

The Chisum Patent Academy is pleased to announce the September 2015 publication by Wolters Kluwer Law & Business of the annual Update for Volume I (Patentability and Validity) of the practitioner treatise, [Mueller on Patent Law](#), authored by our co-founder, [Janice M. Mueller](#)

The two-volume Mueller on Patent Law treatise was first published in 2012. [Volume I](#) addresses patentability, validity, and prosecution procedures; [Volume II](#) covers patent infringement, USPTO post-issuance procedures, design patents, and international patenting issues. For detailed tables of contents for both volumes, click [here](#).

The full text of the 2015 Update for Volume I (Patentability and Validity) is available electronically on Wolters Kluwer's [Intelliconnect](#) electronic platform. By examining in detail each of the cases highlighted below (plus many others), the 2015 Update adds extensive and important new matter to Volume I.

Highlights of the September 2015 Update:

- Undoubtedly the most significant and troubling change in U.S. patent law in the past five years surrounds the unsettled question of which inventions qualify as patent-eligible subject matter under 35 U.S.C. §101 and what subject matter is excluded from that statutory provision as “laws of nature,” “natural phenomena,” or “abstract ideas.” In a four-year period following its 2010 decision in *Bilski v. Kappos*, the Supreme Court has issued three additional decisions on the §101 eligibility issue: *Mayo Collaborative Servs. v. Prometheus Labs., Inc.* (2012); *Association for Molecular Pathology v. Myriad Genetics, Inc.* (2013); and *Alice Corp. Pty. Ltd. v. CLS Bank Int’l* (2014).
- *Association for Molecular Pathology*, decided in 2013, significantly limited the patenting of genetic material. The Supreme Court held that Myriad’s patent claims to isolated DNA recited naturally-occurring subject matter that was not patent eligible under §101; rather, the claims were directed to a “natural phenomenon,” a “law of nature,” or a “product of nature.” However, the Court also held that Myriad’s claims to complimentary DNA (“cDNA”) were patent eligible subject matter under §101. In the Court’s view, the cDNA claims were within §101 because they were drawn to synthetic DNA created in the laboratory. See §3.04[C][2].
- The Supreme Court’s pivotal 2012 *Mayo* decision announced a two-step framework for determining if a claimed invention falls within one of three enumerated exceptions to patent-eligible subject matter. Step one of the *Mayo* framework asks “whether the claims at issue are directed to one of those patent-ineligible concepts.” If the answer is yes, step two of the *Mayo* framework asks “[w]hat else is there in the claims before us?” To answer the second *Mayo* question, courts should “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” The second step of the *Mayo* framework can be described as “a search for an ‘inventive concept’—i.e., an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” Especially troubling is the Court’s reliance on antiquated terminology such as “inventive” as an eligibility requirement. See §3.02[D][4][c].

- In 2014, the Supreme Court applied the Mayo framework in *Alice* to determine that claims drawn to a method using computers to minimize settlement risk in financial transactions were attempts to patent an “abstract idea” (a nebulous concept the Court has never clearly defined) and thus not patent eligible under 35 U.S.C. §101. See §3.02[D][4][d].
- As of August 2015, the Federal Circuit had issued eleven decisions addressing the issue of patent eligibility since the Supreme Court’s 2014 *Alice* decision. In the nine Federal Circuit cases that concerned software-implemented inventions or business methods, only one, *DDR Holdings, LLC v. Hotels.com, L.P.*, found patent-eligible subject matter. See §3.02[D][4][e].
- The Federal Circuit’s two post-*Alice* decisions involving chemical/biotechnological subject matter held the claimed inventions ineligible in both cases. In the Federal Circuit’s 2014 decision in *In re BRCA1- & BRCA2- Based Hereditary Cancer Test Patent Litigation* (a follow-on to the Supreme Court’s 2013 decision in *Ass’n for Molecular Pathology*), the Circuit held that claims to primers (“short, synthetic, single-stranded DNA molecule[s] that bind [] specifically to ... intended target nucleotide sequence[s]”) were not patent-eligible compositions of matter under 35 U.S.C. §101 because the primers had “DNA structure[s] with a function similar to that found in nature,” and those structures were not “unique” or “different from anything found in nature.” See §3.04[C][2][b].
- In *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, the Federal Circuit in 2015 professed itself compelled by the Supreme Court’s 2012 *Mayo* decision to affirm the invalidation under 35 U.S.C. §101 of a groundbreaking patent on methods of non-invasive prenatal testing. The Circuit considered the claimed methods patent-ineligible “natural phenomena,” although the “natural phenomena” (i.e., the presence of certain DNA in maternal plasma and serum) was previously unknown and had never before been measured, assayed, or amplified. See §3.02[E][2][c].
- The Supreme Court has taken an interest in critical aspects of patent claiming, a task central to every aspect of patent practice. In its 2014 decision *Nautilus, Inc. v. Biosig Instruments, Inc.*, the Court rejected the Federal Circuit’s overly-lenient and uncertain formulation of the patent claim definiteness standard and replaced it with a new standard turning on “reasonable certainty” of claim scope to a skilled artisan. See §2.04[C]. The Federal Circuit has applied the new standard in several cases, sometimes sustaining claim validity against indefiniteness challenges and sometimes invalidating. See §2.04[D].
- In a June 2015 partially en banc decision, the Federal Circuit in *Williamson v. Citrix Online, LLC*, focused on the treatment of means-plus-function claim elements under 35 U.S.C. §112, para. 6. The Circuit had previously recognized a “negative” proposition that the absence of the word “means” in a claim limitation creates a presumption that the claim element is not to be treated as a means-plus-function element. Certain of the Circuit’s earlier decisions had raised the bar required to overcome the negative presumption by characterizing it as a “strong” one (against application of §112, para. 6). The en banc court in *Williamson* rejected this heightened burden. Rather, the correct standard post-*Williamson* for assessing whether a claim element lacking the word “means” should nevertheless be interpreted as a §112, para. 6 element asks “whether the words of the claim are understood by person of ordinary skill in the art to have a sufficiently definite meaning as the name for structure.” Thus it appears more probable post-*Williamson* that

