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Strategies With US Patent Practice

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Not legal Advise!

Broad Organization

A. Pre filing
B. Application preparation / Filing
C. Prosecution
D. Post grant
E. Policy / Future

A. Pre Filing Stage

A1. Prior Art Defined

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A3. Clearance Prior to Foreign Filings

B. Application Preparation / Filing Stage

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D. Post-grant Stage

D1. Certificate of Correction

D2. Reissue of Patents

D3. Reexamination

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D5. Patent Term

A1. Prior Art Definition

- 35 USC § 102
  - any 'prior art' has to be identified in one of the sub-sections
- One year grace period BEFORE US FILING DATE of your application vs.
  - patented or published anywhere (by anyone)
  - public use or sale in US only (not elsewhere)
    - Public use or sale in India is not prior art
  - 35 USC 102(b)

A1. Prior Art Defined (Cont…)

- Before the 'invention' by applicant
  - known or used by others in US (not elsewhere)
  - patented or published anywhere
  - 35 USC 102(a)
- Prior foreign filings
  - if filed more than 12 months before the subject application
  - + patented before filing in US
  - 35 USC 102(d)

A1. Prior Art Defined(Cont…)

- Prior filed US/PCT applications not published as of Applicants' US filing date
  - becomes prior art as of filing date of the reference when later published
  - PCT application should have designated US + published in English
  - E.g.,
    - Your application filing date (FD) = Jan 1 2009
    - Reference FD= Nov 1 2008 and published May 1 2010
    - YES PRIOR ART
  - 35 USC § 102(e)

A1. Prior Art Defined (Cont…)

- First to 'invent' in case of applications for same claims
  - who first invents + shows diligence
  - interference declared
  - 102(g)
- Practice tips:
  - be sure the information qualifies as prior art under one of the sections
  - swear behind opportunity
    - 102(a), (e) and (g)
    - maintain notes/evidence of conception/implementation
    - activities in WTO countries covered (35 USC § 104)

A2. Patentable Subject Matter

- 35 USC § 101
  - any new and useful
  - process, machine, manufacture, or composition of matter
  - Improvements
  - "anything under the sun standard"

A2. Patentable Subject Matter (contd…)

- Software based inventions
  - tied to a particular machine or apparatus,
  - OR transforms a particular article into a different state or thing
  - US Supreme Court: Not sole test
  - test generally passing if tied to technology
  - 'non-transitory' computer readable storage medium
- Bio-technology
  - Mere isolation of genes not patentable (being challenged at CAFC)
  - Isolated and altered qualifies for patent protection (Myriad)

A3. Clearance Prior to Foreign Filings

- When invention 'is made in' US
- Foreign filing license (FFL) in case of first filing in US
  - usually expressly granted within 2 weeks in a filing receipt
  - Deemed granted if no communication for 6 months
  - Satisfies export control laws
- Can request foreign filing license
  - usually takes a week
  - can be retroactive if unintentionally violated

B1. Definition of Infringement

- 35 USC § 271
  - makes, uses, offers to sell, or sells any patented invention, within the United States
  - imports into the United States any patented invention
  - imports a product made by a patented process
  - Inducement
  - Contributory infringement
- Claims to ensure direct infringement of specific 'target'
  - method, apparatus, component, system, user interfaces
- Description to satisfy the claims thereafter

B2. Best Mode Definition

- Disclose best mode
  - contemplated by the inventors at the time of filing
  - need not identify in the specification
- Mostly raised in litigation
- 35 USC § 112, first paragraph

B3. Enablement

- Disclosure has to enable one skilled in the relevant arts to make and use
- Deposit of Biological materials supplements the enablement requirement

B4. Written Description Requirement

- Needs to show 'possession' of claimed invention at the time of filing
- Mechanism to constrain the scope of claims
- Predictable vs. unpredictable arts distinguished
- Disclose more species
- Trend towards limiting scope of protection to what is enabled by the disclosure (Ariad)

C1. Duty of Disclosure

- Disclose any information material to patentability
  - Would a reasonable Examiner wanted to have it?
- Extends to any person involved in preparation and filing of patent applications
  - Inventors and attorneys/agents
- Risk of finding of intentional violation
  - Patent unenforceable even if there are valid claims otherwise
- Normal Practice is to submit to USPTO
  - References (examination reports) from other patent offices
  - References in any internal searches conducted

