

DROIT AMERICAIN DES BREVET

Mise à Jour 2023



Philippe Signore
U.S. Patent Attorney

Copyright © 2023 Oblon, McClelland, Maier & Neustadt, LLP

1

DROIT AMERICAIN DES BREVET

Programme – 1^{ère} partie

1. Domaine Brevetable (35 USC 101)

2. Suffisance de Description (« enablement » 35 USC 112)
3. Interprétation des Revendications
4. Entité inventive

Programme – 2^{ème} partie

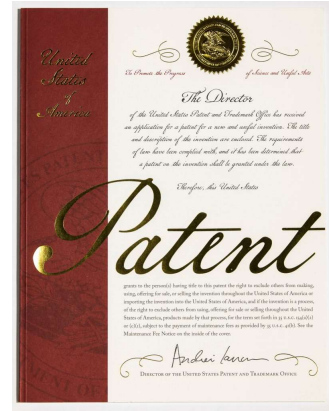
5. Stratégies d'Examen
6. Devoir de Divulgation
7. Estoppel du Pétitionnaire de Procédures Post-Délivrance
8. Morceaux Choisis

Copyright © 2023 Oblon, McClelland, Maier & Neustadt, LLP

2

35 U.S.C. 101: Inventions patentable

Whoever invents any new and useful **process, machine, manufacture, or composition of matter** ... may obtain a patent therefor, subject to the conditions of this title.



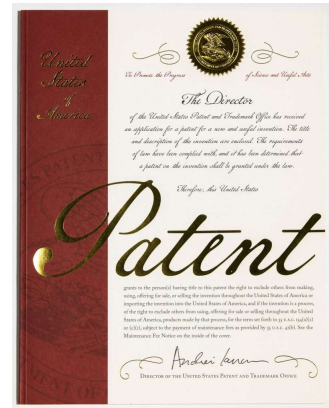
Copyright © 2023 Oblon, McClelland, Maier & Neustadt, LLP

OBLON

3

Judicial Exceptions to 35 U.S.C. 101

- Supreme Court cases have long recognized **three judicial exceptions** to patent eligibility:
 - **Abstract ideas**: intellectual concepts, mathematical formulas, or methods of organizing human activity (*Alice* (Sup. Ct. 2014))
 - **Laws of nature**: scientific principles, biological processes (*Mayo* (Sup. Ct. 2012))
 - **Natural phenomena/products**: substances, materials (*Myriad* (Sup. Ct. 2013))



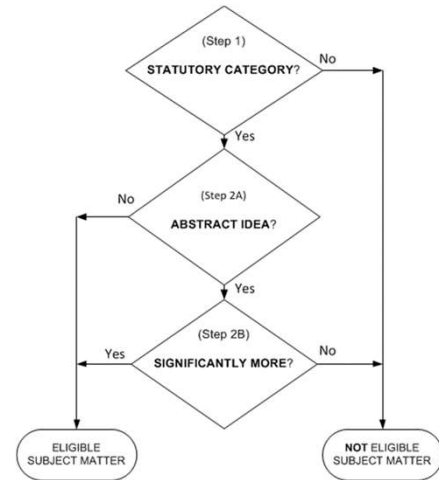
Copyright © 2023 Oblon, McClelland, Maier & Neustadt, LLP

OBLON

4

Mayo/Alice Framework (2012-2014)

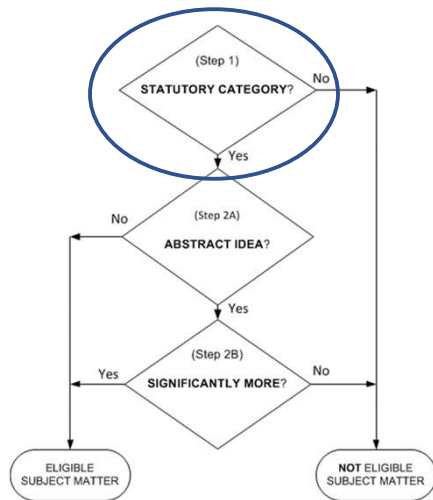
- Step 1: Does the claim recite one of the four statutory categories?
- Step 2A: Is the **core concept** of the claim directed to one of the three judicial exceptions: an abstract idea, a law nature, or a natural phenomenon
- Step 2B: Does the claim recite additional elements that transform the claim into something “significantly more” than just the judicial exception



