Patent Prosecution Update

June 2016

Motivation to Combine and Teaching Away: Viable Tools, but with Limits

Though inter partes reexamination has faded from view in the post-AIA legal landscape, the proceedings continue to generate important precedent. In *Allied Erecting & Dismantling Co. v. Genesis Attachments, LLC*, No. 2015-1533 (Fed. Cir. June 15, 2016), the Federal Circuit affirmed a finding of obviousness in an inter partes reexamination. The Federal Circuit's analysis regarding the principles of "motivation to combine" and "teaching away" supplies valuable guidance for all types of patent validity challenges. Practitioners seeking to mount or thwart a validity argument based on these principles should appreciate that, while they remain viable tools to demonstrate patentability, they receive careful scrutiny. **More**

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Motivation to Combine and Teaching Away: Viable Tools, But With Limits

by Elliot C. Cook

Though inter partes reexamination has faded from view in the post-AIA[1] legal landscape, the proceedings continue to generate important precedent. In *Allied Erecting & Dismantling Co. v. Genesis Attachments, LLC*, No. 2015-1533 (Fed. Cir. June 15, 2016), the Federal Circuit affirmed a finding of obviousness in an inter partes reexamination. The Federal Circuit's analysis regarding the principles of "motivation to combine" and "teaching away" supplies valuable guidance for all types of patent validity challenges. Practitioners seeking to mount or thwart a validity argument based on these principles should appreciate that, while they remain viable tools to demonstrate patentability, they receive careful scrutiny.

The challenged patent, which was assigned to Allied Erecting and Dismantling Co., Inc., is directed to heavy machinery tools for construction and demolition that can be attached to a universal structure, which in turn can be attached to various tools such as a shear, concrete crusher, or grapple. The patent purports to address a need in the art for easily changing machine tools using common machine structures. Addressing this purported need, the patent describes "a multiple tool attachment system which is easily converted between a plurality of distinct tools." Slip op. at 2 (citation omitted).

On May 5, 2010, Genesis Attachments, LLC, filed a petition for inter partes reexamination, challenging the validity of the patent. Following claim amendments by Allied, the examiner allowed the claims over a prior art reference called "Ogawa." On appeal, the Patent Trial and Appeal Board (PTAB) reversed, finding that the challenged claims would have been obvious over a separate reference—"Caterpillar"—in view of Ogawa. Recognizing that its reversal constituted a new ground of rejection, the PTAB allowed Allied to reopen prosecution or request rehearing, and instructed the examiner to consider a third reference, "Clark." On remand, after Allied again amended the claims, the examiner found that the challenged claims would have been obvious over Caterpillar in view of Ogawa and Clark. The PTAB affirmed the examiner's rejections, and Allied appealed to the Federal Circuit.

Allied raised two primary arguments at the Federal Circuit. First, Allied challenged the motivation to combine Caterpillar with Ogawa as part of an obviousness analysis. According to Allied, the PTAB's analysis required combining Caterpillar such that the "jaw" described in the reference would become "movable," yet that change would alter the "principle of operation" of Caterpillar and render the described device "inoperable." *Id*. at 13 (citation omitted). Second, Allied argued that Caterpillar taught away from combining its teachings with Ogawa. In particular, Allied asserted that Caterpillar criticized an approach—such as that taught by Ogawa—where a main pivot pin for two "jaws" also mounted the jaws to the frame of the machine. *Id*. at 16.

Neither argument was sufficient to persuade the Federal Circuit that the PTAB erred in its obviousness analysis. Regarding the "motivation to combine" principle, the Federal Circuit noted that the embodiments disclosed in prior art references need not be "physically combinable" to support an obviousness rejection. *Id*. at 13 (quoting *In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983)). Instead, references can be combined in an obviousness analysis if a person having ordinary skill in the art would be motivated to combine the "teachings" of the references to arrive at the claimed solution. *Id*. at 14 (quoting *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1361 (Fed. Cir. 2007)). The Federal Circuit recognized that the combination of references required making the "immobilized jaw" of Caterpillar movable, yet concluded that such a modification would have been obvious, since it would have yielded "a wider range of motion as taught by Ogawa, to make the jaw set more efficient." *Id*. Indeed, the court explained, even if such a change would have "simultaneous advantages and disadvantages," that would not make the modification nonobvious. *Id*. (quoting *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006).

Regarding Allied's "teaching away" argument, the Federal Circuit further found that Caterpillar did not expressly teach away from Ogawa. As the court noted, "Caterpillar expresses doubt as to whether an *optimal* design feature may have the main pivot pin for both jaws also mount the jaws to the frame in order to effect the quick change functionality." *Id*. at 16. The court further explained that there was no teaching away between Caterpillar and Ogawa because the combination of references did not use the pivot pin attachment mechanism of Ogawa; instead, the combination used the feature of movable jaws taught in Ogawa, for which there was no teaching away in Caterpillar. Moreover, the court rejected Allied's argument that the PTAB's analysis regarding teaching away overlooked the need for "two separate cylinders," since the court found such details to be "extraneous" to the PTAB's rejections. *Id*.

Two caveats to the Federal Circuit's analysis in *Allied Erecting* are worth noting. First, as the Federal Circuit stated in the case, although the ultimate determination of obviousness receives de novo review on appeal, "underlying factual findings, including what a reference teaches and the differences between the prior art and the claimed invention," are reviewed for "substantial evidence." *Id*. at 11. Second, a finding of "motivation to combine" is also reviewed on appeal for "substantial evidence." *Id*. (quoting *In re Kahn*, 441 F.3d 977, 985 (Fed. Cir. 2006)) Thus, the Federal Circuit's affirmance of the obviousness rejections in *Allied Erecting* is not to say that the Federal Circuit necessarily would have reversed if the PTAB had found the claims patentable.

With these caveats in mind, *Allied Erecting* is instructive for practitioners seeking to build or destroy an obviousness position. The Federal Circuit's admonition that references may be combined even if their disclosed apparatuses are not "physically combinable" is important. Instead, the focus is on whether the "teachings" of the references are combinable. Similarly, the Federal Circuit's instruction that references do not "teach away" merely because a technique of one is described as less than "optimal" in the other is significant. Teaching away requires more—specifically, a finding that a reference would discourage a particular technique, or lead a person of ordinary skill in a "divergent" direction. *Id*. at 15 (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)). While *Allied Erecting* highlights the flaws in imperfect "motivation to combine" and "teaching away" arguments, practitioners should not be discouraged from advancing such arguments. Both principles for attacking an obviousness analysis remain available. In light of *Allied Erecting*, a "motivation to combine" challenge should remain potent, for example, where the teachings of one reference are disconnected from the teachings of another reference. And if one reference specifically counsels against a combination of the two sets of teachings—not merely "extraneous" teachings in the references—that should further erode the foundation of an obviousness position based on the references.

