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# IP YEAR IN REVIEW: IMPORTANT CASES DECIDED IN 2019

Andrew J. Gray IV, Julie S. Goldemberg, Alexandria Petterson,  
Ayaka Hatori, Benjamin H. Pezzner, W. Scott Tester, Ka-Lo Yeh, Ph.D.,  
Han Gao, Ehsun Forghany, Austin L. Zuck, Kannan Narayanan, and  
Pablo Herrera  
May 14, 2020

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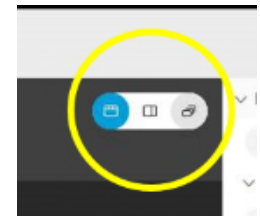
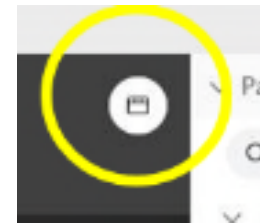
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# Before we begin: Morgan Lewis and Global Technology

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<b>Artificial Intelligence and Automation</b>	<b>Fintech</b>	<b>Mobile Tech</b>
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We have formed a multidisciplinary **Coronavirus/COVID-19 Task Force** to help guide clients through the broad scope of legal issues brought on by this public health challenge.

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If you would like to receive a daily digest of all new updates to the page, please visit the resource page to [subscribe](#) using the purple “Stay Up to Date” button.

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The background is a vibrant, abstract digital composition. It features a dark blue base with a complex network of glowing lines and dots in various colors including orange, yellow, green, and purple. The lines and dots are arranged in a way that suggests a 3D perspective, with some elements appearing to recede into the distance, creating a sense of depth and movement. The overall effect is reminiscent of a data visualization or a digital cityscape.

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May 14, 2020

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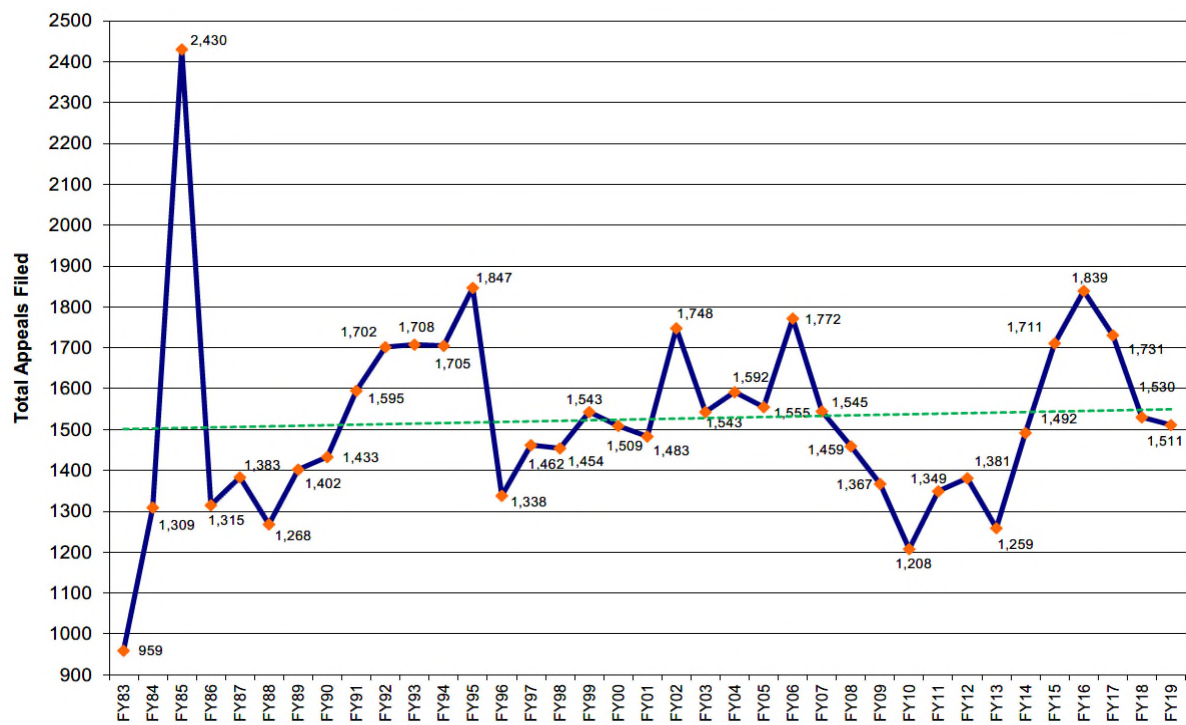
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# 2019 FEDERAL CIRCUIT CASELOAD STATISTICS AND COVID-19 IMPACT ON OPERATIONS

Julie Goldemberg

May 14, 2020

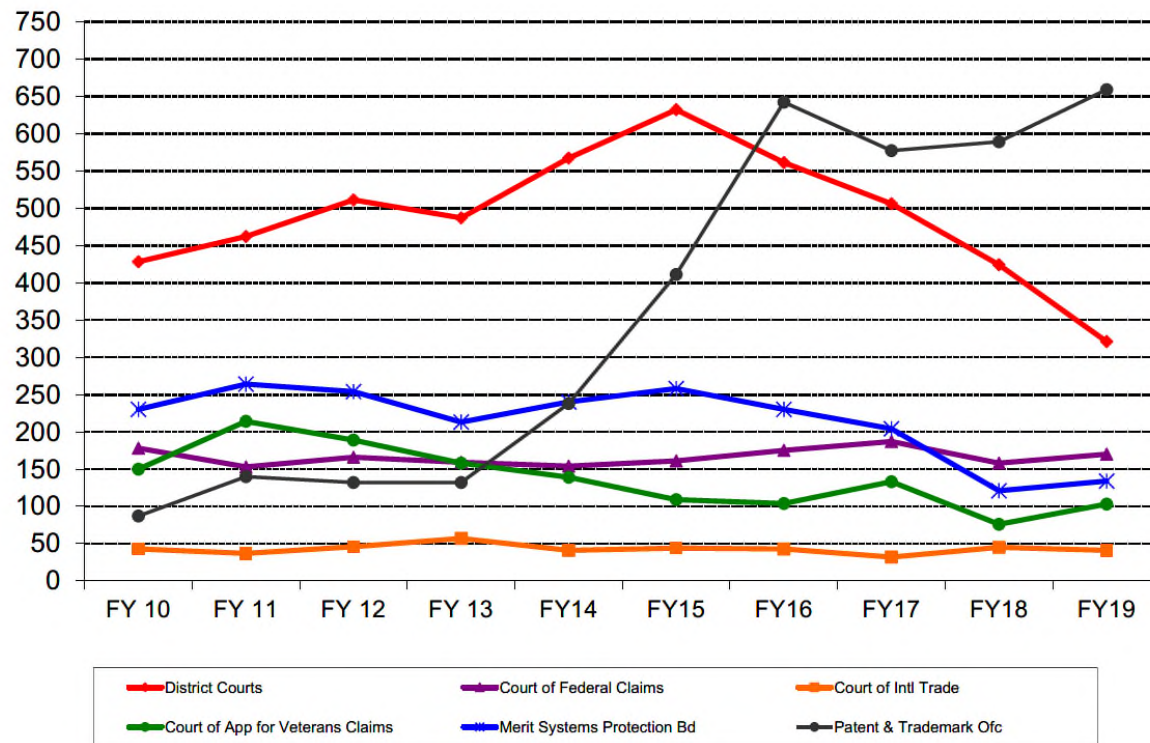
## United States Court of Appeals for the Federal Circuit Historical Caseload



Note: Includes reinstated, cross- and consolidated appeals.



## United States Court of Appeals for the Federal Circuit Appeals Filed in Major Origins

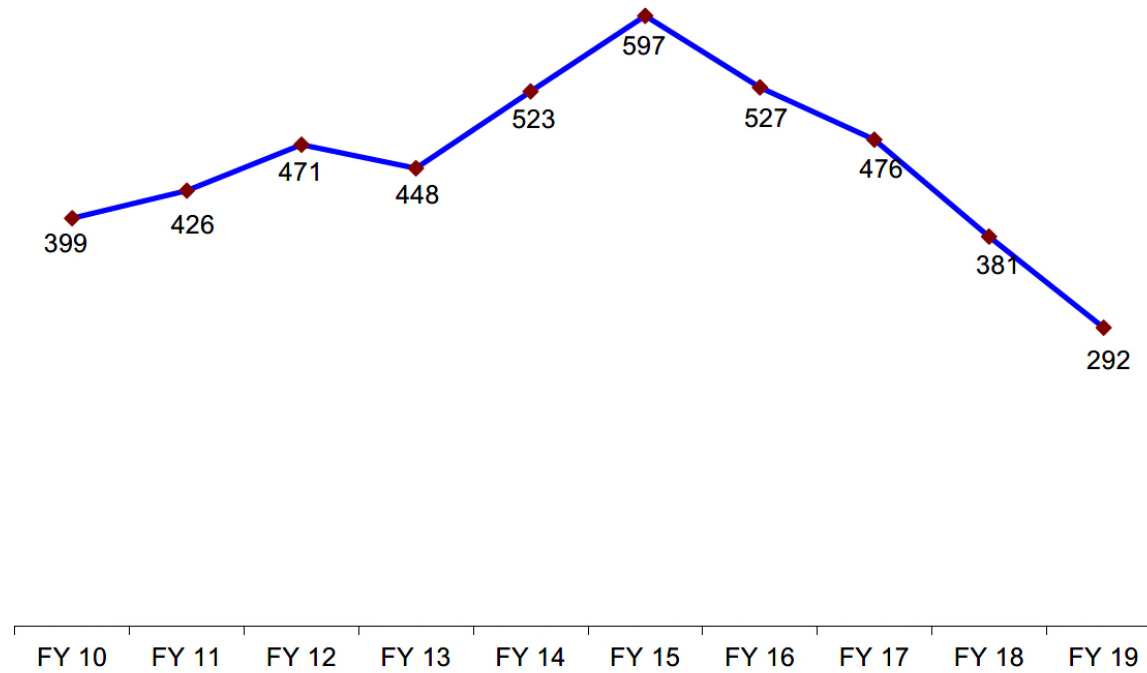


Notes: Includes reinstated, cross-, and consolidated appeals.