functional claim language will be deemed within the scope-narrowing strictures of §112, para. 6 even when the word “means” is absent. See §2.05[A][4].

- The Federal Circuit’s July 2014 decision in *AbbVie Deutschland GMH & Co. v. Janssen Biotech, Inc.* extended to antibody technology the reasoning of the Federal Circuit’s controversial 1997 decision in *Regents of Univ. of Cal. v. Eli Lilly and Co.*, which concerned claims to genres of gene sequences. (Antibodies are proteins that bind to unwanted foreign substances called “antigens” in order to remove them from the body.) The *AbbVie* decision calls into question the continued viability of antibody claims reciting a genus based on functionality (rather than structure). In an opinion authored by Judge Lourie, the Federal Circuit majority in *AbbVie* affirmed a jury’s invalidation based, *inter alia*, on failure to satisfy the written description of the invention requirement with respect to the asserted claims in two *AbbVie* patents directed to a genus of human antibodies. See §6.07[F].
- The Federal Circuit continues to debate the timing of “unexpected results” evidence proffered in support of nonobviousness. In a controversial 2014 decision, the Circuit affirmed a district court’s invalidation of pharmaceutical patent claims for obviousness in *Bristol-Myers Squibb Co. v. Teva Pharms. USA Inc.* The appellate court stated that “[t]o be particularly probative, evidence of unexpected results must establish that there is a difference between the results obtained and those of the closest prior art, and that the difference would not have been expected by one of ordinary skill in the art at the time of the invention” (emphasis added). Dissenting from denial of rehearing *en banc* in *Bristol-Myers Squibb*, four Circuit judges posited important (but as yet unanswered) questions about the relevance of unexpected results evidence obtained after the invention date (for AIA patents, after the effective filing date). See §§9.07[B][2], 9.07[D][2].
- The Federal Circuit in 2014 invalidated four biotechnology patents for want of enablement in *Promega Corp. v. Life Techs. Corp.* The *Promega* patents in suit concerned “multiplex amplification” of “short tandem repeats” (STR) loci. The Circuit’s invalidation turned on the failure to enable the full scope of the “broad” claim construction sought by the patentee, which construction neither party contested on appeal. See §4.02[C].
- The Federal Circuit in 2015 confirmed that even an unauthorized use by third parties will not trigger the public use bar of 35 U.S.C. §102(b) (2006) if the individuals maintain the invention as confidential. In *Delano Farms Co. v. California Table Grape Comm'n*, the Federal Circuit affirmed a district court’s judgment sustaining the validity of two plant patents against a §102(b) public use invalidity challenge. The Circuit sustained the district court’s findings that the actions of two third party individuals (non-inventors) who obtained samples of two unreleased but later-patented table grape varieties from the government and planted them in their own fields did not constitute a §102(b) invalidating public use. See §7.06[F][2].
- In its 2014 decision *Novartis AG v. Lee*, the Federal Circuit reviewed a challenge to the USPTO’s patent term adjustment (PTA) computations with respect to requests for continued examination (RCEs) filed by *Novartis* in certain of its patent prosecutions. Siding in part with the government, the Federal Circuit held firstly that “any time consumed by continued examination,” no matter when initiated, does not count toward depleting the allotment of three years the USPTO has before any adjustment time begins to accrue. Agreeing in part with *Novartis*, however, the Circuit also held that time consumed by continued examination, for which no PTA

is available, should run only until allowance of the application, not until its later issuance as a patent (so long as no examination actually occurs following allowance). The Circuit's decision in *Novartis AG* will likely result in the receipt of additional PTA for a large number of recently issued patents that included an RCE in their prosecution. See §11.05[C].

- In its 2015 decision *The Medicines Co. v. Hospira, Inc.*, the Federal Circuit held that an on sale bar-triggering “commercial offer for sale” under 35 U.S.C. §102(b) (2006) can occur based on the sale of services to the patentee when the seller's performance of those services results in manufacture of the patented product, even though title to the product does not change hands. See §7.06[G][4].

