pressure to harmonize the drawing standard. But only time will tell.

[1] http://www.uspto.gov/sites/default/files/documents/FINAL%20HAGUE%20FORUM%20SLIDES%204-29.pptx, at slide 12 (last visited June 13, 2015).

[2] http://www.wipo.int/edocs/mdocs/hague/en/wipo_hs1_15/wipo_hs1_15_1.pdf, at slide 24.

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Rule Review

An Appealing Trade: The Expedited Patent Appeal Pilot Program

by Clara N. Jiménez

Obtaining a patent can be a slow process. The process becomes even longer when an applicant decides to appeal the final rejection of its claims. According to data released by the U.S. Patent and Trademark Office (USPTO), the average appeal takes about thirty months to be decided. In an effort to address its backlog, the USPTO has announced the Expedited Patent Appeal Pilot program (EPAP), which has as a goal to reduce the backlog of appealed applications and shorten the pendency of an appeal to the Patent Trial and Appeal Board (Board).

Patent appeals are generally taken up by the Board in the order in which they are docketed. The EPAP will allow appellants who have multiple appeals pending before to Board to file a request to make special one of the pending appeals, therefore expediting its consideration by the Board, on the condition that the appellant withdraws a copending appeal in either another application, or an ex parte reexamination with an ex parte appeal. According to the USPTO, not only will the EPAP help reduce the USPTOe's backlog, but it will also allow appellants having multiple ex parte appeals currently pending before the Board to have greater control over the priority with which their appeals are decided. Thus, at least in theory, an appellant can accelerate the Board's decision on an appeal involving an invention of greater importance to the appellant. For example, a successful appeal could hasten the pace at which the appellant's invention is patented, and the pace at which products or services embodying the patent are brought to the marketplace. This in turn could spur follow-on innovation, economic growth, and job creation. All these benefits, however, come at the cost of the appellant foregoing another pending appeal, perhaps one in which the underlying invention is no longer a business pursuit or priority of the appellant.

For the USPTO to accord special status to an appeal pending before the Board, an appellant must certify that docketing notices were issued for the appeal to be made special and the appeal to be withdrawn before June 19, 2015, and that both applications underlying the identified appeals are owned by the same party as of June 19, 2015, or name at least one inventor in common. The appellant must agree to waive any requested oral hearing in the appeal to be made special. And while no petition fee is required, the appellant must acknowledge that any oral hearing fees paid in connection with the appeal to be made special and any appeal fees, including oral hearing fees, paid in connection with the appeal to be withdrawn will not be refunded. The petition must be signed by a registered practitioner who has a power of attorney for the application involved in the appeal to be made special and for the application or patent under reexamination involved in the appeal to be withdrawn.

The USPTO's goals for handling an EPAP application is to render a decision on the petition to make the appeal special no later than two (2) months from the filing date of the petition, and deciding the appeal made special no later than four (4) months from the date a petition to make an appeal special is filed. The pilot program became effective on June 19, 2015, and has been adopted on a temporary basis until two thousand (2,000) appeals have been accorded special status under the EPAP, or until June 20, 2016, whichever occurs earlier. As with other pilot programs, the USPTO may extend the pilot program, depending upon its results. Complete details of the requirements to participate in the program are available at https://www.federalregister.gov/articles/2015/06/15/2015-14754/expedited-patent-appeal-

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EPO Practice

Examination of Clarity in EPO Opposition Proceedings - Enlarged Board of Appeal Decision, G3/14

by Daryl Penny

Overview

Lack of clarity is not a ground of opposition at the European Patent Office (EPO). However, a recent decision from the EPO's Enlarged Board of Appeal, G3/14,[1] held that clarity can be examined when an amendment is made during opposition, but "only when, and then only to the extent that the amendment introduces non-compliance with Article 84 EPC"[2] (i.e., introduces a lack of clarity). Lack of clarity does not arise where (1) the amendment consists of the literal insertion of a granted dependent claim into an independent claim, or (2) alternative embodiments contained in a dependent claim are introduced into an independent claim. Effectively, then, the dependent claims are unimpeachable, but amendments relying upon wording taken from the specification are open to attack for lack of clarity.