Copyright © 2023 Oblon, McClelland, Maier & Neustadt, LLP

5

Sequoia Technology v. Dell (CAFC April 2023)

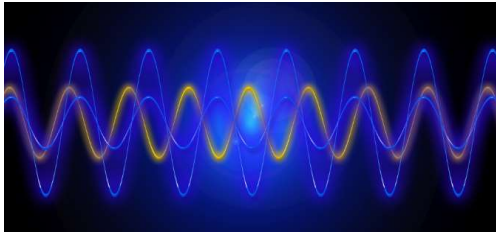


- **Claim:** A computer-readable recording medium storing instructions for executing a method comprising the steps of:
 - a) ...
- **Question for the court:** Should “computer-readable recording medium” be interpreted to cover **transitory** signals?
 - If so, claim is invalid under 35 U.S.C. 101 as directed to a non-statutory category

Copyright © 2023 Oblon, McClelland, Maier & Neustadt, LLP

6

Sequoia Technology v. Dell (Fed. Cir. April 2023)



- Side note: The USPTO's 2010 guidelines state that “computer-readable medium” should be interpreted broadly enough to include transitory media (signals)
- This is the reason why USPTO examiners sometimes ask applicant to add “non-transitory” in front of “computer-readable medium” in order to satisfy 35 USC 101
- During litigation, such as the *Sequoia Technology v. Dell* case, the judge does not rely on this USPTO guideline
- Instead, the district court judge interprets the claims based on the intrinsic evidence of the patent:
 - Claims
 - Specification
 - Prosecution History

Copyright © 2023 Oblon, McClelland, Maier & Neustadt, LLP

7

Sequoia Technology v. Dell (Fed. Cir. April 2023)

- In this case, the **Court** finds that “**computer-readable recording medium**” does NOT cover transitory signals because the claim limitations **and the specification** only gives examples of hardware computer-readable medium including RAM, CDROM, and types of disk drives
 - Therefore, the claim satisfies 35 U.S.C. 101
- Practical Tips:
 - Specify non-transitory in the specification and claims
 - Describe examples of specific components for implementing the invention, **even when these components are conventional**
 - Other benefits of describing examples of conventional components for claimed limitations:
 - Render limitations less abstract
 - Provides support for means-plus-function limitations
 - See e.g., *WSOU v. Google* (CAFC Sept 2023) holding the claims reciting “means for issuing an alert” invalid as indefinite under 35 USC 112(b) because of insufficient structure described in the specification for issuing the alert



Copyright © 2023 Oblon, McClelland, Maier & Neustadt, LLP

8

Nianti (Google) v. NantWorks

District of Northern California (Jan 2023)

- Claim: A **device** for rendering augmented reality (AR), comprising:
 - a location sensor;
 - a display;
 - a **non-transitory computer readable memory storing software instructions**; and
 - a processor configurable to obtain sensor data ...
- ...
render an AR object on the display as an overlay of an image related to the real world
- Question for Court: Should this claim be interpreted to cover an abstract idea and thus invalid under 35 U.S.C. 101



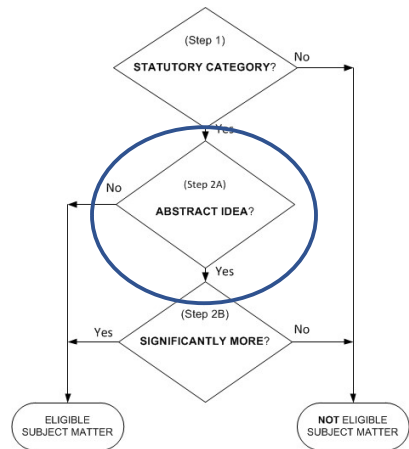
Copyright © 2023 Oblon, McClelland, Maier & Neustadt, LLP