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## United States Court of Appeals for the Federal Circuit

### Filings of Patent Infringement Appeals from the U.S. District Courts



Note: Includes reinstated, cross- and consolidated appeals.

Source: [http://www.ca9.uscourts.gov/sites/default/files/the-court/statistics/Patent\\_filings\\_historical.pdf](http://www.ca9.uscourts.gov/sites/default/files/the-court/statistics/Patent_filings_historical.pdf)

## United States Court of Appeals for the Federal Circuit

Median Time to Disposition in Cases Terminated After Hearing or Submission<sup>1</sup>

Docketing Date<sup>2</sup> to Disposition Date, in Months

	<u>FY 10</u>	<u>FY 11</u>	<u>FY 12</u>	<u>FY 13</u>	<u>FY 14</u>	<u>FY 15</u>	<u>FY 16</u>	<u>FY17</u>	<u>FY 18</u>	<u>FY 19</u>	<u>Overall Median per Origin</u>
District Court	11.0	11.2	11.8	11.8	12.0	12.0	13.0	13.0	14.0	16.0	12.0
Court of Federal Claims	10.0	10.6	9.9	10.4	10.0	10.0	9.0	9.0	11.0	12.0	10.0
Court of International Trade	11.0	12.2	12.6	12.4	13.0	12.0	13.0	15.0	14.0	14.0	12.8
Court of Appeals Veterans Claims	9.3	6.0	8.6	11.2	10.0	7.0	7.5	6.0	14.0	12.0	9.0
Board of Contract Appeals	8.8	10.0	11.5	13.3	16.0	10.0	10.0	9.0	13.5	16.0	10.8
Department of Veterans Affairs	n/a	19.4	15.7	n/a	n/a	16.0	13.0	17.0	19.0	17.0	17.0
Department of Justice	8.9	n/a	n/a	9.7	12.0	5.9	12.0	13.0	12.0	15.0	12.0
International Trade Commission	14.8	14.6	16.1	13.7	16.0	13.0	17.0	13.0	11.0	17.0	14.7
Merit Systems Protection Board	6.1	6.1	6.4	7.4	6.0	6.5	7.0	6.0	12.0	12.5	6.5
Office of Compliance	13.0	15.0	n/a	n/a	n/a	n/a	n/a	n/a	14.0	13.0	13.5
Patent and Trademark Office	8.2	11.2	11.7	10.1	10.0	11.0	11.0	13.0	15.0	15.0	11.1
Government Accountability Office	n/a	n/a	n/a	n/a	n/a	n/a	11.0	n/a	n/a	n/a	11.0
<b>Overall Median per Fiscal Year</b>	<b>9.7</b>	<b>11.2</b>	<b>11.7</b>	<b>11.2</b>	<b>12.0</b>	<b>10.5</b>	<b>11.0</b>	<b>13.0</b>	<b>14.0</b>	<b>15.0</b>	<b>11.5</b>

<sup>1</sup> Excludes cross and consolidated appeals, writs, and OPM petitions

<sup>2</sup> Calculated from Date of Docketing or Date of Reinstatement, whichever is later

## COVID-19's Impact at the Federal Circuit

1. Court is still fully functioning remotely, all deadlines remain in effect
2. Oral arguments in April and May via telephone
  - Reports in April are that the arguments have gone smoothly
  - Anyone from the public can call into the arguments
3. Although traditionally all cases where parties are represented by counsel are set for oral argument, in April and May certain panels have in their discretion canceled oral argument altogether
4. Court has suspended requirement that paper copies be submitted
5. Judicial Conference has been canceled, FCBA Bench & Bar will be a virtual conference

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**ROMAG FASTENERS, INC.,  
PETITIONER V. FOSSIL, INC.**

**WILLFUL INFRINGEMENT NEED NOT BE PROVEN  
TO RECOVER AN AWARD OF PROFITS IN  
TRADEMARK CASES**

**Alexandria Petterson  
United States Supreme Court, No. 18–1233, April 23, 2020**

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## Facts

- “Romag sells magnetic snap fasteners for use in leather goods.”
- “Fossil designs, markets, and distributes a wide range of fashion accessories.”
- The parties “signed an agreement allowing Fossil to use Romag’s fasteners in Fossil’s handbags and other products.”
- “Romag discovered that the factories Fossil hired in China to make its products were using counterfeit Romag fasteners—and that Fossil was doing little to guard against the practice.”
- Romag sued and won. Jury found that Fossil’s behavior was not willful, which barred an award of profits under the Second Circuit’s precedent.
- Federal Circuit applied law of regional circuit and affirmed.



## Question Presented

- Whether a plaintiff can win a profits remedy only after showing the defendant *willfully* infringed its trademark.
- Even split between the Federal appeals courts:
  - Third, Fourth, Fifth, Sixth, Seventh, and Eleventh Circuits do not require a threshold showing of willfulness
  - The Second, Eighth, Ninth, Tenth, DC, First Circuits, for the most part, do require a threshold showing of willfulness.

## Remedies under the Lanham Act - 15 U. S. C. §1117(a)

- “When a violation of any right of the registrant of a mark registered in the Patent and Trademark Office, a violation under section 1125(a) or (d) of this title, or a willful violation under section 1125(c) of this title, shall have been established . . . , the plaintiff shall be entitled, subject to the provisions of sections 1111 and 1114 of this title, and subject to the principles of equity, to recover (1) defendant’s profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action.”
- Here, we’re concerned with a violation of section 1125(a) (trademark infringement).

## Plaintiff's argument

- §1117(a) says nothing about willfulness with respect to a violation under section 1125(a), and yet expressly requires willfulness with respect to “a willful violation under section 1125(c)” (trademark dilution).

## Defendant's argument

- Traditional principles of equity, expressly incorporated into §1117(a) ("subject to the principles of equity"), require willfulness for an award of profits.



## Takeaways

Gorsuch Majority Opinion (Joined by all but Sotomayor)

- A plaintiff in a trademark infringement suit is not required to show that a defendant willfully infringed the plaintiff's trademark as a precondition to a profits award.
- "Without question, a defendant's state of mind may have a bearing on what relief a plaintiff should receive. An innocent trademark violator often stands in very different shoes than an intentional one. But some circuits have gone further."

## Takeaways

Alito Concurrence (joined by Breyer and Kagan)

- “[W]illfulness is a highly important consideration in awarding profits under §1117(a), but not an absolute precondition.”

Sotomayer Concurrence

- “[A] district court’s award of profits for innocent or good-faith trademark infringement would not be consonant with the “principles of equity” referenced in §1117(a).”

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# **QUEST INTEGRITY USA, LLC V. COKEBUSTERS USA INC.**

**IMPACT ON PATENT CLAIMS BY SALE OF  
SERVICES BEFORE CRITICAL DATE**

**Ayaka Hatori  
924 F.3d 1220 (FED. CIR. 2019)**

## *Quest Integrity USA Case premise*

- **February and March 2003**, Quest provided a service to Orion Norco Refinery for \$72,060 (“Norco sale”) that produced two inspection reports (“Norco Reports”) that Quest provided to Orion Norco.
- The Norco Reports contained color-coded strip charts displaying the collected inspection data.
- Cokebusters allege Quest’s ‘874 patent filed **June 1, 2004** is invalid based on the Norco Reports and the Norco Sale, violating the 35 USC 102(b) on-sale bar.

## *Quest Integrity USA, LLC V. Cokebusters USA Inc.*

- Pre-AIA 35 USC §102(b):
  - A person shall be entitled to a patent unless –
    - (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or ***on sale in this country***, more than one year prior to the date of the application for patent in the United States
- The “on-sale bar” prevents a person from receiving a patent if the invention was on sale in the United States over 1 year prior to the application of a patent for said invention.
- The two-part test for determining whether an invention is “on sale” requires:
  - The invention be the subject of a commercial offer for sale; and
  - The invention be ready for patenting.

Note: Secret sales can invoke 102(b) and invalidate a patent.



## Does a commercial sale of *services* invoke the 102(b) bar?

- Sale of a **product** produced by **performing** a claimed process implicates the on-sale bar.
- Performance of a claimed method for compensation, or a commercial offer to perform the method, can also trigger the on-sale bar, even when no product is sold or offered for sale. *Scaltech, Inc. v. Retec/Tetra, LLC*, 269 F.3d 1321, 1328 (Fed. Cir. 2001).
- “[t]he on sale bar rule applies to the sale of an ‘invention,’ and in this case, the invention was a process.” *Id.*
- The same approach applies where a service is performed for compensation using a claimed computer-readable storage medium (CRSM) or system that generates a “product.”

## Claim Validity Analysis

- The invention that is the subject matter of the offer for sale must satisfy each claim limitation of the patent.
- Claims at issue include claims 12 and 33 (method claims) claim 24 (CRSM claim)
- The claims and the prosecution history of the claims are analyzed to determine whether the Norco Sale satisfied each claim limitation.
- The court determined both the originally filed and the allowed claims 12, 24, and 33 as being performed in the sale of a service (Norco Sale) that generates a product (Norco Reports) and invalid.

## Takeaways

- Sales of services invoke 35 USC 102(b), implicating method and CRSM patent claims
- Unanswered Question: Does the holding with regards to pre-AIA 102(b) apply to AIA 102(a)(1)?
- Advice to clients:
  - timely file patent applications before the 1 year mark after any **public disclosure** of the invention including the **sale of services** that perform a method and/or CRSM of the claimed invention.
  - Secret sales trigger the on-sale bar, as well.

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# **AJINOMOTO CO., INC. V. ITC**

**PROSECUTION HISTORY ESTOPPEL  
AND THE DOCTRINE OF EQUIVALENTS**

**Ben Pezzner**

**932 F.3d 1342 (FED. CIR. 2019)**

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## Overview: Prosecution History Estoppel

- A patentee seeking to assert a patent must prove (i) literal infringement or (ii) infringement under Doctrine of Equivalents (DOE)
  - Literal: accused product has every claimed feature
  - DOE: accused product doesn't have every claimed feature, but performs substantially same function in substantially same way to obtain substantially same result
- Defense against reliance on DOE: Prosecution History Estoppel (PHE)
  - Rebuttable presumption that an amendment (during prosecution) surrenders asserted equivalents under DOE
  - If the patentee gave up claim scope in return for obtaining the patent, the patentee cannot assert that scope under DOE ("Product A is equivalent to mine!")