Background

Following grant of a European patent by the EPO, there is a nine-month window within which an opposition may be filed against the grant.[3] The only grounds on which an opposition may be filed are that the subject matter of the European patent is expressly excluded or excepted from patentability;[4] lacks novelty[5] or an inventive step;[6] is not susceptible of industrial application;[7] or extends beyond the content of the application as filed;[8] or that the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.[9] In particular, lack of clarity is not a ground for opposition at the EPO.

However, when amendments are filed during opposition proceedings, Article 101(3) of the European Patent Convention (EPC) states that, "[i]f the Opposition Division is of the opinion that, taking into consideration the amendments made . . ., the patent and the invention to which it relates […] meet the requirements of this Convention, it shall decide to maintain the patent as amended . . . ."[10] (emphasis added). When considering or objecting to amendments made during opposition proceedings, then, there is a tension between whether objection can be raised (1) only on the basis of the limited list of grounds for opposition or (2) on a wider basis, in view of the seemingly more general reference to a need to "meet the requirements of this Convention."

This has resulted in difficulties for patentees, opponents, and EPO opposition divisions considering whether an amended claim, which could be considered to lack clarity, should be allowed, as there is no explicit basis in the EPC for objecting to such an amendment solely on grounds of lack of clarity.

In attempting to address this issue, different EPO Technical Boards of Appeal (hearing appeals from first-instance decisions of EPO opposition divisions) have interpreted the EPC in diverging ways.

For example, in T301/87, the board set out the principle that, when amendments were made to a patent during an opposition, the EPC required consideration as to whether the amendments introduced any contravention of any requirement of the Convention, including Article 84 EPC. However, objections were not allowed to be based on Article 84 EPC if such objections did not arise out of the amendments made.[11] More specifically, in T1855/07, the board took the view that, in principle, an examination of

clarity did not come into question where a dependent claim as granted was inserted literally into the claim under scrutiny, whereas substantial amendments to the claim were to be assessed to ensure their compliance with the requirements of the EPC.[12]

Nevertheless, in T459/09, the board held that clarity of an amended independent claim should, in principle, be examined, even if the amendment only consists of a mere, literal combination of claims of the patent as granted.[13] That is, irrespective of the manner in which the patent is modified, the amended patent should be examined to ensure compliance with all the requirements of the EPC.[14] Any other approach would risk unduly restricting the mandate for examination of an amended patent provided by Article 101(3) EPC. Thus, the board distinguished between a power of examination that is restricted to the grounds for opposition in cases where the claims are unamended, and an unrestricted power to examine claims that have been amended during opposition or appeal. Similarly, in T409/10, the board held that any amendment that can be qualified as being of a substantial nature would in principle justify an unrestricted exercise of the examination power derivable from Article 101(3) EPC, including the examination of clarity, independently of whether the amendment arises from the incorporation of a feature from the description or from the combination of claims of the granted patent.[15]

Thus, whether an opponent could object to, and an opposition division or board of appeal could examine, particular types of claim amendments during opposition proceedings depended upon which line of cases the opposition division or appeal board chose to follow.

Opposition Case

The opposition and subsequent appeal that gave rise to this Enlarged Board decision related to European Patent No. 1,814,480 ("the '480 patent"), in the name of Freedom Innovations, LLC. Claim 1 recited a prosthetic medical device comprising a prosthetic liner and claim 7 recited a process for its manufacture. The opponent, Otto Bock Healthcare GmbH, had been successful in having the '480 patent revoked at first instance for lack of inventive step. On appeal, the patentee filed an auxiliary request for maintenance of the '480 patent in which the independent claim was amended by adding the subject matter of dependent claim 3 as granted, namely, to specify that "the prosthetic liner is coated over substantially all of its surface area." The opponent argued that this request should be refused for noncompliance with Article 84 EPC, because the term "substantially" rendered the claim unclear. To support its position, the opponent relied upon the case law discussed above, which supported a broad approach to the examination of clarity in opposition proceedings. To the extent that other case law came to a different conclusion on this point, the opponent argued that the jurisprudence of the Boards of Appeal was not therefore consistent and that a referral to the Enlarged Board of Appeal should be made for the purpose of ensuring a uniform application of the law.

