

# DROIT AMERICAIN DES BREVETS

Mise à Jour 2022

The logo for Oblon, featuring the word "OBLON" in a white, serif, all-caps font. The letter "O" is significantly larger and more stylized than the other letters, which are in a standard weight. The logo is set against a dark blue background with a faint, light blue geometric pattern of overlapping lines and shapes.

***Philippe Signore***

U.S. Patent Attorney  
Managing Partner

## Programme

Philippe  
Nicolas

- 1) **Actualités de l'USPTO**
- 2) « **Written Description Requirement** »
- 3) « **Definiteness** »
- 4) **Actualités du PTAB**
- 5) **Clauses de sélection de forum dans les licences et accords de confidentialité**
- 6) « **On sale** »
- 7) **Morceaux choisis**

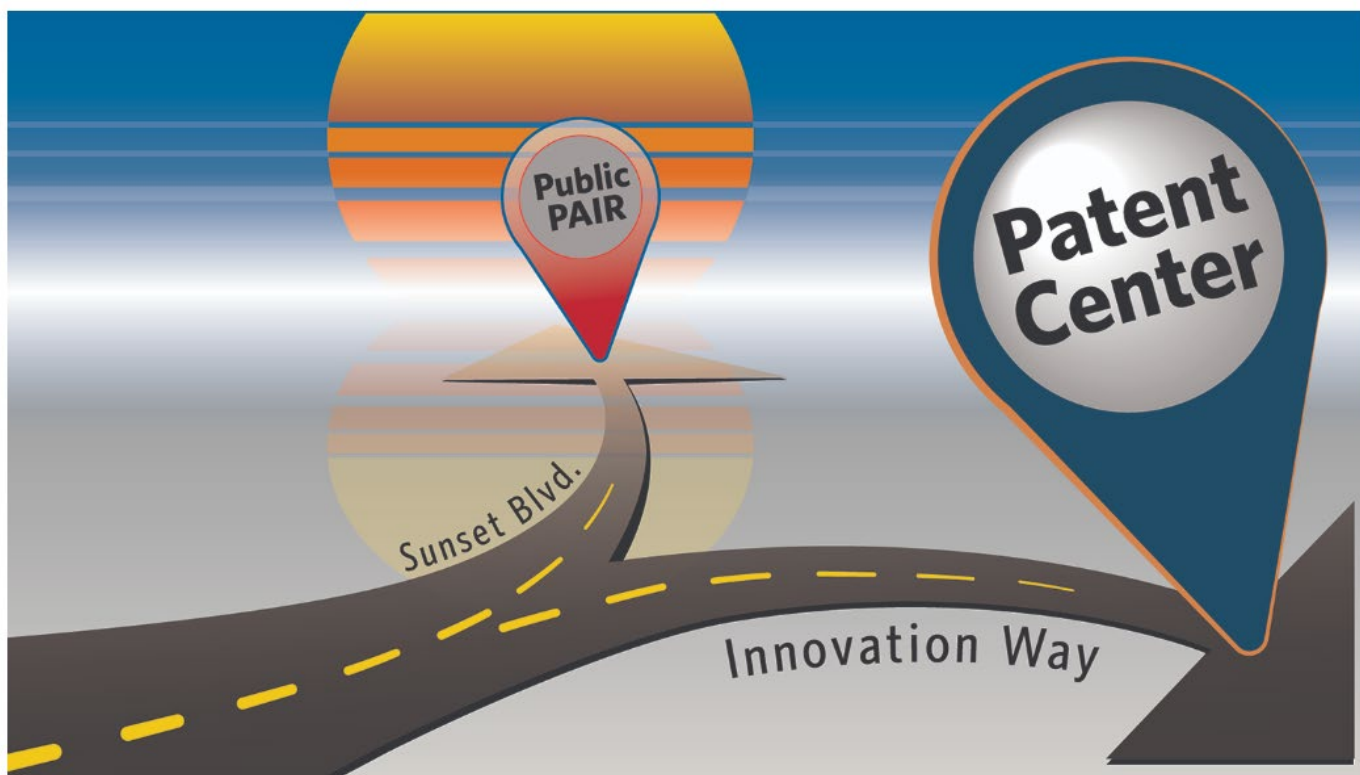


# New USPTO Director Kathi Vidal as of April 2022

- Decades of experience in patent litigation and counseling
  - Former managing partner of law firm
  - Electrical engineer
- Director Vidal may focus on:
  - Examiners' Return to the Office ?
  - 35 USC 101 Guidelines?
    - July 2022 Director's post: "we are revisiting our subject matter eligibility guidance"
  - DOCX?
  - IDS Rules?
  - Discretionary denials at PTAB
  - Reviews under the *Arthrex* case
  - Diversity



## Public PAIR Retired August 2022



After July 31, 2022, Public PAIR will no longer be available. To access publicly available documents, guest users may access Patent Center.

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#### Search for a patent application

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**Application # ▾**

Search



All fields

Application #

Patent #

PCT #

Publication #

missions to post grant request and admin tasks su  
number



## Notice of Nov. 22, 2021

Non-DOCX surcharge fee  
effective January 1, 2023

**\$400**

*Correction*



# DOCX Filing

- Applicants must file applications in DOCX format in order to avoid the \$400 surcharge
  - Non-provisional utility
  - Does not apply to PCT/US national stage
  - PDF acceptable for drawings
- The PTO will convert the DOCX file into a PDF
- The DOCX file will be the authoritative document for 12 months
- Applicants can review and correct conversion errors in the PDF during this window of 12 months
  - It is important to check both the DOCX and USPTO-generated PDF documents as soon as possible after filing.

