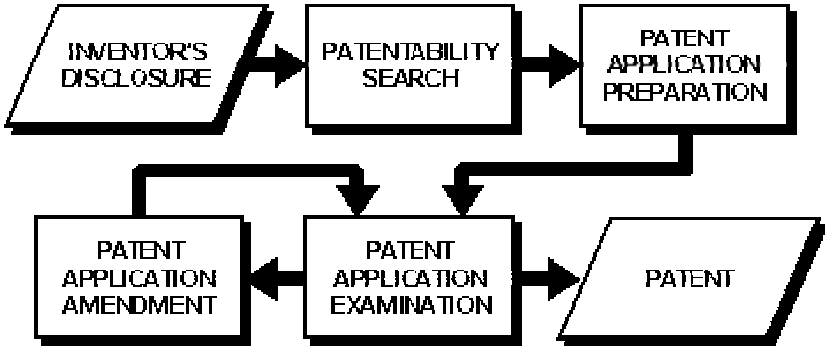
Patent Law

- Slides for Module 9
- Prosecution and Post-Grant Procedures

Patent Prosecution Basics

- Provisional, §111(b), no claims, no examination, 12 months to claim priority, no loss of term
- §132 – one additional look by the PTO as a matter of right
  - Note – the word "reexam" in §132 does not mean the same thing as a post-grant reexamination
- During this "additional look" – patent attorney may amend, or argue against the examiner ("traverse")



Patent Prosecution Basics – "continuing"

- Types
  - Continuing §120
    - Claims same invention with some variation in scope of claims
    - Requires "continuity of disclosure" w/ parent
      - §112¶1 support in parent (and any earlier generations on which to base priority) for all claims in Continuing application
  - Divisional - §121
    - Results when earlier application disclosed and claimed more than one independent invention
  - Continuation-in-part (CIP)
    - Like a continuing application, but with new matter, claims depending on the new matter cannot use parent priority date

Patent Prosecution Basics - Continuing

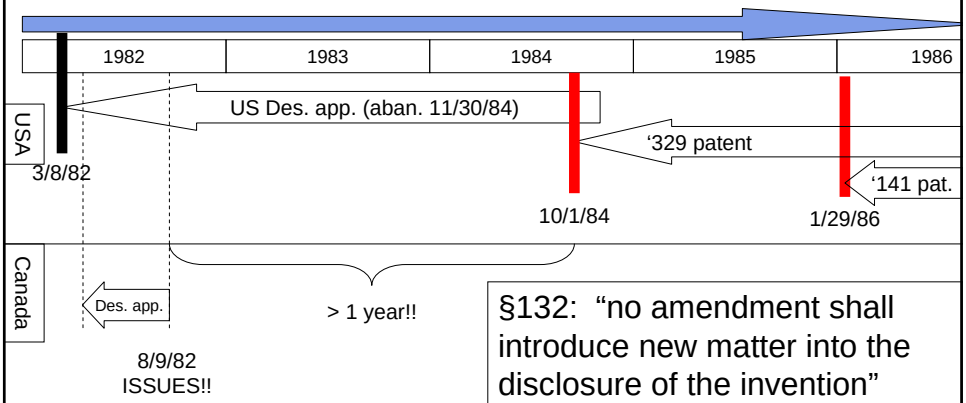
- §120 - priority
  - An application for patent for an invention ***[1]*** disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an ***[2]*** inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, ***[3]*** if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and ***[4]*** if it contains or is amended to contain a specific reference to the earlier filed application.
- Four requirements for priority
  1. Continuity of disclosure (see previous slide)
  2. Continuity of prosecution – co-pending for at least one day with earlier application
  3. Common Inventor
  4. Reference to earlier "parent" application

Patent Prosecution Basics - Continuing

- §121 – divisional applications
  - If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application.
- Refers back to the four requirements of §120 as a test to determine whether priority is proper

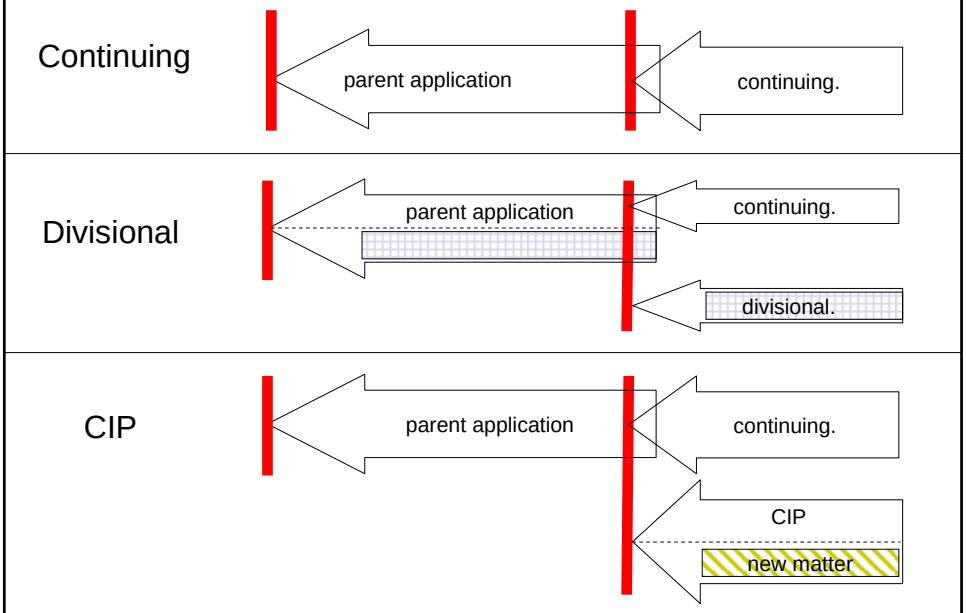
Vas-Cath v. Mahurkar (Fed. Cir. 1991) (Rich, J.)