[1] The Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112-29, § 6(a), 125 Stat. 284, 299-304 (2011), replaced inter partes reexamination with other inter partes validity challenges, including inter partes review and post-grant review.

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The Federal Circuit Affirms: It's OK to Be Wired at a Coffee Shop

by Eric P. Raciti

When undertaking a patent infringement analysis, a patent owner's first task is to construe the claims. When technology continues its march forward, the evolving state of the art can present opportunities for wider adoption of earlier-patented inventions, but can also foreclose patent enforcement if the specification does not leave room for technological alternatives. Such was the case in the Federal Circuit decision in *Ruckus Wireless, Inc. v. Innovative Wireless Solutions, LLC*, Nos. 2015-1425, -1438 (Fed. Cir. May 31, 2016). This case provides a useful reminder to patent practitioners that when drafting specifications, providing a range of exemplary alternatives can be an important consideration.

The case involved Innovative Wireless Solution's U.S. Patent Nos. 5,912,895; 6,327,264; and 6,587,473 (collectively, "the Terry patents"), claiming a collision avoidance scheme for data communicated in a local area network (LAN) where there is a relatively large distance between master and slave modems. In their simplest form, the Terry patents claim managing data traffic over a "communications path" connecting two modems. Slip op. at 3-4.

The claimed "communications path" was held by the trial court to require wired communication, and thus found Ruckus's use of wireless communications to be noninfringing. On appeal, the Federal Circuit took this outcome-determinative issue of claim construction de novo, noting that the trial court had used exclusively intrinsic evidence from the file wrapper.

The Federal Circuit affirmed the Western District of Texas in a 2-1 decision, with a dissent filed by Judge Leonard P. Stark, Chief District Judge from the District of Delaware, who sat by designation.[1] Consistent with the trial court's findings, the Federal Circuit found that the Terry patents made no mention of wireless communication. In discussing the trial court's decision, the Federal Circuit stated:

> The district court found particularly persuasive a passage from the written description regarding the scope of alternative embodiments. That passage states that, "although as described here the line 12 is a telephone subscriber line, it can be appreciated that the same arrangement of master and slave modems operating in accordance with the new protocol can be used to communicate Ethernet frames via any twisted pair wiring which is too long to permit conventional 10BASE-T or similar LAN interconnections."

(citation omitted). The Federal Circuit found that the repeated discussions of wired communications exclusively, and the disclosure's solution to a problem belonging to long-distance communications over wires, was an important consideration. *Id*. at 7. The appeals court also explained that the patentee's

assumption that the term “communications path” had an ordinary meaning that encompassed both wired and wireless communications was not supported by the intrinsic or extrinsic record. *Id*. The majority further found that the intrinsic record “militate[d] powerfully” against patentee’s argument in several important ways, in addition to the absence of any discussion of wireless embodiments. *Id.* at 7-8.

First, the shared title of the Terry patents is “Information Network Access Apparatus and Methods for Communicating Information Packets Via Telephone Lines.” Second, the specification describes “[t]his invention” as one “particularly concerned” with “two-wire lines such as telephone subscriber lines.” *See* ’895 patent, col. 1 ll. 6–10. Third, every embodiment described in the specification utilizes a telephone wire, and every statement expressing the full breadth of the invention refers only to other wired connections. *Id*. at col. 9 ll. 45–51.

The insights of *Plas-Pak*—and the line of cases cited in the opinion—might be useful in attacking rejections where obviousness rejections violate a prior art reference’s “principle of operation” or “intended purpose.” Because these attributes are questions of fact, applicants should build a record that will support an advantageous position, which could include using declarations in appropriate circumstances.

The majority also analyzed the claims as a whole, but found no support for the patentee’s argument that “communications path” includes wireless communications. The dependent claims, to the extent that they characterized the “communications path,” referred to a “two-wire telephone subscriber line” (’895 patent, claims 13, 21, 23, 25) or a “two-wire line” (’473 patent, claims 6, 21, 27, 28). Each variation is a form of wired communication, and although the court acknowledged that the doctrine of claim differentiation can broaden a claim element’s meaning, it cannot extend it outside the boundaries of what would be understood by one of ordinary skill in the art. *Ruckus Wireless*, slip op. at 8-9.

The Federal Circuit concludes its analysis by pointing out that, in litigation, an ambiguous claim should be construed to preserve its validity. Here, to construe the claims to include wireless communications would implicate their validity as lacking written description. So, even if the extrinsic evidence were to show that one of skill in the art would understand the term “communications path” to include wireless communications, one could speculate that the claims might nevertheless fail the test for written description.

Patent prosecutors should try to accommodate alternatives to claim elements in the specification. While there are no crystal balls, emerging technical alternatives are sometimes possible to identify. As shown in this case, even when claims are broad, if the specification is not written to accommodate alternatives, it can limit the claims, especially where vague claim terms correspond to relatively narrow disclosure. Practitioners should avoid giving narrow examples without a more general description of the elements forming the exemplary embodiment. Also, beware of titles and how the word “invention” is used in the specification. Ordinary words may be limiting!

[1] The dissent argues that, procedurally, the litigants should have been given the opportunity to present extrinsic evidence showing whether or to what extent one of ordinary skill in the art would have understood the term “communications path” to have included wireless communications at the time the application was filed. Judge Stark admits there is no evidence of record, but disagreed with the disposition of the majority.

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IP5 Offices

Continuing Application Practice in the IP5 Offices

by Arpita Bhattacharyya, Ph.D.

Availability of continuing applications allows a patent owner to build a portfolio of patents covering multiple aspects of a product, platform, or process, so long as there is support for the claims in the priority patent application. All of the IP5 offices permit some form of continuing application practice, although the content, timing, and procedure for filing such continuing applications differ between the IP5 offices. This article will cover the similarities and differences in the continuing application practice in the IP5 offices.

United States

Under U.S. patent law, a continuing application can be a continuation, divisional, or continuation-in-part (CIP) application filed under the conditions specified in 35 U.S.C. §§ 120, 121, 365(c), or 386(c), and 37 C.F.R. § 1.78. No other IP5 office has a continuation or CIP practice; however, a divisional may essentially be used as a continuation application in some jurisdictions.

A continuing application (continuation, divisional, or CIP) must claim the benefit of the prior-filed application to be entitled to the benefit of the filing date of the prior application. A continuing application must also be filed before the prior application issues or is abandoned. Moreover, a continuing application must name the inventor or at least one joint inventor named in the prior application.