# Overview: Prosecution History Estoppel

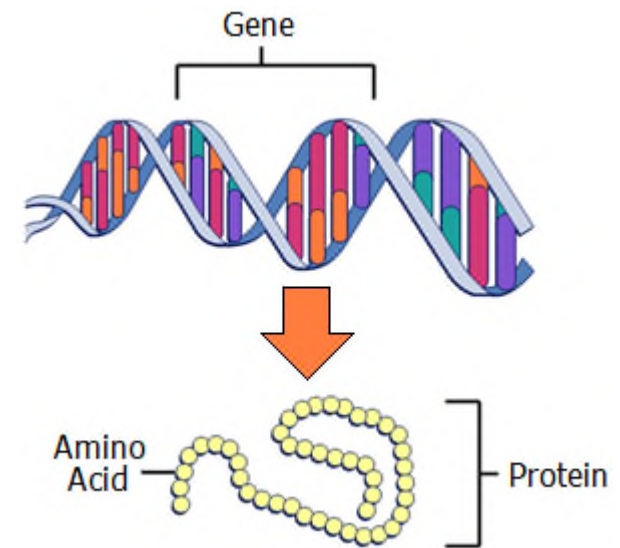
- During Prosecution
  - Claim: “a PowerPoint slide with a colorful header”
  - Reference: a PowerPoint slide with a multi-colored header
  - Amendment: “a PowerPoint slide with a ~~colorful~~ single-colored header”
- Example 1:
  - Accused product: a PowerPoint slide with an orange and yellow header
  - PHE: presumption that the amendment surrenders equivalents having headers with more than one color
- Example 2:
  - Accused product: a PowerPoint slide with single-colored half-header
  - Is PHE presumption rebutted? Amendment was about *color*, not *type* of header

# Overview: Prosecution History Estoppel

- PHE Exceptions (rebut the presumption that equivalents are surrendered)
  - Equivalent **unforeseeable** at time of application
  - No **reasonable expectation** for patentee to have described the equivalent
  - Rationale behind amendment bears no more than a **tangential relation** to the equivalent
    - Ask whether the reason for amending was peripheral (not directly relevant) to the alleged equivalent
    - Is the difference between the literal claim and the equivalent tangential to the reason for the amendment?
    - Ex: Reason for amending was clarifying header *color* → irrelevant to header *type*

# Ajinomoto v. ITC (Fed. Cir. 2019)

- Overview
  - Ajinomoto developed E. coli bacteria genetically engineered to produce aromatic L-amino acids
  - CJ Cheiljedang imported products into the U.S.
  - Ajinomoto sued, ITC found CJ infringed (PHE did not bar DOE), CAFC affirmed
- Patent: US 7,666,655
  - Identifies a gene in E. coli (**yddG gene**) that encodes a membrane protein (**YddG protein**), which transports aromatic L-amino acids out of the bacterial cell where they can be collected
  - Enhance **gene** activity → produce **protein** → bacterium increases production of aromatic L-amino acids

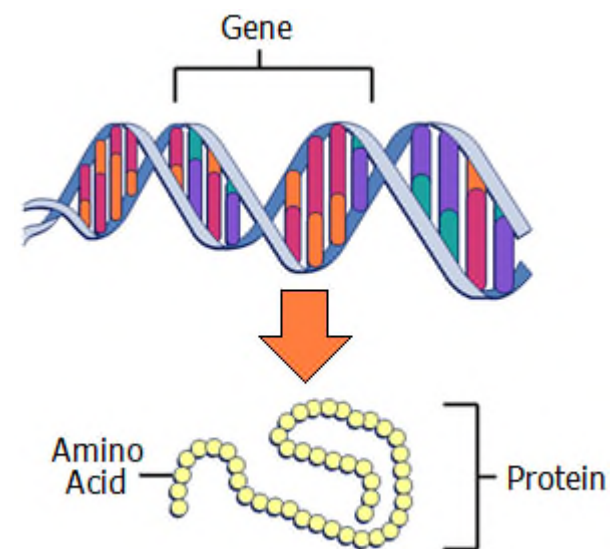


**yddG gene** → **YddG protein** → aromatic L-amino acids

## Ajinomoto v. ITC (Fed. Cir. 2019)

- Asserted claim: a **protein** comprising the specified **amino acid sequence**  
“the amino acid sequence shown in SEQ ID NO:2”
- Non-asserted claim: a **protein** comprising **variations** of the specified amino acid sequence

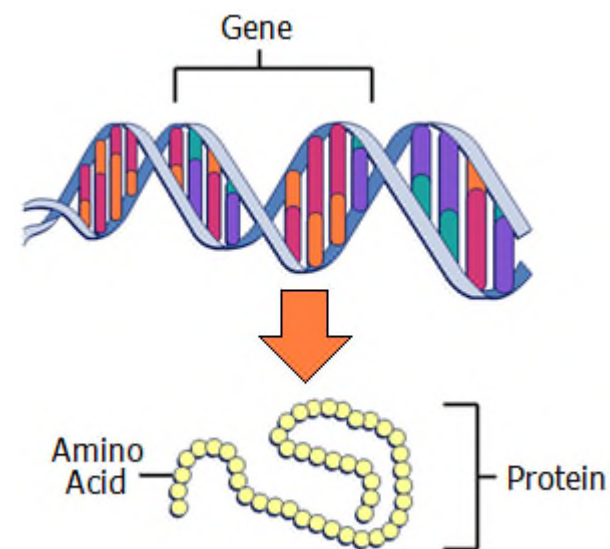
“an amino acid sequence including deletion, substitution, insertion, or addition of one or several amino acids in the amino acid sequence shown in SEQ ID NO:2”



yddG gene → YddG protein → aromatic L-amino acids

## Ajinomoto v. ITC (Fed. Cir. 2019)

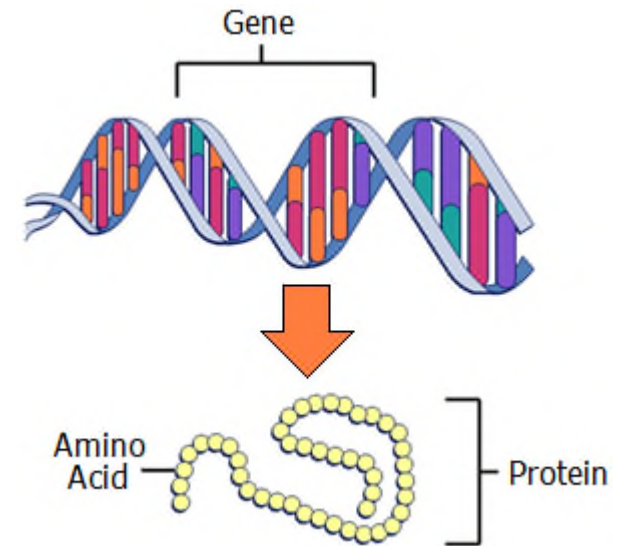
- Non-asserted claim: a protein comprising variations of the specified amino acid sequence (E. coli YddG protein)  
“a protein which comprises an amino acid sequence including deletion, substitution, insertion, or addition of one or several amino acids in the amino acid sequence shown in SEQ ID NO:2”
- Prior Art Reference: E. coli YfiK protein
- Amended claim: a protein comprising narrowed variations of the specified amino acid sequence  
“a protein which comprises an amino acid sequence including deletion, substitution, insertion, or addition of one or several amino acids in the amino acid sequence shown in SEQ ID NO:2 that is encoded by a nucleotide sequence that hybridizes with the nucleotide sequence of SEQ ID NO:1”



yddG gene → YddG protein → aromatic L-amino acids

# Ajinomoto v. ITC (Fed. Cir. 2019)

- Asserted Claim
  - **E. coli YddG protein** (protein encoded by E. coli yddG gene)
- Alleged Equivalent (CJ's E. coli strain)
  - **non-E. coli YddG protein** (protein encoded by non-E. coli yddG gene)
- CJ's PHE defense to DOE
  - Amendment narrowing the **amino acid variations** of the protein surrendered DOE for the **YddG protein**
- Tangential Relation exclusion
  - Purpose of the amendment was to limit the set of **amino acid variations** within the claim's scope so that claim no longer included **YfiK protein**
  - Had nothing to do with choosing among **gene variations** that correspond to the same protein
  - → Amendment did not surrender the **YddG protein** encoded by other gene variations (including CJ's non-E. coli yddG gene)



**yddG gene** → **YddG protein** →  
aromatic L-amino acids

# Takeaways

## Life Science-centric Takeaways

1. An amino acid amendment may qualify for the tangential relation exception to PHE if patented and offending proteins have the same amino acid sequences, even if the proteins are encoded by different genes.
2. Gene variations may not prevent literal infringement of a claimed protein if the offending amino acid sequence literally corresponds to the patented amino acid sequence listing.

## General Takeaways

1. Non-asserted claim amendments may trigger PHE presumption against DOE.
2. Focus on the purpose of the amendment when considering PHE (in the context of the Tangential Relation exception).

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# **ARTHREX V. SMITH & NEPHEW**

**WERE (AND ARE) PTAB JUDGES  
CONSTITUTIONALLY APPOINTED?**

**Scott Tester  
941 F.3d 1320 (FED. CIR. 2019)**



## *Arthrex v. Smith & Nephew*

- PTAB found that the challenged claims of Arthrex's patent were anticipated.
  - No party argued that the judges were not properly appointed.
- Arthrex appealed to the Federal Circuit
  - Arthrex argued that the PTAB judges were not properly appointed in its opening brief.
  - Smith & Nephew (and the PTO) argued both that the judges were constitutionally appointed and that Arthrex waived the issue.
- Federal Circuit held:
  1. Raising constitutionality in an opening brief is still timely.
  2. The judges were not inferior officers and were not constitutionally appointed.
  3. Removing certain job protections for patent judges makes them inferior officers going forward.

Thus... Smith & Nephew's IPR was remanded for a rehearing with new judges.