- Ultimate effective f/d for Mahurkar's two utility patents on the catheter is based on priority [red bars] from a design patent application
  - Design patent applications consist almost exclusively of the drawings



§132: "no amendment shall introduce new matter into the disclosure of the invention"

Patent Prosecution Basics – Continuing - illustrations



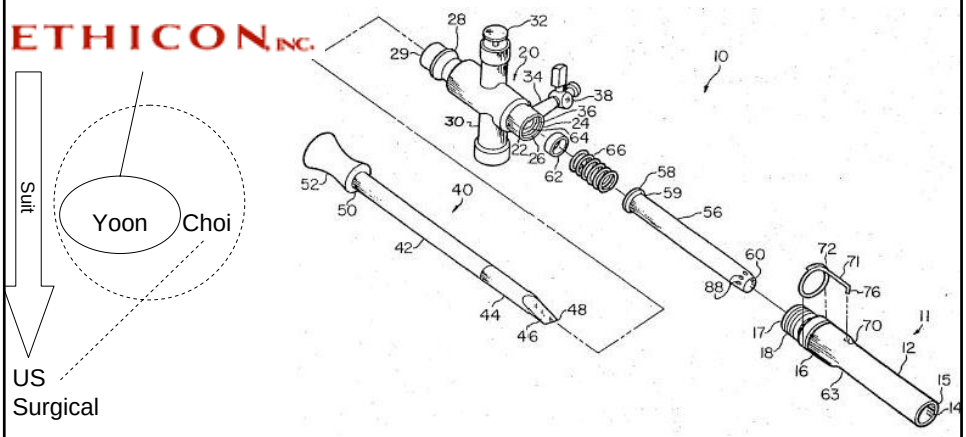
Patent Prosecution – other mechanics

- Appeal and Petition Practice
  - Petition is to the PTO Commissioner [procedural and formal requirements]
  - Appeal is the Board [merits of the invention]
  - Board is merely "highest level" in the Examining Corps, subject to Commissioner's "overall ultimate authority and responsibility"
- Publication of pending applications
  - AIPA (1999) – aligning US practice with global norms of publishing patent applications, 18 months after filing
    - Unless, applicant represents that she will not file in any foreign jurisdictions w/ publication requirement
  - Redaction possibility if broader claims filed in US
  - Provisional rights equivalent to a reasonable royalty if conditions met – (i) only effective upon issuance, (ii) apply only when infringer had actual notice of application, and (iii) the issued claims must be substantially identical to those published
    - After issuance date, full range of remedies are available

Patent Prosecution – other mechanics

- Patent Term
  - Current applications – 20 years from effective filing date
  - Applications pending before 6/8/1995
    - Special rules to preserve guaranteed 17 years from issuance term
  - New term regime diminishes the power and potential of "submarine" patents
  - Various conditions on term, ways to extend it
    - Pay fees
    - FDA approvals
    - Interferences, secrecy order, successful appeal to Board or court
    - Automatic extensions for delays (give and take process)

Inventorship – Ethicon v. US Surgical (Fed. Cir. 1998) (Rader)



- Better trocar to keep the blade from lunging into the cavity and damaging organs
- Yoon, M.D., has Choi work with him (unpaid) on trocar project
- After 18 months, Choi left in 1982, believing Yoon found his work unsatisfactory & unlikely to produce product
- In 1982, Yoon filed application, as sole inventor, 55 claims, that issued as '773 patent in 1985
- Yoon then granted exclusive license to Ethicon

Ethicon

- Issues on appeal
  - Is Choi's co-inventor testimony sufficiently corroborated?
  - Did Choi present sufficient evidence to show co-invention of claims 33 & 47?
  - Do the terms of the license limit it to only that part of the invention to which Choi contributed?
- Conception (see next slide)
  - Idea is "definite and permanent" when
    - "only ordinary skill would be necessary to reduce the invention to practice, without extensive research or experimentation"

Conception

- Five-element test that must be met for the ultimately claimed invention – mapped to the two-element test used by the court in Oka
  - Formation
  - in the Inventor's Mind
  - of a Definite and Permanent Idea
    - In sufficient detail
  - of the Complete and Operative Invention
  - as it is thereafter applied in Practice

"the directing conception"

means for carrying out

Ethicon

ETHICON INC.

- Joint inventorship
  - No requirement for the same type or amount of contribution
    - Merely need to perform part of the task which produces the invention
      - But, merely communicating prior art or stating principles will not qualify
    - Need “firm and definite” idea
    - One who merely reduced to practice not necessarily a joint inventor (even if it is to reduce the best mode)
    - Contribution to one claim is enough
- Courts correcting inventorship under §256
  - CCE standard, which testimony alone can’t meet
  - Rule of reason analysis for corroboration

Corroboration

- Inventor may make use of C, D or ARtoP – only if corroborated
- Corroboration of oral evidence of prior invention is the general rule in patent disputes
  - 8 factors in assessing corroboration – “rule of reason” analysis
    - (1) the relationship between the corroborating witness and the alleged prior user,
    - (2) the time period between the event and trial,
    - (3) the interest of the corroborating witness in the subject matter in suit,
    - (4) contradiction or impeachment of the witness' testimony,
    - (5) the extent and details of the corroborating testimony,
    - (6) the witness' familiarity with the subject matter of the patented invention and the prior use,
    - (7) probability that a prior use could occur considering the state of the art at the time,
    - (8) impact of the invention on the industry, and the commercial value of its practice.

Ethicon

ETHICON INC.

- Claim 33 – blunt rod/probe moves ahead of the blade
  - What was Choi's contribution and does it appear in the claim?
  - Yoon conceived of using a blunt rod/probe that spring-releases to move beyond the blade as the blade finishes the cut
    - But, Choi conceived of two items in the subject matter of claim 33
      - Locating the rob/probe in the trocar shaft and having it pass through an aperature in the blade
      - The "means . . . for . . . creating a sensible signal"
    - Claim 33's language required that (i) the blade surface be perforated and (ii) that the shaft to be "longitudinally accommodatable within [the] outer sleeve"
      - "***Properly construed***, claim 33 includes the elements that Choi contributed to the invention according to the district court's findings"
    - Choi could corroborate his testimony of conceiving of the blunt probe via sketches he drew
  - Yoon's rebuttal evidence was properly discredited by the district court
    - Backdating documents, altering drawings and inconsistency

Ethicon

ETHICON INC.

- Claim 47 – blade snaps back into "interior bore"
  - Counterforce on blade from cavity wall is stored and used to pop the blade back once it punctures through the wall
  - Pertinent claim portion:
    - *means interposed between said puncturing means proximal end and said interior bore assuming a normally protruding position for detaining said puncturing means proximal end extended from said interior cavity in opposition to said biasing means* **[detaining means]**
  - A cocked spring pulls the trocar back
  - Release of the detaining means triggers the spring action
    - Two detaining means disclosed:
      - detent extending outward from the trocar extending into a hole in the sheath
      - rod extending from proximal end that interfaces with a slidable bar with hole in its center
  - District court found that Choi invented both means
  - But, Federal Circuit found clear error in this finding
    - Corroborating sketches only showed the same rob/bar detaining means
    - The detent detaining means in Choi's sketches were different because a plunger inserted inwardly through a hole in the sheath
  - However, contribution of one structural means that corresponds with a means plus function claim element is sufficient
    - Unless such structure is shown to be merely a reduction to practice of the broader concept, which Yoon has not shown

Ethicon ETHICON INC.

- Corroboration
  - Taken together, inventor's testimony and corroborating evidence must show inventorship by CCE
  - Yoon admits that Choi made sketches, but claims that Choi simply drew concepts Yoon conveyed to Choi
  - Other corroborating "rule of reason" circumstantial evidence supports that Choi conceived of what he drew in the sketches

Ethicon ETHICON INC.