9

Nianti (Google) v. NantWorks

District of Northern California (Jan 2023)

- Step 2A**
 - Patentee argues that claim is directed to improving AR content management
 - Accused infringer argues that claim is directed to abstract idea of providing information based on a location on a map
 - Court agrees with accused infringer
 - The focus of the claim is collecting information, analyzing it and displaying it
 - Next: Go to Step 2B



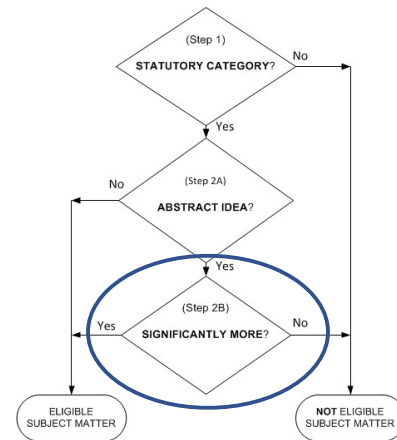
Copyright © 2023 Oblon, McClelland, Maier & Neustadt, LLP

10

Nianti (Google) v. NantWorks

District of Northern California (Jan 2023)

- **Step 2B:**
 - The court finds that the claim does **not** recite “significantly more” than the abstract idea
 - The other limitations recited in the claim are **generic** computer components
 - The claim does not recite steps related to a specific improvement in computer technology
 - Any discussion of improvement in technology is discussed only in the specification
 - Claim is interpreted as covering only an abstract idea and is this invalid under 35 U.S.C. 101



Copyright © 2023 Oblon, McClelland, Maier & Neustadt, LLP

11

Nianti (Google) v. NantWorks

District of Northern California (Jan 2023)

- Practical Tips:
- **Claim how** the technical features provide a specific solution to the identified problem
 - Claim the link between the structures/steps and the solution to the technical problem
 - Not enough to claim a desired result
 - Use **dependent claims** to recite specific problem/solution
 - Other benefit of **claiming** the problem/solution:
 - Limit the universe of “analogous” prior art. See *Netflix v. DivX* (CAFC Sept 2023): prior art reference not analogous because it is from a different field, **and it does not address the claimed problem to be solved**
 - Limit motivation-to-combine analysis to finding a motivation in the prior art to solve **the claimed technical problem**. See *Axonics v. Medtronic* (CAFC July 2023)
- **Avoid making admissions** that the techniques and steps to implement the invention are well-known and conventional



Copyright © 2023 Oblon, McClelland, Maier & Neustadt, LLP

12

DROIT AMERICAIN DES BREVET

Programme – 1^{ère} partie

1. Domaine Brevetable (35 USC 101)
2. Suffisance de Description (« enablement » 35 USC 112)
- 3. Interprétation des Revendications**
4. Entité inventive

Programme – 2^{ème} partie

5. Stratégies d'Examen
6. Devoir de Divulgence
7. Estoppel du Pétitionnaire de Procédures Post-Délivrance
8. Morceaux Choisis

13

Claim Interpretation

- General Rule of Interpretation
 - **comprising** a microprocessor = including one or more microprocessor
 - See e.g., *Baldwin Graphic v. Siebert* (CAFC, 2008)
 - A system to clean the cylinder of printing machines **comprising:**
 a **fabric roll** saturated with solvent, **said** fabric roll having a sleeve which can be removed from **said** fabric roll for use of said fabric roll....
 - Claim interpreted by CAFC to cover systems with **one or more** fabric roll

“The name of the game is the claim”



Judge Rich (1904-1999)

14

Claim Interpretation

Salazar v. AT&T (Fed. Cir. Apr. 2023)

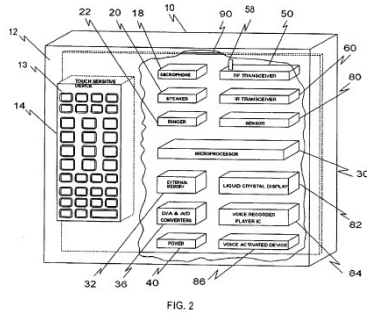
USP 5,802,467, Claim 1

A system . . . **comprising:**

a microprocessor for generating . . . ,
said microprocessor creating . . . ;

. . . **said microprocessor** configured to
 store a plurality of parameter sets retrieved
 by **said microprocessor** . . . ;

. . . **said microprocessor** generating . . .