# Information Disclosure Statement (IDS)

- Access to Relevant Prior Art initiative
  - Still in Phase 1: continuation applications in **selected** art units; USPTO will retrieve and consider references cited in **parent** application without IDS
  - Second phase: expanding involved art units
  - **Possible future wave: incorporating Global Dossier; substantial elimination of burden of IDS**

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> (Not for submission under 37 CFR 1.99)	Application Number		
	Filing Date		
	First Named Inventor		
	Art Unit		
	Examiner Name		
	Attorney Docket Number		

U.S. PATENTS					
Examiner Initial*	Cite No	Patent Number	Kind Code <sup>1</sup>	Issue Date	Name of Patentee or Applicant of cited Document

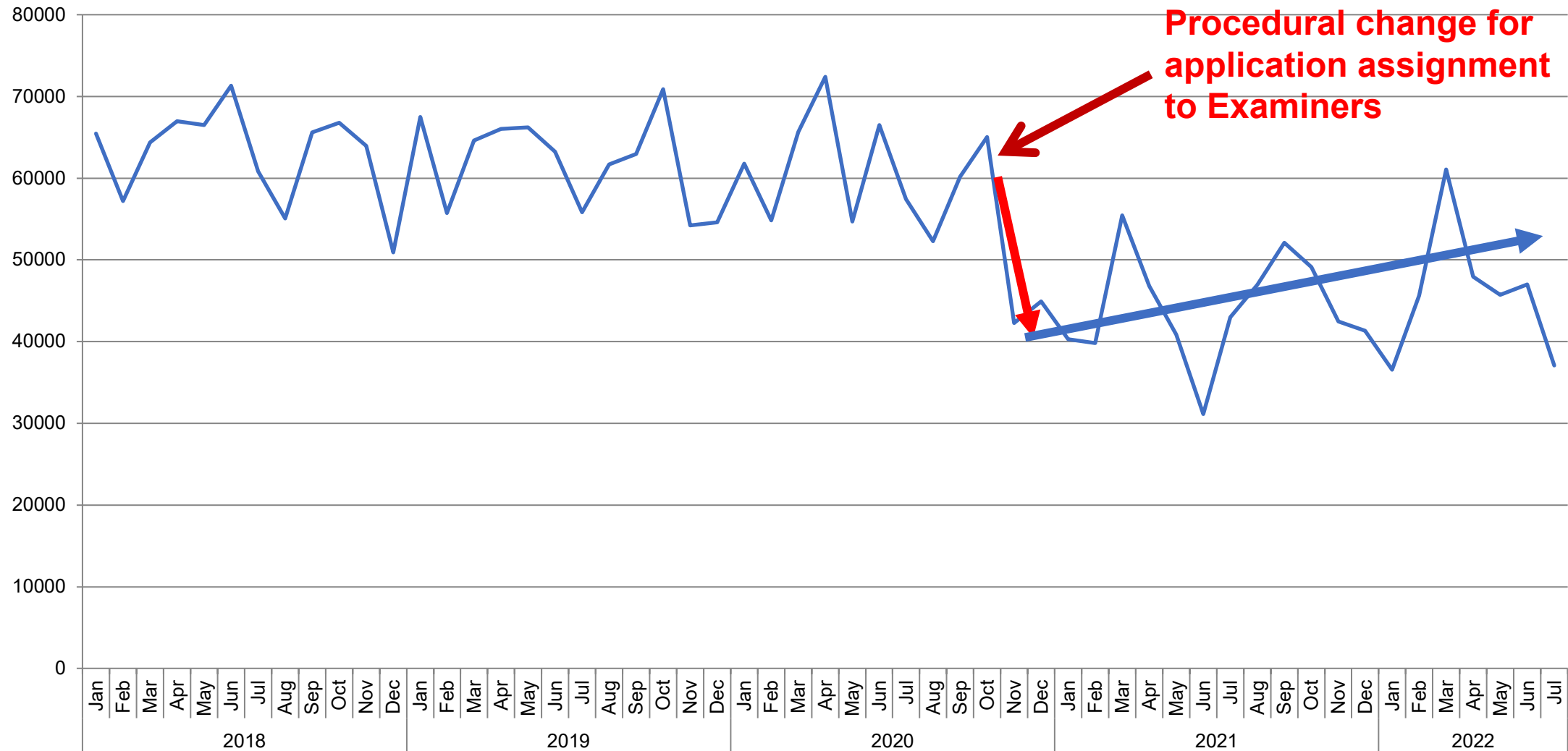
If you wish to add additional U.S. Patent citation information please click the Add button.