- Consequences of joint inventorship & the license
  - Presumptively, no matter what the individual contribution, each co-inventor owns a pro rate undivided interest in the entire patent
    - §261 – patents shall have the attributes of personal property, suggesting that ownership rights attach to the patent as a whole
- §116
  - When an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath, except as otherwise provided in this title. Inventors may apply for a patent jointly ***even though*** (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.
  - If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Director, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.
  - Whenever through error a person is named in an application for patent as the inventor, or through error an inventor is not named in an application, and such error arose without any deceptive intention on his part, the Director may permit the application to be amended accordingly, under such terms as he prescribes.

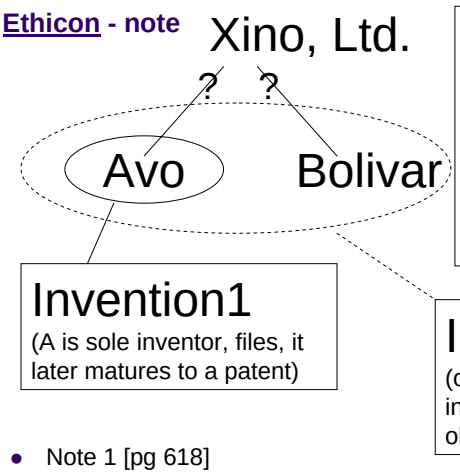
Ethicon ETHICON INC.

- §262
  - In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use, offer to sell, or sell the patented invention within the United States, or import the patented invention into the United States, without the consent of and without accounting to the other owners.
- Majority concludes that
  - Thus, where inventors choose to cooperate in the inventive process, their joint inventions may become joint property without some express agreement to the contrary. In this case, Yoon must now effectively share with Choi ownership of all the claims, even those which he invented by himself. Thus, Choi had the power to license rights in the entire patent

Ethicon ETHICON INC.

- Dissent
  - Before present law, no good solution to the problem of identifying inventors
    - Filing separate patent applications was a poor solution
  - Legislative history for §116 indicates no Congressional intent to deal with patent ownership
  - The change merely allows any inventor to be named to spare some patents being held invalid for inventorship
  - Choi would not have passed the pre-1984 test of joint inventor
- Which rule is better?
  - Advantages/disadvantages of each?
  - Should patent instruments name the inventor(s) for each claim?

Ethicon - note



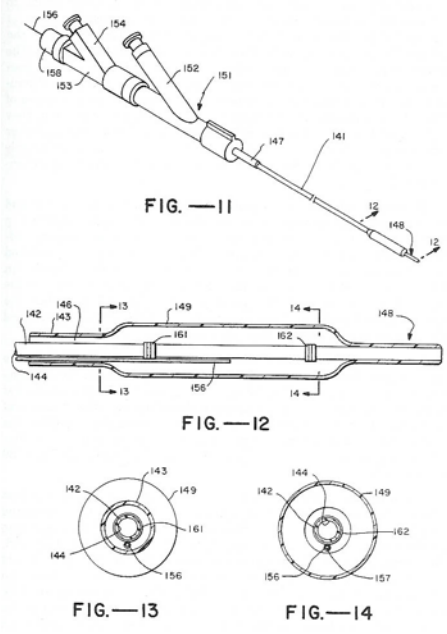
§103(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

§§ 103(c)(2)-(3) [_Joint research provisions for "owned by the same person . . ."_]

- Note 1 [pg 618]
  - Invention2 is at risk of a §102(e)/103(a) rejection [???]
    - Or not, given obligation of assignment to the same person?
  - Assume that there is a rejection
    - One way for X to get around this is to pare away from the patent any of B's contributions
    - Then, Invention1 is no longer a valid §102(e) reference because it is not "by another" §102(e)

Hess v. Advanced Cardio. Sys. (Fed. Cir. 1997) (Friedman)

- Affirming district court's determination that Hess' materials and suggestions did not make him a co-inventor
- Inventor's had trouble w/ material for balloon in balloon angioplasty device
- Referred to Hess, a Raychem engineer
  - He provided sample heat shrinkable tubing and some suggestions as to using it in the device
- Ultimately, inventors developed the balloon using a technique "free blowing" that Hess did not suggest



Hess v. Advanced Cardio. Sys. (ACS)

- Application filed in April, 1978, patent issued in April, 1982
- Suit against SciMed (started in 1987)
  - Complex procedural history; reexamination of patent from 1987-90, resulting in new claims 22-52
  - Hess affidavits of contribution (1989) & inventorship (1990)
  - Hess attempt to intervene (1990), dismissed by District court for laches, reversed by Fed. Cir. (1993)
  - During appeal, Hess sues directly for inventorship, ACS and SciMed settle
  - District court finds inventorship claim on original claims barred by laches, and that Hess failed to prove sufficient contribution by CCE on the reexamination claims
  - Hess only informed them of products available in the marketplace
  - As a backup, the district court also found that the record did not establish Hess as an inventor for the original claims

Hess v. Advanced Cardio. Sys. (ACS)

- §256
  - If "through [inadvertent] error an inventor is not named in an issued patent ... the Commissioner [of Patents] may ... issue a certificate correcting such error," and that "[t]he court ... may order correction of the patent ... and the Commissioner shall issue a certificate accordingly."
- [a]n inventor "may use the services, ideas, and aid of others in the process of perfecting his invention without losing his right to a patent.“
  - Hess did no more that what a skilled salesperson would do
- Questions
  - Import of Hess’ contributions already being in the prior art?
  - Would the device have even been functional without Hess’ input?

Duty of Disclosure - 37 CFR §1.56

- (a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a ***duty of candor and good faith*** in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be ***material to patentability*** as defined in this section. The duty to disclose information exists with respect to ***each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned***. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which ***fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct***.

Duty of Disclosure - 37 CFR §1.56

- The Office encourages applicants to carefully examine:
  - (1) Prior art cited in search reports of a foreign patent office in a counterpart application, and
  - (2) The closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.
- (b) Under this section, information is material to patentability when it is ***not cumulative to information already of record or being made of record in the application***, and
  - (1) It establishes, ***by itself or in combination with other information, a prima facie case of unpatentability of a claim***; or
  - (2) It ***refutes, or is inconsistent with, a position the applicant takes*** in:
    - (i) ***Opposing an argument of unpatentability*** relied on by the Office, or
    - (ii) ***Asserting an argument of patentability***.
- A *prima facie* case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

Duty of Disclosure - 37 CFR §1.56

- (c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:
  - (1) Each inventor named in the application;
  - (2) Each attorney or agent who prepares or prosecutes the application; and
  - (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.
- (d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.