Issue: Whether the claims require a **single microprocessor** that is capable of performing **all** the recited “generating,” “creating,” “retrieving,” and “generating” functions

Copyright © 2023 Oblon, McClelland, Maier & Neustadt, LLP

OBLON

15

15

Claim Interpretation

Salazar v. AT&T (Fed. Cir. Apr. 2023)

- **Patentee: No**
 - The claim should be interpreted to encompass one microprocessor capable of performing one claimed function and another microprocessor capable of performing a different claimed function, even if no one microprocessor could perform all of the recited functions
- **District Court: Yes**
 - The Court interpreted the term to mean “one or more microprocessors, **at least one of which is configured to perform** the generating, creating, retrieving, **and** generating functions”
 - **No infringement** because AT&T’s accused system uses **multiple** microprocessors for performing the various claimed functions

Copyright © 2023 Oblon, McClelland, Maier & Neustadt, LLP

OBLON

16

16

Claim Interpretation

Salazar v. AT&T (Fed. Cir. Apr. 2023)

- CAFC affirms the district court and focuses on the claim language:
 - The indefinite article “**a**” means “**one or more**” in **open-ended claims** containing the transitional phrase “**comprising**”
 - The use of the term “**said**” indicates that this portion of the limitation is a **reference back** to the previously claimed term
 - **The subsequent limitations** referring to “**said microprocessor**” require that **at least one microprocessor be capable of performing each of the claimed functions**
 - See *Convolve v. Compaq* (CAFC 2016)


17

Claim Interpretation

Practical Tip: Use **express** language in the claims to obtain the intended interpretation

- **Broad** interpretation: See *Salazar v. AT&T*
- **Narrow** interpretation: The current trend from the CAFC is to refuse to import a limitation from the specification into the claims
 - *Masimo v. Sotera* (CAFC, Sept 2023)
 - Court affirmed the PTAB’s broad interpretation of “trigger an alarm based on exceeding threshold” as not requiring that exceeding the threshold directly triggers the alarm
 - *Sisvel v. Sierra Wireless* (CAFC, Sept 2023)
 - Court affirmed the PTAB’s broad interpretation a particular type of “message” as not limited to a message from GSM/UMTS networks, although the disclosed embodiments all focused on GSM/UMTS networks
 - *DaliWireless v. CommScope* (CAFC, Sept 2023)
 - Court affirmed the PTAB’s broad interpretation of “sending signal to any unit” as not limited to sending signals to a specific unit despite embodiments showing selective sending of signals

18



DROIT AMERICAIN DES BREVET


Programme – 1^{ère} partie

1. Domaine Brevetable (35 USC 101)
2. Suffisance de Description (« enablement » 35 USC 112)
3. Interprétation des Revendications
4. Entité inventive


Programme – 2^{ème} partie

5. Stratégies d’Examen
- 6. Devoir de Divulgation**
7. Estoppel du Pétitionnaire de Procédures Post-Délivrance
8. Morceaux Choisis

Copyright © 2023 Oblon, McClelland, Maier & Neustadt, LLP



19



The Duty of Disclosure

- 37 CFR 1.56: **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**
- Information is material to patentability when it is **not cumulative** to information 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 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

INFORMATION DISCLOSURE STATEMENT BY APPLICANT		Complete if Known	
Application Number		Filing Date	
First Named Inventor		Group AUI Unit	
Inventor Name		Attorney Docket Number	
Sheet	of		

OTHER PRIOR ART – NON PATENT LITERATURE DOCUMENTS			
Sequence No.	Doc. No.	Include title of the document, inventor, applicant, assignee, title, date, non-patent, magazine, journal, book, newspaper, radio, TV, film, video, CD, DVD, digital, internet, etc. (include country where filed)	Yes