## *Arthrex v. Smith & Nephew*: Rehearing Requested

1. Arthrex argued the IPR statute should be held unconstitutional.
  - Congress would never have enacted the IPR statute if it had known PTAB judges would lose their job tenure protections.
  - Even without job protections, the PTO Director still cannot “review and reverse” IPR Final Written Decisions.
2. Smith & Nephew argues no re-hearing is necessary.
  - Even with job protections, the PTAB judges were inferior officers.
3. The PTO also argued no re-hearing is necessary:
  - Appointment Clause challenges must be raised at the PTAB.

## *Arthrex v. Smith & Nephew*: Rehearing DENIED

Short *per curiam* denial of all petitions. *Arthrex v. Smith & Nephew*, 953 F.3d 760, 761 (Fed. Cir. 2020).

- Four dissenting judges.
- Hughes Dissent:
  - That the APJs have “significant authority” only makes them “officers,” not “principal” officers.
- Wallach Dissent:
  - That the director can select APJs for a hearing and appoint judges to rehear matters indicates APJs are inferior officers.
- Dyk Dissent:
  - “The **draconian remedy** chosen by the panel... rewrites the statute contrary to Congressional intent.”
  - Job protections for judges are “an important and longstanding feature” of Congressional legislation.

Multiple Constitutional Law professors believe the case may receive Supreme Court review due to the broader issues of principal vs. inferior officers.

- Cert petition filed.
- *Arthrex* has already been cited regarding SEC and SSA Officers.

## Arthrex v. Smith & Nephew: Who Gets Relief?

1. Can petitioners get a re-do?
  - **No.** Petitioners “consented to adjudication by the Board.” *Ciena Corp. v. Oyster Optics*, 2020 WL 2124762, at \*4 (Fed. Cir. May 5, 2020).
2. Can parties who fail to raise the issue in their opening briefs get a re-do?
  - **No.** A Petitioner “forfeit[s] its Appointments Clause challenge” by not raising it in its opening brief. *Customedia Techs. v. Dish Network Corp.*, 941 F.3d 1174, 1175 (Fed. Cir. 2019).
  - *Arthrex* was not a “change in governing law” justifying waiver of forfeiture.
3. Can parties who just note the issue in their opening briefs get a re-do?
  - **Yes.** *Bedgear, LLC v. Fredman Bros. Furniture Co.*, 2020 WL 2050663 (Fed. Cir. Apr. 29, 2020).
    - But not in a footnote. *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1320 (Fed. Cir. 2006).
4. Can parties who have already lost their appeals get a re-do?
  - **Maybe.** If the mandate hasn’t issued. *Bedgear, LLC v. Fredman Bros. Furniture Co.*, 2020 WL 2050663 (Fed. Cir. Apr. 29, 2020).
5. Can parties who received their IPR decisions after *Arthrex* get a re-do?
  - **No.** “[T]he APJs were constitutionally appointed as of the implementation of the severance.” *See Caterpillar Paving Prod. Inc. v. Wirtgen Am., Inc.*, 2020 WL 2176034, at \*1 (Fed. Cir. May 6, 2020).

## *Arthrex v. Smith & Nephew*: Takeaways

1. Only IPRs whose decisions came in before the original *Arthrex* opinion issued, cancelled at least one claim, and for which the Patent Owner raised the constitutionality issue in an appeal get a re-do.
  - Currently, this is only 103 IPRs.
  - The PTAB has put all such re-dos on hold pending Supreme Court review. See General Order in Cases Remanded Under *Arthrex v. Smith & Nephew*. (May 1, 2020).
2. Be sure to raise all potential issues in your Opening Brief, even if you do not think they are winners.
  - Just not as a footnote.

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**REGENTS OF THE UNIV. OF MINN.  
V. LSI CORP.**

**STATE SOVEREIGN IMMUNITY DOES NOT APPLY  
IN INTER PARTES REVIEW**

**Ka-Lo Yeh**

**926 F.3d 1327 (FED. CIR. 2019)**

## Litigation History

- August 25, 2016: The Regents of the University of Minnesota (“UMN”) sued LSI for infringing 1 patent and separately sued Ericsson’s customers in district court for infringing 5 patents.
- March 10, 2017: LSI filed an IPR petition (IPR2017-01068) challenging UMN’s U.S. Patent No. 5,859,601 (the ‘601 patent).
- March 28-30, 2017: Ericsson filed six IPR petitions.
- May 9, 2017: UMN filed a motion to dismiss in each proceeding based on state sovereign immunity.
- December 19, 2017: USPTO convened an expanded panel (three APJ, Chief Judge, Deputy Chief Judge, and two Vice Chief Judges), concluding that state sovereign immunity applied to IPR proceedings but that UMN waived its immunity by filing suit against petitioners in district court.
- UMN timely appealed PTAB’s decision to the Federal Circuit

## Litigation History

- July 20, 2018: *Saint Regis Mohawk Tribe v. Mylan Pharmaceuticals Inc.*, 896 F.3d 1322 decided: IPR proceedings not barred by tribal sovereign immunity. Cert denied in 2019.
- June 14, 2019: the Federal Circuit held that state sovereign immunity does not apply to petitions for IPR and affirmed PTAB's decision declining to dismiss petition for IPR.
- Jan 13, 2020: Supreme Court denied petition for writ of certiorari.



## Holding

- State sovereign immunity does not apply to IPR proceedings
  - IPR represents the sovereign's reconsideration of the initial patent grant, differences between state and tribal sovereign immunity do not warrant a different result than in *Saint Regis*
- Opinion does not address whether, if sovereign immunity were to apply to IPR proceedings, the state here waived such immunity by asserting patent claims in district court that were later challenged in a petition for IPR
- Recall PTAB's determination: state sovereign immunity applied to IPR proceedings but UMN waived its immunity by filing suit in district court.

## Discussion

- IPR proceedings are essentially agency reconsideration of a prior patent grant. *Cuozzo*, 136 S. Ct. at 2144 (“[T]he purpose of the proceeding is not quite the same as the purpose of district court litigation . . . . [Instead,] the proceeding offers a second look at an earlier administrative grant of a patent.”)
- Congress enlisting the assistance of private parties does not change their essential character.
- USPTO Director, the politically appointed executive branch official, not the private party, who ultimately decides whether to proceed against the sovereign
- Any “person who is not the owner of [the] patent” may file a petition, 35 U.S.C. § 311(a), even those who do “not have a concrete stake in the outcome; indeed, they may lack constitutional standing,” *Cuozzo*, 136 S. Ct. at 2143–44

## Takeaways

- Neither Tribal immunity nor State immunity (from the 11<sup>th</sup> Amendment) applies to IPRs.
- State universities having actively licensed patent portfolios will likely be a target for IPR challenges.

**Morgan Lewis**

# **GENERAL ELECTRIC CO. V. UNITED TECHS. CORP.**

**NO STANDING FOR FEDERAL CIRCUIT REVIEW OF  
USPTO DECISION UPHOLDING PATENT CLAIMS FOR  
IPR PETITIONER THAT HAS NOT BEEN SUED**

**Han Gao**

**928 F.3d 1349 (FED. CIR. 2019)**

## Litigation History

- January 29, 2016: General Electric Company (GE) filed an IPR petition (IPR2016-00531) challenging United Technologies Corporation (UTC)'s U.S. Patent No. 8,511,605 (the '605 patent).
  - GE was neither sued nor threatened to be sued by UTC
  - Claims 1-2 on grounds of anticipation, and Claims 7-11 on grounds of obviousness
- June 26, 2017: the PTAB issued a Final Written Decision holding that GE had not shown by a preponderance of evidence that claims 7-11 of the '605 patent were unpatentable on the grounds of obviousness (claims 1-2 were dismissed by UTC)
- GE timely appealed PTAB's decision to the Federal Circuit
- December 29, 2017: UTC moved to dismiss GE's appeal for lack of standing since GE failed to demonstrate any injury in fact

## Litigation History

- The Federal Circuit denied UTC's motion without addressing the merits, and ordered GE and UTC to brief the matter and submit additional affidavit
- November 7, 2018: the Federal Circuit heard oral arguments on whether GE has constitutional standing to appeal and whether general statements made in GE's affidavit establishes standing
- July 10, 2019: the Federal Circuit held that GE lacks Article III standing and dismissed the appeal

## Holding

- GE lacks Article III standing to appeal the Board's Final Written Decision and the appeal is dismissed.
- Judge Hughes' concurring opinion:
  - "I write separately because I believe that precedent has developed an overly rigid and narrow standard for Article III standing in the context of appeals from *inter partes* review proceedings."
  - "Thus, even when the parties are direct competitors, our cases require an unsuccessful IPR appellant/petitioner to show concrete current or future plans to infringe the challenged patent. I do not believe that Article III requires such as showing, particularly where Congress has provided IPR petitioner a procedural right of appeal."

## Discussion

- “To establish Article III standing to appeal a Final Written Decision of the Board, an appellant must have suffered an injury in fact that has a nexus to the challenged conduct and that can be ameliorated by the court.”
- GE submitted three theories of harm to support standing: (1) competitive harm; (2) economic losses; and (3) estoppel under 35 U.S.C. 315(e).
  - For (1): “No present or non-speculative interest in engaging in conduct even arguably covered by the patent claims at issue.”
  - For (2): “There is no evidence that GE is in the process of designing an engine covered by claims 7-11 of the ‘605 patent. Nor has GE demonstrated that it has definite plans to use the claimed features of the ‘605 patent ...”
  - For (3): “We have previously rejected the estoppel argument as a basis for Article III standing”



## Takeaways

- A losing inter partes review petitioner who has not been sued by the patent owner generally will not have standing to appeal to the Federal Circuit
- This case, however, indicates that the Federal Circuit may be reluctant to apply the standard too rigidly. For example, the Federal Circuit denied UTC's motion to dismiss and asked GE to submit additional affidavits.