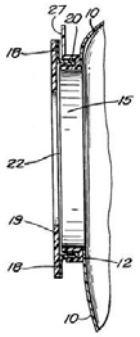
Duty of Disclosure - 37 CFR §1.56

- Federal Circuit application of new (1992) standard
  - Standard for materiality from 1977 to 1992 was that information is material when
    - "there is a substantial likelihood that a reasonable examiner would consider it important in deciding whether to allow the application to issue as a patent."
      - The Federal Circuit applies this standard to pre-1992 activity

Kingsdown v. Hollister (Fed. Cir. 1988) (Markey)

- Two piece ostomy appliance: pad and detachable pouch, matched sealing coupling rings
- After indefiniteness rejection related to the word "encircled" Kingsdown amends claim 50 (original claim language became claim 9 in issued patent):

A coupling for an ostomy appliance comprising a pad or dressing having *a* *body contacting surface and an outer surface with* a generally circular aperture for passage of the stoma *extending through*~~,~~ said pad or dressing~~, aperture encircled by~~ a coupling member *extending outwardly from*~~and an ostomy bag also having a generally circular aperture for passage of the stoma,~~ *said outer pad or dressing surface and encircling the intersection of said aperture and said outer pad or dressing surface,* and an ostomy bag also having a generally circular aperture *in one bag wall* for passage of the stoma *with*~~*aperture encircled by*~~ a second coupling member *affixed to said bag wall around the periphery of said bag wall aperture and extending outwardly from said bag wall*, one of said coupling members being two opposed walls of closed looped *annular* channel form and the other coupling member of closed loop form having a rib or projection dimensioned to be gripped between the mutually~~mutually (sic)~~ opposed channel walls when said coupling members are connected, said rib or projection having a thin resilient deflectible seal strip extending therefrom, which, when said rib or projection is disposed between said walls, springs away therefrom to sealingly engage one of said walls, and in which each coupling member is formed of resilient synthetic plastic~~plastics~~ material.¶



Kingsdown v. Hollister (Fed. Cir. 1988) (Markey)

- These changes convinced the examiner that there was no longer a definiteness problem
- While appeal of other rejected claims pending, Kingsdown's patent attorney saw Hollister's two piece ostomy appliance
- As a result, Kingsdown did the following:
  - Appeal withdrawn and continuation filed by newly hired outside counsel
  - Claim correspondence chart (child to parent) had a problem
    - Continuation claim 43 indicated to correspond to amended claim 50 in parent, but actually corresponded to unamended claim 50
  - There was another claim 43 in the continuing application – it had the amended "encircling" language

Kingsdown v. Hollister (Fed. Cir. 1988) (Markey)

- One issue is whether the examiner made an independent examination of continuation claim 43 (carrying the unamended claim 50 language of the parent); or, if the examiner relied on Kingsdown's claim correspondence chart
- Another issues is inferred intent
  - Kingsdown's patent attorney saw that Hollister's device had a floating flange
  - The theory of intent is:
    - The amended language of parent claim 50 is narrower
    - Kingsdown's patent attorney was worried that Hollister's device would escape infringment if the amended claim applied
    - Thus, the attorney made a "mistake" that resulted in the original claim 50 being issued without ever overcoming the examiner's original indefiniteness rejection

Kingsdown v. Hollister (Fed. Cir. 1988) (Markey)

- Federal Circuit frames the issue:
  - Whether the district court's finding of intent to deceive was clearly erroneous, rendering the district court's determination that inequitable conduct occurred an abuse of discretion
- ***Two elements that must be proven by CCE***
  - ***Materiality***
    - ***Failure to disclose material information***
    - ***Submission of false material information***
  - ***Intent to deceive***
- Here, no direct evidence of intent to deceive
  - So, two possible alternative grounds to find intent:
    - Gross negligence
    - Acts indicating an intent to deceive
- Gross negligence
  - Is not itself enough to find intent – but can be with other evidence
  - This behavior may not even be gross negligence
    - Ministerial recording error
    - The subject matter was allowable
    - So many others overlooked this error, by definition it is not sufficient to find intent to deceive the PTO

Kingsdown v. Hollister (Fed. Cir. 1988) (Markey)

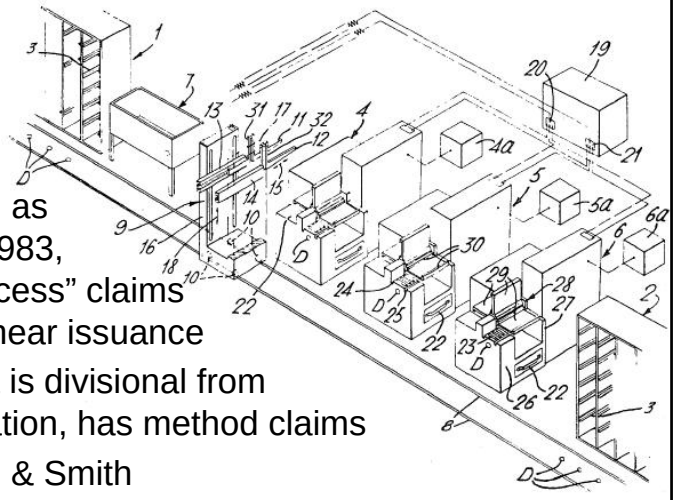
- Inferences drawn from "acts" by the Kingsdown attorney
  - Trying to obtain patent to cover the Hollister device
    - Not improper or illegal & not evidence of "bad" intent
  - Failing to disclaim or reissue after being accused of inequitable conduct by Hollister
    - This later act (1987) would not establish bad faith in the prosecution (1982)
    - A nonsensical suggestion
      - "The right of patentees to resist such charges must not be chilled to extinction by fear that a failure to disclaim or reissue will be used against them as evidence that their original intent was deceitful."
      - This approach would only "encourage the present proliferation of inequitable conduct charges"
- Context of the entire prosecution is important
  - Emphasizes ministerial nature of the mistake
  - District court's implications based on claim 9 are unknown because the district court did not develop the case to know whether any of the other claims would cover the Hollister device

Kingsdown v. Hollister (Fed. Cir. 1988) (Markey)

- Notes and closing points
  - In banc rulings
    - Gross negligence itself is not enough for a finding of intent
    - Inequitable conduct is a question that is equitable in nature – so committed to discretion of trial court, reviewed under abuse of discretion
    - Inequitable conduct with respect to one claim renders the entire patent unenforceable
- Inequitable conduct applies to the entire prosecution
- Other effects of PTO Misconduct
  - Patent unenforceable due to inequitable conduct
  - "exceptional" case under 35 USC 285 for award of attorney fees
  - Common law fraud which can support a particular type of antitrust claim