The appeal board agreed that there was a divergence in the case law on this point and referred the following (paraphrased) questions to the Enlarged Board of Appeal:

1. Does the term "amendments" encompass a literal insertion of (a) elements of dependent claims as granted and/or (b) complete dependent claims as granted into an independent claim, so that such amendments always require an examination for clarity?

2. If yes, is the examination of clarity limited to the inserted features or may it extend to other features in the claim?

3. If the answer to Question 1 is no, is an examination of the clarity of independent claims so amended always excluded?

4. If such clarity examination is neither always required nor always excluded, what conditions apply in deciding whether to examine clarity?

Enlarged Board of Appeal Decision

After providing a detailed review of the case law, the Enlarged Board held that "in considering whether, for the purposes of Article 101(3) EPC, a patent as amended meets the requirements of the EPC, the

claims of the patent may be examined for compliance with the requirements of Article 84 EPC only when, and then only to the extent that the amendment introduces non-compliance with Article 84 EPC."[16] The Enlarged Board thus approved the conventional line of jurisprudence, and disapproved the other, broader or diverging decisions. The Enlarged Board elaborated on some specific points:

1. Considerations of clarity under Article 84 EPC do not come to an end upon grant of a European patent. For example, it has never been doubted that when features are taken from the description and are inserted into a granted claim by way of amendment, the amended claim must be examined for compliance with Article 84 EPC in light of those new features, whether considered by themselves or in their combination with other parts of the claim as now amended.[17]

2. The requirements of Article 84 EPC play no role in opposition proceedings where the patentee seeks to have the patent upheld as granted. A granted claim may turn out not to comply with Article 84 EPC, but such noncompliance must be lived with (although lack of clarity may have a negative impact on the consideration of sufficiency, or of novelty or inventive step of the claim).[18]

3. When amendments to the claims in opposition proceedings are necessary to overcome a ground of opposition, the focus is on how the amendments have changed the claimed subject matter vis-à-vis the previous claims and not other aspects of the patent or the claims that remain unchanged. Amendments must not themselves give rise to new objections under the EPC.[19]

4. Where an amendment involves combining an independent claim with a complete dependent claim—a so-called combination claim—the claim which is in place after the amendment is in reality and substance not a new claim. It was already in the granted patent, albeit written in a shortened form as a dependent claim. As such, clarity in relation to such an amendment is not open to objection under Article 84 EPC.[20]

5. Where a granted dependent claim recites a number of alternative embodiments and the amendment involves combining an independent claim with one of the alternatives from the dependent claim, the dependent claim could have been written out as two (or more) separate dependent claims. As such, this type of amendment is in substance no different from that in point 4 above.[21]

6. This is also the case, for the same reasons, with:

   (a) amendments consisting of deleting wording from a granted (independent or dependent) claim, thereby narrowing its scope, but leaving intact a pre-existing lack of compliance with Article 84 EPC, and

   (b) amendments consisting of deleting optional features from a granted (independent or dependent) claim.[22]

7. For an amendment by means of which features are disconnected from other features of a dependent claim, thereby introducing an alleged lack of compliance with Article 84 EPC, it has never been doubted that the claim may be examined for such compliance. However, where the alleged lack of compliance has not been introduced by the amendment, clarity under Article 84 EPC should not be considered.[23]

Guidance for Practitioners

This decision provides increased certainty over the circumstances under which clarity can be considered when claims are amended during opposition proceedings. Opposition divisions, appeal boards, opponents, and patentees should now have a clearer understanding of when it is and is not permissible to consider the clarity of amended claims and therefore which attacks and defenses might be most likely to succeed.

