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**ASPI-GRAPI Oct. 3&5, 2023**

**Intellectual Property Law**

# ASPI-GRAPI Oct. 3&5, 2023

Philippe Signore – Nicolas Seckel

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- 1) Domaine brevetable (article 101): quelques décisions
- 2) Suffisance de description: « enablement »
- 3) Interprétation des revendications: quelques décisions
- 4) Entité inventive: co-inventeurs

\*\*\* Pause \*\*\*

- 5) Stratégies d'examen: reissue, continuation, prioritaire...
  - 6) Devoir de divulgation: quelques décisions
  - 7) Procédures post-délivrance: estoppel du pétitionnaire
  - 8) Morceaux choisis: Office US, Congrès, tribunaux
-

ASPI-GRAPI Oct. 3&5, 2023

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Patent-eligible subject matter (section 101):  
A few recent decisions - products/laws of nature

## *Chromadex v. Elysium* (Fed. Cir. Feb. 13, 2023)

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### ■ Chromadex patent claim 1:

1. A composition comprising isolated nicotinamide riboside in combination with one or more of tryptophan, nicotinic acid, or nicotinamide, wherein said combination is in admixture with a carrier comprising a sugar, starch, cellulose, powdered tragacanth, malt, gelatin, talc, cocoa butter, suppository wax, oil, glycol, polyol, ester, agar, buffering agent, alginic acid, isotonic saline, Ringer's solution, ethyl alcohol, polyester, polycarbonate, or polyanhydride, wherein said composition is formulated for oral administration and increased NAD<sup>+</sup> biosynthesis upon oral administration.

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# District Court: invalid under section 101

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- District Court's interpretation: "isolated NR" means "NR that is separated or substantially free from at least **some other components associated with the source of NR**"
  - District Court's conclusion: "the decision to create an oral formulation of NR after discovering that NR is orally bioavailable is **simply applying a patent-ineligible law of nature**"
-

# Federal Circuit: affirmed

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- No “markedly different characteristics” from natural product under Supreme Court case law
  - Citations:
    - S. Ct.: *Diamond v. Chakrabarty* (1980) (patent-eligible)
      - Claimed a genetically engineered bacterium to digest crude oil
    - S. Ct.: *AMP v. Myriad* (2013) (patent-ineligible)
      - Claimed isolated DNA segment
    - Fed. Cir.: *Natural Alternatives v. Creative Compounds* (2019) (patent-eligible)
      - Claimed a dosage (“between about 0.4 to 16 grams of beta-alanine”)
      - Claimed a functionality (“to effectively increase athletic performance”)
-



# Conclusion: control your [claim] language

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## ■ Claim 1:

polyanhydride, wherein said composition is formulated for oral administration and increased NAD+ biosynthesis upon oral administration.

## ■ Fed. Cir.:

- “Milk is formulated for oral administration. See J.A. 10096”
  - “Milk (through tryptophan) increases NAD+ biosynthesis upon consumption”
-

# Note 1: Chromadex dependent claims

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2. The composition of claim 1, wherein the nicotinamide riboside is isolated from a natural or synthetic source.

3. The composition of claim 1, wherein the formulation comprises a tablet, troche, capsule, elixir, suspension, syrup, wafer, chewing gum, or food.

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# Note: Chromadex patent date

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(10) **Patent No.:** **US 8,197,807 B2**

(45) **Date of Patent:** **Jun. 12, 2012**

(12) **United States Patent  
Brenner**

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(54) **NICOTINAMIDE RIBOSIDE KINASE  
COMPOSITIONS AND METHODS FOR  
USING THE SAME**

(75) **Inventor:** **Charles M. Brenner**, Lyme, NH (US)

(73) **Assignee:** **Trustees of Dartmouth College**,  
Hanover, NH (US)

(\*) **Notice:** Subject to any disclaimer, the term of this  
patent is extended or adjusted under 35  
U.S.C. 154(b) by 213 days.

(21) **Appl. No.:** **11/912,400**

(22) **PCT Filed:** **Apr. 20, 2006**

(86) **PCT No.:** **PCT/US2006/015495**  
§ 371 (c)(1),  
(2), (4) **Date:** **Nov. 20, 2007**

(87) **PCT Pub. No.:** **WO2006/116322**

**PCT Pub. Date:** **Nov. 2, 2006**

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# Additional conclusion: control your documents\*

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\* also, treatment of  
business partners

- Elysium was Chromadex's (unhappy) licensee:
  - "Chromadex allegedly provided Elysium with a '**manipulated and misleading Excel spreadsheet**' which purported to list the prices at which ChromaDex was selling [NR] to purchasers other than Elysium under various supply agreements"
  - "The spreadsheet... **inadvertently included 'unblinded' sheets**, which listed additional customers that ChromaDex omitted from the 'blinded' sheets, and **purportedly showed that ChromaDex had agreed to sell NR to other purchasers at a price more favorable** than the price given to Elysium"
-

# *CareDx v. Natera* (Fed. Cir., Jul 18, 2022)

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- Claim 1: A method of detecting transplant rejection... comprising:
    - a) providing a sample comprising cfDNA from a subject who has received a transplant...
    - b) obtaining a genotype of donor-specific polymorphisms...
    - c) multiplex sequencing of the cfDNA...
    - d) **diagnosing**.. a transplant status... by determining a quantity of the donor cfDNA...
-

# CareDx claim: “diagnosing” clause d)

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(d) diagnosing, predicting, or monitoring a transplant status or outcome of the subject who has received the transplant by *determining a quantity of the donor [cfDNA] based on the detection of the donor [cfDNA] and subject [cfDNA] by the multiplexed sequencing, wherein an increase in the quantity of the donor [cfDNA] over time is indicative of transplant rejection, graft dysfunction or organ failure, and wherein sensitivity of the method is greater than 56% compared to sensitivity of current surveillance methods for cardiac allograft vasculopathy (CAV).*

Law of nature

Improved  
Lab technique?