A continuation application allows a patent owner to pursue additional claims to subject matter disclosed in a prior application. No new disclosure can be added to a continuation application. A CIP application, on the other hand, may include new subject matter. Claims in the CIP application may be directed to subject matter disclosed in the prior application, to the newly disclosed subject matter, or both. The priority date of the CIP claims is determined on a claim-by-claim basis, i.e., claims directed to newly disclosed subject matter may only be entitled to the benefit of the filing date of the CIP (and not the filing date of the prior application).

A divisional application can only be filed as a result of a restriction or an election of species requirement (to be discussed in the next IP5 article) made by a U.S. Patent and Trademark Office (USPTO) examiner in the parent application. A divisional application cannot be filed voluntarily. The claims in the divisional application must be directed to an invention that is independent and distinct from that claimed in the prior application.

Japan

A continuing application under the Japan Patent Law is referred to as a divisional application. Any

number of divisional applications can be filed based on a parent patent application directed to inventions that are distinctly different from the invention claimed in the parent application. That is, a divisional application may be filed voluntarily, or in response to a determination by the Japan Patent Office (JPO) that the claims in the parent application lack Unity of Invention. If any claim of a divisional application is directed to an invention that is substantially identical to that claimed in the parent application, the claim may be rejected for double patenting under Article 39. A divisional application is entitled to have an effective filing date the same as that of its parent application.

A divisional application may be filed at any time before a first office action is issued; within the time period designated by the JPO examiner to respond to an office action (i.e., whenever an amendment can be filed); within thirty days from receipt of a Decision of Grant; or within four months from receipt of a Decision of Rejection. If the applicant wishes to appeal the Decision of Rejection, the Notice of Appeal must be filed at the same time as the divisional application. Once an appeal is filed, no divisional application can be filed after an allowance or decision of rejection.

A subsequent divisional may be filed based on an earlier divisional, but it is subject to additional limitations.

China

A divisional application may be filed to address a unity defect, or voluntarily to pursue a different set of claims supported by the disclosure of the parent patent application. A divisional application may be filed at any time while a parent application is pending, but no later than the expiration of two months from the date of receipt of the Notification to Grant Patent Right for the parent application. If, however, the parent application has been rejected, the divisional application has to be filed (1) within three months of receiving the decision rejecting the parent application; (2) after a request for reexamination of the parent application is filed; (3) within three months of receiving a reexamination decision rejecting the parent application; or (4) during an administrative litigation against a reexamination decision of rejection of the parent application. If the patent application itself is a divisional application, the deadline for filing a divisional application is no later than the expiration of two months from the date of receiving the Notification to Grant Patent Right for the initial parent application. If, however, the examiner issues a unity rejection in a divisional application during examination, the deadline for filing a divisional application is no later than the expiration of two months from the date of receiving the Notification to Grant Patent Right for the divisional application (instead of the initial parent application).

Korea

A divisional application can be filed to pursue additional claims to an invention, or to pursue different aspects of the invention. A divisional application can be filed (1) within the time period for responding to an Office action; (2) within the time period for filing a Request for Reexamination; and (3) within the time period for filing a Notice of Appeal after receiving a final rejection or another final rejection in the reexamination; or (4) within three months of receiving a Notice of Allowance or until the application is registered, whichever is earlier. The divisional application can include any claim that is supported by the specification and the drawings of the parent application.

EPO

A divisional application can be filed at any time from any pending European patent application. The two-year deadline on filing a divisional application, which was introduced in April 2010, was widely unpopular and was lifted effective April 1, 2014. Divisional applications can have claims directed to an invention not claimed in the prior application, or claims directed to the invention previously claimed. A properly filed

divisional is entitled to the filing and priority date of the parent application. The subject matter of the divisional cannot extend beyond the disclosure of the as-filed parent application. It is also possible to file a divisional application based on an earlier divisional.

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Design Patents

Could a "Real" Design Solve a "Virtual" Problem? Protecting Innovative Design Against Physical or Online Infringing Products

by Elizabeth D. Ferrill and Paul Townsend

Want to buy a Porsche 911 for only $159? Well, now you can. Or at least you can buy the virtual 3-D model of a Porsche 911 to 3-D print or to use in an online video game. How is this possible? Certain websites, such as turbosquid.com, 3dexport.com, 3docean.net, creativecrash.com, and many others sell virtual 3-D models in the form of digital files that a customer can download.[1] Searching the name of any company listed in the top ten design patent filers[2] into one of these sites turns up hundreds of results. Many of the files that appear seem to be exact virtual replicas of physical products, many of which are protected by design patents.[3]

The situation bears some resemblance to the peer-to-peer downloading that companies such as Napster used in the early 2000s. Copyright law was originally used to shut down those websites; however, to date, courts have not applied patent law to prevent virtual 3-D models from being shared or sold as Computer Aided Design (CAD) files online. The vast majority of design patents are directed to physical articles, not virtual ones. Does having a design patent that appears to be directed to a physical product provide any recourse to stop these virtual sales? As the sale and use of virtual 3-D articles becomes more prevalent, this will be an issue that courts will be asked to consider.

What Does the Law Say?

To date, the law has not squarely addressed this issue. But we have a few nuggets that we can glean from the current case law and guidance from the U.S. Patent and Trademark Office (USPTO) that may be helpful.

First, the design patent protects the design, not the article. The Patent Act states: "Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor…."[4] But this design does not need to be applied to a specific article of manufacture.[5] In *In re Zahn*, the Federal Circuit held that 35 U.S.C. § 171 permitted an applicant to obtain a patent for a "design," not an "article of manufacture." According to the court, "[35 U.S.C.] 171 refers, not to the design *of* an article, but to the design *for* an article, and is inclusive of ornamental designs of all kinds…."[6]

For virtual designs, the underlying article of manufacture has been to date the display device. After an appeal involving a computer icon, the USPTO adopted guidelines recognizing that "computer-generated icons may constitute articles of manufacture in that they are surface ornamentation on the computer

display.[7] This means, at present, the virtual design must be “grounded” by a display device to be patentable subject matter.

Second, in the past, the USPTO has not interpreted standard line drawings to be limited to a specific color or a specific material, so long as “the appearance of the material does not patentably depart from the visual appearance illustrated in the drawing.”[8] More than one court has agreed that these factors are not pertinent in the infringement analysis.[9] The Manual of Patent Examining Procedure (MPEP) guidelines show, and the courts have confirmed, that the comparison centers on the visual appearance of the claimed design and the accused article, not the article’s material. A survey of issued design patents for computer icons and interfaces shows that many include specific colors, while others are depicted in the more traditional black and white line drawings, and thus presumably not limited by color.