**Morgan Lewis**

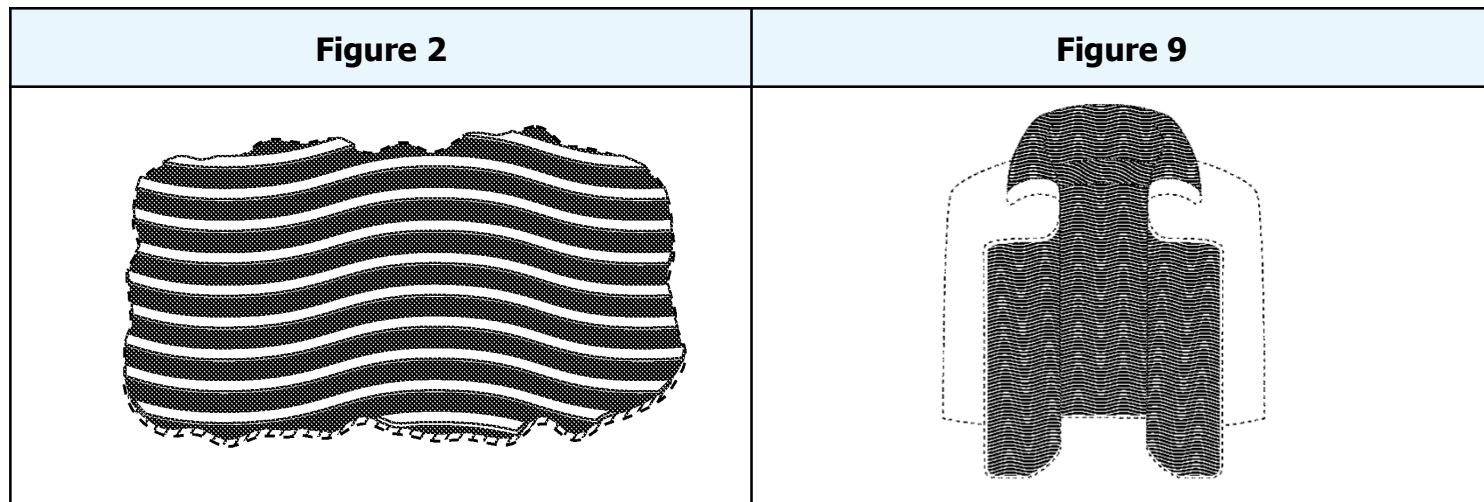
# **COLUMBIA SPORTSWEAR V. SEIRUS INNOVATIVE ACCESSORIES, INC.**

**FACTUAL DISPUTES FOR DESIGN PATENT  
INFRINGEMENT**

**Ehsun Forghany**  
**942 F. 3d 1119 (FED. CIR. 2019)**

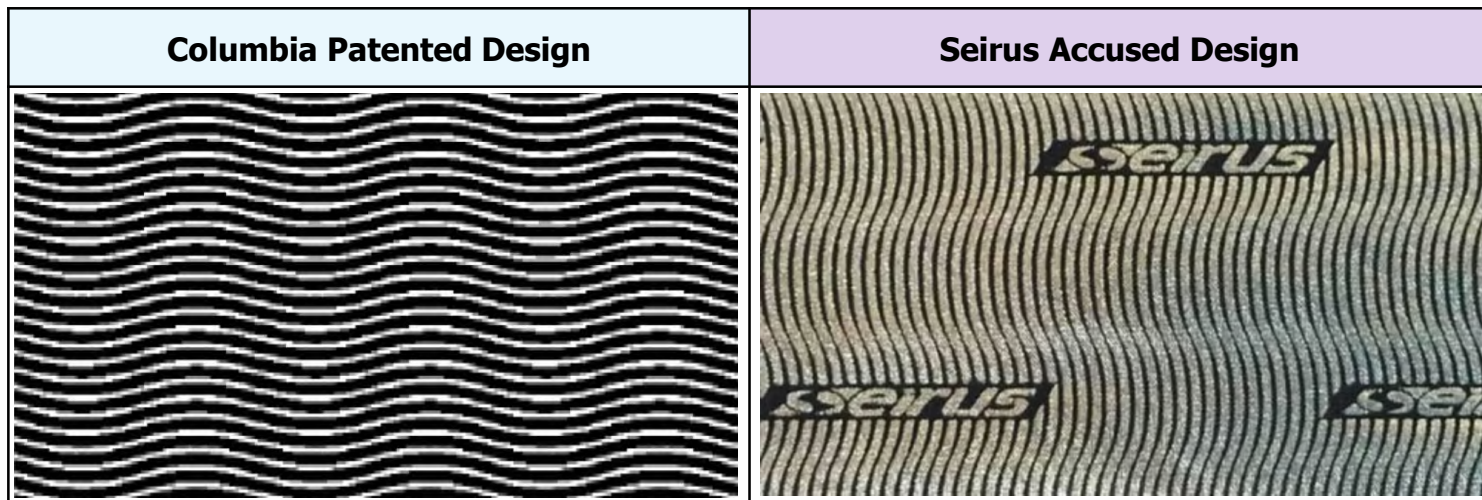
## Background

Columbia sued Seirus for infringing two patents, including **D657,093**, that protect its “Omni-Heat” technology—a fabric liner that reflects body heat and wicks moisture.



## Background

Columbia moved for summary judgment that certain “HeatWave” products—the heat-reflective material used in Seirus’s cold-weather gear—infringed the Omni-Heat patents.

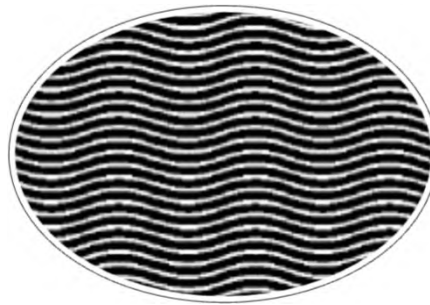


# Standard for Design Patent Infringement

Whether the *overall appearance* of the patented design and the accused products would be *substantially similar* to the *ordinary observer* giving *such attention* as purchasers usually give *who is familiar with the prior art*.



# Factual Disputes Identified by Seirus



<b>Logo</b>	No	Yes
<b>Wave Orientation</b>	Horizontal	Vertical
<b>Wave Width</b>	Varied	Uniform
<b>Wave Size</b>	Large	Small

## District Court

Relying on *LA Gear* and its progeny, the district court declined to consider Seirus's logo placement in its infringement analysis, noting that it is "well-settled that a defendant cannot avoid infringement by merely affixing its logo to an otherwise infringing design."

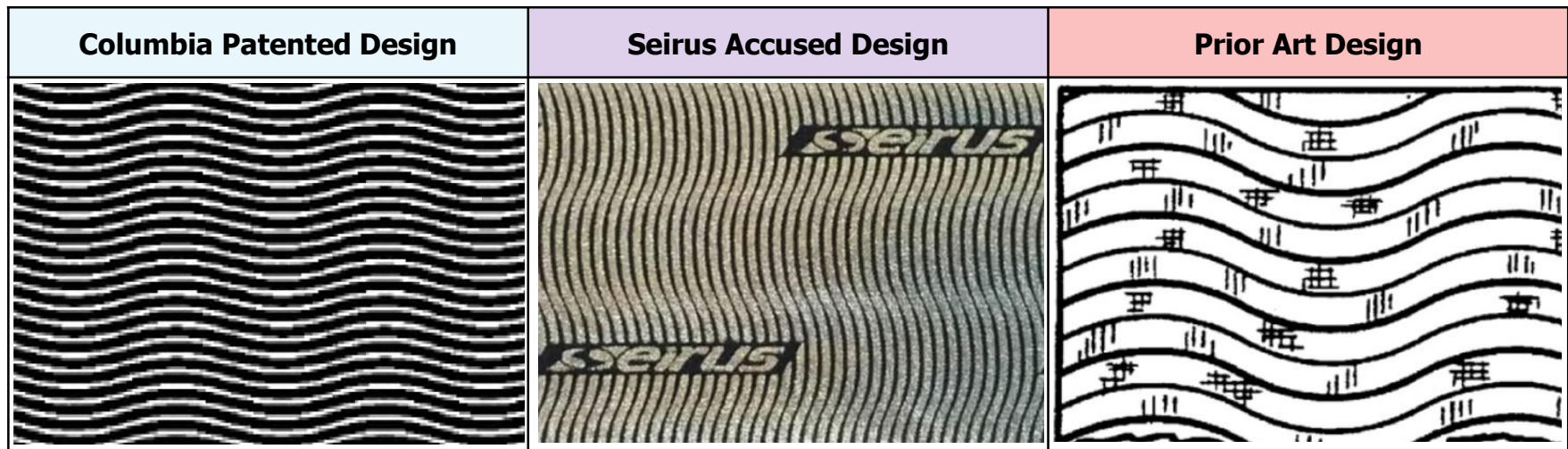
For the differences in wave orientation, width, and size, the district court found them to be "so minor as to be nearly imperceptible" and that they did "not change the overall visual impression that the Seirus design is the same as Columbia's patented one."

*Columbia Sportswear N. Am., Inc. v. Seirus Innovative Access., Inc.*, 202 F. Supp. 3d 1186, 1193 (D. Or. 2016) (Summary Judgment Decision)



## District Court

Court also considered Seirus' submitted prior art, and after identifying the closest art, found Columbia and Seirus's designs to be "substantially closer" than the prior art design.





# Federal Circuit

Federal Circuit vacated summary judgment for two reasons.

## **#1: Improperly Excluded Seirus Logo from Consideration**



*LA Gear* does not prohibit the fact finder from *considering* an ornamental logo, its placement, and its appearance as one among other potential differences between a patented design and an accused design. ... [T]he fact finder cannot ignore elements of the accused design *entirely* because it must determine whether an ordinary observer would find the effect of the *whole* design substantially the same.

942 F. 3d 1119, 1131 (Fed. Cir. 2019)



# Federal Circuit

Federal Circuit vacated summary judgment for two reasons.

## **#2: Improperly Resolved Factual Disputes**



[T]he district court made a finding of fact—whether an element of Seirus’s design would give an ordinary observer a different visual impression than Columbia’s design—over a disputed factual record,” which is “not permitted by Rule 56 and should be resolved by the jury on remand.”

942 F. 3d 1119, 1131 (Fed. Cir. 2019)



# Takeaways

## **For Litigants**

- Each party should carefully consider whether there are potential factual disputes that could inform an ordinary observer's overall impression of a design and adjust their summary judgment strategy accordingly.