U.S. PATENT APPLICATION PUBLICATIONS					
Examiner Initial*	Cite No	Publication Number	Kind Code <sup>1</sup>	Publication Date	Name of Patentee or Applicant of cited Document

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FOREIGN PATENT DOCUMENTS						
Examiner Initial*	Cite No	Foreign Document Number <sup>3</sup>	Country Code <sup>2</sup>	Kind Code <sup>4</sup>	Publication Date	Name of Patent Applicant of cited Document

# USPTO Office Actions



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# After Final Consideration Pilot 2.0

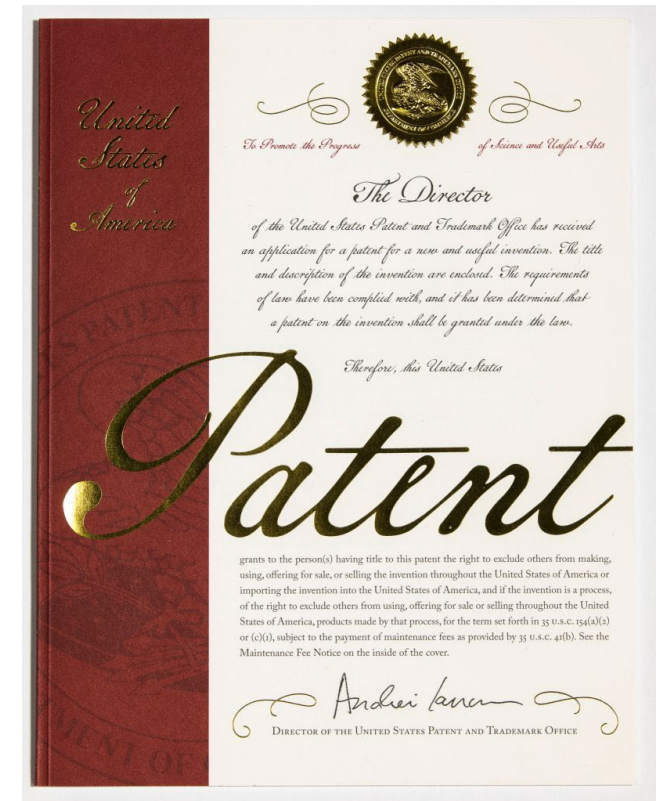
The After Final Consideration Pilot 2.0 (AFCP 2.0) has been extended through **September 30, 2023**. AFCP 2.0 is part of the USPTO's on-going efforts towards compact prosecution and increased collaboration between examiners and stakeholders.

"If you are considering filing a response to a final rejection under 37 CFR 1.116 that you believe will lead to allowance of your application with only limited further searching and/or consideration by the examiner, you should consider requesting consideration of the response under AFCP 2.0."

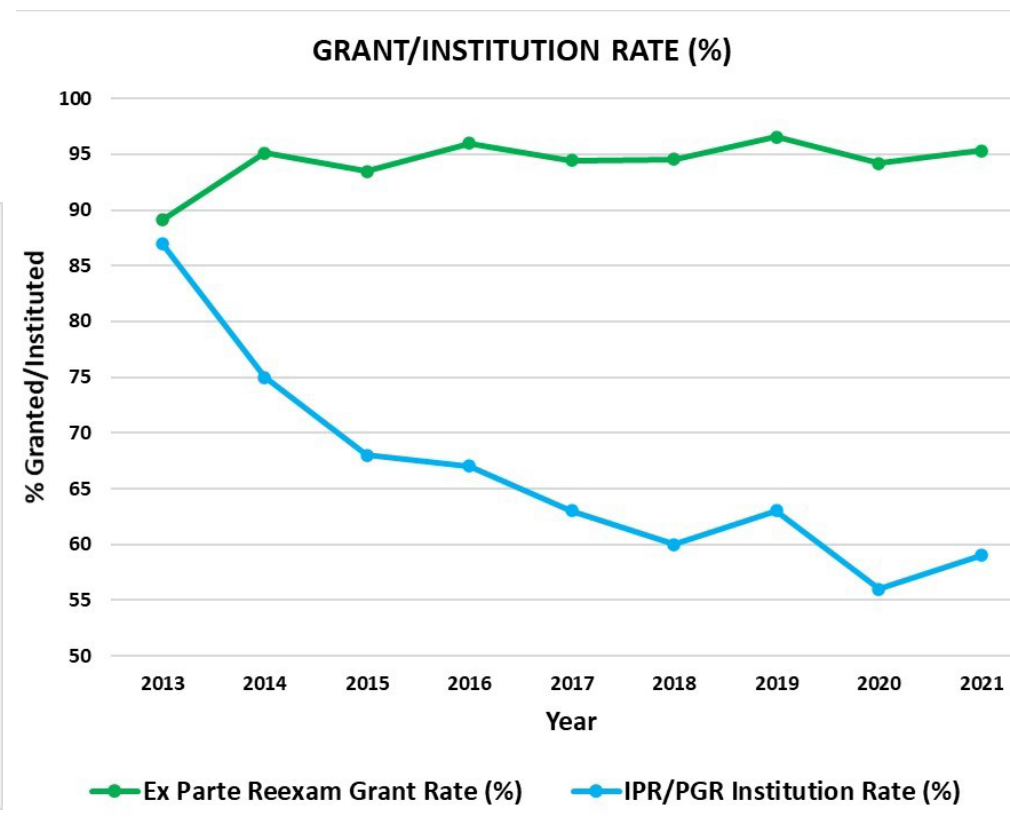
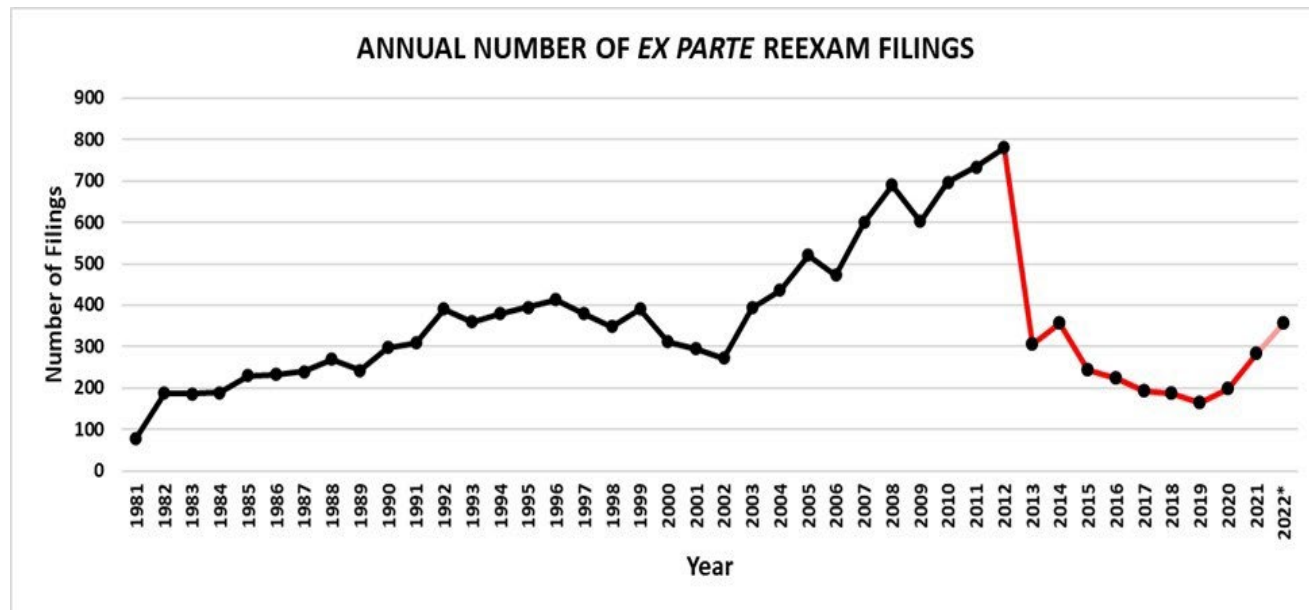