Third, although the case law is sparse, one case is worth noting. In *P.S. Products, Inc. v. Activision Blizzard, Inc.*, the plaintiff alleged that its U.S. Design Patent No. D561,294 (“the '284 patent”) for a brass-knuckle-style stun gun was infringed by a weapon found in a video game.[10] For reference, the ’294 patented design looks like this:

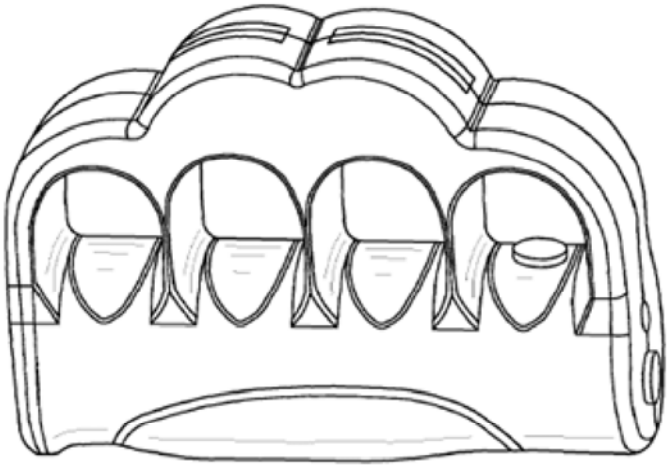

FIG. 6

Perspective View

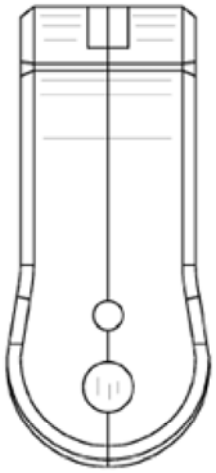

FIG. 4

Side View

The weapon, which is called the “Combat Suppression Knuckles” or “Galvaknuckles,” is used in the video game *Call of Duty: Black Ops II* and is also a brass-knuckle-style stun gun that looks like this[11]:

Although the concept of a stun gun in the form of brass knuckles was used by *Activision*, the actual stun gun depicted in the game looks very different than the claimed design of the '294 patent. In the end, the court found no infringement, but not by applying the traditional ordinary observer test, where the overall visual appearance of the claimed design is compared to the accused product in light of the prior art. Rather, the court determined that no ordinary observer would be deceived into purchasing a video game, believing it to be the plaintiffs' patented physical stun gun.[12] As a result, the court failed to reach the more important question of whether a design patent directed to a physical article could be infringed by a virtual 3-D depiction and failed to look at the design of the allegedly infringing article, the 3-D virtual weapon itself. While it is unlikely the court would have come to a different conclusion if it had compared the virtual article to the design patent, the court's approach could set a standard that may make enforcement of design patents directed to physical articles more difficult when the infringing article is a virtual article.

Protecting Innovative Designs in Both the Real and Virtual Worlds

The two design patents at issue in *Activision*, the '294 patent and D576,246, both claimed "the ornamental design for a stun gun, as shown and described." Both patents show the design of a brass knuckle stun gun, but there is no specific mention that the infringing article must be tangible. Up until now, it was generally assumed that the design in a design patent was intended for some physical article. Today, this has changed.

While the courts can deal with the question of applying existing design patents to virtual accused products, an important consideration moving forward is how to protect these types of designs, now that we know that infringement may occur in both the physical and virtual worlds.

Some commentators have suggested that the mere act of creating a design that is so detailed that the customer need only buy it and push the "print button" to infringe should be the basis for direct infringement—a new type of infringement called "direct digital infringement."[13] Until that day, the most straightforward case would be if the design patent is crafted to cover both the physical and virtual embodiments.

One possible strategy would be to draft two design patents—one which covers the physical representation and one which explicitly covers the virtual representation. This might be cost prohibitive to clients because it would require paying twice the government fees.

Another strategy would be to draft a single application, but use a title or language in the specification that tried to designate the application as covering both virtual and physical embodiments. The USPTO's requirement that the virtual design be "seated" in the display device would likely mean that the application would need at least two sets of figures. But, it is unclear how the USPTO would classify this application, and whether it would be sent to the art unit that examines the physical articles of that type, or the art unit that considers computer icons and interfaces.[14] It is also possible that the USPTO might issue a restriction requirement. Thus, this option is not without risk or expense.

In the end, if an exact copy of the stun gun was made into a CAD file online and sold, what is the difference between the physical product's design and the virtual product's design? Under *Zahn*, it would seem that the design patent covers the use of the design on any article, physical or not. The MPEP even says the appearance of the material doesn't matter, as long as the article looks like the design as shown in the design patent. Why can't the "material" be a display on a computer screen? Why does the "material" need to be something physical?

Design patents don't actually require the patent owner to build a physical product. The design itself is what is protected. It seems that an exact virtual replica of a design should infringe as a physical replica, especially when that virtual copy is being sold. If artists can get protection for their music being sold online, shouldn't design patent owners get protection for their designs being sold online?

[1] Once the user has the CAD file, he can use it for a variety of activities. Not only are the 3-D models shown on www.turbosquid.com, many times the webpage will show what the model would look like if printed from a 3-D printer.

[2] From 2014, the most recent list published by the USPTO.

[3] Intellectual Property Owners Association, *The IP Spotlight*, http://www.ipo.org/index.php/the-ip-spotlight/ (last visited June 10, 2016). Note that the Target and 3M brands have to be searched on turbosquid.com to find virtual 3-D products.

[4] 35 U.S.C. § 171(a).

[5] *In re Zahn* 617 F.2d 261, 268 (CCPA 1980) ("[w]e are of the opinion that the word 'therefor' in the phrase 'may obtain a patent therefor' refers back to 'design,' not to 'article of manufacture.'").

[6] *Id.* (emphases added).

[7] *Ex parte Strijland*, 26 USPQ2d 1259 (BPAI 1992) (holding that a computer-generated icon alone is merely surface ornamentation).

[8] MPEP § 1503.02 (II) Drawing [R-07.2015].

[9] *See, e.g.*, *Hutzler Mfg. Co., v. Bradshaw Int'l., Inc.*, No. 11 Civ. 7211(PGG), 2012 WL 3031150 (S.D.N.Y. July 25, 2012), at *12 ("Where—as here—the design patent is not limited to a particular size, color, or construction material, such factors should not be taken into consideration in performing an infringement analysis."); *Superior Merch. Co., v. M.G.I. Wholesale, Inc.*, Nos. Civ. A. 98-3174, Civ. A. 99-3492, 2000 WL 322779, at *11 (E.D. La. Mar. 27, 2000).