IDS

Copyright © 2023 Oblon, McClelland, Maier & Neustadt, LLP

20

Reminder about the Importance of the Duty of Disclosure

Global Tubing v. Tenaris (Southern District of Texas, March 2023)

- Juge ruled that the Tenaris **patents were unenforceable** because of a **breach of the duty of disclosure** during prosecution
 - **Materiality:** Tenaris failed to disclose a brochure disclosing “essentially” the invention
 - **Intent:** Internal Tenaris communication stating “I’m not sure it is a good idea to disclose this brochure”



Copyright © 2023 Oblon, McClelland, Maier & Neustadt, LLP

21

Reminder about the Importance of the Duty of Disclosure

Bridgestone v. Speedways (Northern District of Texas, August 2023)

- Court refused to hold that the patentee committed inequitable conduct
 - The basis for the intent to mislead the USPTO was that the prosecuting attorney attempted to hide three prior art references “in a sea of less material references” (about 200 references)
 - Hiding references in a sea of other references is not the same as not disclosing the prior art references



Copyright © 2023 Oblon, McClelland, Maier & Neustadt, LLP

22

Reminder about the Importance of the Duty of Disclosure

Bridgestone v. Speedways (Northern District of Texas, August 2023)

- Practical Tip: Find the right balance
- The more references we disclose:
 - ✓ the less the risk of a breach of the duty of disclosure
 - ✓ the more difficult it is to invalidate the issued patent
- the more costly prosecution can be?
- the higher risk that more prior art is analogous and/or combinable to show obviousness
 - See *Elekta v. ZAP Surgical* (Fed. Cir. 2023) The patentee claimed a radiation therapy invention, but included references to imaging devices in its IDS. That inclusion (along with some other evidence) led to a conclusion that PHOSITA would generally be motivated to combine prior art across these two different fields



Copyright © 2023 Oblon, McClelland, Maier & Neustadt, LLP

23

Duty of Candor and Good Faith in Post-Grant Proceedings

Spectrum Solutions v. Longhorn Vaccines & Diagnostics (PTAB, June 2023)

- 37 CFR 42.11(a) **Duty of candor.** Parties involved in a proceeding have a duty of candor and good faith to the Office during the course of the proceeding.
- During an IPR, Patentee submitted test results in support with the novelty and non-obviousness of the claims
- During a deposition, the employee from the testing lab revealed that the patentee withheld some test results inconsistent with Patentee's arguments
- Sanction: All 183 challenged claims cancelled by the PTAB



Copyright © 2023 Oblon, McClelland, Maier & Neustadt, LLP

24

DROIT AMERICAIN DES BREVET

Programme – 1^{ère} partie

1. Domaine Brevetable (35 USC 101)
2. Suffisance de Description
(« enablement » 35 USC 112)
3. Interprétation des Revendications
4. Entité inventive

Programme – 2^{ème} partie

5. Stratégies d'Examen
6. Devoir de Divulgation
- 7. Estoppel du Pétitionnaire de Procédures Post-Délivrance**
8. Morceaux Choisis

25

Estoppels from *Inter Partes* Reviews

- 35 USC 315(e)(2): Following an IPR, the petitioner may not assert that a claim is invalid on *any ground the petitioner raised or reasonably could have raised* during the IPR
- Estoppel applies only **after a final written decision** from the PTAB
 - No estoppel if the IPR is not instituted
 - No estoppel if the IPR settles prior to the final written decision.



26

Estoppels from *Inter Partes* Reviews

Ironburg Inventions v. Valve Corp. (Fed. Cir. April 2023)

- Ironburg sued Valve for patent infringement
- Valve filed an IPR petition based on several grounds
- PTAB partially instituted on some of the asserted grounds and issued a final decision confirming some claims
 - Note, this IPR was pre-SAS 2019 Supreme Court decision preventing PTAB to partially institute
- The district court held:
 - (1) Valve was **estopped** from litigating the grounds included in the IPR petition, **but not instituted**
 - (2) Valve was **estopped** from litigating two other grounds **not raised in the IPR petition**