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# CareDx claim: “sequencing” clause c)

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- Claim 1:

(c) multiplex sequencing of the [cfDNA] in the sample followed by analysis of the sequencing results using the polymorphism

- Other claims:

- “genotyping... polymorphism... SNP profiles”
  - “high-throughput sequencing”
  - “digital polymerase chain reaction (dPCR)”
-

# District Court: patent-ineligible

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- No early dismissal
    - Expert discovery on conventionality
  - But Summary judgment of invalidity:
    - Detection of natural phenomenon
    - Conventional detection technique
-

# Fed. Cir.: affirmed

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- No improved laboratory technique
    - “Laws of nature and natural phenomena are not patentable, but applications and uses of such laws and phenomena may be patentable”
    - “We have repeatedly held that **applying standard techniques in a standard way to observe natural phenomena does not provide an inventive concept**”
-



# Note: Stanford (CareDx) patent date

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(10) **Patent No.:** **US 8,703,652 B2**

(45) **Date of Patent:** **Apr. 22, 2014**

(12) **United States Patent**  
**Quake et al.**

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(54) **NON-INVASIVE DIAGNOSIS OF GRAFT  
REJECTION IN ORGAN TRANSPLANT  
PATIENTS**

(75) **Inventors:** **Stephen R. Quake**, Stanford, CA (US);  
**Thomas M. Snyder**, Palo Alto, CA  
(US); **Hannah Valentine**, Stanford, CA  
(US)

(73) **Assignee:** **The Board of Trustees of the Leland  
Stanford Junior University**, Palo Alto,  
CA (US)

(\*) **Notice:** Subject to any disclaimer, the term of this  
patent is extended or adjusted under 35  
U.S.C. 154(b) by 0 days.

(21) **Appl. No.:** **13/508,318**

(22) **PCT Filed:** **Nov. 5, 2010**

(86) **PCT No.:** **PCT/US2010/055604**

§ 371 (c)(1),  
(2), (4) **Date:** **Jul. 19, 2012**

(87) **PCT Pub. No.:** **WO2011/057061**

**PCT Pub. Date:** **May 12, 2011**

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# The operative case law: *Ariosa v. Sequenom* (Fed. Cir. 2015)

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- Sequenom patent claim:
    - Detecting paternally inherited cfDNA of a fetus in the blood of a pregnant female
    - Using conventional PCR
  - Fed. Cir. in *CareDx*: “seeing that the cfDNA exists” [in the sample]
-

# Conclusion: patent-eligibility of diagnostic claims

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Your search for "coffin" didn't match any icons.  
Please try another term.

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# Questions, comments?

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This presentation is not legal advice

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Enablement requirement  
Amgen v. Sanofi (S. Ct. 2023)

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Washington, DC

# Enablement requirement: Amgen v. Sanofi (S. Ct., May 18, 2023)

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- Technology keywords:
    - Antibodies
    - Receptor binding
    - Antibody generation and testing “roadmap”
    - Conservative substitutions
  - Patent keywords:
    - Functional claiming
    - Genus/species claims (broad claims, narrow claims)
    - Enablement (teaching persons of the art to practice the claimed invention)
  - S. Ct. keywords:
    - Unanimous
    - Cites *O’Reilly v. Morse* (1853), *The Incandescent Lamp Patent [Sawyer v. Edison]* (1895), *Holland Furniture v. Perkins Glue* (1928)
    - Does not cite the Federal Circuit’s *In re Wands* (1988)
-



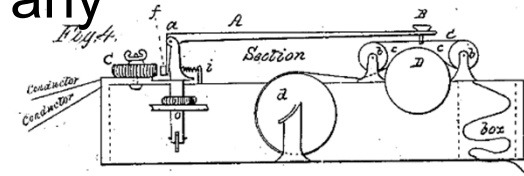
## 35 U.S.C. 112(a): enablement

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- 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
-

# O'Reilly v. Morse (S. Ct. 1853)

- Morse's patent claim 8: "the use of the motive power of the electric or galvanic current... however developed for marking or printing intelligible characters... at any distances"
- Morse's description: "combining two or more electric or galvanic circuits with independent batteries for... overcoming the diminished force of electro-magnetism in long circuits"
- O'Reilly: same (multi-circuit with batteries)
- S. Ct. (1853): "too broad, and not warranted by law... [I]f the eighth claim... can be maintained... no necessity for any specification"
- S. Ct. (2023):
  - "The problem was that it covered all means of achieving telegraphic communication, **yet Morse had not described how to make and use them all**"

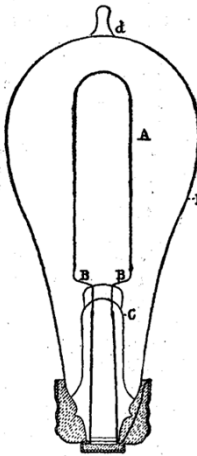


# *Incandescent Lamp*

## *[Sawyer v. Edison] (S. Ct. 1895)*

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- Sawyer's patent claim: electric lamp having incandescing conductor in carbonized fibrous or textile material
- Sawyer's description: carbonized paper
- Edison's product: bamboo
- S. Ct. (1895): “[T]he fact that paper happens to belong to the fibrous kingdom did not invest [Sawyer] with sovereignty over this entire kingdom [of fibrous or textile materials].”
- S. Ct. (2023):
  - “That is not to say a specification always must describe with particularity how to make and use every single embodiment within a claimed class. For instance, it may suffice to give an example (or a few examples) if the specification also discloses **‘some general quality . . . running through’** the class that gives it **‘a peculiar fitness for the particular purpose.’** *Incandescent Lamp*, 159 U.S., at 475.”