Patentees faced with the need to amend claims during opposition proceedings should try where possible

to source the amendment from the dependent claims. Preferably, the amendment would introduce a complete dependent claim, or one of a number of alternatives recited within a dependent claim. Amendments sourced from the description or by removing individual features from a prior combination of features in a dependent claim may well open the door to objections for lack of clarity under Article 84 EPC. Where amendments are made that do not affect a pre-existing, unclear term in a claim, however, clarity objections cannot be raised and should not be entertained.

Opponents cannot argue lack of clarity over a claim in its granted form, or over a claim amendment that consists of the combination of an entire dependent claim, or an alternative embodiment from a dependent claim, with an independent claim. If such a granted or amended claim has a pre-existing, unclear term in it, consideration should instead be given to attacking the claim on the basis of a lack of sufficiency[24] (the claimed invention is not disclosed in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art), lack of novelty,[25] or lack of inventive step.[26] However, when amendments made during opposition proceedings do introduce a clarity problem, opponents may then attack the amendments under Article 84 EPC.

[1] http://www.epo.org/law-practice/case-law-appeals/recent/g140003ex1.html.

[2] The European Patent Convention (http://www.epo.org/law-practice/legal-texts/epc.html).

[3] Opposition filing: Article 99(1) EPC

[4] Excluded/excepted: Article 100(a) EPC in combination with Article 52 or 53 EPC.

[5] Novelty: Article 100(a) EPC in combination with Articles 52(1) and 54 EPC.

[6] Inventive step: Article 100(a) EPC in combination with Articles 52(1) and 56 EPC.

[7] Industrial applicability: Article 100(a) EPC in combination with Articles 52(1) and 57 EPC.

[8] Added subject-matter: Article 100(c) EPC; cf. Article 123(2) EPC.

[9] Insufficiency: Article 100(b) EPC; cf. Article 83 EPC.

[10] Article 101(3) EPC in full: “If the Opposition Division is of the opinion that, taking into consideration the amendments made by the proprietor of the European patent during the opposition proceedings, the patent and the invention to which it relates (a) meet the requirements of this Convention, it shall decide to maintain the patent as amended, provided that the conditions laid down in the Implementing Regulations are fulfilled; (b) do not meet the requirements of this Convention, it shall revoke the patent.”

[11] T301/87, points 3.7 and 3.8 of the Reasons.

[12] T1855/07, points 2.2 and 2.3 of the Reasons.

[13] T459/09, point 4.1.6 of the Reasons.

[14] T459/09, point 4.1.3 of the Reasons.

[15] T409/10, point 3.1 of the Reasons.

[16] G3/14, point 85 of the Reasons.

[17] G3/14, point 54 of the Reasons.

[18] G3/14, point 55 of the Reasons.

[19] G3/14, points 56 and 62 of the Reasons.

[20] G3/14, point 80 of the Reasons.

[21] G3/14, point 82 of the Reasons.

[22] G3/14, point 83 of the Reasons.

[23] G3/14, point 84 of the Reasons.

[24] Article 100(b) or Article 83 EPC.

[25] Article 100(a) or Article 54 EPC.

[26] Article 100(a) or Article 56 EPC.

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At the Federal Circuit

Reviewing the Law of Anticipation of Ranges

by Amanda L. Lutz

Claims reciting numerical ranges face particular challenges when analyzed for patentability in view of the prior art. A claim reciting a range may sometimes be anticipated by a prior art reference that discloses an overlapping range or a point within the range. Or at other times, an overlapping range may not anticipate the claimed range at all. In *Ineos USA LLC v. Berry Plastics Corp.*, No. 2014-1540, slip op. (Fed. Cir. Apr. 16, 2015), the Federal Circuit provides a review of the prevailing analytical framework used when assessing whether a claimed range is anticipated by the prior art. This review is particularly helpful, considering the very brief treatment of the issue appearing in section 2131.03 of the Manual of Patent Examining Procedure (MPEP).