[10] Complaint at *2, P.S. Prods, Inc. v. Activision Blizzard, Inc.*, No. 4:13-cv-00342-KGB (E.D. Ark, 2013), ECF No. 1-2.

[11] Wikia, *Combatant Suppression Knuckles*, http://vignette3.wikia.nocookie.net/callofduty/images/c/cc/Combatant_Supression_Knuckles_BOII.png/revision/latest?cb=20121127093911 (last visited June 10, 2016).

[12] Opinion and Order at 11, *P.S. Prods* Case No. 4:13-cv-00342-KGB (E.D. Ark. Feb 21, 2014), ECF No. 39 ("No reasonable person would purchase plaintiffs' video game believing that they were purchasing defendants' stun gun.").

[13] Timothy R. Holbrook and Lucas S. Osborn, *Digital Patent Infringement in an Era of 3D Printing*, 48 U.C. Davis L. Rev. 1319, 1332 (2015).

[14] This practice might also complicate foreign filings. For example, in the European Union Intellectual Property Office, you must select one Locarno Class for the application. Class 14 covers screen displays and icons, but other classes cover other physical articles like musical instruments (Class 17), games and toys (Class 21), and furniture (Class 6). Therefore, if you had a hybrid U.S. application, it may be difficult to pick the correct Locarno class.

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Rule Review

Latest Guidance to USPTO Examiners Regarding § 101 After Enfish v. Microsoft Decision

by David R. Lefebvre

Following the Federal Circuit's decision in *Enfish, LLC v. Microsoft Corp.*, No. 2015-1244 (Fed. Cir. May 12, 2016), the U.S. Patent and Trademark Office (USPTO) issued another memorandum[1] on May 19, 2016, providing further guidance to examiners regarding 35 U.S.C. § 101 subject matter eligibility for patents.

In *Enfish*, the Federal Circuit held that software claims can be patent eligible when the claims are directed to improvements in computer-related technology. Slip op. at 11. In its opinion, the Federal Circuit also provided further guidance on the subject matter eligibility framework under § 101. *Id*. at 11-14. Because *Enfish* is only the second decision by the Federal Circuit that has held software-related claims patent eligible since the Supreme Court's decision in *Alice Corp. v. CLS Bank International*, 134 S. Ct. 2347 (2014), this decision will likely prove valuable to some software patent owners facing § 101 challenges and software patent applicants facing § 101 rejections.[2]

The USPTO, likely anticipating arguments relying on *Enfish*, issued the *Memo* to provide guidance to examiners based on the Federal Circuit's reasoning for its decision in *Enfish*. The Memo begins by setting out the subject matter eligibility framework established by the Supreme Court in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289 (2012), which was not modified by *Alice*. *Memo* at 1. Then, the *Memo* highlights for examiners several points made by the Federal Circuit in *Enfish* regarding whether a claim is directed to an abstract idea (i.e., Step 2A of the subject matter eligibility examination guidelines). *Id*. These points are as follows:

> (1) It is appropriate to compare claims at issue to claims already found to be directed to an abstract idea in a previous case when determining whether a claim is directed to an abstract idea;
>
> (2) The "directed to" inquiry of Step 2A applies a filter to claims, when interpreted in view of the specification, based on whether their character as a whole is directed to excluded subject matter;
>
> (3) When determining the focus of the claimed invention, caution should be taken against describing a claim at such a high level of abstraction untethered from the language of the claims; and

(4) An invention's ability to run on a general purpose computer does not automatically make it patent ineligible. *Id*.

The *Memo* makes clear that the earlier subject matter eligibility examination instructions set out in the 2014 Interim Eligibility Guidance, July 2015 Update, and May 4, 2016, memorandum to examiners are consistent with these points, and thus still applicable. *Id*.

The *Memo* explains that the Federal Circuit in *Enfish* reiterated that claims directed to improvements in computer-related technology, including claims directed to software, are not necessarily abstract. *Id*. at 1-2. Some examples the court gives of improvements in computer-related technology that are undoubtedly not abstract, when appropriately claimed, include, for example, chip architecture or an LED display. *Id*. at 1. The *Memo* also emphasizes the Federal Circuit's holding that software, like hardware, is not inherently abstract, and software, like hardware, can make nonabstract improvements to computer technology. *Id*.

The *Memo* clarifies that an examiner may determine that a claim directed to improvements in computer-related technology is not directed to an abstract idea under Step 2A. *Id*. at 2. And as a result, the examiner may find that the claims are patent eligible without needing to analyze the additional elements under Step 2B. *Id*.. The *Memo* points out to examiners that a claim directed to an improvement to computer-related technology (e.g., computer functionality) is likely not similar to claims that have been previously identified as abstract by the courts. *Id*.

The *Memo* also briefly summarizes the facts of *Enfish* and the Federal Circuit's analysis. In particular, it explains to the examiners the court's position that the improvement does not have to be defined by reference to "physical" components, but rather may be defined by logical structures and process, as is the case in *Enfish*. *Id*.

The more recent case *TLI Communications LLC v. A.V. Automotive, L.L.C.*, No. 15-1372 (Fed. Cir. May 17, 2016), in which the Federal Circuit held that the claims directed to recording, administration, and archiving of digital images were directed to the abstract idea of classifying and storing digital images in an organized manner, is also discussed in the *Memo*. *Memo* at 2. In particular, the *Memo* notes that the Federal Circuit found under the Step 2B analysis that the use of a telephone unit and a server did not add significantly more to the abstract idea. *Id*.

The *Memo* concludes by reminding examiners that they should continue to determine if the claims recite a concept similar to concepts previously found abstract by the courts. *Id*.

In light of *Enfish* and this latest guidance to examiners, it may prove fruitful when preparing software and computer-related applications to consider including disclosure explaining how the technology being claimed is an improvement over existing technology, as well as illustrative examples. And for applications currently being prosecuted, it may be beneficial to articulate to the examiner the claimed improvement to the technology, to the extent there is support in the application. Of course, characterizations of the application over the prior art are to be done with caution to avoid potential disclaimer issues down the road.

[1] Memorandum from Robert W. Bahr to Patent Examining Corps, *Recent Subject Matter Eligibility Decisions* (May 19, 2016) [hereinafter *Memo*], http://www.uspto.gov/sites/default/files/documents/ieg-may-2016_enfish_memo.pdf.

[2] The first Federal Circuit decision after *Alice* was *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1259 (Fed. Cir. 2014).