# *Holland v. Perkins* (S. Ct. 1928)

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- Perkin's patent claim: "starch glue which... will have substantially the same properties as animal glue"
- Perkin's description: instruction to gluemakers to select a "starch ingredient" with "such qualities" to make the glue "as good as animal glue"
- Holland: same (starch glue)
- S. Ct. (1928): "would extend the monopoly beyond the invention."
- S. Ct. 2023:
  - "As the [*Holland*] Court put it: 'One attempting to use or avoid the use of Perkins' discovery as so claimed and described functionally **could do so only after elaborate experimentation**' with different starches."
  - [more S. Ct. cases] "[The] specification may call for **a reasonable amount of experimentation** to make and use a patented invention. What is reasonable in any case will **depend on the nature of the invention and the underlying art.**"

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FRANK G. PERKINS, DECEASED, LATE OF SOUTH BEND, INDIANA, BY GERTRUDE S.  
PERKINS, OF SOUTH BEND, INDIANA, EXECUTRIX, AND PERKINS GLUE COMPANY,  
A CORPORATION OF PENNSYLVANIA, ASSIGNEE.  
GLUE AND METHOD OF MAKING THE SAME.

# Amgen's patent claims at issue

## ■ US'165 claims 19, 29

19. The isolated monoclonal antibody of claim 1 wherein the isolated monoclonal antibody binds to at least two of the following residues S153, I154, P155, R194, D238, A239, I369, S372, D374, C375, T377, C378, F379, V380, or S381 of PCSK9 listed in SEQ ID NO:3.

29. A pharmaceutical composition comprising an isolated monoclonal antibody, wherein the isolated monoclonal antibody binds to at least two of the following residues S153, I154, P155, R194, D238, A239, I369, S372, D374, C375, T377, C378, F379, V380, or S381 of PCSK9 listed in SEQ ID NO:3 and blocks the binding of PCSK9 to LDLR by at least 80%.

## ■ US'741 claim 7

1. An isolated monoclonal antibody that binds to PCSK9, wherein the isolated monoclonal antibody binds an epitope on PCSK9 comprising at least one of residues 237 or 238 of SEQ ID NO: 3, and wherein the monoclonal antibody blocks binding of PCSK9 to LDLR.

7. The isolated monoclonal antibody of claim 2, wherein the epitope is a functional epitope.

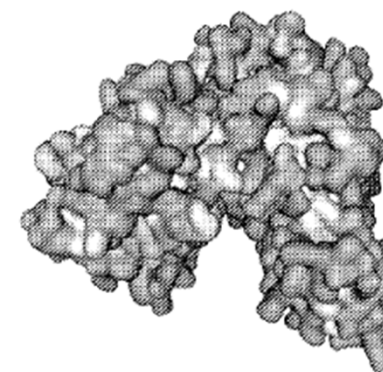


FIG. 25A is a depiction of the surface coverage of PCSK9.

# Amgen patent descriptions

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- 26 exemplified antibodies
  - “Roadmap” method:
    - Generate a range of antibodies
    - Test binding to PCSK9
    - Test binding to “sweet spot”
    - Test blocking PCSK9 binding to LDL receptors
  - “Conservative substitution” method:
    - Start with antibody selected from “roadmap”
    - Replace select amino acids
    - Test described functions
-



## S. Ct.'s holding on antibody technology

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Despite recent advances, aspects of antibody science remain unpredictable. For example, scientists understand that changing even one amino acid in the sequence can alter an antibody's structure and function. See *id.*, at 14. But scientists cannot always accurately predict exactly how trading one amino acid for another will affect an antibody's structure and function. *Ibid.* As Amgen's expert testified at trial: “[T]he way in which you get from sequence to that three-dimensional structure isn't fully understood today. It's going to get a Nobel Prize for somebody at some point, but translating that sequence into a known three-dimensional structure is still not possible.” *Id.*, at 14–15.

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# S. Ct.'s holding on enablement

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- “[T]he more a party claims, the broader a party claims... the more it must enable”
    - “That holds true whether the case involves telegraphs devised in the 19th century, glues invented in the 20th, or antibody treatments developed in the 21st.”
  - “These two approaches [roadmap, conservative substitution] amount to little more than two research assignments.”
    - Roadmap: “trial-and-error method”
    - Conservative substitution: “uncertain prospect given the state of the art”
  - Invalidity for lack of enablement affirmed
-

## S. Ct.'s “all-technologies” quote

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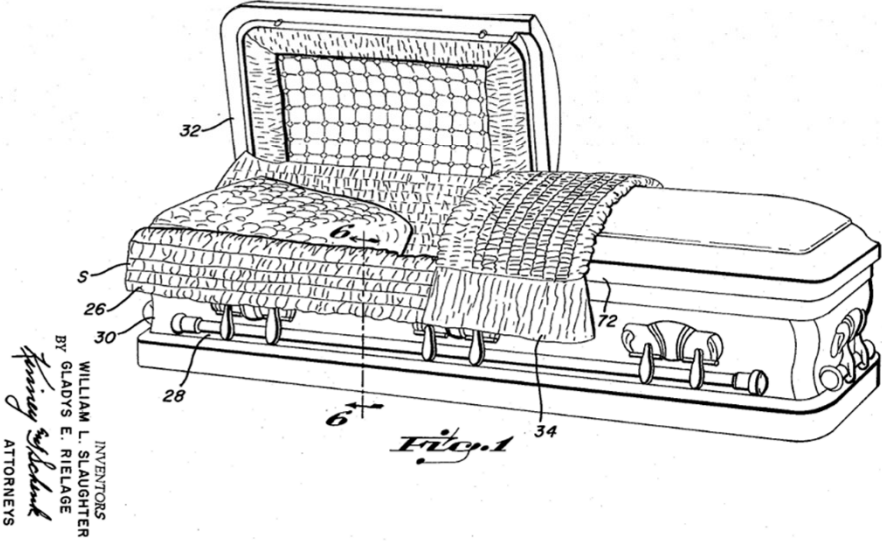
- “Amgen warns that an affirmance risks ‘destroy[ing] incentives for breakthrough inventions’” ... For more than 150 years, this Court has enforced the statutory enablement requirement according to its terms.”
  - “If the Court had not done so in *Incandescent Lamp*, it might have been writing decisions like *Holland Furniture* in the dark.”
-