In the *Ineos* case, the Federal Circuit affirmed the district court's grant of summary judgment that U.S. Patent No. 5,948,846 ("Prior Art") anticipated Ineos's patent, U.S. Patent No. 6,846,863 ("the '863 patent"). The '863 patent, which claims polyethylene-based compositions, has only one independent claim:

> 1. Composition comprising at least [1] 94.5% by weight of a polyethylene with a standard density of more than 940 kg/m^3,
>
> [2] 0.05 to 0.5% by weight of at least one saturated fatty acid amide represented by $CH_3(CH_2)_nCONH_2$ in which n ranges from 6 to 28[,]
>
> [3] 0 to 0.15% by weight of a subsidiary lubricant selected from fatty acids, fatty acid esters, fatty acid salts, mono-unsaturated fatty acid amides, polyols containing at least 4 carbon atoms, mono- or poly-alcohol monoethers, glycerol esters, paraffins, polysiloxanes, fluoropolymers and mixtures thereof, and
>
> [4] 0 to 5% weight of one or more additives selected from antioxidants, antacids, UV stabilizers, colorants and antistatic agents.

Id. at 2-3 (alterations in original).

Neither Ineos nor Berry Plastics disputed that the Prior Art disclosed limitation [1]. Likewise, neither party disputed that the Prior Art's disclosure of stearamide falls within a "saturated fatty acid amide represented by $CH_3(CH_2)_nCONH_2$ in which n ranges from 6 to 28" of limitation [2]. The district court concluded that the Prior Art satisfied limitations [3] and [4], which claim ranges of subsidiary lubricant and additive beginning with 0%. *Id.* at 4.

Central to both the district court's and the Federal Circuit's analyses was the following passage from the Prior Art[1]:

> The composition according to the invention includes the lubricating agent in a total quantity *of at least* 0.1 part by weight per 100 parts by weight of polyolefin, in particular of

> at least 0.2 parts by weight, quantities of at least 0.4 parts by weight being the most common ones; *the total quantity of lubricating agents does not exceed* 5 parts by weight, more especially 2 parts by weight, *maximum values* of 1 part by weight per 100 parts by weight of polyolefin being recommended.

Id. at 6 (citing Prior Art col. 2 l. 66-col. 3 l. 7). The district court concluded that this passage anticipates limitation [2] because it discloses *specific values* (e.g., 0.1 part by weight) in addition to the full range (0.1 to 5 parts by weight). *Id.* at 3. The Federal Circuit, however, also found that this passage anticipates limitation [2], but as an *overlapping range*.

When the Prior Art Discloses Points Within a Range

> "[A] range is anticipated by a prior art reference if the reference discloses a point within the range." *Id.* at 6 (citing *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 782 (Fed. Cir. 1985)).

In assessing whether the Prior Art disclosed points falling within limitation [2]'s claimed range, the Federal Circuit considered a specific passage from the Prior Art: "the lubricating agent in a total quantity of *at least* 0.1 part by weight per 100 parts by weight of polyolefin . . . *the total quantity of lubricating agents does not exceed* 5 parts by weight." *Id.* According to the court, this passage discloses ranges, not specific values. *Id.* To make its determination, the court considered the Prior Art's use of the qualifiers "at least" and "does not exceed," finding that these phrases clearly establish corresponding minimum and maximum amounts of primary lubricant, i.e., a *range* of primary lubricant amounts. *Id.*

Next, the Federal Circuit assessed whether the endpoints of the Prior Art range could anticipate limitation [2]'s range. The court restated the principle that a prior art reference's disclosed range does not constitute specific disclosure of the endpoints of that range. *Id.* (quoting *Atofina v. Great Lakes Chem. Corp.*, 441 F.3d 991, 1000 (Fed. Cir. 2006)). Applying the *Atofina* principle, the Federal Circuit held that the district court erred in finding anticipation based on a point within a range in the Prior Art. *Id.* at 6-7. Instead, the Prior Art was held to disclose a range that overlaps the range recited in limitation [2].

When the Prior Art Discloses an Overlapping Range

> "If the prior art discloses its own range, . . . then the prior art is only anticipatory if it describes the claimed range with sufficient specificity such that a reasonable fact finder could conclude that there is no reasonable difference in how the invention operates over the ranges." *Id.* at 6 (citing *Atofina*, 441 F.3d at 999).