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EPO Practice

Early Certainty from EPO Oppositions

by Daryl Penny

Overview

Following grant of a European patent, third parties wishing to challenge the grant may file an opposition at the European Patent Office (EPO) within a nine-month window. EPO opposition proceedings are a powerful tool, being highly cost-effective, with no institution hurdle to overcome, and still the only mechanism available for achieving revocation of a European patent in its entirety, for all countries, in a single action. However, current timescales to reach a decision compare unfavorably with those in other fora, such as inter partes reviews (IPRs) and post-grant reviews (PGRs) before the U.S. Patent and Trademark Office's (USPTO) Patent Trial and Appeal Board (PTAB) and revocation proceedings in the soon-to-open Unified Patent Court (UPC) in Europe: procedural delays in processing oppositions mean typical time frames of two years or longer before first-instance decisions are reached. However, under the EPO's "Early Certainty" streamlining drive, details of which have recently been announced, standard opposition cases filed from July 1, 2016 should now be decided at first instance within fifteen months from the end of the nine-month opposition-filing window. The modified opposition procedure should prove beneficial to third parties by helping to provide legal certainty in a more timely manner, but will place additional pressure on patent proprietors who may need to prepare their defenses more quickly.

Background

While a European patent granted by the EPO is a bundle of national patents that need to be maintained and managed separately,[1] within a nine-month window following grant[2], it may be attacked as a whole—for all of the states it covers, no matter where validated—in a single action by means of opposition proceedings centrally at the EPO. An opposition may be filed on grounds related to exclusions/exceptions from patentability,[3] novelty,[4] inventive step,[5] industrial applicability,[6] added subject matter[7], and/or insufficiency.[8] On average, of the 5% of European patents opposed, around 30% are revoked (cancelled, as if they never existed); around 40% are maintained in amended form (typically with the independent claims being limited to overcome prior art or other objections); and around 30% are maintained as granted (i.e., the opposition is rejected).[9] That equates to around 70% of European patents that are opposed being at least wounded, if not killed off completely.

An EPO opposition offers a number of advantages and can be a powerful weapon for a third party wishing to challenge the grant of a European patent:

- it is the only forum in which the whole patent may be attacked and revoked;
- its success rate in wounding or killing patents is high;

- it is a relatively inexpensive procedure;[10]
- there is no limit on the number of pages or arguments that may be submitted, so an opponent can try out different arguments and attacks, which may help with envisaged IPR/PGR proceedings;
- the written submissions and official communications/decisions all appear on the EPO's public file, so an opposition can be a useful way to obtain public statements on the meaning and scope of a European patent and/or the prior art;
- it can force disclosure of documents to the USPTO on corresponding U.S. cases; and
- there is effectively no institution standard or hurdle to overcome—provided that at least one reasoned ground of opposition has been presented, an opposition will be deemed admissible, no matter how strong or weak the arguments presented may be.

While these positive attributes of the EPO's opposition procedure are significant and appealing, one aspect that is viewed less favorably is the length of time typically elapsing between opposition filings and oral proceedings, i.e., how long it is generally taking for the EPO to decide on oppositions. According to the EPO's 2015 annual report, the average duration of the opposition procedure was 26.1 months, up from 25.5 months in 2014.[11] In contrast, once instituted, IPRs and PGRs at the PTAB must be completed within twelve months (with a six-month extension possible for good cause);[12] and at the soon-to-open Unified Patent Court (UPC), revocation actions are expected to follow a timeline from the filing of a revocation claim to the handing down of the written decision of less than fourteen months.[13] First-instance EPO opposition decisions are therefore taking a year or so longer than before these panels, which is clearly undesirable for parties wishing to know the legal standing of a European patent.

One reason behind the slow handling of oppositions is down to staffing pressures at the EPO, but it is also contributed to by patent proprietors and opponents legitimately requesting extensions of time when responding to notices of opposition or subsequent replies during the written procedure. Typically, an extension of time of two months will be granted automatically at present. Further extensions of time must be justified, but it is not uncommon for further extensions of two or more months to be allowed where an opposition case is complex or involves multiple opponents.

New Procedure

The EPO announced an "Early Certainty" streamlining drive two years ago, aimed at speeding up the search phase for European patent applications, to help clear the backlog of cases at the EPO. This drive has been successful and the backlog is expected to have been cleared shortly, so the EPO has now announced an expansion of the streamlining drive to other areas of the patenting process, including oppositions.[14]

The newly announced aim is that "standard" or "straightforward" opposition cases filed from July 1, 2016, should be decided at first instance within fifteen months from the end of the nine-month opposition-filing window. Against current timescales, this should have the effect of reducing the time taken for a decision to be reached in an opposition by around a year on average.

It should be noted that the new, streamlined procedure will only apply to oppositions that are considered to be "standard" or "straightforward". However, it is not yet clear how the EPO will decide whether an opposition is standard or nonstandard. Some factors that it is understood will be determinative, though, include the number of opponents and the type of evidence being relied upon in the opposition: cases with more than one opponent are expected to be considered to be nonstandard and therefore not subject to the new, streamlined procedure, as are cases where evidence of public prior use is submitted in attacking the patentability of the claims. It can be appreciated that the level of work involved for the EPO in

considering—as well as for the patent proprietor in defending—a multi-opponent opposition and/or an allegation of public prior use (especially if witnesses are to be involved) is typically higher, so the streamlined procedure would likely be inappropriate in such cases. Since the majority of oppositions are by a single opponent and arguments over public prior use are rare, it would appear that most cases[15] will be processed under the streamlined procedure.

The EPO has indicated that it will shorten the duration of oppositions by streamlining practices and procedures with regard to both its own internal handling and processing of oppositions and the procedural interactions with the parties involved.

Under the current practice of the EPO, after the nine-month window for filing an opposition has closed, the EPO invites the proprietor to respond to the opposition within a four-month term, but this term may be freely extended by two months, and in some cases even further. Under the new procedure, extensions to the initial four-month term for the proprietor's reply will be allowed by the opposition division in exceptional cases only. For proprietors in some technology areas, this will have a significant impact on the handling of oppositions in future as it will shorten the typical time available for preparing responses by up to a half, or even more.

No specific guidance has yet been issued as to what circumstances might be considered to be exceptional and therefore warranting a two-month extension. Looking at the EPO's Guidelines for Examination, however, there is a useful discussion of the circumstances under which exceptional requests for extensions of time during the examination phase of a European patent application may be allowed: "when the reasons given are sufficient to show convincingly that a reply in the period previously laid down will not be possible. Such exceptional circumstances might be e.g. the fact that a representative or client is so seriously ill that he cannot deal with the case in time; or the need to perform extensive biological experiments or tests. On the other hand, foreseeable or avoidable circumstances (e.g. leave, pressure of other work) should not be accepted as a sufficiently exceptional circumstance."[16] It would be reasonable to expect that a similar approach will apply to the exceptional allowance of requests for extensions under the new streamlined procedure for oppositions. As such, with the likelihood of obtaining extensions of time being very low, proprietors should from now on plan to have opposition replies prepared and ready to file within the initial four-month term set by the EPO. The reply should be a full response to the opposition, i.e., all of the facts, evidence, and arguments in support of the case, and any amendments to the patent, should be submitted within this time limit.