## **For Applicants**

- Consider incorporating logos into a design (*e.g.*, via broken lines) to reinforce the optional relationship between a design and possible logo placement.
- Consider claiming more of the design, in at least one filing, to deemphasize certain differences in the partial design(s) and to also preserve the ability to collect damages should changes in the law eventually limit damage awards for certain partial designs.

**Morgan Lewis**

# **ARCTIC CAT V. GEP POWER PRODUCTS**

**REASONABLE DILIGENCE - REDUCTION TO PRACTICE**

**Austin Zuck**  
**919 F.3D 1320 (FED.CIR. 2019)**

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## Background - *Arctic Cat v. GEP Power*

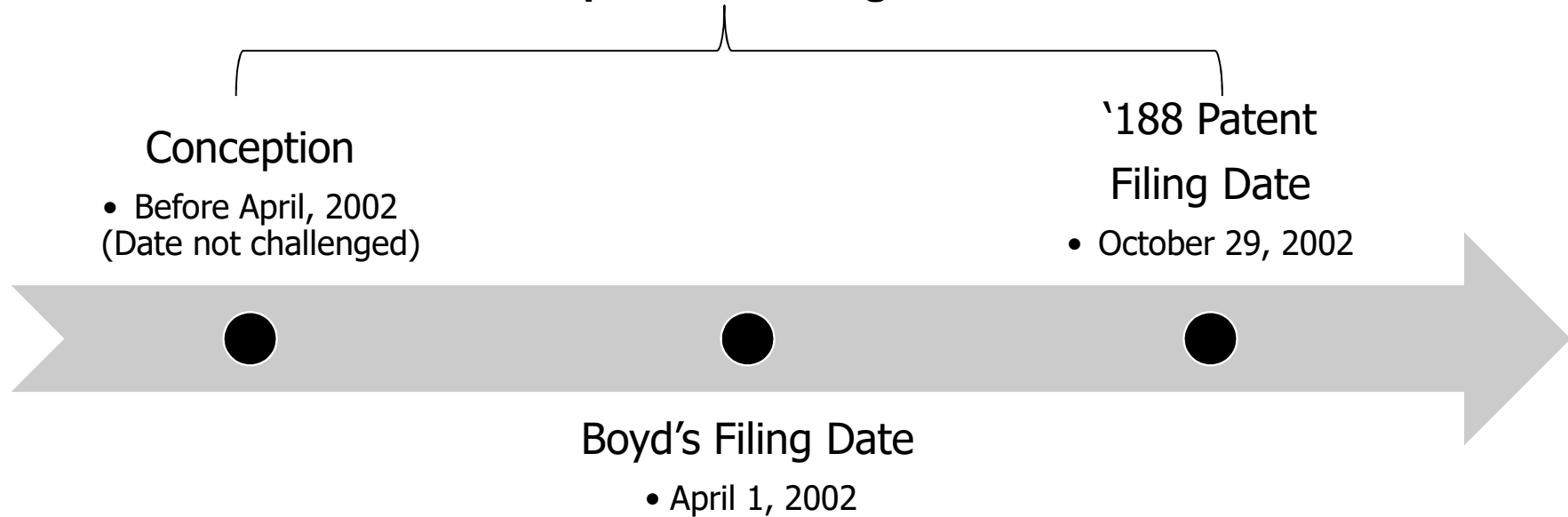
- GEP filed an IPR on U.S. Pat. No. 7,072,188 in IPR2016-01385.
  - Patent related to an electrical-connection box allowing wires to be arranged and secured in various positions for better power distribution.
- To challenge patentability, GEP used a reference, U.S. Pat. No. 6,850,421 (“Boyd”), that was filed 6 months before the challenged patent.
- GEP asserted that Boyd was prior art pursuant to 35 U.S.C. § 102(e)(2).

## Prior Invention - 35 U.S.C. § 102(e)(2)

- For Boyd to qualify as prior art pursuant to § 102(e)(2), it must be:
  - “... **a patent granted on an application** for patent by another **filed** in the United States **before the invention by the applicant** [Arctic Cat] ... ”
- To prove prior “invention by the applicant” under 102(e)(2), Arctic Cat must show:
  - (1) conception of the invention, and
  - (2) **diligent reduction to practice.**

# Timeline of Relevant Dates

Was the invention “diligently reduced to practice” between conception and filing?



## Prior Invention – Diligent Reduction to Practice

- “**Reasonable diligence** must be shown throughout the entire critical period, which begins just prior to the competing reference’s effective date and ends on the date of the invention’s reduction to practice.”
- “[D]iligence **need not be perfectly continuous**—only *reasonably* continuous.”
- “[P]eriods of inactivity within the critical period do not automatically vanquish a patent owner’s claim of reasonable diligence.”
- “[T]he adequacy of the reduction to practice is determined by whether, in light of **the evidence as a whole**, ‘the invention was **not abandoned or unreasonably delayed.**’”



## PTAB Decision – No Reasonable Diligence in Reduction to Practice

- Board found that there was **no diligent reduction to practice**.
- Inventor submitted a declaration with evidence showing reasonable diligence.
  - Multiple week-long periods without inventor activity due to third party testing.
- PTAB held that the inventor’s inactivity spanned too many days and constituted unreasonable delay.
  - “The critical period in this case spans 211 days (April 1, 2002 to October 29, 2002), and the two exemplary time periods [during which the inventor was not personally active] account for 102 days of the critical period, or almost half.” IPR2016-01385, Paper 27 at 19-20.
- The Board therefore found that the Boyd reference qualified as prior art and rendered the challenged claims unpatentable.

## Federal Circuit – Reversed PTAB

- Reversed the PTAB’s decision - reduction to practice **was reasonably diligent.**
- Federal Circuit focused on the fact that the majority of the unaccounted time was when the inventor sent the invention to a 3<sup>rd</sup> party testing facility.
  - **“Lack of diligence cannot be inferred from putting the invention into someone else’s hands for needed testing and awaiting test results for a short period commensurate with the testing need, at least where oversight was diligent.** That course of action, as a way of reducing an invention to practice, does not give rise to an inference of unreasonable delay or abandonment of the invention.”
- Inventor also “pressed for progress” and asked for updates “with apparent urgency” from the third party testing facility.
  - “[T]he evidence confirms Mr. Janisch’s diligent oversight—indeed, his persistence in moving the project of reduction to practice through multiple stages in a timely manner.”

## Takeaways

- Third party testing, if reasonably and diligently managed, does not constitute an unreasonable delay or abandonment of the invention.
- Important to document and manage progress of product development, including any third party testing.
- Reinforces need for corroborating information when attempting to swear behind a prior art reference under 102(e)(2).
- Inventors do not need to be personally involved during the entire reduction to practice period, but must oversee or control the product timeline with reasonable diligence.