# Electronic Patents Coming Soon

- USPTO to Issue Patents Electronically
  - Official copy (with seal and Director's signature) to be available for downloading
    - Announced for 2022 ...
- Paper copies will still be available for \$25



# Ex Parte Reexamination on the Rise Again



Source: M. Sartori, published in LAW360, August 2022

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35 USC 112(a) includes three distinct requirements:

1. **Written Description**
2. **Enablement**
3. **Best Mode**

## The Written Description Requirement

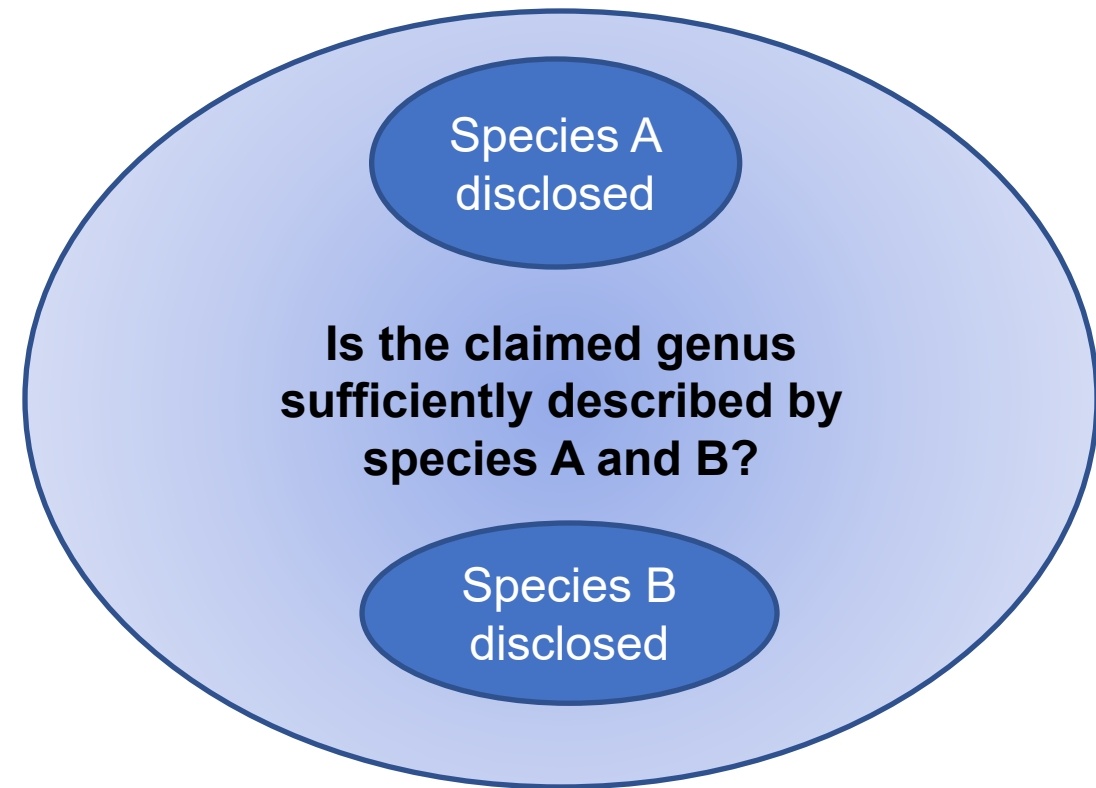
**35 USC 112(a): The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention**