Once the proprietor has filed a reply to the opposition, a copy of the reply is immediately sent to the opponent. This will be for the opponent's information only and will not include an invitation to the opponent to submit any comments on the reply. If, however, the opponent does file comments on his/her own initiative, they will be incorporated into the proceedings and considered by the opposition division.

It is at this stage that the principal streamlining of the EPO's internal procedures will take place. Whereas, in the past, opposition divisions have been known to sit on oppositions for between six months and two years before considering them and issuing summonses to oral proceedings, under the new procedure, a summons should be issued within three months. This represents a significant shortening of the EPO's evaluation process and will lead to oral proceedings—and therefore decisions—being reached much faster than at present.

The summons specifies the date on which the oral proceedings are to take place and, as a rule under the new procedure, it will be at least six months after dispatch of the summons. The summons also fixes a

final date for the parties to file written submissions and any amendments, and this will normally be set at two months before the oral proceedings.

As is currently the case, the summons will continue to include a communication setting out the issues that the opposition division wishes to discuss at the oral proceedings and the opposition division's provisional and nonbinding opinion on the arguments put forward by the parties and any amendments submitted by the proprietor. Thus, providing at least six months' notice of the oral proceedings date should ensure that there is sufficient time for the parties to react to the summons and prepare further arguments and/or amendments ahead of the oral proceedings.

On the day of the oral proceedings, the decision of the opposition division is announced at the end, after the parties have presented their arguments and the proprietor has submitted any further amendments to the patent. With the new streamlined procedure announced by the EPO, this process—from the end of the opposition-filing window through to the day of the oral proceedings—is expected to last only fifteen months.

Of course, the decision announced at the oral proceedings is a first-instance decision and this is subject to appeal to the EPO's Boards of Appeal. It should be noted that the Boards of Appeal are independent and not bound by the new streamlining initiative, so some critics might argue that this could simply lead to cases reaching the appeal stage sooner and merely increasing the already sizeable backlog at the Boards of Appeal. It is not uncommon for an appeal at the EPO to take three or more years to reach a final decision. However, not all cases are appealed and the new streamlining initiative will be of significant benefit in providing legal certainty for the proprietor, the opponent, and the public in general on all those cases for which the first-instance decision is the final decision.

Summary

The EPO's new streamlining initiative will be effective for oppositions filed from July 1, 2016, onwards. The EPO's aim is to process oppositions, from the end of the nine-month opposition-filing window through to oral proceedings where the decision is made, within fifteen months. This streamlined procedure will apply to all straightforward/standard oppositions, but not where there are multiple opponents or public prior use evidence is at issue.

In order to ensure that oppositions can be processed according to this shortened time frame, opponents should ensure that they present their full case promptly from the outset, and proprietors should ensure that their reply to an opposition is a full and complete response, including amendments to the patent where appropriate. The opportunity to file a final set of submissions (arguments and/or amendments, including auxiliary requests) will still be available to the parties in the lead-up to oral proceedings.

The modified opposition procedure should prove beneficial by helping to provide legal certainty in a more timely manner, and is therefore generally considered a welcome development from the EPO.

[1] This is the case at present, but, within the next year, it is expected that the new Unitary Patent system will come into effect. When in force, at grant of a European patent, validation as a unitary patent will be an option as an alternative to the current system of validating in individual countries (but only for the European Union (EU) member states that have signed up to, and completed ratification of, the new system at that time). The unitary patent will be a single patent covering at least thirteen EU member states, with a single annual renewal fee payable to maintain it in force. Over time, the number of states covered by the unitary patent will rise towards the twenty-six EU member states that have signed up to

the system, as individual country ratifications are completed.

[2] Opposition filing: Article 99(1) EPC.

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

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

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

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

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

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

[9] https://www.epo.org/about-us/annual-reports-statistics/annual-report/2015/statistics/searches.html#tab4.

[10] The official opposition fee is EUR 785 (around $900).

[11] This is the median value, calculated from expiry of the opposition filing period to the date of the opposition decision. https://www.epo.org/about-us/annual-reports-statistics/annual-report/2015/statistics/quality-indicators.html.

[12] http://www.uspto.gov/patents-application-process/appealing-patent-decisions/trials/inter-partes-review and http://www.uspto.gov/patents-application-process/appealing-patent-decisions/trials/post-grant-review.

[13] Rules 49, 51, 56, 101, 108, and 118 of the UPC Rules of Procedure.

[14] http://www.epo.org/law-practice/legal-texts/official-journal/2016/05/a42.html and http://www.epo.org/law-practice/legal-texts/official-journal/2016/05/a43.html.

[15] The EPO has indicated that this will occur in 90% of cases.

[16] http://www.epo.org/law-practice/legal-texts/html/guidelines/e/e_vii_1_6.htm.

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At the Federal Circuit

Applying the Doctrine of Equivalents: Both Intrinsic and Extrinsic Evidence Can Be Relied Upon in Determining the Function of a Claimed Element

by Wen Li, Ph.D.

The Federal Circuit in *Intendis GmbH v. Glenmark Pharmaceuticals Inc., USA*, No. 2015-1902 (Fed. Cir. May 16, 2016) affirmed the district court's final judgment that Glenmark's Abbreviated New Drug Application (ANDA) infringed claims 1-12 of U.S. Patent No. 6,534,070 ("the '070 patent") under the doctrine of equivalents (DOE) and that the '070 patent is not invalid.

The '070 patent, which is Orange Book listed, covers Finacea® Gel, a drug approved by the U.S. Food and Drug Administration for topical treatment of inflammatory papules and pustules of mild to moderate rosacea. Finacea® Gel is a hydrogel formulation containing 15% azelaic acid by weight and excipients including triglycerides and lecithin. Claim 1, the sole independent claim of the '070 patent, reads:

> 1. A composition that comprises:
> (i) azelaic acid as a therapeutically active ingredient in a concentration of 5 to 20% by weight,
> (iii) at least one triacylglyceride in a concentration of 0.5 to 5% by weight,
> (iv) propylene glycol, and
> (v) at least one polysorbate, in an aqueous phase that further comprises water and salts, and the composition further comprises
> (ii) at least one polyacrylic acid, and
> (vi) lecithin,
> wherein the composition is in the form of a hydrogel.