# Conclusion on enablement post-*Amgen*

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- **Wands factors** (*In re Wands* (Fed. Cir. 1988); USPTO directives MPEP 2161):
    - (1) the breadth of the claims;
    - (2) the nature of the invention;
    - (3) the state of the prior art;
    - (4) the level of one of ordinary skill;
    - (5) the level of predictability in the art;
    - (6) the amount of direction provided by the inventor;
    - (7) the existence of working examples; and
    - (8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure.
  - “We see no meaningful difference between *Wands*’ **‘undue experimentation’** and [the Supreme Court’s] *Amgen*’s **‘[un]reasonable experimentation’** standards.” *Baxalta v. Genentech* (Fed. Cir., Sep 20, 2023)
-

# Conclusion on antibody functional claiming



April 19, 1966  
Filed Dec. 20, 1963  
W. L. SLAUGHTER ET AL  
BURIAL CASSETT INTERIOR  
3,246,379  
8 Sheets-Sheet 1

# Side note:

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## ■ US'741

### **Related U.S. Application Data**

- (60) Continuation of application No. 13/251,909, filed on Oct. 3, 2011, which is a division of application No. 12/197,093, filed on Aug. 22, 2008, now Pat. No. 8,030,457.
- (60) Provisional application No. 61/086,133, filed on Aug. 4, 2008, provisional application No. 60/957,668, filed on Aug. 23, 2007, provisional application No. 61/008,965, filed on Dec. 21, 2007, provisional application No. 61/010,630, filed on Jan. 9, 2008.

## ■ US'259

### **Related U.S. Application Data**

- (63) Continuation of application No. 13/655,984, filed on Oct. 19, 2012, which is a continuation of application No. 12/474,176, filed on May 28, 2009, now Pat. No. 8,563,698, which is a continuation of application No. 12/197,093, filed on Aug. 22, 2008, now Pat. No. 8,030,457.
  - (60) Provisional application No. 60/957,668, filed on Aug. 23, 2007, provisional application No. 61/008,965, filed on Dec. 21, 2007, provisional application No. 61/010,630, filed on Jan. 9, 2008, provisional application No. 61/086,133, filed on Aug. 4, 2008.
-

# Questions, comments?

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**Co-inventors: what contribution is needed?**

Intellectual Property Law

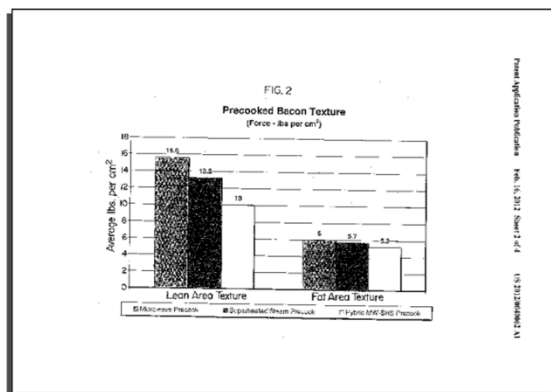
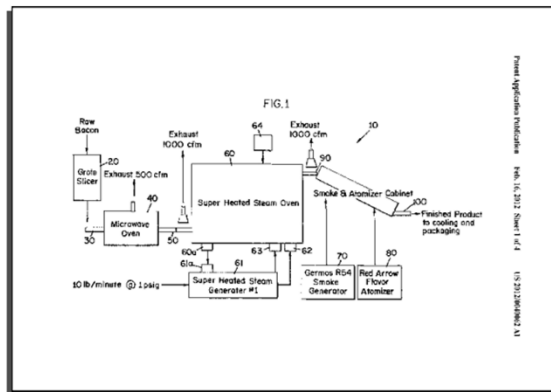


# Hormel v. Hip (Fed. Cir., May 2, 2023)

- Hormel patent in words:
  - Title: “**Hybrid** bacon cooking system”
- Hormel patent in images:

Note to self/viewers: the system, not the bacon!

Drawing pages of US201204006

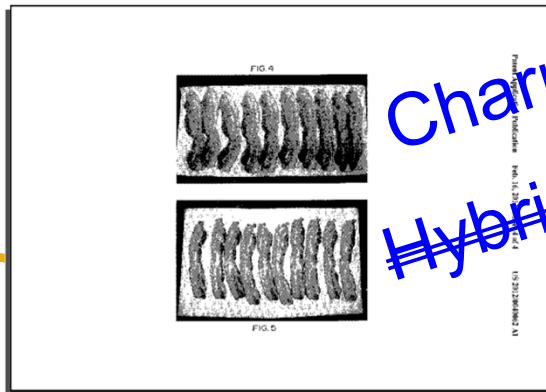


2 A1

FIG. 3

Lab analysis of finished product.

Sample	Aw	% moist	% Salt	% Sugar
AP Microwave Oven	.85	21.12	3.08	2.39
R&D Super Heated Steam (SHS) oven	.85	21.29	2.75	1.97
R&D SHS oven with atomizer	.85	24.06	3.16	2.66
R&D Microwave/SHS Hybrid system	.85	27.66	4.00	2.74



Charred  
Hybrid Superior

# Hormel storyline (1)

---

- You are a big-name company in the processed-meat business
  - You are trying to improve the taste of pre-cooked bacon
  - You are developing a two-step process:
    - Pre-heat at moderate temperature to create a protective layer of melted fat
    - Cook at higher temperature to develop flavors
  - You discuss with oven manufacturers
-

# HIP storyline (1)

---

- You are an oven manufacturer
  - You meet with a big-name processed-meat product manufacturing company
  - You work with the client to offer them an optimal product
  - You propose your infrared oven instead of their microwave oven
-