# The Written Description Requirement

- The specification must **describe** the claimed invention in sufficient detail such that one skilled in the art can reasonably conclude that **the inventor had possession of the claimed invention at the time of filing**
- The level of detail required varies depending on the scope of the claims and on the complexity and **predictability of the relevant technology**
  - Information that is well known in the art need not be described **in detail** in the specification

# Genus claims supported by disclosure of species

- There is no special rule for supporting a claimed genus by the disclosure of a species
- Disclosure of the species must be sufficient to convey to one skilled in the art that the inventor possessed the subject matter of the genus
- Whether a genus is supported **depends upon the technology**, the state of the art and the scope of the genus





# Example from the Mechanical Arts

*Based on Ascion v. Ashley Furniture (Fed. Cir. 2022)*

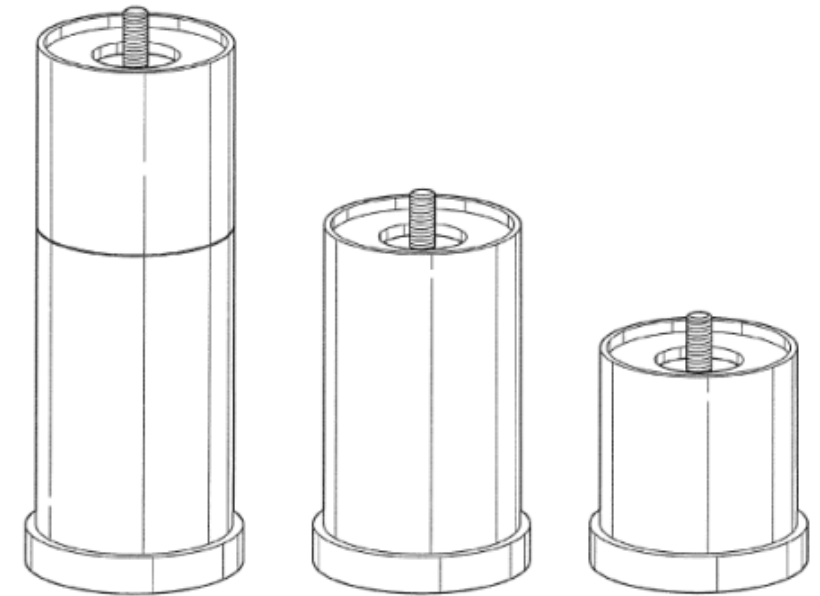
The asserted patent described legs for a mattress frame

Claim 1 recited:

... a first leg having a body portion with an outer surface, a top end and an opposite bottom end, **the bottom end having a horizontal bottom surface...**

The specification did not provide any information about the bottom surface, and the bottom surface cannot be seen in drawings

**Question:** Does the specification sufficiently describe the claimed bottom surface with a horizontal surface?



**FIG. 58A**

**FIG. 58B**

**FIG. 58C**

# Example from the Mechanical Arts

*Based on Ascion v. Ashley Furniture (Fed. Cir. 2022)*

**Patentee** argued that one skilled in the art would have inferred from portions of the specification and drawings that the bottom surface was horizontal

**District Court** (W. D. Wisconsin): Granted motion for summary judgment that Claim 1 is invalid for lack of written description

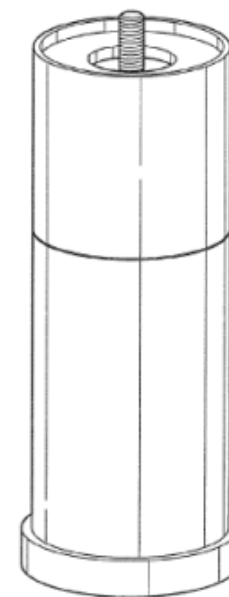


FIG. 58A

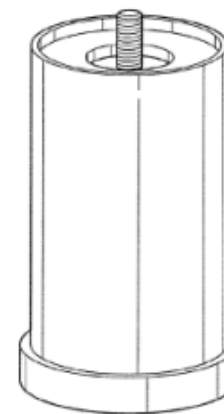


FIG. 58B

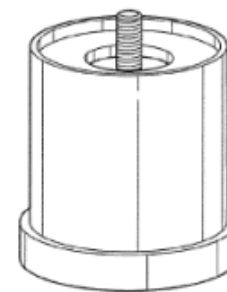


FIG. 58C



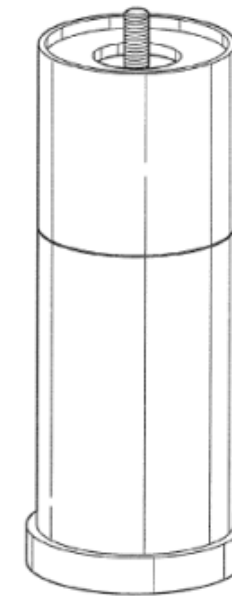


# Example from the Mechanical Arts

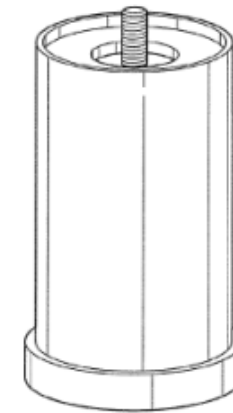
*Based on Ascion v. Ashley Furniture (Fed. Cir. 2022)*