C2. Substantive Examination

- Key difference from India Practice
  - Any number of rounds with US Patent Office possible
  - Normal time to respond in each round: 3 months
  - Extensions generally possible up to 3 more months
- No request for Examination
  - Petition to make special for expedited examination
  - Several grounds

C2. Substantive Examination (contd…)

- 'Final' rejection practice
  - Two searches generally for each fees
  - Request for Continued Examination (RCE) to continue
- Examiner interviews
  - Can be done on telephone
  - Mostly granted routinely if non-final office action outstanding
  - Duty to summarize

C3. Prosecution Highways

- General concept
  - Fast-track (out of sequence examination) option for applications
  - if claims of same scope as that allowed in other jx presented
- With various jurisdictions (jxs)
  - Australia, Canada, Denmark, Finland, Germany, Japan
  - Korea, Singapore, UK and EPO
  - PCT IPER/Written opinion from USPTO or EPO
- Procedure
  - fill applicable form explaining claim scope same
  - Last substantive action from foreign jx
  - Must file electronically
  - Fees eliminated for petition to make special

C4. Anticipation

- Everything in the claim found in a single reference
- Either inherently or expressly
  - inherency → no other way to interpret it

C5. Obviousness

- Prima facie case
  - More than one reference relied upon to show the claimed features
  - Motivation to combine
- Effect of KSR vs. Teleflex
  - Reduced bar for motivation to combine

C6. Appeals

- After two substantive rejections
- Two paths
  - Pre-Appeal Brief Request for Review (recent)
  - Traditional Appeal process

C6. Appeals (Cont..)

- Pre-Appeal Brief Request for Review
  - Less than 5 pages
  - point out errors of patent office on record
  - No oral hearing
  - decision within few weeks
  - Decided by a small panel including Examiner, SPE and external primary
  - Proceed to traditional appeal if adverse decisions
- Traditional appeal process
  - File an appeal brief (complex/comprehensive) as a response
  - Oral hearing optional
  - Administrative judges decide
  - Patent office backlogged substantially

C7. Protest

- Third parties can submit prior art documents or other information
- Processing by the US PTO
  - made of record
  - Examiner must consider references if submitted in time to permit review by Examiner
- Submitting party not part of proceedings

D1.Certificate of Correction

- Initiated by owner of the patent
- For clerical mistakes
  - no fees if office mistake
- Normal post-grant process is to check for errors

D2. Reissue of Patents

- Initiated by owner of the patent
- To correct defects in patents made without deceptive intent
  - no new matter can be added
- Claims scope
  - must be for the same general invention as in the original patent
  - can be broadened if within 2 years of grant date
  - narrowing any time in the patent term

D3. Reexamination

- *Ex parte* reexam
  - Any one may cite prior art during enforceability of patent
  - Any one can request reexamination (with statement explaining basis)
  - PTO decides if ' substantial new question of patentability' exists
  - Patent owner may make statement/amendments
  - Third party requester may file reply/comments
  - PTO then issues office action
  - Patent owner may appeal to BPAI or court
  - Requester has no role post-reply

D3. Reexamination (Contd…)

- Optional inter partes reexam
  - Since 2001
  - 3rd party requesters send comments on office action
  - 3rd party requesters have right to appeal
  - 3rd party agrees to statutory estoppel

D4. Maintenance fees

- Due in 3-3.5 years, 7-7.5 years, and 11-11.5 years windows
- 6 month additional duration with surcharge

D5. Patent Term

- US: basic 20 year term and adjusted for
  - PTO delay less applicant's delay
  - Hatch-Waxman Act due to regulatory delays
- Events ignored for start of the 20 year term
  - Claim from Foreign or Provisional applications
  - National phase entry based on PCT
- Events considered to start the 20 year term
  - Claim to earlier US application starts the 20 year term from the priority date
  - Conversion from provisional starts 20 year term from provisional filing date

E. Policy/Future

- Ever-greening with patents NEVER THERE (almost)
- Scope of allowed claims being increasingly tightened
  - more understanding of 'obviousness'
- Where patents are not bad
  - Case made more by computer/communication arts
- Where patents are needed
  - Case made more by pharma sector

THANK YOU!

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