- A divided panel of the Federal Circuit held in *Solvay S.A. v. Honeywell Int'l Inc.*, a 2014 decision stemming from an infringement suit, that 35 U.S.C. §102(g)(2) (2006) allows the inventor of the prior art invention to conceive the invention outside the United States. However, the reduction to practice of that prior art invention must occur in the United States for the invention to count as §102(g)(2) “made in this country” prior art. See §7.11[D][4].

- In early 2013, Congress passed a “technical corrections” bill to implement certain fixes to the America Invents Act of 2011. The changes made by the Leahy-Smith America Invents Technical Corrections Act relate to patent prosecution, including an inventor's oath/declaration; post-grant proceedings including IPRs, derivation proceedings, and interference proceedings; litigation, including advice of counsel; and patent term adjustment. See §7A (Chapter Explanatory Note).

- Concern for potential harassment by multiple assignees drove the Federal Circuit's 2013 double patenting decision in *In re Hubbell*. There a divided panel of the Circuit affirmed a USPTO obviousness-type double patenting rejection of an application in view of an issued patent owned by a completely separate entity. Notably, the rejected application and the reference patent shared two common inventors but lacked identical inventorship (each had two other, different inventors). In holding that the double patenting rejection was properly entered, the Circuit majority blessed the USPTO's position that obviousness-type double patenting does not require either common ownership or the identical inventive entity between a rejected application and a reference patent; some overlap in inventorship is enough (see MPEP §804(I)(A)). In so doing, the *Hubbell* majority approved the USPTO position that the Circuit had specifically declined to adopt in its 2009 decision *In re Fallaux*. See §12.03[B].

- In its 2015 decision *Biogen MA, Inc. v. Japanese Foundation for Cancer Research*, the Federal Circuit observed that under the AIA's effective date provision, AIA §3(n)(1), “interference proceedings are to continue with respect to . . . applications filed before March 16, 2013,” with the single exception of AIA §6(f)(3)(A), which provides that the USPTO Director may dismiss a pending interference in favor of a post-grant review. See §7A.03[C].

- The Federal Circuit's 2013 divided decision in *Dawson v. Dawson and Bowman* illustrates the complexities of determining, often many years after the fact, whether an inventor had conceived a claimed invention by a certain date, or whether at that time he merely possessed a “general goal or research plan.” The *Dawson* decision also reinforces that historic pre-AIA concepts such as conception and reduction to practice remain relevant post-AIA. The parties disputed whether Dr. Dawson conceived his invention while employed at a major public university or instead after he

joined a private pharmaceutical manufacturer. The Circuit majority agreed with the pharmaceutical manufacturer, affirming an interference decision by the USPTO. See §8.02[A][1][a].

- Sufficient nexus was not established with respect to licensing activity to support nonobviousness in the Federal Circuit’s 2013 decision, *Soverain Software LLC v. Newegg Inc.* The Circuit reversed a district court’s judgment, entered on a jury verdict, that had sustained the validity of two *Soverain Software* patents. See §9.06[E][2].
- In its 2015 decision *Daiichi Sankyo Co. v. Lee*, the Federal Circuit upheld the USPTO’s February 1, 2010 Interim Procedure for patent term adjustment (PTA), including the Optional Interim Procedure providing a 180 day-post issuance time period for seeking PTA recalculation for patents issuing before March 2, 2010. The agency had acted within its discretion in promulgating the challenged PTA regulations. See §11.05[B].
- The Federal Circuit articulated standards in its 2013 decision, *In re Biedermann*, for determining whether the USPTO Board of Appeals has improperly entered a new ground of rejection on appeal. The central issue was “whether the Board and the examiner properly relied on the same articulated reasoning and factual underpinnings in rejecting [the applicant’s] claims or whether the Board made new findings and adopted different reasons to support a new ground of rejection, thus depriving [the applicant] of both notice and an opportunity to respond.” The Federal Circuit agreed with the applicant and accordingly vacated and remanded the Board’s decision for further proceedings. See §11.09[C].
- The Federal Circuit remains divided on the question whether “secondary considerations” evidence (such as commercial success, failure of others, etc.) must be considered in an obviousness-type double patenting analysis. For example, the court in its 2003 decision *Geneva Pharms., Inc. v. Glaxo SmithKline PLC* stated that “[o]bviousness requires inquiry into objective criteria suggesting non-obviousness; nonstatutory double patenting does not,” and other Circuit decisions followed *Geneva*. However, the court’s 2012 double patenting decision in *Eli Lilly and Co. v. Teva Parenteral Medicines, Inc.* stated that “[w]hen offered, such evidence [of secondary considerations] should be considered.” A district court had erred in “categorical[ly] repudiat[ing]” patentee *Eli Lilly*’s evidence of the “unexpected clinical properties” and “considerable” commercial success of its patented drug. See §12.06[C].
- A 2013 Federal Circuit decision showed that the court remains undecided on the question whether intentional concealment is required for a best mode violation. Answering in the affirmative, a divided panel in *Ateliers de la Haute-Garonne v. Broetje Automation USA Inc.* reversed a district court’s grant of summary judgment that *Ateliers de la Haute-Garonne*’s (AHG’s) two patents in suit were invalid for failure to satisfy the best mode requirement. See §5.06[B][5].