## Hormel storyline (2)

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- The supplier's infrared ovens are complex and expensive
  - You decide to work in-house adapting your existing microwave ovens to the two-step method
  - You file your patent application
    - You name 4 Hormel employees as inventors
-

# Hormel's patent claim

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- A two-step method of making precooked bacon pieces using a hybrid cooking system:
    - Preheating bacon pieces using a preheating method **selected from the group consisting of a microwave oven, an infrared oven, and hot air**
    - Transferring the preheated meat pieces to the second cooking compartment... keeping the internal surfaces at a temperature below a smoke point of fat...
-

# Hormel's patent claim

---

5. A method of making precooked meat pieces using a hybrid cooking system, comprising:

preheating meat pieces in a first cooking compartment using a preheating method selected from the group consisting of a microwave oven, an infrared oven and hot air to a temperature of at least 140° F. to create preheated meat pieces, the preheating forming a barrier with melted fat around the preheated meat pieces and reducing an amount of condensation that forms on the preheated meat pieces when transferred to a second cooking compartment, the barrier preventing any condensation that forms from contacting the preheated meat pieces under the melted fat and diluting flavor in the preheated meat pieces;

transferring the preheated meat pieces to the second cooking compartment, the second cooking compartment heated with an external heating source, the external heating source being external to the second cooking compartment, the second cooking compartment including internal surfaces, the external heating source assisting in keeping the internal surfaces at a temperature below a smoke point of fat from the meat pieces thereby reducing off flavors during cooking in the second cooking compartment; and

cooking the preheated meat pieces in the second cooking compartment to a water activity level of 0.92 or less to create precooked meat pieces.

---

## HIP storyline (2)

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- You lost the Hormel contract
  - You are not happy
  - You file a lawsuit
    - Requesting correction of inventorship to add Howard, a HIP employee, as co-inventor
-

## *HIP v. Hormel* (District Court)

---

- HIP: Howard is co-inventor of at least the “infrared oven” in the Markush group of Hormel’s patent claim
  - Hormel: it’s insignificant, plus we did not even use infrared
  - District Court: it’s significant because it’s listed in the patent claim
    - Correction of inventorship granted
-



## Hormel storyline (3)

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- You lost sole-ownership of the patent
  - You are not happy
  - You appeal to the Fed. Cir.
-

## *HIP v. Hormel* (Fed. Cir., May 2, 2023)

---

- Basic rule under Fed. Cir. case law: the co-inventor's contribution must be
    - 1) a significant contribution to conception
    - 2) not insignificant in quality relative to the invention as a whole
    - 3) more than explaining well-known concepts or the state of the art
-

# *HIP v. Hormel* (Fed. Cir., May 2, 2023)

---

- Howard's contribution was insignificant in quality (prong 2)
    - Hormel did not use the infrared ovens
    - Hormel's application mentions infrared ovens only once
    - Hormel's application focuses on microwave oven
  - No need to establish that infrared ovens were well-known (prong 3)
  - No discussion of the inventive concept (prong 1)
  - Reversed
-

# What is significant/insignificant?

## *Ethicon v. U.S. Surgical* (Fed. Cir. 1998)

---

- Claim 47 recites a “means for detaining”
  - Interpretation under section 112, sixth paragraph (now 112(f))
    - Corresponding structures in description + equivalents
  - Description:
    - Invented by Yoon (Ethicon): a detent extending radially outward through a hole in the sheath
    - Invented by Choi (U.S. Surgical): a solenoid plunger extending radially inward through a hole in the sheath
  - Holding: Choi is co-inventor
-

# Conclusion on *HIP v. Hormel*

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## *Blue Gentian v. Tristar* (Fed. Cir. June 9, 2023)

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- Blue Gentian sued Tristar for patent infringement
    - Patent claim: expandable hose
  - Tristar counter-claimed to correct inventorship
    - Argument: third party Mr. Ragner is co-inventor
-

# *Blue Gentian v. Tristar: images*

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- Blue Gentian patent

FIG. 1

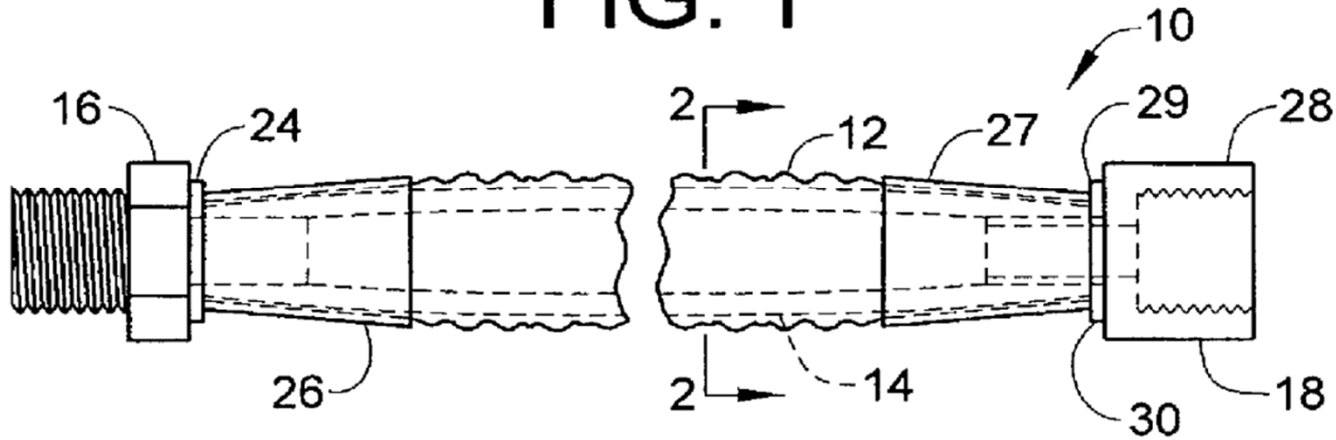
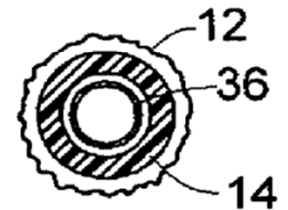