The generic version of Finacea® Gel sought by Glenmark substituted isopropyl myristate for the combination of lecithin and triglyceride. Despite Glenmark's contention of noninfringement and invalidity of the '070 patent, the district court found that the '070 patent was not invalid for obviousness and was infringed under the DOE. *Intendis GmbH v. Glenmark Pharm. Ltd.*, 117 F. Supp. 3d 549 (D. Del. 2015).

Specifically, the district court found DOE infringement under the function-way-result test. Based on expert testimony and Glenmark's own ANDA submission, the district court found that isopropyl myristate in Glenmark's proposed generic version performs substantially *the same function* as the claimed combination of lecithin and triglyceride: enhancing azelaic acid's penetration of the skin. *See Intendis GmbH v. Glenmark Pharm., Inc.*, No. 2015-1902, 2016 U.S. App. LEXIS 8907, at *4-6 (Fed. Cir. May 16, 2016). The district court also found that isopropyl myristate performed in substantially *the same way* as

the claimed combination of lecithin and triglyceride, namely, "by disrupting the lipids in the skin's outermost layer, known as the stratum corneum." *Id* at *8. Further, the district court found that isopropyl myristate obtained substantially *the same result* as the claimed combination of lecithin and triglyceride, i.e., "a therapeutically effective azelaic acid composition that is able to penetrate the skin in order to deliver the active ingredient." *Id.* at *9. In doing so, the district court further rejected Glenmark's arguments that infringement under the DOE (1) would encompass the prior art and (2) was barred by prosecution history estoppel. *Id*. at *4-6, *19-20.

On appeal, Glenmark first argued that the district court erred in its application of the function prong of the function-way-result test under the DOE. *Id*. at *7. In particular, Glenmark argued that there is no affirmative evidence proving that the claimed combination of lecithin and triglyceride functions as a penetration enhancer in the claimed composition. In support of its argument, Glenmark contended that the '070 patent itself is silent with respect to the claimed combination of lecithin and triglyceride as a skin penetration enhancer and that Finacea® Gel's FDA filings and other reports identified the claimed lecithin and triglyceride as an emulsifier and an emollient, respectively. *Id*. at *9-10. But the Federal Circuit saw no clear error in the district court's finding of DOE infringement. *Id*. at *10. Specifically, the Federal Circuit disagreed that the lack of disclosure of the claimed combination of lecithin and triglyceride as penetration enhancers in the '070 patent is fatal to the infringement case. Instead of emphasizing the intrinsic record as the only source for the finding of a claimed element's function, the Federal Circuit stated that "[t]he relevant inquiry is what the claim element's function in the claimed composition is to one of skill in the art, *and a fact finder may rely on extrinsic evidence in making this factual determination*." *Id*. at *11 (citing *Zenith Labs., Inc. v. Bristol-Myers Squibb Co.*, 19 F.3d 1418, 1425 (Fed. Cir. 1994). Furthermore, the Federal Circuit indicated that Glenmark repeatedly referring to the claimed combination of lecithin and triglyceride as a penetration enhancer in its own ANDA submissions was fatal to Glenmark's arguments. The Federal Circuit was not persuaded by Glenmark's assertion during oral argument that its ANDA statements about the claimed combination of lecithin and triglyceride as a penetration enhancer were "a guess" and "wrong." *Id*. at *12-13 (citation omitted).

Glenmark also challenged the district court's determination that the scope of equivalency does not ensnare prior art. *Id*. at *13-15. Under the two-step analysis required by an ensnarement determination, the first step is "to construct a hypothetical claim that literally covers the accused device." Next, prior art introduced by the accused infringer is assessed to "determine whether the patentee has carried its burden of persuading the court that the hypothetical claim is patentable over the prior art." In short, [courts] ask if a hypothetical claim can be crafted, which contains both the literal claim scope and the accused device, without ensnaring the prior art." *Id.* at *14. The district court concluded that the hypothetical claim was not anticipated by or rendered obvious over the cited art. The conclusion was based on expert testimony that (1) one of ordinary skill in the art would not have been motivated to substitute isopropyl myristate or triglyceride and lecithin for DMSO; and (2) the substitution would not have had reasonable expectation of success. *Id.* at *15. Glenmark argued that the hypothetical claim adopted by the district court was "inexplicably narrower" than Intendis's range of equivalents. *Id.* at *15 According to Glenmark, the hypothetical claim should recite any penetration enhancer (thus ensnaring the art disclosing DMSO). *Id*.

The Federal Circuit disagreed with Glenmark. *Id*. Rather, the Federal Circuit agreed with the district court's rejection of Glenmark's proposed hypothetical claim as too broad, stating that "[t]he district court's infringement finding was that the excipient in Glenmark's product (isopropyl myristate) was equivalent to the claimed excipients (lecithin and triglycerides); it was not a finding that any penetration enhancer would be equivalent to the claimed excipients." (citing *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*,

339 U.S. 605, 609 (1950) *Id*. at *16). Since Glenmark did not challenge the conclusion that the hypothetical claim would be patentable, the Federal Circuit found no error in the district court's factual findings concerning the DOE infringement. *Id* at *16-17.

The Federal Circuit further rejected Glenmark's argument on appeal that the doctrine of prosecution history estoppel barred the application of the DOE to the claims of the '070 patent. Specifically, Glenmark argued that a lethicin-free composition was surrendered during prosecution of the '070 patent. *Id*. at *18.

During prosecution of the '070 patent, the examiner objected to two dependent claims for reciting a lecithin "concentration of up to 1%" and "concentration of up to 3%," respectively, because they could include zero lethicin. *Id*. at *18. Applicants responded to indicate that those two dependent claims would not include a lethicin concentration as zero because their base claims clearly required lecithin. *Id.* Applicants regardless amended the two claims to recite a lecithin "concentration of from more than 0 to 1%" and "concentration of from more than 0 to 3%," respectively, noting that they were amended to "expressly state what has already been made clear on the record." *Id.* at *18-19.

The district court rejected Glenmark's argument for the surrender of lethicin-free composition. According to the district court, the amendments were made for clarification purposes and did not amount to the level of disavowing or disclaiming a composition without lecithin. *Id*. at *19-20. The Federal Circuit saw no error in the district court's analysis and affirmed that the doctrine of prosecution history estoppel did not apply when claims were amended for clarification but not narrowed to obtain a patent. *Id*.

The *Intendis* case is a primer on the correct application of the DOE in patent cases, which is not always an easy task. The opinion covers common pitfalls such as determining "same" function, scope, and ensnarement of prior art, and prosecution history estoppel. The DOE may be enjoying a very modest resurgence, and opinions such as *Intendis* further clarify how infringement claims relying on this theory may succeed.

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