Detailed Table of Contents for Volume I

Mueller on Patent Law, Volume I: Patentability and Validity
Detailed Table of Contents (includes September 2015 Annual Update for Vol. I)

Chapter 1

Basic Principles

§1.01 Patents in Context

[A] Introduction

[B] Patents as Strategic Business Assets

[C] Patents and Global Trade

[D] Patents and the Public Interest

[E] Patents as a Form of Intellectual Property (IP) Protection

[1] The Appropriability Problem of Public Goods

[2] IP Rights as an Incentive Mechanism

[3] IP Rights as an Exception to Competition by Imitation

§1.02 The Right to Exclude Conveyed by a Patent

[A] Negative, Not Positive, Right

[B] Blocking Patents

§1.03 Policy Justifications for Patent Protection

[A] Natural Rights

[B] Reward for Services Rendered

[C] Monopoly Profits Incentive

[D] Exchange for Secrets

§1.04 Economics of the Patent System

[A] Patent Ownership Versus Monopoly Power

[B] Cost/Benefit Analysis

[1] Costs

[2] Benefits

§1.05 The Term of a Patent

[A] Length of Term

[B] Patent Term Adjustment

§1.06 Sources of U.S. Patent Law

[A] The Constitution

[B] Federal Statutes and Regulations

[C] Case Law

§1.07 Government Entities in the Patent System

[A] The U.S. Patent and Trademark Office

[B] U.S. Federal Courts

[1] U.S. District Courts

[i] Eastern District of Virginia

[2] U.S. Court of Appeals for the Federal Circuit

[3] U.S. Supreme Court

[C] U.S. International Trade Commission

Chapter 2

Patent Claims

§2.01 Introduction

[A] Statutory Basis: 35 U.S.C. §112(b)

[B] The Paramount Role of Patent Claims

[C] Definition of a Patent Claim

[D] Public Notice Function

[E] Peripheral versus Central Claiming

[F] Fundamentals of Patent Claim Construction

[1] “Own Lexicographer” Rule

[2] Default Rule: “Ordinary and Customary” Meaning

§2.02 Components of Patent Claims

[A] Preamble

[1] Introduction

[2] Preamble Language as Claim Limiting

[B] Transition

[1] “Comprising”

[2] “Consisting of”

[3] “Consisting Essentially of”

[4] Other Transition Terminology

[C] Body

§2.03 Dependent Patent Claims

[A] Statutory Basis: 35 U.S.C. §112(c)-(e)

[B] Claim Differentiation Principle

[C] Multiple Dependent Claims

§2.04 Definiteness Requirement

[A] Statutory Basis: 35 U.S.C. §112(b)

[B] Perspective for Determining Claim Definiteness

[C] Definiteness Standard: *Nautilus v. Biosig* (U.S. 2014)

[D] Examples of Definite and Indefinite Claim Terms

[1] Examples of Definite Claim Terms

[2] Examples of Indefinite Claim Terms

[E] Judicial Correction of Harmless Errors in Claims

[F] Use of Antecedent Basis in Patent Claims

§2.05 Specialized Claiming Formats

[A] Means-Plus-Function Claims

[1] Functional Claiming Generally

[2] Statutory Basis: 35 U.S.C. §112(f)

[3] The Interpretation and Scope of Means-Plus-Function Elements

[4] Presumptions Regarding “Means” Claim Elements

[a] Claim Elements Including the Word “Means”

[b] Claim Elements Not Including the Word “Means”

[B] Product-By-Process Claims

[C] Jepson Claims

[D] Markush Claims

[E] Beauregard Claims

Chapter 3

Patent-Eligible Subject Matter

§3.01 Introduction

[A] 35 U.S.C. §101: The First Door to Patentability

[B] The Statutory Categories within §101

[C] Drafting Claims within the Statutory Categories

[D] Exceptions to §101

§3.02 Processes within §101

[A] Definition of a Process

[B] Process versus Product

[C] Computer-Implemented Processes: The Supreme Court’s Benson (1972)/Flook (1978)/Diehr (1981) Trilogy

[D] Business Methods and the “Abstract Idea” Exception

[1] Overview

[2] Expansive View of Business Method Eligibility: State Street Bank (Fed. Cir. 1998)

[3] “Mental Processes”

[4] “Abstract Idea” Exception Narrows Business Method Patentability

[a] In re Bilski (Fed. Cir. 2008) (en banc)

[b] Bilski v. Kappos (U.S. 2010)

[c] Two-Step Framework of Mayo v. Prometheus (U.S. 2012)

[d] Alice Corp. v. CLS Bank (U.S. 2014)

[e] Federal Circuit Decisions Applying “Abstract Idea” Exception to Process Patent Eligibility

[E] Methods of Treatment

[1] Overview

[2] Patent-Ineligible “Laws of Nature”

[i] Prometheus v. Mayo (Fed. Cir. 2010)

[ii] Mayo v. Prometheus (U.S. 2012)