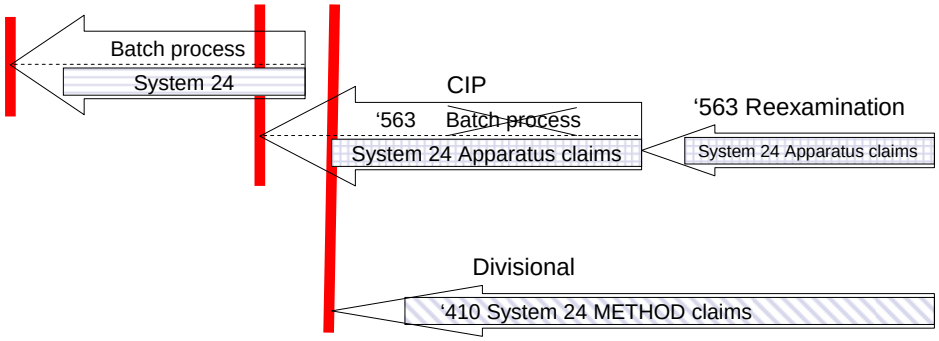
Molins v. Textron (Fed. Cir. 1995) (Lourie)

- Molins, a UK maker of machine tools, developed two items to claim
  - The "batch process" (1965) (UK & foreign patents filed)
  - The "system 24" apparatus (1966) (UK & foreign patents filed 1966-67)
- Combine US "foreign" applications in 1967 (CIP)
- This CIP issued as '563 patent in 1983, after "batch process" claims were removed near issuance
- The '410 patent is divisional from the '563 application, has method claims
- Whitson, Hirsch & Smith
  - Wagenseil reference



Molins

- Molin's US Applications for the "batch process" and "system 24"
  - The '563 "batch process" claims were cancelled near the end of the application process for the '563 CIP application



Molins

- Wagenseil reference – anticipated the "batch process"
  - Caused Whitson to abandon foreign applications to the "batch process"
    - Except, he did not abandon US application because it also contained the "system 24" claims
  - Prosecution of the system 24 invention in foreign (to UK) countries generated further Wagenseil cites by foreign PTOs
  - Eventually, Whitson abandoned these applications
- Hirsch takes over in 1983
  - Sees the problem that Wagenseil was not disclosed to the US PTO and informs Smith, the US PTO correspondent who had prosecuted the applications for Whitson
  - File Rule 501 prior art statement w/ US PTO in 1984
  - In 1984, TP request for rexamination, cited Wagenseil,
    - In reexam, the Rule 501 filing was acknowledged, but partially defective because no foreign translations filed
    - Examiner circled each reference (including Wagenseil) indicating he considered it, but did not reject any claims based on Wagenseil
- In 1986, Molins sues three parties, including TP who requested reexamination
  - IN 1992, District court held ***both*** Molins patents unenforceable

Molins

- § 1.501 Citation of prior art in patent files. [CURRENT]
  - (a) At any time during the period of enforce-ability of a patent, any person may cite, to the Office in writing, prior art consisting of patents or printed publications which that person states to be pertinent and applicable to the patent and believes to have a bearing on the patentability of any claim of the patent. If the citation is made by the patent owner, the explanation of pertinency and applicability may include an explanation of how the claims differ from the prior art. Such citations shall be entered in the patent file except as set forth in §§ 1.502 and 1.902.

Molins

- Application of Materiality-Intent test to a failure to disclose prior art
  - Materiality
    - Materiality of the prior art
    - Knowledge by applicant of (i) the PA and (ii) its materiality
    - Failure to disclose the PA
  - Intent to mislead the PTO
- District court
  - Found overwhelming circumstantial evidence of Whitson's intent to deceive
    - Molins argues that Wagenseil reference is only material to the batch process, not system 24
      - The reference was not used by the examiner to reject on reexamination
  - Court notes that Molins' argument ignores the "reasonable" examiner standard
    - Just because this examiner does not reject does not mean that a reasonable examiner would
  - Moreover, a reference can still be material even if the "reasonable" examiner eventually finds the claims patentable over the reference
- Wagenseil was material
  - It taught "recirculate" and "bypass" features absent in the other PA
  - Whitson cited it to foreign PTO offices who treated it as relevant & material (the district court acknowledged the need to be careful when drawing inferences from statements of foreign patent offices)

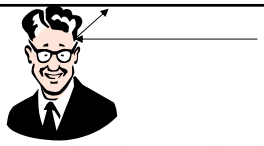
Molins

- Intent
  - For 13 years Whitson did not cite the reference to the PTO
  - Yet he cited it to foreign offices as the closest PA
  - Failure to cite a material reference cited elsewhere supports a strong inference of intentional withholding
- Although it can be a tough call to sort out whether
  - It is actual inequitable conduct, or
  - The "plague" on the patent system
  - The district court did not abuse its discretion, misapply the law, or make clearly erroneous findings
- Later citing to the PTO does not cure or purge the earlier problem
- All of '563 patent unenforceable, AND
- All of the '410 patent is unenforceable because
  - The '410 patent "relied on the '563 patent"

Molins - notes

- Purging inequitable conduct – three requirements
  - Expressly advise the PTO of the existence of misrepresentation in the prosecution, stating specifically wherein it resides
  - If the misrepresentation is of one or more facts, advise the PTO of the actual facts
    - make it clear that further examination in light thereof may be required if any PTO action has been based on the misrepresentation
  - Establish patentability of the claimed subject matter on the basis of the new and factually accurate record
  - NOTE
    - It does not suffice that one knowing of misrepresentations in an application or in its prosecution merely supplies the examiner with accurate facts without calling his attention to the untrue or misleading assertions sought to be overcome, leaving him to formulate his own conclusions

Molins - notes



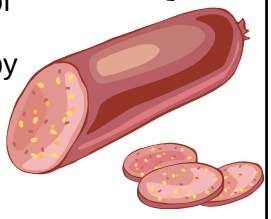
- Examiner's independent discovery?
  - If a reference is before the examiner, it cannot be deemed to be withheld from the examiner
  - Dissent on this point – does this leave inconsistent Federal Circuit caselaw on this issue?
- Cumulative PA references
  - Examiner is already aware of the reference
  - It is cumulative or less material than references already disclosed
- Affidavits, oaths or declarations are never cumulative – inherently material
  - Goes to the weight of the evidence
- Plague?
  - A defense too attractive to ignore? (puts patentee on defensive, allows wider scope of discovery
  - Eliminate this defense for completely valid patents?