## CAFC:

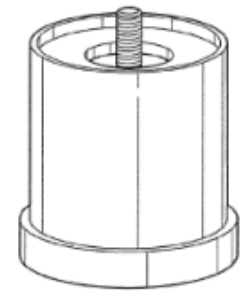
- In the predictable field of mechanical inventions, the level of detail required to satisfy the written description requirement is lower than for unpredictable arts
- In this case, one skilled in the art could conclude that the specification discloses legs with horizontal bottom surfaces
- Summary judgement was not justified in this case: the case was **remanded**



**FIG. 58A**



**FIG. 58B**



**FIG. 58C**



# Example from the Electrical Arts

*Based on Hynix Semiconductor Inc. v. Rambus Inc. (Fed. Cir. 2011)*

The asserted patent described a bus interface for computer systems

The specification mentioned “a bus,” but only disclosed embodiments with a **multiplexed** bus:

***‘The present invention is designed to provide a high speed, multiplexed bus for communication between processing devices and memory devices ...***

\*\*\*\*

*Another major advantage of **this invention** is that it drastically reduces the memory system power consumption. ... **By using a multiplexed (time-shared) bus, the pin count for an arbitrarily large memory device can be kept quite small-on the order of 20 pins.***



# Example from the Electrical Arts

*Based on Hynix Semiconductor Inc. v. Rambus Inc. (Fed. Cir. 2011)*

*Asserted claim: A memory device comprising:*

*...*

*a driver to output data on a bus in response to the first and second internal clock signals*

*....*

- The asserted claim recited a bus, not a “multiplexed bus”
- In litigation, the patentee asserted that the claimed “bus” covered both multiplexed and non-multiplexed buses
- **Question:** Does the disclosure reasonably convey to one skilled in the art that the inventor had possession of an invention using a generic bus?



# Example from the Electrical Arts

*Based on Hynix Semiconductor Inc. v. Rambus Inc. (Fed. Cir. 2011)*

- During trial, a technical expert testified that:
  - The invention would not be undermined using a non-multiplexed bus
  - Persons of ordinary skill in the art would understand that buses “come in all shapes and sizes”



# Example from the Electrical Arts

*Based on Hynix Semiconductor Inc. v. Rambus Inc. (Fed. Cir. 2011)*

The CAFC relied on the expert testimony and found that in view of the level of skill in the art, the disclosure of a species (the multiplexed bus) was sufficient to support the genus (the generic bus).

The Court explained:

“Whether the genus is supported [or not] depends upon the state of the art and the nature and breadth of the genus.”

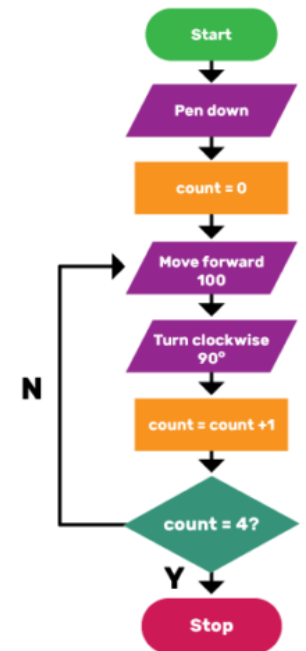
“[S]o long as disclosure of the species is sufficient to convey to one skilled in the art that the inventor possessed the genus, the genus will be supported by an adequate written description.”

# Example from the Software Arts

- For each function of the software, the specification must disclose **the computer and the algorithm that achieve the claimed function**
- The specification **must describe/explain how** the claimed function is achieved
  - It is not enough that one skilled in the art **could** theoretically write a program to achieve the claimed function

"Move forward 100 pixels, then  
turn clockwise 90 degrees.  
Do this a total of 4 times."

```
pen Down  
count <- 0  
  
repeat until count = 4  
  forward 100  
  clockwise 90°  
  count = count + 1
```



# Example from the Software Arts

Based on *TransPerfect Global, Inc. v. Matal* (Fed. Cir. 2017)