§3.03 Machines within §101

[A] Definition of a Machine

[B] Computer-Implemented Machines

§3.04 Compositions of Matter within §101

[A] Definition of a Composition of Matter

[B] Structure versus Properties: Newly Discovered Properties of Known Compositions

[C] Products of Nature

[1] Purified Forms of Natural Products

[2] Genetic Materials

[a] Ass’n for Molecular Pathology v. Myriad Genetics (U.S. 2013)

[b] Post-Myriad (U.S. 2013) Federal Circuit Decisions

[D] Spontaneously Generated Compositions

[E] Life Forms

[1] Foundation: Diamond v. Chakrabarty (U.S. 1980)

[2] Multi-Cellular Organisms

[3] Clones

§3.05 Manufactures within §101

[A] Definition of a Manufacture

[B] Embedded Software

[C] Electrical Signals

§3.06 Non-Eligible Subject Matter

§3.07 Remedies Exclusion for Medical/Surgical Procedures

Chapter 4

The Enablement Requirement

§4.01 Introduction

[A] Disclosure Requirements of Section §112(a)

[B] Bargain/Exchange Theory

[C] Enabling “How to Make” and “How to Use”

[D] Filing Date as Measure of Disclosure Compliance/New Matter Prohibition

[1] Incorporation by Reference

[2] Biological Deposits

[3] Timing for Enablement versus Novelty/Nonobviousness

§4.02 Undue Experimentation

[A] Wands Factors Framework

[B] Predictability of the Technology

[C] Scope of Enabling Disclosure Versus Scope of the Claims

[1] “Reasonable Correlation” Standard

[2] “Full Scope” Enablement

[D] Use of Working and Prophetic Examples

§4.03 Nascent and After-Arising Technologies

Chapter 5

The Best Mode Requirement

§5.01 2011 Legislative Scale-Back of the Best Mode Requirement

§5.02 Best Mode as Enablement-Plus

§5.03 Unclear Policy Objectives

§5.04 No Best Mode Obligation in Many Foreign Countries

§5.05 Best Mode Compliance and Foreign Priority Claims

§5.06 Two-Step Analysis

[A] Step One: Subjective Inquiry

[1] Best Mode of the Inventor, not Assignee

[2] Multiple Inventors

[B] Step Two: Objective Inquiry

[1] Integrating Enablement with Best Mode

[2] Proprietary Materials

[3] Production Details and Routine Details

[4] Manner of Identifying Best Mode

[5] Concealment: Is Intent Required?

§5.07 Scope of the Best Mode Disclosure versus Scope of the Claims

Chapter 6

The Written Description of the Invention Requirement

§6.01 The Varied Meanings of “Written Description”

§6.02 Priority Policing Mechanism

§6.03 Policy Rationale

§6.04 “Inventor in Possession” Test

[A] How the Specification Conveys Possession

[B] Ambiguity in the Possession Test

§6.05 Written Description Versus Enablement

§6.06 Traditional “Time Gap” Situations Invoking Written Description Scrutiny

§6.07 Federal Circuit's Expansion of the Written Description Requirement

- [A] Regents of Univ. of Cal. v. Eli Lilly and Co.
- [B] Enzo Biochem., Inc. v. Gen-Probe, Inc.
- [C] Univ. of Rochester v. G.D. Searle & Co.
- [D] Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.
- [E] Ariad Pharms., Inc. v. Eli Lilly and Co. (en banc)
- [F] AbbVie Deutschland v. Janssen Biotech

§6.08 Conclusion

Chapter 7

Novelty, No Loss of Right, and Priority [Pre-America Invents Act of 2011]

Chapter Explanatory Note

§7.01 Statutory Basis: 35 U.S.C. §102 (2006)

- [A] Burden of Proof on USPTO
- [B] Claim Interpretation in USPTO
- [C] Prior Art As Defined by §102
- [D] Lack of Novelty Versus Loss of Right
- [E] Persons Who Can Trigger the §102 Provisions
- [F] Geographic Limitations in §102
- [G] Temporal Limitations in §102

§7.02 Anticipation

- [A] Definition
- [B] Strict Identity Rule
- [1] "Four Corners"/Single Reference Rule
- [2] "Arranged As In the Claim"
- [3] Exceptions to the Four Corners Rule
- [4] No Analogous Art Requirement for Anticipation

[C] Species/Genus Relationships

[D] Question of Fact

§7.03 Inherent Anticipation

§7.04 Enablement Standard for Anticipatory Prior Art

[A] General Principle

[B] Exception for Prior Art Compounds Lacking a Utility

§7.05 Anticipation under §102(a)

[A] Filing Date as Prima Facie Invention Date

[1] References Having Effective Date Less Than One Year Before Applicant's Filing Date

[2] Antedating a Putative §102(a) Reference by Establishing Earlier Invention Date

[a] Generally

[b] Relying on Inventive Activity Outside the U.S. under 35 U.S.C. §104

[c] Disclaiming Affidavits

[B] "Known or Used by Others" under §102(a)

[C] "Patented" under §102(a)

[D] "Printed Publication" under §102(a)

[E] Strategies for Overcoming a §102(a) Anticipation Rejection

§7.06 Loss of Right/Statutory Bars under §102(b)