FIG. 2



# *Blue Gentian v. Tristar*: storyline

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- Mr. Berardi owns Blue Gentian, a business development firm
- Mr. Ragner, a third party, is looking for investors to launch his “MicroHose” startup
- Ragner sends to Berardi a business plan and a video showing a spring-expandable hose
- Ragner-Berardi meeting: discuss springs, elastomers
- Mr. Berardi comes up with the idea of a hose with an elastic band instead of a spring
- Mr. Berardi files a patent application

(54) EXPANDABLE AND CONTRACTIBLE HOSE

(75) Inventor: Michael Berardi, Jupiter, FL (US)

(73) Assignee: Blue Gentian, LLC, Jupiter, FL (US)

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## *Blue Gentian v. Tristar*: quotes (1)

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- On Blue Gentian: “Mr. Berardi has a **degree in sociology**. At the time of the meeting, he had no experience designing or building hoses [but] he was **familiar with elastic bands** based on his experience working in a hardware store decades earlier.”
  - On third party: “Mr. Ragner has a **B.S. in physics and an M.S. in aerospace engineering**. Prior to the meeting, Mr. Ragner has **designed many expandable hose prototypes...**”
-

## *Blue Gentian v. Tristar*: quotes (2)

---

- On third party: “Mr. Ragner demonstrated a prototype of the MicroHose during the meeting [which] had a vinyl inner tube for water to flow through, a **wire coil spring** for biasing... and a yarn [cover] attached to the outside of the hose.”
  - On Blue Gentian/third party: “Mr. Berardi testified... that Mr. Ragner ‘**might have mentioned elastomer**’ in the meeting.”
    - “Margaret Combs and Robert de Rochemont testified that they did not hear this conversation – Ms. Combs because she was seated too far away, and Mr. de Rochemont because he has hearing loss.”
    - “Mrs. Berardi testified that she did not hear this conversation either, but she also testified that she wasn’t paying as much attention as others present.”
-

## *Blue Gentian v. Tristar*: quotes (3)

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- On Blue Gentian/third party: “Mrs. Berardi testified that she did not hear this conversation either, but she also testified that she wasn’t paying as much attention as others present.”
  - On Blue Gentian: “Within hours after the meeting, Mr. Berardi went to Home Depot to buy supplies to build a hose prototype [which] had an inner elastic tube to provide a biasing force and an outer tube that water ran through.”
-

# *Blue Gentian v. Tristar*: holding

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- District Court:
    - Mr. Ragner is co-inventor
  - Federal Circuit:
    - Affirmed
-

# Blue Gentian's rejected arguments

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- Ragner's contribution is insignificant to conception (prong 1)
  - Ragner's contribution is insignificant relative to the invention (prong 2)
  - Ragner's contribution was only well-known and state of the art (prong 3)
  - No collaboration: no common intention to develop the invention
    - BUT they discussed ways to build an expandable hose
-

# Conclusion on inventorship

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- Investigation:
  - Ownership attaches to inventive contributions
  - Inventorship is a multi-factor analysis
- Action:
  - Document inventorship
  - Obtain or verify assignments of inventor rights



# Questions, comments?

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# ASPI-GRAPI Oct. 3&5, 2023

Philippe Signore – Nicolas Seckel

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- 1) Domaine brevetable (article 101): quelques décisions
- 2) Suffisance de description: « enablement »
- 3) Interprétation des revendications: quelques décisions
- 4) Entité inventive: co-inventeurs

\*\*\* Pause \*\*\*

- 5) Stratégies d'examen: reissue, continuation, prioritaire...
  - 6) Devoir de divulgation: quelques décisions
  - 7) Procédures post-délivrance: estoppel du pétitionnaire
  - 8) Morceaux choisis: Office US, Congrès, tribunaux
-



ASPI-GRAPI Oct. 3&5, 2023

Nicolas E. Seckel  
Seckel IP, *PLLC*  
Washington, DC

Reissue, other examination strategies  
In re Float'n'Grill LLC (Fed. Cir., July 12, 2023)

# Float'N'Grill's patent claim

1. A floating apparatus for supporting a grill comprising. . .

. . .

a plurality of magnets disposed within the middle segment of the upper support of each of the right grill support and the left grill support . . .

. . .

wherein a flattened bottom side of a portable outdoor grill is removably securable to the plurality of magnets and removably disposed immediately atop the upper support of each of the right grill support and the left grill support.