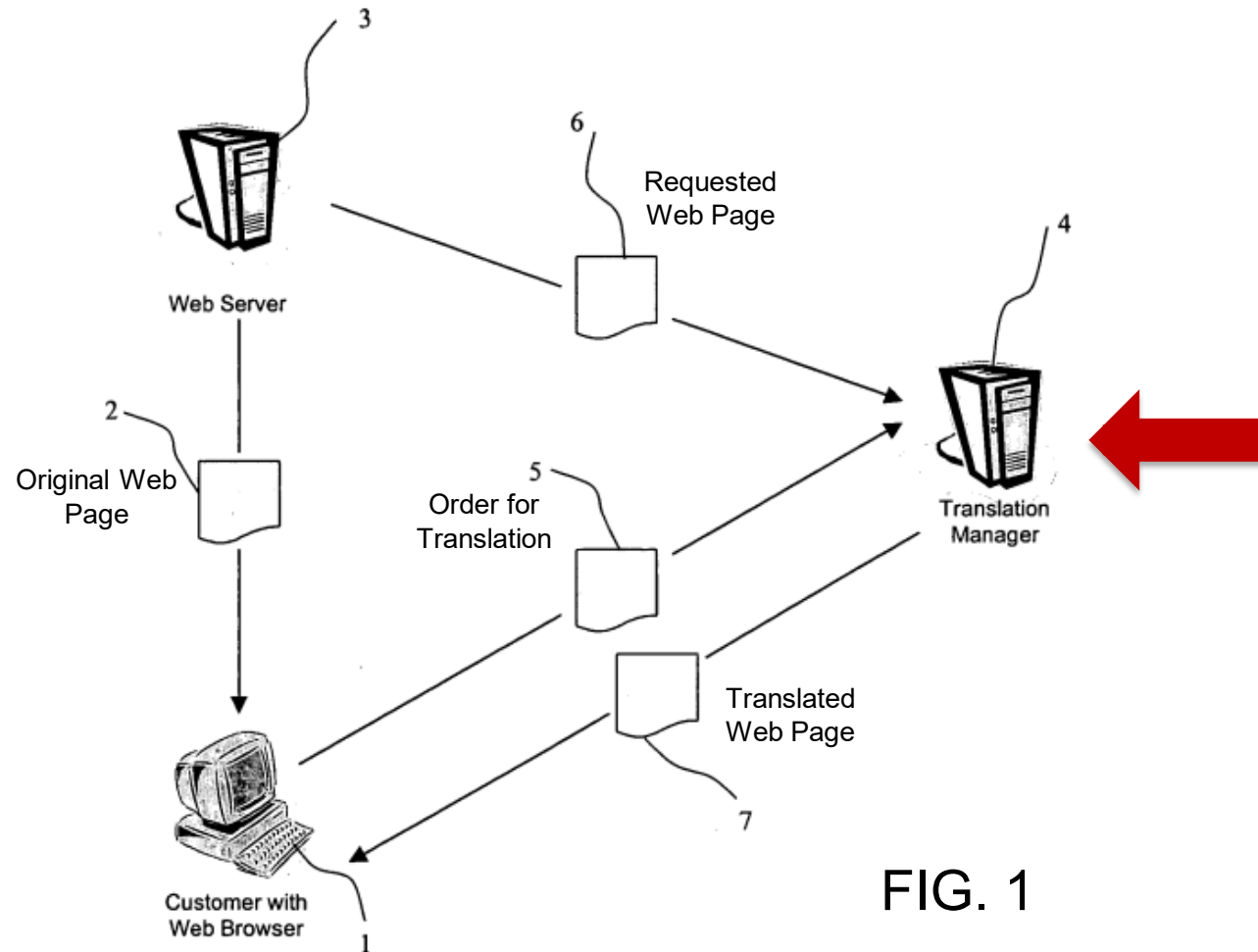


FIG. 1



## Example from the Software Arts

Based on *TransPerfect Global, Inc. v. Matal*, (Fed. Cir. 2017)

1. A method of ordering a translation of web page comprising text and **original hyperlinks** to further web pages, including the steps of:  
a user clicking to request a translation of said text from a translation manager;  
said translation manager obtaining a translation of said text, and  
transmitting said translation to said user; and  
**providing translation of said further web pages when said original hyperlinks are activated.**

**Question:** Does the specification provide a description of how to achieve the limitation of providing translation of the further web pages when the original (untranslated) hyperlinks are activated?





## Example from the Software Arts

Based on *TransPerfect Global, Inc. v. Matal* (Fed. Cir. 2017)

- The CAFC finds that the claim **lacks written description** under § 112(a)
- The specification does **not** describe how the web browser provides translation of the further web pages when the **original** (untranslated) hyperlinks are activated
  - Not enough that one of ordinary skill in the art could write a program to replace original hyperlinks with translated hyperlinks to retrieve the translated web pages from the translation manager

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## OVERVIEW

- A forum selection clause in a license or confidential agreement can protect the patentee from PTAB challenges launched by the other party to the agreement
  - *Dodocase VR v. MerchSource* (Fed. Cir. 2019)
  - *Kannuu Pty v. Samsung Electronics* (Fed. Cir. 2021)
  - *Nippon Shinyaku v. Sarepta Therapeutics* (Fed. Cir. 2022)

## *Dodocase VR v. MerchSource* (Fed. Cir. 2019)

- The parties entered into a **license** agreement with a forum selection clause requiring that disputes “**arising out of or under**” the agreement be brought in California courts
- The parties disagreed whether certain products were covered by the licensed patent
- The licensee elected to challenge the licensed patents via post grant proceedings at the PTAB (USPTO) rather than to pay royalties for the products
- Question: Do PTAB petitions constitute disputes “arising out of or under” a license agreement?
- CAFC: **Yes**, the validity of a licensed patent is an issue arising out of or under a license agreement
  - The PTAB petitions at the USPTO must be withdrawn
  - Instead, the licensee must challenge the validity of the licensed patents in California court, as required by the forum selection clause

## *Kannuu Pty v. Samsung Electronics* (Fed. Cir. 2021)

- The parties entered into a **Mutual Confidentiality Agreement** (MCA) with a forum selection clause requiring that any legal action “**arising out of or relating to**” the MCA be brought in New York courts
- The potential deal fell apart and Kannuu sued Samsung for patent infringement
- Samsung filed an IPR petition at the PTAB (USPTO) against the asserted patent
- Question: Do IPR petitions constitute legal actions arising out of or relating to an MCA?
- CAFC: **No**, the validity of a patent does not impact the parties’ confidential obligations

- *Nippon Shinyaku v. Sarepta Therapeutics* (Fed. Cir. 2022)