[A] Introduction

[1] Filing Date

[2] "Critical Date"

[B] Grace Period

[C] Policies Underlying the Statutory Bars

[D] "Patented" under §102(b)

[1] Conceptually Same as "Patented" Under §102(a)

[E] “Printed Publication” under §102(b)

[1] Public Accessibility

[2] The Thesis Cases

[3] Confidentiality Norms

[4] Scientific or Technical Presentations

[5] Internet Postings

[F] “Public Use” Bar of §102(b)

[1] Foundation: Egbert v. Lippmann (1881)

[2] Public Use by Third Parties

[3] Non-Public “Public Use”

[G] “On Sale” Bar of §102(b)

[1] Introduction

[2] Policy Considerations

[3] When Is An Invention Capable of Being Placed On Sale? Pfaff v. Wells (U.S. 1998)

[4] Post-Pfaff Decisions Interpreting “Commercial Offer”

[5] Post-Pfaff Decisions Interpreting “Ready for Patenting”

[H] Experimental Use Negation of the Statutory Bars

[1] Meaning of “Negation”

[2] Foundation: City of Elizabeth v. Nicholson Pavement (1878)

[3] Experimental Use Factors

[4] Must Experimental Use End with Actual Reduction to Practice?

[5] Positioning Experimental Use within the Pfaff Framework

[I] Cannot Antedate a §102(b) Reference

[J] Cannot Rely on Paris Convention Foreign Priority Date to Remove a §102(b) Reference

§7.07 Abandonment under §102(c)

§7.08 Foreign Patenting Bar of §102(d)

[A] Policy Basis Underlying §102(d) Bar

[B] Two Prongs of §102(d)

[C] Meaning of “Patented” in §102(d)

§7.09 Description in Another’s Earlier-Filed Patent Application under 35 U.S.C. §102(e)

[A] Foundation: *Milburn v. Davis-Bournonville* (1926)

[B] Reference Patent or Application Describes But Does Not Claim Same Invention

[C] Ameliorating the “Secret Prior Art” Problem of §102(e)

[1] Issued U.S. Patent As §102(e) Prior Art Issued U.S. Patent as §102(e) Prior Art

[2] Published U.S. Patent Application as §102(e) Prior Art

[3] Published PCT Application as §102(e) Prior Art

[D] Effective Date of §102(e) Prior Art

[1] Earliest U.S. Filing Date

[2] Reference’s Foreign Priority Date Is Not Applicable (Hilmer Rule)

[E] Provisional §102(e) Rejections

[F] Strategies for Overcoming a §102(e) Rejection

§7.10 Originality Requirement and Derivation under §102(f)

[A] Originality

[B] Derivation

[C] Qualifying as an Inventor

[D] Correcting Inventorship

§7.11 Prior Invention under §102(g)

[A] Introduction

[B] The First-to-Invent Priority Rule

[1] Statement of the Priority Rule

- [2] Reduction to Practice
 - [a] Actual Reduction to Practice
 - [b] Constructive Reduction to Practice
- [3] Abandonment/Suppression/Concealment
- [4] Conception
- [5] Diligence
- [C] Interference Proceedings under §102(g)(1)
 - [1] Burdens of Proof
 - [2] Conducted under §135(a)
 - [3] Time Bar Under §135(b)
 - [4] Reliance on Foreign Inventive Activity under §104
 - [5] Examples: Applying the Priority Rule in Interferences
- [D] Anticipation under §102(g)(2)
 - [1] Introduction
 - [2] Prior “Making” by Another
 - [3] “In this Country” Requirement
 - [4] Inurement
 - [5] Examples: Applying the First-to-Invent Priority Rule in Anticipation

Chapter 7A

Novelty and Priority [Post-America Invents Act of 2011]

Chapter Explanatory Note

§7A.01 Statutory Text: Post-AIA 35 U.S.C. §102

§7A.02 Sense of Congress and Legislative History for Post-AIA 35 U.S.C. §102

§7A.03 Prior Art under Post-AIA 35 U.S.C. §102(a)

[A] Introduction

[B] What Section 3 of the AIA Retained

[C] What Section 3 of the AIA Changed

[D] Presumptively Novelty-Destroying Events under Post-AIA 35 U.S.C. §102(a)(1)

[1] Invention “Patented, Described in a Printed Publication, or in Public Use, [or] On Sale” Before Effective Filing Date

[2] Invention “Otherwise Available to the Public” Before Effective Filing Date

[3] Does the AIA Permit Secret Prior Art?