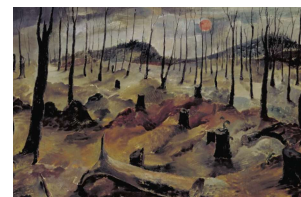
Copyright © 2023 Oblon, McClelland, Maier & Neustadt, LLP

27

Estoppels from *Inter Partes* Reviews

Ironburg Inventions v. Valve (Fed. Cir. April 2023)

- The CAFC held:
 - (1) Valve was estopped from litigating the grounds included in the IPR petition, but not instituted
 - (2) **Remanded the issue of whether Valve was estopped from litigating other grounds not raised in the IPR petition**
- CAFC adopts the **“skilled searcher” standard**: a patent challenger is estopped from asserting later-discovered prior art that “a skilled searcher **conducting a diligent search** could have been expected to discover.”
 - Estoppel does not apply if a “scorched-earth search” was necessary to find prior art
- Patent owner has the burden of proof that estoppel applies
 - May rely on a declaration from a prior art searcher that a reference would have been found using a diligent search



Copyright © 2023 Oblon, McClelland, Maier & Neustadt, LLP

28

DROIT AMERICAIN DES BREVET

Programme – 1^{ère} partie

1. Domaine Brevetable (35 USC 101)
2. Suffisance de Description
(« enablement » 35 USC 112)
3. Interprétation des Revendications
4. Entité inventive

Programme – 2^{ème} partie

5. Stratégies d'Examen
6. Devoir de Divulgence
7. Estoppel du Pétitionnaire de Procédures Post-Délivrance

8. Morceaux Choisis

Copyright © 2023 Oblon, McClelland, Maier & Neustadt, LLP

OBLON

29

35 USC 101 Proposed Legislative Reform

- June 2023: Senators Tillis and Coons introduced the "Patent Eligibility Restoration Act of 2023":
- Article 101 would still identify a process, machine, manufacture or composition of matter as the four categories of patentable subject matter
- **Patent eligibility should be determined without consideration of Sections 102, 103 or 112**
- All **judicial** exceptions to patent eligibility would be eliminated, but some **exceptions would be codified in the law:**
 - A mathematical formula
 - A mental process performed solely in the mind of a human being
 - An unmodified natural material (including a human gene), as that material exists in nature
 - A process that is substantially economic, financial, business, social, cultural, or artistic, except if the process **cannot practically** be performed without the use of a machine or manufacture.



Copyright © 2023 Oblon, McClelland, Maier & Neustadt, LLP

30

Should Judge Newman Retire from the CAFC?

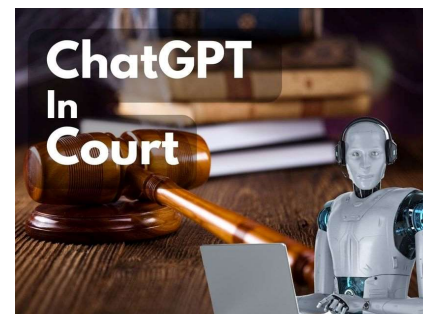
- Ph.D. Chemistry from Yale U.
- Research Scientist
- Inventor on several patents
- Patent Attorney
- In-house Director of IP Department
- Appointed Judge at the CAFC in 1984
- Became known as the “Great Dissenter” and a strong supporter of patent rights
- She is now 95 years old
- Her colleagues at the CAFC are investigating her mental capacity and want her to retire
- She is suing her colleagues to prevent this investigation
- To be continued...



31

Generative Artificial Intelligence in the Courts

- November 2022: Two lawyers filed a brief in the Southern District of New York that had been written in part by ChatGPT
- The judge determined that the brief cited to case law that did not exist and the quotes from these fictitious cases were fabrications by ChatGPT
- June 2023: The judge sanctioned the two lawyers to pay a \$5,000 penalty
- Judges are issuing standing orders for parties to disclose the use of generative A.I. and to certify the accuracy of the A.I.-generated information



32

OBLON

DROIT AMERICAIN DES BREVET

Mise à Jour 2023



Philippe Signore
U.S. Patent Attorney

Copyright © 2023 Oblon, McClelland, Maier & Neustadt, LLP

OBLON