- The parties entered into a **Mutual Confidentiality Agreement** (MCA) with a forum selection clause requiring that all legal actions “**relating to patent infringement or invalidity**” be brought in Delaware District Court
- The potential deal fell apart and Sarepta filed IPR petitions at the PTAB (USPTO) against Nippon Shinyaku’s patents
- Question: Do IPR petitions constitute legal actions relating to patent invalidity?
- CAFC: **Yes**, the plain and explicit language of the MCA shows that the parties negotiated the right to challenge a patent at the PTAB (USPTO)
  - Sarepta bargained-away its right to file the IPR petitions

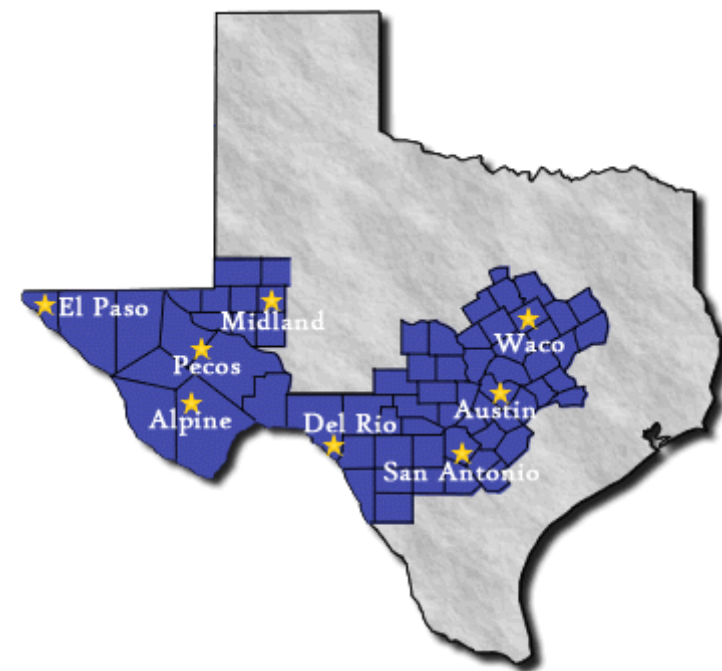
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## Order in the *Western* District of Texas

- In 2020 and 2021, the WDT was the top venue for patent litigation (25% of all cases), especially for Non-Practicing-Entities
- Judge Alan Albright (Waco Div.), former patent litigator, **was the sole judge for all patent litigations** filed in the Waco division of the WDT
  - Fast procedures and patentee friendly rulings
- Many organizations, Congress, and the CAFC criticized the situation
- In July 2022, the Chief Judge of WDT ordered that all patent litigations filed in Waco be randomly assigned among 12 judges of the district
  - Since then, there is a sharp drop (50%) in patent litigations filed in WDT







# A.I. is not an inventor under US statute

- Stephen Thaler created DABUS, an artificial intelligence system that generates inventions
  - Filed patent applications identifying DABUS as the “inventor” in a dozen countries
- In 2020, the USPTO refused to examine the application because it does not name an inventor
- **In 2021, the E.D. VA affirms:** The patent statute (35 USC 100, 101, 115) define an “inventor” as an “**individual**”
  - Supreme Court previously defined an “individual” as a “**natural person**”
  - CAFC previously held that “inventors must be natural persons”
    - Case law defines an inventor as an individual who conceives, which is a “mental act” taking place “in the mind of” an inventor
- **In August 2022, the CAFC affirmed**





# The Patent Eligibility Restoration Act of 2022

**Current 35 USC 101:** Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor...

**Except for ... the judicial exceptions** of an abstract ideas, products of nature, and natural phenomena

June 2022: Supreme Court denies review of *American Axle* case (Claims directed to a method of manufacturing an automobile drive shaft with a liner tuned to reduce vibrations is invalid under 35 USC 101)

## **Proposed 35 USC 101:**

Paragraph (a) same as current statute, “**subject only to the exclusions in subsection (b)**”:

- (A) A mathematical formula, apart from a useful invention or discovery.
- (B) A process that— (i) is a **non-technological** economic, financial, business, social, cultural, or artistic process; (ii) is a mental process performed solely in the human mind; or (iii) occurs in nature wholly independent of, and prior to, any human activity.
- (C) An **unmodified human gene**, as that gene exists in the human body.
- (D) An unmodified natural material, as that material exists in nature.



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Managing Partner

# The Equitable Doctrine of Assignor Estoppel

- Federal common law: an assignor may not challenge the validity of the assigned patent
- 2021 Supreme Court decision (*Minerva v. Hologic*): Assignor estoppel applies only when the validity challenge contradicts a representation made in the assignment
  - Case remanded to the CAFC to check if this condition is satisfied in this case
- 2022 CAFC decision (*Minerva v. Hologic*): inventor/founder of accused infringer is barred by the doctrine of assignor estoppel from challenging the asserted patent



## *Minerva v. Hologic (CAFC 2022)*

### Simplified facts

- Patent applications were assigned to a company, which was later acquired by the owner of the asserted patent
  - **The assignment included a warranty as to the assigned claims' validity** by stating that the assignor had no present knowledge from which the assignor could reasonably conclude that the assigned patent rights were invalid or unenforceable
- Asserted claim were amended after the assignment was executed
- Court finds that the asserted claim is not "materially broader" than the assigned claims
- Thus, the assignment included a warranty as to the **asserted** claim
- Thus, a validity challenge by the assignor contradicts the warranty in the assignment and the doctrine of assignor estoppel bars such a validity challenge