[E] Presumptively Novelty-Destroying Events under Post-AIA 35 U.S.C. §102(a)(2)

§7A.04 Novelty-Preserving Exceptions under Post-AIA 35 U.S.C. §102(b)

[A] Introduction

[B] Post-AIA 35 U.S.C. §102(b)(1): Shields against Post-AIA §102(a)(1) Presumptively Novelty-Destroying Events

[1] “(A)-Type” Exceptions

[2] “(B)-Type” Exceptions

[C] Post-AIA 35 U.S.C. §102(b)(2): Shields against Post-AIA §102(a)(2) Presumptively Novelty-Destroying Events

[1] “(A)-Type” Exceptions

[2] “(B)-Type” Exceptions

§7A.05 Effective Date for AIA §3 “First Inventor to File” Amendments

§7A.06 Common Ownership under Joint Research Agreements

Chapter 8

Inventorship

§8.01 Originality Requirement

§8.02 The Process of Inventing

[A] Patent Law’s Construct of Inventing: A Two-Step Process

[1] Conception

[a] Definition

[b] Scientific Certainty Not Required

[c] Corroboration

[d] Importance of Conception

[2] Reduction to Practice

[a] Actual Reduction to Practice

[b] Constructive Reduction to Practice

[B] The Reality

§8.03 Joint Inventors

[A] Statutory Basis

[B] Who Qualifies as a Joint Inventor?

[1] Conception as the Touchstone

[2] Quality of the Contribution

[C] Burden of Proof and Standard of Review

[D] Decisions Denying Joint Inventorship

[E] Decisions Finding Joint Inventorship

[F] The Impact of Inventorship on Ownership

§8.04 Correction of Inventorship

[A] Correction of Inventorship in Pending Patent Applications

[B] Correction of Inventorship in Issued Patents

§8.05 Derivation

[A] Derivation Defined

[B] Derivation in Patent Litigation

[C] Derivation-Related Proceedings in the USPTO

[1] Derivation as an Issue in Interference Proceedings [Pre-AIA]

[2] Derivation Proceedings Under the America Invents Act of 2011

Chapter 9

The Nonobviousness Requirement

§9.01 Statutory Basis: 35 U.S.C. §103

§9.02 Historical Background

[A] Hotchkiss v. Greenwood and the Elusive Requirement for “Invention”

[B] The Hotchkiss “Ordinary Mechanic”

[C] Replacing “Invention” with Nonobviousness

[1] Patent Act of 1952

[a] Enactment of Section 103

[b] “Shall Not Be Negated”

[c] The “Person Having Ordinary Skill in the Art”

[d] “Would Have Been” Obvious

[2] Graham v. John Deere Co. (U.S. 1966)

[a] Constitutionality of Section 103

[b] Analytical Framework for Nonobviousness Determinations: Overview

§9.03 Graham Factor (1): Scope and Content of the Prior Art

[A] Terminology

[B] What Is Prior Art for §103 Purposes

[C] Section 102/Section 103 Overlap

[1] In re Bass (C.C.P.A. 1973)

[2] Section 103(c) Exclusion of Commonly-Owned Subject Matter [Pre-America Invents Act of 2011]

[3] Section 103(c) Exclusion of Joint Research Work [Pre-America Invents Act of 2011]

[4] Use of Temporarily Secret Prior Art to Establish Obviousness
[Pre-America Invents Act of 2011]

[D] Analogous Art

[1] Required for Obviousness Under §103

[2] Not Required for Anticipation Under §102

§9.04 Graham Factor (2): Differences between Claimed Invention and Prior Art

§9.05 Graham Factor (3): Level of Ordinary Skill in the Art

§9.06 Graham Factor (4): Secondary Considerations

[A] Evidentiary Weight

[B] Commercial Success

[1] Nexus Requirement

[C] Long Felt But Unsolved Needs

[D] Failure of Others

[E] “Etc.”

[1] Copying

[2] Licensing

§9.07 Combining Prior Art Disclosures

[A] Teaching, Suggestion, or Motivation (TSM) to Combine

[B] Reasonable Expectation of Success

[1] Degree of “Reasonableness”

[2] Timing of Expectation

[3] Relation to KSR (U.S. 2007)

[C] “Obvious to Try” (pre-KSR Meaning)

[D] Unexpected Results

[1] Generally

[2] Timing of Evidence

[3] Placement in Graham Framework

[E] Teaching Away

§9.08 Nonobviousness in the 21st Century: KSR v. Teleflex (U.S. 2007)

[A] Expanding the Reasons for Combining Prior Art Disclosures

[B] Common Sense

[C] Requirement for Explicit Analysis

[D] Redefining “Obvious to Try”

[E] Predictability

[F] Representative Federal Circuit Applications of KSR

[1] Mechanical Inventions

[2] Computer/Internet-Implemented Inventions

[3] Pharmaceutical and Biotechnology Inventions

§9.09 The Prima Facie Case of Obviousness

§9.10 Federal Circuit’s Standards of Review for §103 Determinations

[A] USPTO

[1] Factual Findings

[2] “Harmful Error” Requirement

[B] Federal District Court

[1] Factual Findings by Court

[2] Factual Findings by Jury

§9.11 Biotechnological Processes: Section 103(b) [Pre-America Invents Act of 2011]

Chapter 10

The Utility Requirement

§10.01 Statutory Basis: 35 U.S.C. §101

§10.02 Practical/Real-World Utility

§10.03 Historical Development

[A] Justice Story’s Standard

[B] Brenner v. Manson (U.S. 1966)