Double patenting

- Prohibition against "double patenting"
  - Issue only a single patent instrument per invention
  - Can serve as a validity defense in infringement
  - Policy basis
    - Without it, opportunity to extend term via multiple instruments
    - Two instruments for same invention one can assert against an infringer
  - Applies when
    - Same or overlapping inventive entity OR
    - common assignee even if different inventive entities
  - Types
  - Statutory double-patenting ("a patent" in 35 USC §101) "same invention" type
    - "Cross-reading" test – device that literally infringes one must infringe the other
      - i.e., a claim in each of the two applications covers the same subject matter
      - For example, if all other claim limitations are equal, 36 inches is the same claimed subject matter as three feet
    - Not curable via a terminal disclaimer
  - Obviousness-type double patenting (judicial doctrine)
    - The two applications are not the same identical invention (think "anticipation" – has all the elements/limitations), but the two applications are obvious variations of each other
    - In most situations the test is "one-way" obviousness – is a claim in the second application obvious in light of a claim in the first application/patent

In re Vogel (CCPA 1970)

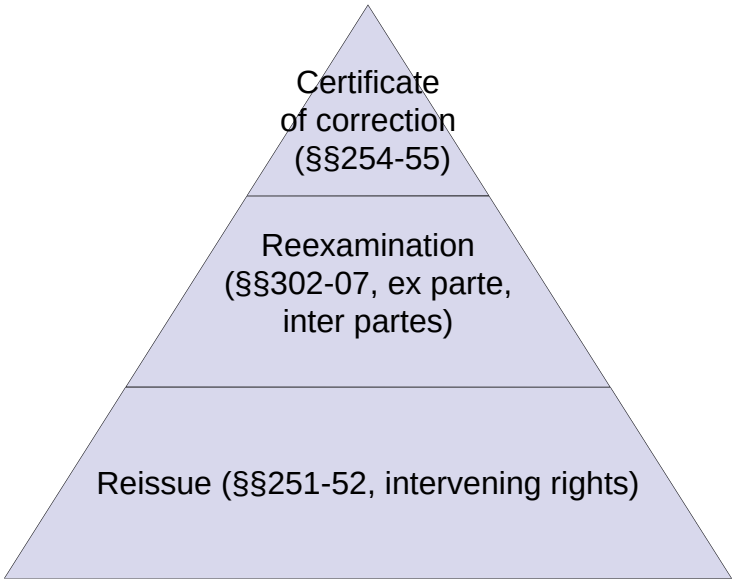
- Application claims are to a method of packaging meat (claim 10) and a similar method for beef (claim 11)
- Pre-existing patent to applicant – packaging pork
- Generally, method is to packaging the meat just after slaughtering in materials with some degree of air impermeability
- "same invention" type double patenting rejection by the Board
- Patent examiner used dictionary definition of "sausage"
  - To show that beef and pork are equivalent?
- CCPA
  - The definition of "sausage" does not show equivalency of the two meats for this purpose
  - The Board discussed whether the pork method was a "patentable advance," meaning that what it really was analyzing was an "obviousness-type" double patenting situation



In re Vogel (CCPA 1970)

- Same invention type double patenting
  - Meat process claim does not cross-read on pork process claim
  - Beef process claim does not cross-read on pork process claim
- Obviousness-type double patenting
  - Compare claim(s) of second application to claim(s) (not disclosure) of first patent/application
    - But, can use the disclosure for claim interpretation
    - And, can compare to a disclosed tangible embodiment that falls within the scope of the earlier patent/application
      - An anomaly in patent law
  - Claim 11
    - Beef is not an obvious variation of pork!?
  - Claim 10
    - The only limitation in claim 10 not appearing in the earlier patent is the permeability range
    - But, this is an obvious variation as shown by the Ellies reference
    - Claim 10 is properly rejected
- 35 USC §253
  - Disclaim claim(s)
  - Disclaim the "terminal" (remaining) period of time for all claims in the patent
    - Common ownership requirement

Post-Grant Procedures



Post-Grant Procedures - CofC

- Certificate of correction (CofC)
  - §254 – mistake "incurred through the fault of the [PTO], is clearly disclosed by the records of the [PTO]"
  - §255 – mistake is not PTO's fault and a "showing has been made that such mistake occurred in good faith"
    - Correctable, but the mistake must be "of a ***clerical or typographical nature***, or of ***minor character***"
    - clerical or typographical nature
      - simple mistakes such as obvious misspellings that are immediately apparent
      - can result in a broadened claim "only where it is clearly evident from the specification, drawings, and prosecution history ***[i.e., the public record]*** how the error should appropriately be corrected. Such an interpretation of § 255 insures that the public is provided with notice as to the scope of the claims"
    - minor character
      - exclude mistakes that broaden a claim

Reissue

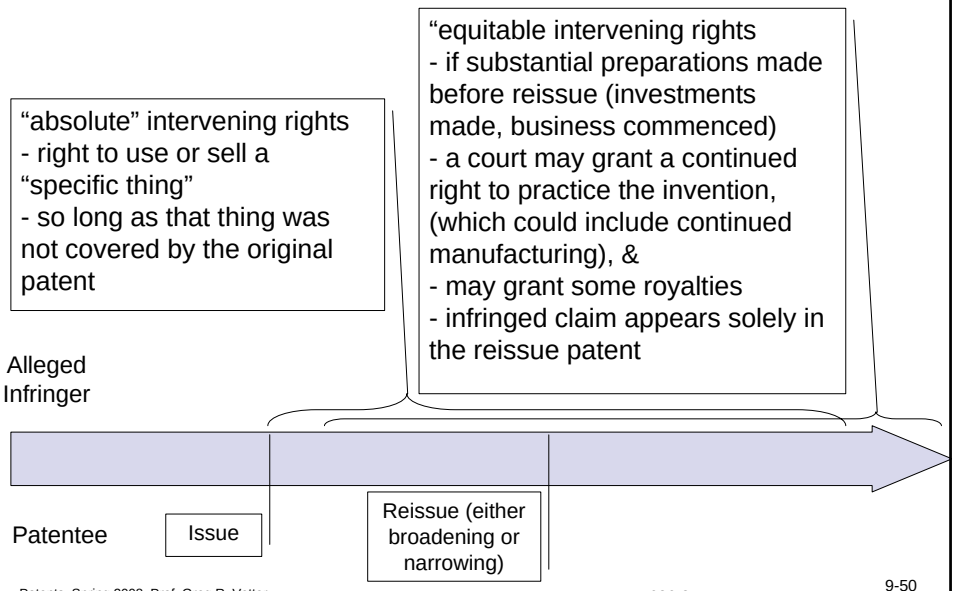
- §251
  - Whenever any patent is,
    - through error without any deceptive intention,
  - deemed wholly or partly inoperative or invalid,
    - by reason of a defective specification or drawing, or
    - by reason of the patentee claiming more or less then he had a right to claim in the patent,
  - the Director shall,
    - on the surrender of such patent and
    - the payment of the fee required by law,
  - reissue the patent for the invention
    - disclosed in the original patent, and
    - in accordance with a new and amended application,
    - for the unexpired part of the term of the original patent.
  - No new matter shall be introduced into the application for reissue.
  - . . .
  - No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

Reissue

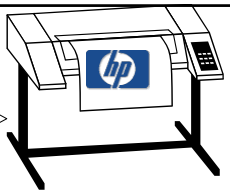
- Process is public
- Patent is subject to complete and full examination similar to its original examination
  - No presumption of validity
  - Originally allowed claims can be rejected on any grounds
  - In evaluating prior art, file date (or other effective dates) of original application applies
- Oath 37 CFR §1.175(a)
  - Wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue

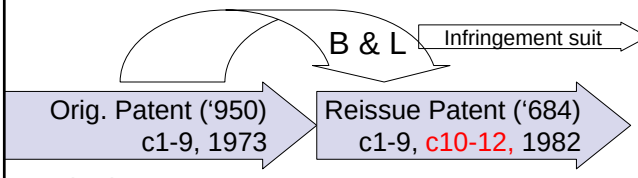
Reissue

- Prior user (intervening) rights- §252

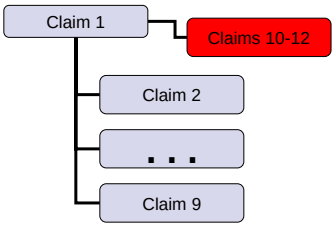


HP v. Bausch & Lomb (Fed. Cir. 1989) (Nies)

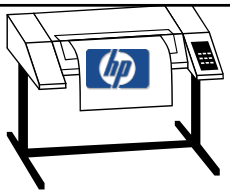




- District court
  - Held on S/J claims 10-12 invalid for defective oath in reissue proceeding
- B & L's reissue application
  - Bogden, Hyer, Jobe & Robbins
    - No consultation with Fleming at time of reissue application
  - Original oath by Mr. More, B & L VP, said
    - no deceptive intent on the part of inventor and his attorney
    - Claimed less than had a right to claim
- Later, two affidavits by Fleming, the attorney who prosecuted the original '950 patent

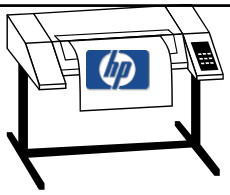


HP v. Bausch & Lomb (Fed. Cir. 1989) (Nies)

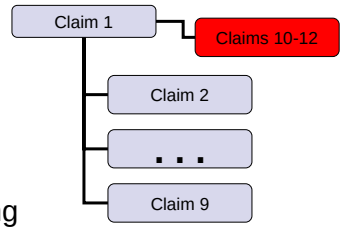


- Dist. Court's problems with the oath
  - Mr. More, Jobe had no knowledge of any error
  - Oath did not specify an error
  - Did not specify that claim 1 is inoperative or invalid
  - Did not specify how the error arose or occurred
    - Saying it was an "oversight" was insufficient
- First affidavit
  - Fleming told Jobe he had trouble getting information from the inventor
  - Fleming mentioned "old file" but Jobe never asked for any backup documentation
- Second affidavit
  - Required because PTO reexaminer rejected first one
    - Did not say how and by whom the scope of the subject matter claimed was determined and why
  - Robbins takes over prosecution
  - Fleming's second affidavit disclaims all inventor involvement in determining the scope of the claims

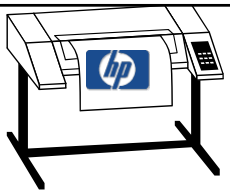
HP v. Bausch & Lomb (Fed. Cir. 1989) (Nies)



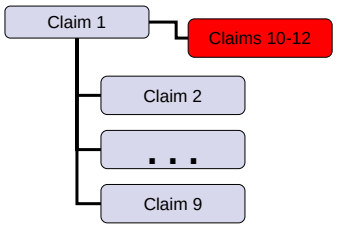
- Error in the patent
  - defective or partly inoperative or invalid because of
    - defects in the specification or drawing, or
    - because the patentee has claimed more or less than he is entitled to ***[claim scope]***
- Error in conduct
  - defective, inoperative, or invalid patent arose through
    - error without deceptive intent
- The reissue claims only show an original error of including too few claims, not claiming more or less than entitled
  - Literally inconsistent with statute, but not deemed to be fatal because some approval in dicta of this practice and in spirit of the remedial purpose of the reissue provisions



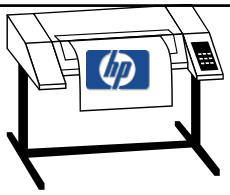
HP v. Bausch & Lomb (Fed. Cir. 1989) (Nies)



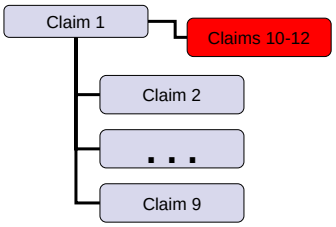
- It is not critical to base the decision on the "error in the patent" prong because B & L cannot meet the "error in conduct" prong
- One cannot accept such a broad definition of "error in conduct" such that every patent has a second chance for prosecution
  - How would B & L have determined when an "error in conduct" occurred?



HP v. Bausch & Lomb (Fed. Cir. 1989) (Nies)



- The original declaration by Mr. More was insufficient, thus the Fleming affidavits were necessary
  - But, they were untrue – so they do not provide the necessary support to show an error in conduct
- Claims 10-12 are invalid
  - But, the original claims remain valid



HP - notes

- Adelman
  - Not including a “reasonable set of dependent claims” is likely the result of error rather than a strategic calculation because to not include such a set is “probably malpractice”
  - Lessening of pressure to “get it right” the first time?
- Elimination of the error requirement?
- Effect of reissue
  - “new” application, surrender old patent
  - continuations/divisionals possible from the reissue, but not CIPs
  - Two month waiting period after reissue announced in PTO Official Gazette
    - Third parties can submit additional prior art or arguments

HP - notes

- Broadening reissue
  - "broader" means reads on any new subject matter
    - Even if narrower in other commercially important respects
  - Broadened claim must be presented within 2 years
    - In re Doll (CCPA 1970) – further broadening after in reissue, but also after 2 years, is not improper because original reissue application sought to broaden the claims
    - In re Graff (Fed. Cir. 1997) – reissue application at 22 months sought only to change drawings, later, after 2 year mark, broadened claims introduced, rejection of this was proper
  - Recapture rule (recapture estoppel)
    - Can't acquire via reissue claims the same or broader scope of
      - Claims cancelled in the original application
      - Claims narrowed in the original application, typically in response to prior art rejections
    - Deliberate decision to narrow the claims is not the sort of error comprehended by the reissue statute

Reexamination

- Ex parte, §301-307 – new label for traditional reexamination
- Inter partes, §311-318– liberalizing changes in Nov. 2002 – as to use of PA and TP opportunity to participate

Section	Provision
§301	Any TP can cite PA (patents & printed publications only) to the PTO, apply it to at least one claim & the item becomes a part of the patent's record
§302	Based on a §301 submission, a TP may request reexamination
§303	PTO director responds "the Director will determine whether a ***substantial new question of patentability*** affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. On his own initiative, and any time, the Director may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 of this title. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office. [New, as of 11/2/2002, overturns In re Portola Packaging (Fed. Cir. 1997), see Notes 1-2, pg. 692-94]]

In re Recreative Technologies, (Fed. Cir. 1996) (Newman)