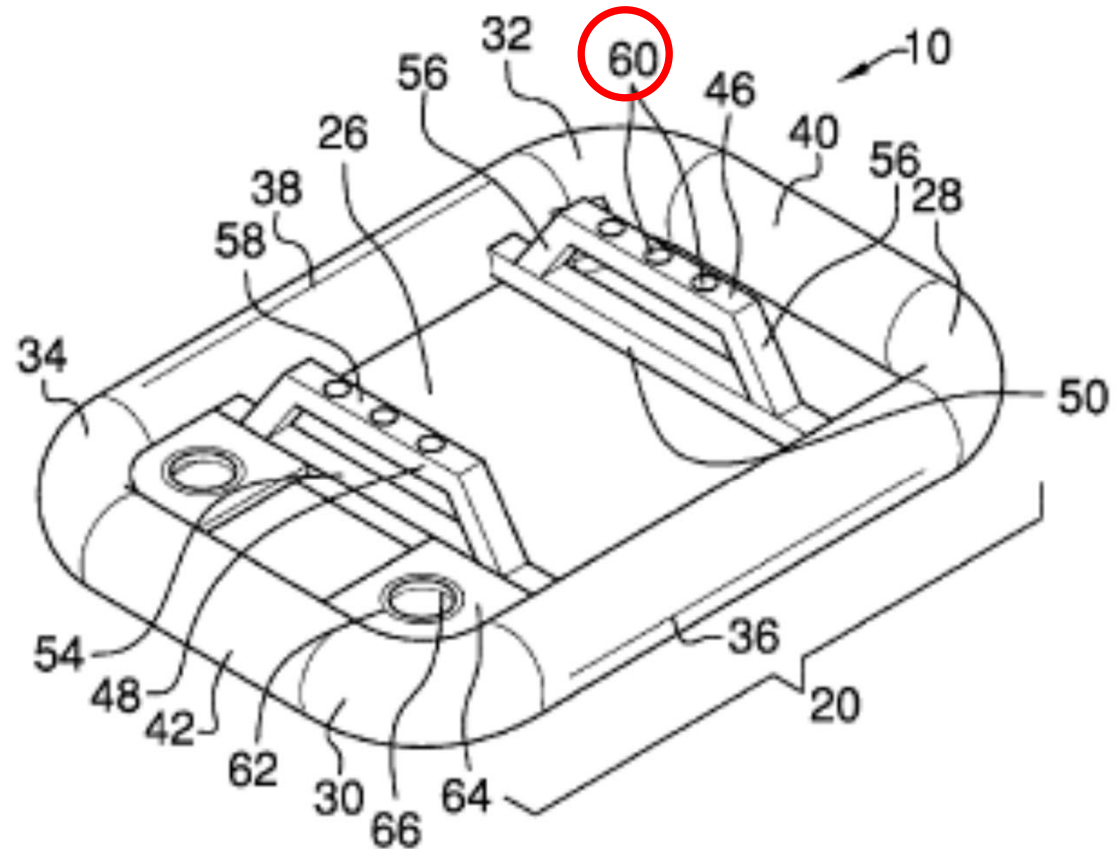


FIG. 1

(12) **United States Patent**  
**Bashawaty et al.**

(54) **FLOATING APPARATUS FOR SUPPORTING  
A GRILL**

# FNG's reissue application claim

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4. A floating grill support apparatus adapted to support a grill on water, the apparatus comprising:

a float having an outer rim wherein the float is buoyant and adapted to float in water and support a grill above the water; and

at least one base rod disposed within the outer rim wherein the base rod comprises a grill support member;

wherein the grill support member has an upper support portion;

wherein a bottom side of the grill is removably securable and removably disposed immediately atop the upper support portion of the grill support member.

---

# Other reissue claims

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- Single “magnet disposed [on] the upper support”
  - Float “adapted to magnetically attach” to the grill
-

# Examiner's rejection affirmed by PTAB

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- Lack of written description support:
  - Single embodiment has a plurality of magnets
  - No disclosure that the plurality of magnets is optional

# Fed. Cir. holding

---

Note: broadening  
reissue filing time  
limit:  $\leq 2$  years

- 35 U.S.C. 251: “same invention” requirement:
    - Reissue must be to “the invention disclosed in the original patent”
  - Distinguished case *In re Peters* (Fed. Cir. 1983):
    - Original patent claim: display device having a panel support by metal tips having a “tapered shape”
    - Description: no disclosure of a particular function for tapered shape
    - Prosecution: no argument to distinguish tapered shape over cited art
    - Reissue without the “tapered shape” limitation not invalid under section 251
  - Analogized case *Forum US v. Flow Valve* (Fed. Cir. 2019):
    - Original patent claim: machining tool having “a plurality of arbors supported by the body member”
    - Description: no disclosure of any alternative to the plurality of arbors
    - Reissue claims replacing “plurality of arbors” by “selectively positionable” invalid under section 251
  - Affirmed
-

# Same invention ≠ written description support (BUT what's the difference?)

---

- “FNG argues that... if the original specification would have supported the reissue claim omitting the limitation, then the original patent requirement is satisfied. **FNG is incorrect.**”
  - BUT: if a feature is presented as essential or critical in the description, a claim not limited to that feature lacks written description
  - Conjectures:
    - ❑ Stricter proof level? (e.g., explicit written description? an earlier decision required “clear and unequivocal” disclosure, and refused to consider an expert declaration about the person of the art)
    - ❑ Two case law trends among judges of the Fed. Cir.?
-

# Alternative options

---

- Reexamination?
    - ❑ Only if a substantive new question of patentability
    - ❑ Based on prior art consisting of patents and printed publications
  - Continuation?
    - ❑ Must ensure continuity of pendency
    - ❑ Written description support is only for benefit of the parent's filing date
-



# Other alternative options?

---

- Not available: continuation of reexam
    - It's not an application, it's a proceeding
  - Not better: continuation of reissue
    - Regular: priority only to reissue request
    - Continuation+reissue: must be for correction of the original patent
-

# Conclusion on reissue

---

- Express or implied statements of criticality exclude later broadening of claims
  - Distinguish
    - Superficial, functionally unimportant features
    - **Optional features**
    - Essential, critical features
  - Context is important
-

# Conclusion on description drafting

---

- Description keywords
    - In one aspect... in another aspect...
    - For example...
    - Preferably...
    - Advantageously...
    - In one embodiment...
    - In some embodiments...
    - ...
  - (and combinations of two or more thereof)
-

# Note:

## Prioritized examination

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- \$4200 fee
  - Complete examination within 12 months (Final rejection or Notice of allowance)
    - Often faster than 12 months
    - Can be requested with RCE or cont/div filing
  - Can be combined with cont/div filing
-

# Questions, comments?

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ASPI-GRAPI Oct. 3&5, 2023

PTAB news

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Intellectual Property Law

# PTAB news

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- 1) Statistics
  - 2) Real Party of Interest (RPI) issues
  - 3) OpenSky controversy
  - 4) USPTO: proposed changes to PTAB rules
  - 5) Congress: PTAB reform bill
-