**Morgan Lewis**

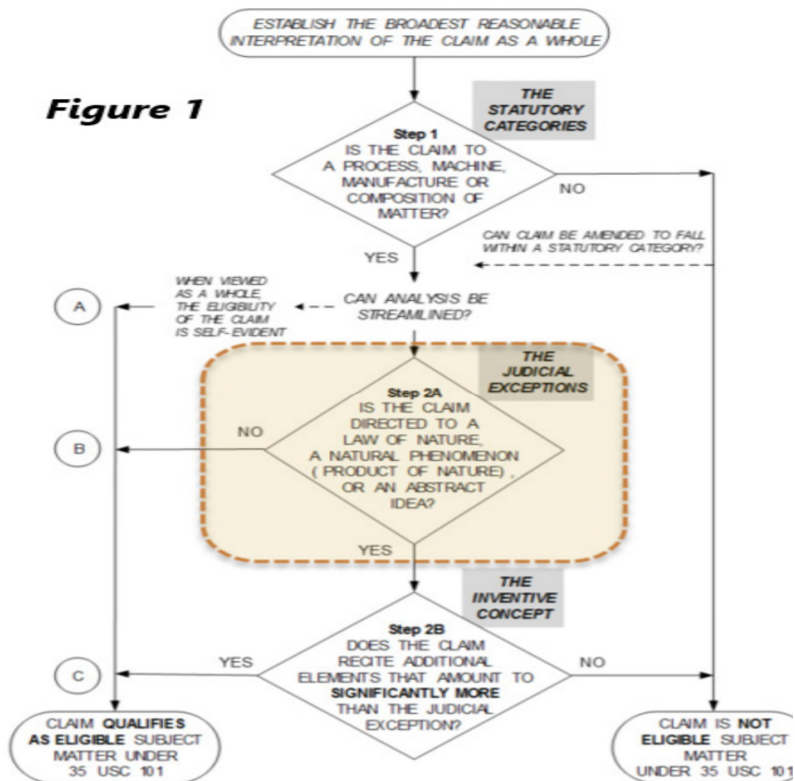
# **EX PARTE HANNUN**

**PATENTABILITY OF AI INVENTIONS**

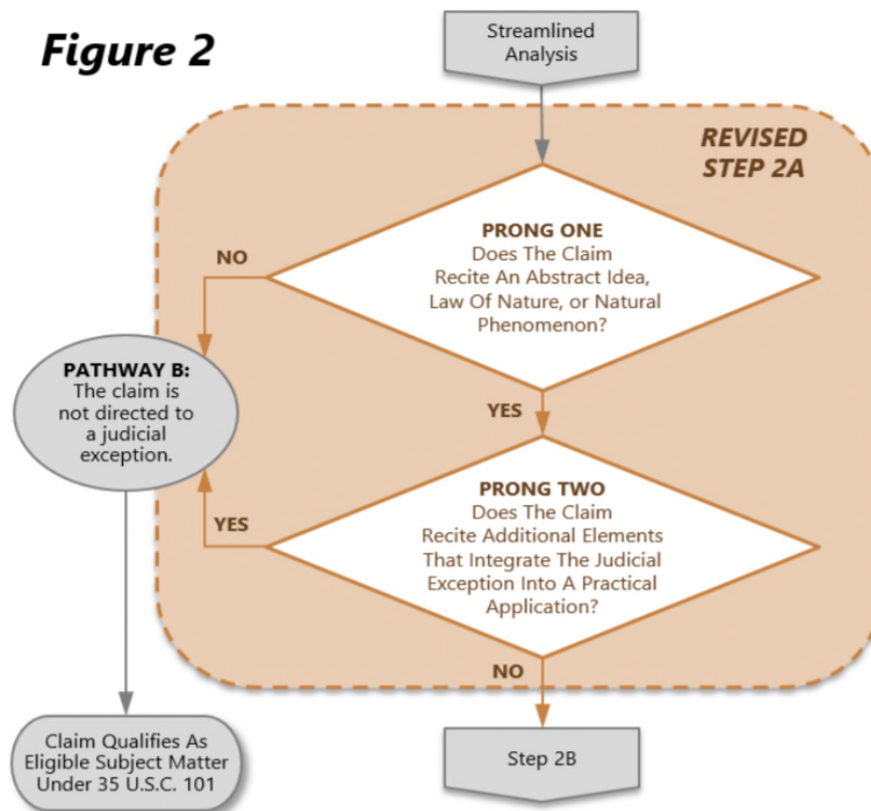
**Kannan Narayanan**

**Appeal No. 2018-003323 (PTAB April 1, 2019)**

# Background (Subject Matter Eligibility Analysis)




**Figure 2**



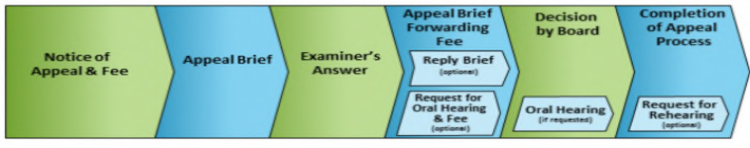
# Background (PTAB Rulings on Patent Eligibility of AI)

**Appeals**

Information about ex parte appeals conducted by the Patent Trial and Appeal Board from adverse decisions of examiners in patent applications, reissue applications, and reexamination proceedings.



**Appeals – General Process**



▼ Patent eligibility - 35 U.S.C. § 101

▼ Statutory subject matter

**Precedential**

- [Ex parte Mewherter](#), 2012-007692 (May 8, 2013) [machine readable storage medium]

**Informative**

- [Ex parte Hannun \(formerly Ex parte Linden\)](#), 2018-003323 (Apr. 1, 2019) [applying 2019 revised guidance]
- [Ex parte Smith](#), 2018-000064 (Feb. 1, 2019) [applying 2019 revised guidance]
- [Ex parte Olson](#), 2017-006489 (Mar. 25, 2019) [applying 2019 revised guidance]
- [Ex parte Kimizuka](#), 2018-001081 (May 15, 2019) [applying 2019 revised guidance]
- [Ex parte Savescu](#), 2018-003174 (Apr. 1, 2019) [applying 2019 revised guidance]
- [Ex parte Fautz](#), 2019-000106 (May 15, 2019) [applying 2019 revised guidance]

Morgan Lewis

Category	Number of Cases (as of May 1, 2020)
Total Number of PTAB Appeals on AI Patent Eligibility	74 (2019 Revised Guidance)
Number of Reversals	12
Not Abstract Idea (Prong 1, Step 2A)	9 (Not directed to mathematical relationship or formula, methods of organizing human activity, or mental processes)
Integrate Judicial Exception into A Practical Application (Prong 2, Step 2A)	2 (Addressed by “specifically using several artificial intelligence classification technologies” or a “machine learning application that included specific steps”)

## ***Ex Parte Hannun (Appeal No. 2018-003323)***

### **– Representative claim 11:**

A computer-implemented method for transcribing speech comprising:

- receiving an input audio from a user;
- normalizing the input audio to make a total power of the input audio consistent with a set of training samples used to train a trained neural network model;
- generating a jitter set of audio files from the normalized input audio by translating the normalized input audio by one or more time values;
  - for each audio file from the jitter set of audio files, which includes the normalized input audio:
    - generating a set of spectrogram frames for each audio file;
    - inputting the audio file along with a context of spectrogram frames into a trained neural network;**
    - obtaining predicted character probabilities outputs from the trained neural network;** and
    - decoding a transcription of the input audio using the predicted character probabilities outputs from the trained neural network constrained by a language model that interprets a string of characters from the predicted character probabilities outputs as a word or words.

### **– Claims are directed to:**

[S]tate-of-the-art speech recognition systems developed using end-to-end deep learning. In embodiments, the model architecture is significantly simpler than traditional speech systems, which rely on laboriously engineered processing pipelines; these traditional systems also tend to perform poorly when used in noisy environments. In contrast, embodiments of the system do not need hand-designed components to model background noise, reverberation, or speaker variation, but instead directly learn a function that is robust to such effects. A phoneme dictionary, nor even the concept of a "phoneme," is needed. **Embodiments include a well-optimized recurrent neural network (RNN) training system that can use multiple GPUs, as well as a set of novel data synthesis techniques that allows for a large amount of varied data for training to be efficiently obtained. Embodiments of the system can also handle challenging noisy environments better than widely used, state-of-the-art commercial speech systems.**

# ***Ex Parte Hannun* (Appeal No. 2018-003323)**

## **PTAB Reversal (Step 2A, Prong 1)**

<b>Examiner's Rejection</b>	<b>PTAB Board Panel's Reversal</b>	<b>Additional Notes from Panel</b>
<p><u>The claim is directed to an invention falling into the mathematical concepts category</u>, because "using the predicted character probabilities (mathematical formula) to decode a transcription of the input audio into words or text data," was "<b>similar to the court case <i>Gottschalk v. Benson</i></b>."</p> <p>The claim was also abstract under the "<u>certain methods of organizing human activity</u>" and "<u>mental process</u>" categories, because a "<b>human can listen to an audio file and transcribe the audio data into text data which can all be done mentally.</b>"</p>	<p>While transcription generally can be performed by a human, the claims here are directed to a specific implementation including the steps of normalizing an input file, generating a jitter set of audio files, generating a set of spectrogram frames, obtaining predicted character probabilities from a trained neural network and decoding a transcription of the input audio using the predicted character probability outputs. <b>These are not steps that can practically be performed mentally. Nor do we see how the claimed invention recites organizing human activity.</b></p>	<p><b>The claims do not recite a mathematical concept. While the specification discloses an algorithm, the claims do not recite the algorithm.</b></p> <p>USPTO's eligibility example 38 explains that even if some claim limitations are based on mathematical concepts, the claim is not abstract unless at least one of those concepts are recited in the claims.</p>



## ***Ex Parte Hannun* (Appeal No. 2018-003323) PTAB Reversal (Step 2A, Prong 2; Step 2B)**

<b>Examiner's Rejection</b>	<b>PTAB Board Panel's Reversal</b>	<b>Additional Notes from Panel</b>
<p>(Step 2B) The claimed invention "[d]oes not amount to significantly more since it is <b>just decoding a transcription using a mathematical formula or relationship.</b>"</p>	<p>(Step 2A, Prong 2) The alleged judicial exception is integrated into a practical application, because the claims <b>"include specific features that were specifically designed to achieve an improved technological result" and "provide improvements to that technical field."</b></p> <p>The specification describes a trained neural network used with a language model that "achieves higher performance than traditional methods on hard speech recognition tasks while also being much simpler."</p>	<p>(Step 2B) The Examiner concludes the claims do not include any additional elements that amounts to significantly more than a judicial exception but <b>fails to provide sufficient factual support.</b> Under the Berheimer decision, such a conclusory rationale cannot stand.</p>

## Other AI Patentability Related PTAB Decisions

PTAB Appeal Case, Background	PTAB Rationale for Reversal	Additional Notes
<p><i>Ex Parte Adjaoute</i>, Appeal No. 2018-007443</p> <p>The claims are directed to <b>“monitoring the operation of machines ... using neural networks, logic decision trees, confidence assessments, fuzzy logic, smart agent profiling, and case-based reasoning.”</b></p>	<p>The claims recite, when read in light of the Specification, <b>recite a method and system difficult and challenging for non-experts due to their computational complexity</b>, not practical to perform mentally.</p>	<p><b>The claim does not recite a mathematical relationship, formula, or calculation.</b> While some of the limitations may be based on mathematical concepts, the mathematical concepts are not recited in the claims.</p>
<p><i>Ex Parte Bushmitch</i>, Appeal No. 2018-008667</p> <p>The claims are directed to an <b>adaptive learning system that is trained to predict operational effectiveness.</b></p>	<p>The claims recite functions that <b>use a “deep learning system” with “at least five layers”</b> to train the adaptive learning system to make “a successful prediction of operational performance factors” that “greatly reduce event evaluation costs, by eliminating human evaluators for the entire event duration.”</p>	<p>The claimed <b>invention achieves a technical improvement</b> in training.</p> <p><b>The claimed subject matter here is similar to Example 39</b> of the <b>Revised Guidance</b>, which describes a “computer-implemented method of training a neural network for facial detection.”</p>

## Other AI Patentability Related PTAB Decisions

PTAB Appeal Case, Background	PTAB Rationale for Reversal	Additional Notes
<p><i>Ex Parte Markram</i> Appeal No. 2018-008166</p> <p>The disclosed and claimed invention is directed to <b>configuring a neural network “to achieve improved information processing and/or information storage.”</b></p>	<p>A <b>“neural network device implemented in hardware or in a combination of hardware and software” and comprising “a collection of [interconnected] node assemblies”</b> is not a mathematical concept, an identified method of organizing human activity, or a mental process.</p>	<p>The Examiner concludes the claims are similar to “organizing information through mathematical correlations”, but <b>the Examiner has not shown that the claims recite a mathematical relationship, formula, or calculation.</b></p>
<p><i>Ex Parte Hueter</i> Appeal No. 2018-007627</p> <p>The invention is directed to <b>a system for tracking subject behavior and making object recommendations for content to be in a web page.</b></p>	<p><b>The claims are directed to an improvement in a computer-related technology.</b> The claims recites steps for improving the generation of content, providing content using predicted affinities by matching vectors to generate affinity scores, generating ranking lists, and eliminating some recommendations.</p>	<p>The claim recites a particular ordered set of instructions including the application of rules to collect behavioral data of a user of a website to generate personalized content by extracting subject and object characteristic represented in vectors, using the vectors to generate recommendations based upon numerical scores.</p>

## Takeaways

- AI-related inventions can be non-abstract and, therefore patentable.
- Claims covering such inventions should “include specific features that [are] specifically designed to achieve an improved technological result” and “provide improvements to that technical field.”
- Even if some claim limitations are based on mathematical concepts, the claim is not abstract unless at least one of those concepts are recited in the claims
- Call-out Examiners when they make conclusory rejections lacking sufficient factual support.