- On reexamination, PTO Board held claims 1, 2 & 4 unpatentable

- After suit, D requested reexamination
  - Citing 5 patents, 3 publications
- Reexaminer rejected claims as obvious in light of Ota
  - Did not rely on the 8 new references
  - Same rejection that patentee overcame in original application
- PTO Board reversed
  - But, rejected the claims as invalid for novelty in light of Ota

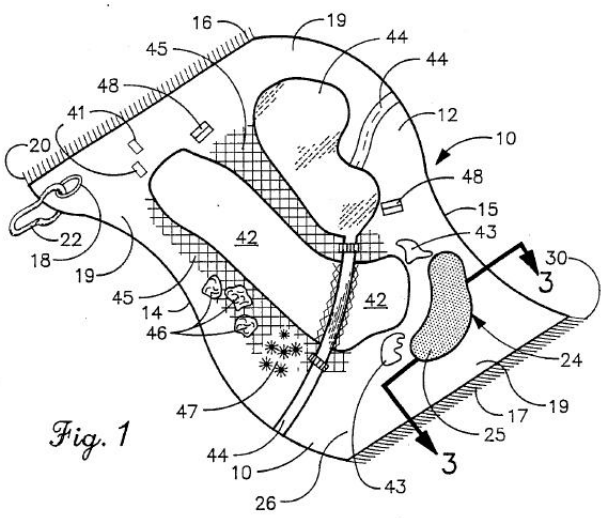


Fig. 1

In re Recreative Technologies, (Fed. Cir. 1996) (Newman)

- Reexamination statute
  - On its face "the reexamination statute was designed to exclude repeat examination on grounds that had already been successfully traversed"
- Balancing benefits of correcting governmental defective examination of patents with use of reexamination as an abusive procedure
  - So, limited to certain forms of new prior art as evaluated via 102 & 103
  - MPEP provision is contrary to language of statute and its legislative history, and internally inconsistent with other MPEP provisions

In re Recreative Technologies, (Fed. Cir. 1996) (Newman)

- "Reexamination is barred for questions of patentability that were decided in the original examination"
  - Because Ota was clearly cited and used in the original examination, the only remaining question is whether "anticipation by Ota" was decided by PTO in the original prosecution via an obviousness rejection based on Ota
    - The court decides not to reach this question
  - On reexamination, the PTO Board probably concluded that it was invoking a new ground of patentability in rejecting based on anticipation
    - But, Board's actions are not controlling – the reexamination never should have made it to that stage
    - Unfair to patentee to allow the appellate stage of a reissue proceeding to raise the new grounds

Reexamination - notes

- Rarely used patentee option to file "preliminary statement" in an TP ex parte reexamination request
  - Not filing is a defensive measure
  - If the patentee files the preliminary statement, the TP obtains the right to respond
- Inter partes reexamination
  - TPs requestors may submit written comments
  - May appeal to PTO Board and courts
  - To discourage abuse, estopped from later raising in court issues that they raised or could have raised during reexamination
  - Until Nov. 2, 2002, unsuccessful challengers not allowed to appeal to Federal Circuit
    - Revised to allow appeal to Federal Circuit
- Note 2, pg. 693-94, statutory override for In re Recreative and In re Portola.

Reexamination - notes

Reexamination	Reissue
Any person	Approval of patentee
No need to point out error w/out deceptive intent - thus, patentee can use to add narrower claims without explaining why not originally included	Must show “error” w/out deceptive intent
PA patents and printed publications - if amend, other issues such as 112 may arise	Any issue that may be considered in the original application
Cannot be used to broaden claims Can’t abandon	Broadened claims allowed if presented in first two years Can abandon the reissue
Do not give rise to interferences	Copy claims to generate interference

Post Grant Procedures Exercises

- 1. The '777 patent contains one independent and two dependent claims. The owner of the '777 patent, Johnson, files a reissue application fourteen months following the patent's issue date. As requested, the PTO reissues claim 1 as in the original patent, but broadens the scope of claims 2 and 3. Later, Johnson sues Boswell for patent infringement. Boswell admits infringement of all claims of the reissued patent and that the claims are valid. May Boswell successfully raise the defense of intervening rights?
- 2. The '888 patent relates to an exhaust hood assembly useful for placement above a stove or other cooking apparatus. It issued to MacDaniel on January 5, 2001, with a single claim defining elements A, B, and C. Element B consisted of "a fan with five blades." On July 1, 2003, MacDaniel filed a reissue application, again with a single claim. That claim comprised elements A, B, C, D and E, where element B consisted of "a fan with a plurality of blades." Did MacDaniel file a proper reissue application?
- 3. Which of the following may *not* be corrected via reissue?
  - (A) One of the actual inventors is not named on the patent.
  - (B) Foreign priority was not claimed under § 119.
  - (C) The applicant failed to disclose an extremely pertinent prior art reference of which he had knowledge.
  - (D) The applicant knew, but did not disclose, a particular mode that was determined only after the time of filing to be the superior method of practicing the invention; he did disclose what he in good faith considered to be the best mode.

Post Grant Procedures Exercises

- 4. On January 4, 1998, Lestrade, a registered patent attorney, filed in the United States Patent Office a patent application on behalf of inventor Moriarity. The application is directed towards an o-ring seal useful with various chemical processing techniques. The patent ultimately issued on December 13, 1999.

  On April 1, 1999, Moriarity begins selling a-rings that were fully disclosed in his application. On September 4, 2000, Moriarity realized that his patent does not claim the precise elements that comprise the 0- ring he is actually selling. Moriarity tells Lestrade, "I would like to file a reissue application to seek broadened claims to cover the a-rings I have been selling. However, I'm worried about an on-sale bar under section 102Cb). What is the last possible date on which I can file-or should have filed-a reissue application?“

  What is the last possible date that a broadening reissue may be filed with respect to the Moriarity patent?

Post Grant Procedures Exercises

- 5. A United States patent issued to Nimmer on September 1, 1997. The Nimmer patent describes and claims a coffee grinding machine. Nimmer's chief competitor, Goldstein, wishes to file a third party request for reexamination. He is aware of the following possibilities for filing the request:
  - (A) Goldstein's own patent application filed on August 12, 1995. The application disclosed, but did not claim, the identical coffee grinding machine in Nimmer's patent. However, Goldstein ultimately abandoned the application on May 1, 1997, and no patent ever arose out of that application.
  - (B) Evidence that Nimmer sold the claimed invention to the Brown & Denicola Company of Boston, Massachusetts, on January 5,1996.
  - (C) Evidence that a third party, the Litman Coffee Company, publicly used the same coffee grinder in Ann Arbor, Michigan, from March through June, 1996.
  - (D) A British patent, issued to Dworkin, which describes and claims the invention. The British patent issued on November 6, 1991, based upon an application filed in the United Kingdom on January 28, 1990.
- May Goldstein file a request for reexamination with any chance of success? On what ground, if any?