§10.04 Federal Circuit Examples

[A] Chemical Compounds

[B] Methods of Treating Disease

[C] Genetic Inventions

§10.05 USPTO Examination Guidelines on Utility

§10.06 Inoperability

[A] Examples of Inoperable Inventions

[B] Inoperable Species within a Genus

§10.07 Immoral or Deceptive Inventions

§10.08 Utility Versus How-to-Use Requirement of §112, ¶1

Chapter 11

Patent Prosecution Procedures in the U.S. Patent and Trademark Office

§11.01 Introduction

§11.02 Filing the Patent Application

[A] Non-Provisional/Regular Application

[B] Provisional Application

§11.03 Examination by the USPTO

[A] Overview

[B] Search of Prior Art

[C] First Office Action

[D] Applicant's Response

[E] Second or Final Office Action

[F] Requests for Continued Examination

[G] Continuing Applications

§11.04 Patent Issuance

§11.05 Patent Term Adjustment

[A] Generally

[B] Overlap Limitation

[C] Treatment of Continued Examination

§11.06 Publication of Pending Nonprovisional Applications

§11.07 Continuing Application Practice

[A] Introduction

[B] Three Types of Continuing Applications

[C] Filing Requirements

[D] Effective Filing Date of Claims in Continuing Applications

[E] Patent Term of Continuing Applications

[F] Divisional Applications

[1] Restriction Requirements

[2] Consonance Requirement

§11.08 Claiming Foreign Priority

[A] Treaty Basis and Statutory Implementation

[B] “Shall Have the Same Effect”

[C] “Same Invention”

[D] Formal Requirements

[E] First-Filed Foreign Applications

§11.09 Appeals to the USPTO Patent Trial and Appeal Board

[A] Generally

[B] Challenging the Board’s Decision

[C] New Ground of Rejection by Board

§11.10 Civil Actions for a Patent

§11.11 Sample Office Action and Applicant’s Response

§11.12 Sample Patent and its Components

Chapter 12

Double Patenting

§12.01 Introduction

§12.02 Two Types of Double Patenting

[A] Same Invention-Type

[B] Obviousness-Type

§12.03 Policy Bases

[A] Prevent Improper Extension of Patentee's Right to Exclude Others

[B] Prevent Potential Harassment by Multiple Assignees

§12.04 Foundational Case Study

§12.05 Twenty-Year Patent Term Did Not Eliminate Double Patenting Concerns

§12.06 How Double Patenting Differs from Anticipation and Obviousness

[A] Claim-to-Claim Comparison

[B] Prior Art is Not Involved

[C] Similarities

§12.07 Proper Use of the Disclosure to Interpret the Claims

§12.08 Improper Use of the Disclosure as Prior Art

§12.09 Use of Terminal Disclaimer to Overcome Obviousness-Type Double Patenting

[A] Terminal Disclaimers in the USPTO

[B] Terminal Disclaimers in Litigation

§12.10 One-Way versus Two-Way Test for Obviousness-Type Double Patenting

About the Author:

Janice M. Mueller is a registered U.S. patent attorney and chemical engineer. She was the first woman to serve as a judicial law clerk for Judge Giles S. Rich, U.S. Court of Appeals for the Federal Circuit, from 1990-1992. Janice litigated patent and copyright infringement cases as an Honors Program Trial Attorney in the U.S. Department of Justice before entering legal academia. From 2004-2011 Janice was a tenured full Professor at the University of Pittsburgh School of

Law, where she taught and wrote in the field of intellectual property law with an emphasis in U.S. and comparative patent law. Janice has also taught at John Marshall Law School (Chicago), Suffolk University (Boston), the University of Kentucky, the University of Washington, Seattle University, Santa Clara University, and William Mitchell College of Law (St. Paul). Aspen Publishers issued the fourth edition of her popular student text, Patent Law, in 2013. Janice's scholarly articles have been published in Baylor Law Review, Berkeley Technology Law Journal, Houston Law Review, Journal of the Patent and Trademark Office Society, Kentucky Law Journal, University of Pittsburgh Law Review, and Washington Law Review. In 2009 Janice co-founded with Donald S. Chisum the Chisum Patent Academy, which provides patent law educational services in a unique small-group seminar format. Janice has served on the American Intellectual Property Law Association's Amicus Committee, lectured for BarBri Patent Bar Review, chaired the Expert Advisory Committee on Intellectual Property for the Consultative Group on International Agricultural Research, and is a trustee of the Federal Circuit Historical Society.

2016 Chisum Patent Academy Seminars:

The [Chisum Patent Academy](#) offers uniquely formatted, small group CLE seminars for experienced patent professionals that drill down into critical and timely patent law issues (prosecution and litigation). Each seminar is limited to ten participants and all sessions are co-taught by patent law treatise authors and educators [Donald Chisum](#) and [Janice Mueller](#).

Registration is now open for the Academy's 2016 seminars. They will be offered:

Cincinnati, Ohio: March 10-11, 2016;

and

Seattle, Washington: August 4-5 and 8-9, 2016 (two identical seminars).

Please visit our [website](#) or contact us at info@chisum.com for more information. All Chisum Patent Academy alumni/ae receive a 10% discount on our registration fee.