After determining that the Prior Art range overlapped the range recited in limitation [2], the Federal Circuit considered whether limitation [2]'s range is "critical" to the operability or functionality of the invention. *Id.* at 7. While ultimately concluding that Ineos did not raise a genuine issue of fact about the criticality of the range, the court restated prior case law dealing with establishing criticality. In its review, the Federal Circuit emphasized the importance of a relationship existing between evidence of criticality of the range on one hand, and the operability or functionality of the claimed invention on the other.

In *Atofina* and *OSRAM Sylvania v. American Induction Technologies, Inc.*, 701 F.3d 698 (Fed. Cir. 2012), the Federal Circuit found that the claimed range was critical to the operation of the invention. In *Atofina*, the Federal Circuit, reversing the district court, found that the patent and the prosecution history highlighted the criticality of the claimed range. *Ineos*, No. 2014-1540, slip op. at 7. The prior art's claimed range—100 °C to 500 °C—overlapped with Atofina's 330 °C to 450 °C range. Atofina successfully argued, however, that the synthesis reaction would not operate as claimed outside of the claimed temperature range. *Id.* An important aspect of the court's conclusion was that a person of ordinary skill in the art would have expected the synthesis reaction to operate differently, or not at all, outside of the claimed temperature range. In *OSRAM*, the Federal Circuit reversed the district court's grant of summary judgment of anticipation where the patentee raised a genuine dispute of material fact concerning the criticality of a claimed range. *Id.* at 8. To counter the allegation of anticipation by the prior

art range, the patentee presented expert testimony and other evidence to establish the criticality of the claimed range. The unrebutted expert testimony established that the recited range was critical to the operation of the claimed lamp. *Id.* at 8-9.

By contrast, in *ClearValue, Inc. v. Pearl River Polymers, Inc.*, 668 F.3d 1340 (Fed. Cir. 2012), the Federal Circuit held that the prior art range anticipated the overlapping claimed range. In this case, ClearValue did not argue that "the claimed range was critical to the invention or that the claimed method would work differently within the prior art range." *Ineos*, No. 2014-1540, slip op. at 8. *ClearValue* demonstrates the value of providing evidence that shows the "considerable difference between how the method would operate within the claimed range and within the range disclosed in the prior art" to defend against an anticipation challenge. *Id.*

In *Ineos*, the Federal Circuit also pointed out that certain types of evidence do not demonstrate the criticality of a recited range. Ineos presented unrebutted evidence that the limitation [2] range was critical to avoid unnecessary manufacturing costs and blemishes on the bottle caps. *Id.* at 9. However, for a claimed range to be critical and not anticipated by the prior art, the disclosed operability or functionality of the claimed invention must differ if the overlapping prior art range were used. According to the court, Ineos's evidence did not establish that the disclosed functionality or operability of the composition recited in the claims would be improved by using the claimed narrower range instead of the broader range disclosed in the Prior Art. *Id.* at 9-10. Further, the Federal Circuit found that no relationship had been shown between the disclosed properties of the claimed invention on the one hand, and the evidence of avoided manufacturing costs and avoided blemishes on the other.

The analytical framework in *Ineos* expands on the approach set forth in MPEP § 2131.03, which does not fully articulate how evidence of criticality of a range weighs on an anticipation analysis. Using *Ineos*'s framework as a roadmap, patent applicants might consider focusing on the criticality of a claimed range as a way to possibly overcome a potentially anticipatory genus range. In addition, applicants should consider whether to include evidence supporting the criticality of the claimed range during prosecution. Where appropriate, this approach may include discussing the importance of the range, and its relevance to the functionality and operability within the claimed invention when drafting an application and submitting expert declarations.

[1] As noted by the Federal Circuit, Ineos and Berry Plastics agreed for purposes of the appeal that the "% by weight" measurement used in the '863 patent is equivalent to the "parts by weight" measurement in the Prior Art. *Ineos*, No. 2014-1540, slip op. at 3 n.1.

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