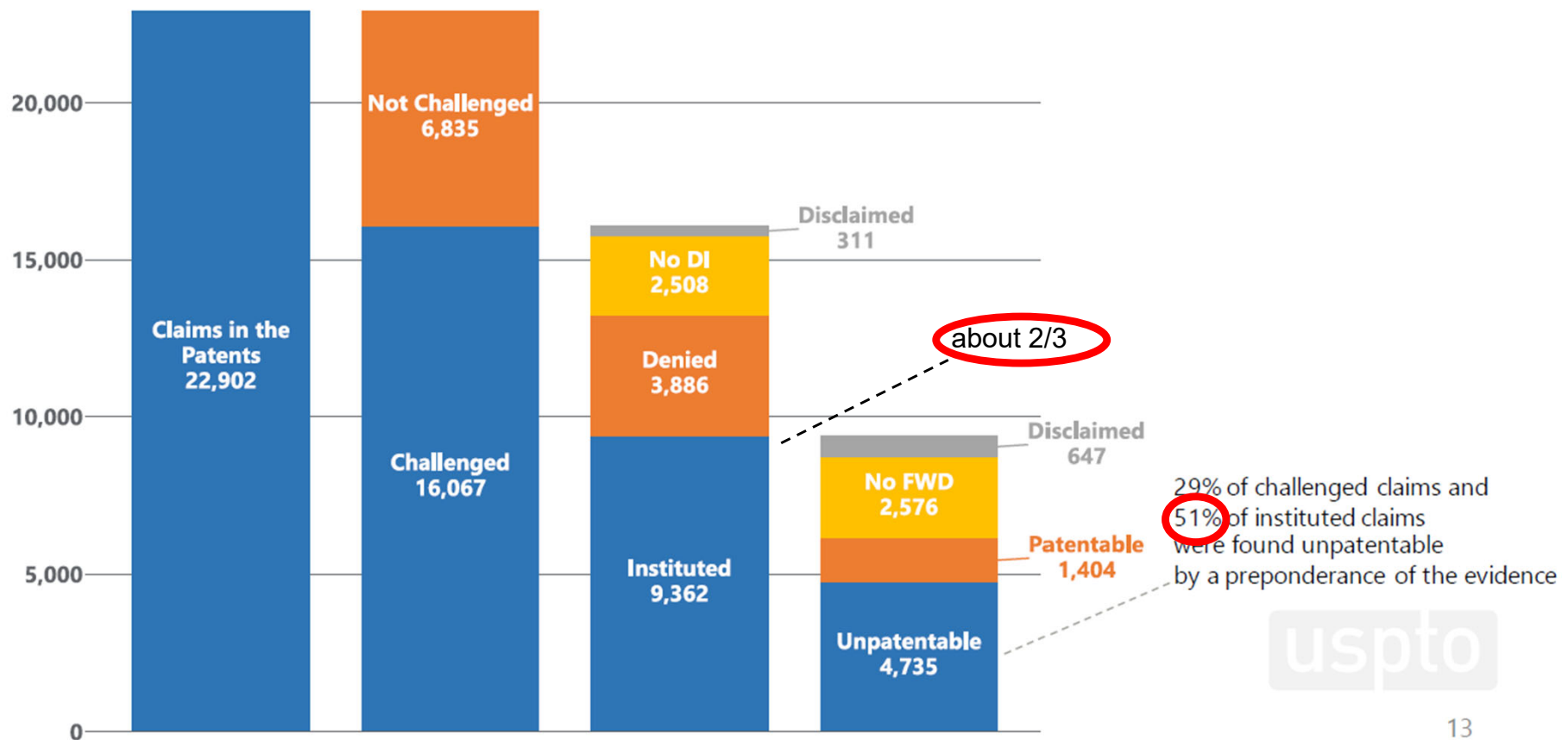


# 1) Statistics: patent claims in petitions

## Claim outcomes

(FY23 through Q3: Oct. 1, 2022 to Jun. 30, 2022)

2023



## 2) Real Party of Interest (RPI) issues

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- Importance: **one-year bar** for filing a petition after being served with patent infringement complaint
    - Applies to “RPI” and “privies”
  - Complexity: common law concepts
    - Multi-factor analysis (closeness of relationship, commonality of interests, benefits...)
  - Hot issue: are members of an association RPIs?
    - Example: technology associations (petitioner Unified Patents, members Apple and Samsung)
-

### 3) OpenSky controversy

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- VLSI won a \$2.18 billion patent infringement lawsuit against Intel
  - Intel had timely filed petitions against the VLSI patents (within one year from service of complaint), but PTAB discretionarily denied
  - Third parties OpenSky and PQA filed similar IPR petitions, which were granted
  - OpenSky and PQA asked payment from both Intel (to continue the IPR) and VLSI (to abandon the IPR)
  - PTAB excluded OpenSky and PQA but continued the IPRs with Intel as joined party, and canceled the VLSI patents
  - Currently on appeal at the Federal Circuit
-

## 4) PTAB proposed rule changes

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- Advance Notice of Proposed Rulemaking (Apr 20, 2023)
  - Proposed changes to PTAB procedure
    - More predictable denials of petitions
      - By certain for-profit entities, against certain small or micro entities, previously decided by a Federal court...
    - More streamlined discretionary denials
      - Replacing RPI by substantial relationship, substantial overlap of claims, compelling merits...
-

## 5) PTAB reform bill

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- “PREVAIL” (Promoting and Respecting Economically Vital American Innovation Leadership”) (Aug 9, 2023)
  - Bipartisan proposal (Senators Coons (D), Tillis (R) and others) Proposed changes to PTAB procedure
  - Changes would codify or modify PTAB practice
    - Benefiting patent owners (requiring standing, election PTAB-District court, clear and convincing evidence...)
    - Benefiting petitioners (limiting discretionary denials, reducing fees for small entities...)
    - Promoting transparency (code of conduct for PTAB judges, sanctions for bad faith...)
-

# Questions, comments?

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