**Morgan Lewis**

# **FORUM US, INC. V. FLOW VALVE, LLC**

**REISSUE CLAIMS INVALID FOR FAILING TO  
COMPLY WITH “ORIGINAL PATENT”  
REQUIREMENT**

**Pablo Herrera  
926 F. 3D 1346 (FED. CIR. 2019)**

## Background

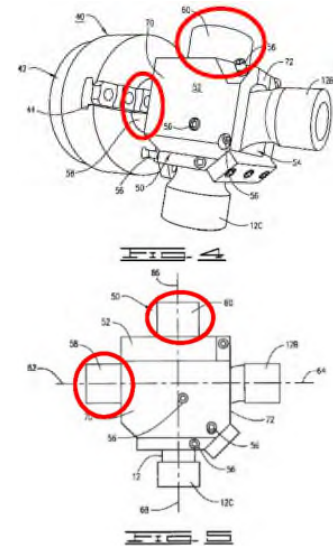
- Forum US, Inc. filed a declaratory judgment action seeking a declaration of invalidity of U.S. Patent No. RE 45,878 (the “Reissue patent”).
- The district court granted summary judgment in favor of Forum on the basis that the written description and drawings of the Reissue patent did not “explicitly and unequivocally” indicate the invention claimed in the reissue claims.
- Flow Valve, LLC appeals from the U.S. District Court for the Western District of Oklahoma’s grant of summary judgment of invalidity of its reissue patent.
- Issue: Support for broadening claims through a reissued patent

# Original and Reissue claims

Original Patent (US 8,215,213) Claim 1	Reissue Patent (US RE 45,878) Claim 14
<p>1. A workpiece machining implement comprising: a workpiece supporting assembly comprising:</p>	<p>14. A workpiece supporting assembly for securing an elbow during a machining process that is performed on the elbow by operation of a workpiece machining implement, the workpiece supporting assembly comprising:</p>
<p>...</p>	<p>...</p>
<p><b>a plurality of arbors</b> supported by the body member, each arbor having an axis coincident with a datum axis of one of the extending workpiece portions; and</p>	<p>a support that is selectively positionable to secure the elbow in the workpiece supporting assembly, the body pivotable to a first pivoted position, ...the body pivotable to a second position and sized so that a second end of the elbow extends from the channel beyond the body so the second end of the elbow is presentable to the workpiece machining implement for performing the machining process.</p>
<p>means for rotating the workpiece supporting assembly about the axis of a selected one of the arbors.</p>	

## Subject matter of the Flow Valve Patent

- The original patent and the reissue patent have the same disclosure
- The reissue patent discloses workpiece supporting assemblies or fixtures for holding workpieces during machining. *See* Reissue patent.
  - All of the embodiments illustrated and described in the Reissue patent are workpiece supporting assemblies with arbors. *Id.* Arbors are used to hold the workpiece while it rotates on the turning machine. *See id.* col. 1 36–58.
  - Arbors are explicitly identified as advantageous because they are capable of holding a workpiece in multiple orientations on a workpiece supporting assembly and expedite machining by minimizing setup time. *See id.*
  - The Reissue patent does not indicate that the arbors are optional features.
  - The Reissue patent includes boilerplate language stating that “numerous changes may be made which will readily suggest themselves to those skilled in the art and which are encompassed within the spirit of the invention disclosed and as defined in the above text and in the accompanying drawings.” *See id.* col. 3 51–60.





## Arguments

- Forum argues that a workpiece supporting assembly without the arbors is not supported by the original disclosure.
- Flow Valve concedes that the disclosure does not explicitly identify an embodiment of the a workpiece supporting assembly without arbors, but argues that a person of ordinary skill in the art would understand from the specification that arbors were an optional feature of the disclosed invention.
  - To support this argument, Flow Valve relies on an expert declaration, which states that “a worker of ordinary skill would understand that not every fixture disclosed in the patent requires a ‘plurality of arbors’” and that “the arbors are an optional feature.” *Forum US, Inc. v. Flow Valve, LLC* 926 F. 3d at 1352 (Fed. Cir. 2019)

## Legal Standard

- 35 U.S.C. § 251(a) (emphases added):

*Whenever any patent is, through error, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.*

- A reissue patent can be used to broaden claims are too narrow
- The broadened claims in the reissue patent must be disclosed in the original patent

## Interpretation of the Legal Standard

- The court must determine whether the original and reissue patents are for the same invention.
  - The court may consider expert “evidence to ascertain the meaning of a technical or scientific term or term of art so that the court may be aided in understanding not what the instruments mean but what they actually say.” *U.S. Indus. Chems., Inc. v. Carbide & Carbon Chems. Corp.*, 315 U.S. 668, 678 (1942)
- “[F]or broadening reissue claims, the specification of the original patent must do more than merely suggest or indicate the invention recited in reissue claims; “[i]t must appear from the face of the instrument that what is covered by the reissue was intended to have been covered and secured by the original.” *Forum*, 926 F. 3d at 1351 (quoting *Indus. Chems.*, 315 U.S. at 676).
- The original patent “must clearly and unequivocally disclose the newly claimed invention as a separate invention.” *Antares Pharma, Inc. v. Medac Pharma Inc.*, 771 F.3d 1362 (Fed. Cir. 2014))

## Analysis

- In reviewing the expert declaration, the court reasons that the expert's declaration does not raise a genuine dispute of material fact. *Forum*, 926 F. 3d at 1352.
  - The court states that the expert declaration “does not aid the court in understanding what the ‘instruments . . . actually say,’ but instead asserts what a person of ordinary skill in the art would purportedly understand in the absence of the disclosure of an arbor-less embodiment.” *See Indus. Chems.*, 315 U.S. at 678.
- The court notes that “nowhere do the written description or drawings disclose that arbors are an optional feature of the invention.” *Id.*
- The court concludes that “[e]ven if a person of ordinary skill in the art would understand that the newly claimed, arbor-less invention would be possible, that is insufficient to comply with the standard set forth in *Industrial Chemicals* and *Antares*.” *Id.*

## Holding

- For broadening claims in a reissue patent, the original patent “must clearly and unequivocally disclose the newly claimed invention as a separate invention.” *Id.*
- “Intent to claim” is not required to claim subject matter in the disclosure. Instead, the “essential inquiry under the ‘original patent’ clause of § 251 . . . is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees.” *See id.* at 1353
- Boilerplate language that modifications can be made to the original disclosed invention does not comply with the standard set forth in *Industrial Chemicals* and *Antares* when broadening claims in a reissue patent. *See id.* at 1352.

## Takeaways

1. Reissue patents can broaden claims; however, the new claims must be clearly and unequivocally disclosed in the original patent.
2. Boilerplate language alone does not support the removal of claim features to broaden a claim in a reissue patent.
3. Patent drafters need to consider all possible options when preparing a patent. In particular, patent drafters need to think like an inventor and incorporate the appropriate support to allow for modifications.
4. Patent drafters need to have an understanding of the clients needs while at the same time try to anticipate the potential directions that may be available to the client in the future.

# QUESTIONS

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Serving as the leader of Morgan Lewis’s semiconductor practice and as a member of the firm’s fintech and technology practices, Andrew J. Gray IV concentrates his practice on intellectual property (IP) litigation and prosecution and on strategic IP counseling. Andrew advises both established companies and startups on Blockchain, cryptocurrency, computer, and Internet law issues, financing and transactional matters that involve technology firms, and the sale and licensing of technology. He represents clients in patent, trademark, copyright, and trade secret cases before state and federal trial and appellate courts throughout the United States, before the US Patent and Trademark Office’s Patent Trial and Appeal Board, and before the US International Trade Commission.

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Alexandria Petterson serves intellectual property clients in patent prosecution. With her background in electrical engineering, Alex prosecutes patents in various technologies, including circuit design, memory architecture, digital signal processing, big data and data analytics, as well as surgical devices. Prior to joining Morgan Lewis, she interned at the Office of Intellectual Property at UCLA. Alex is currently pursuing her J.D. at Santa Clara University School of Law as an Intellectual Property Fellow.

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With an educational and professional background in electrical and computer engineering, litigator W. Scott Tester concentrates his practice on patent disputes involving the electrical and mechanical arts, as well as other related Intellectual Property (IP) matters. Prior to attending law school, Scott worked as a senior design engineer with a major telecommunications firm, where he specialized in telecommunications, network management, and security. He holds a BS degree in electrical and computer engineering from North Carolina State University.

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Ka-Lo Yeh assists clients in protecting their intellectual property and focuses on patent prosecution. She has drafted and prosecuted patent applications in a variety of technological fields including optics, physics, semiconductor devices, mass spectrometry, inkjet printing, 3D printing, photovoltaics, medical devices, and computer science. Ka-Lo is fluent in Mandarin, Cantonese, and German.

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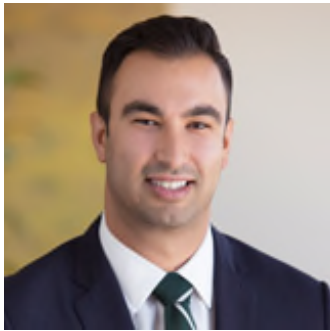
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Austin Zuck focuses his practice on litigation involving patents, trademarks, copyrights, trade secrets, and related intellectual property matters. His practice also includes assisting clients with trials before the Patent Trial and Appeal Board (PTAB), including inter partes review proceedings. While in law school, Austin worked with the Entrepreneurs Law Clinic to advise new clients on intellectual property strategy.

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Drawing on 18 years of R&D experience in the technology industry and a background in computer science and engineering, Kannan Narayanan works with clients to build strong patent portfolios, preparing and prosecuting US and foreign patents, performing patent due diligence, and providing non-infringement and invalidity opinions and freedom to operate in the high technology areas.

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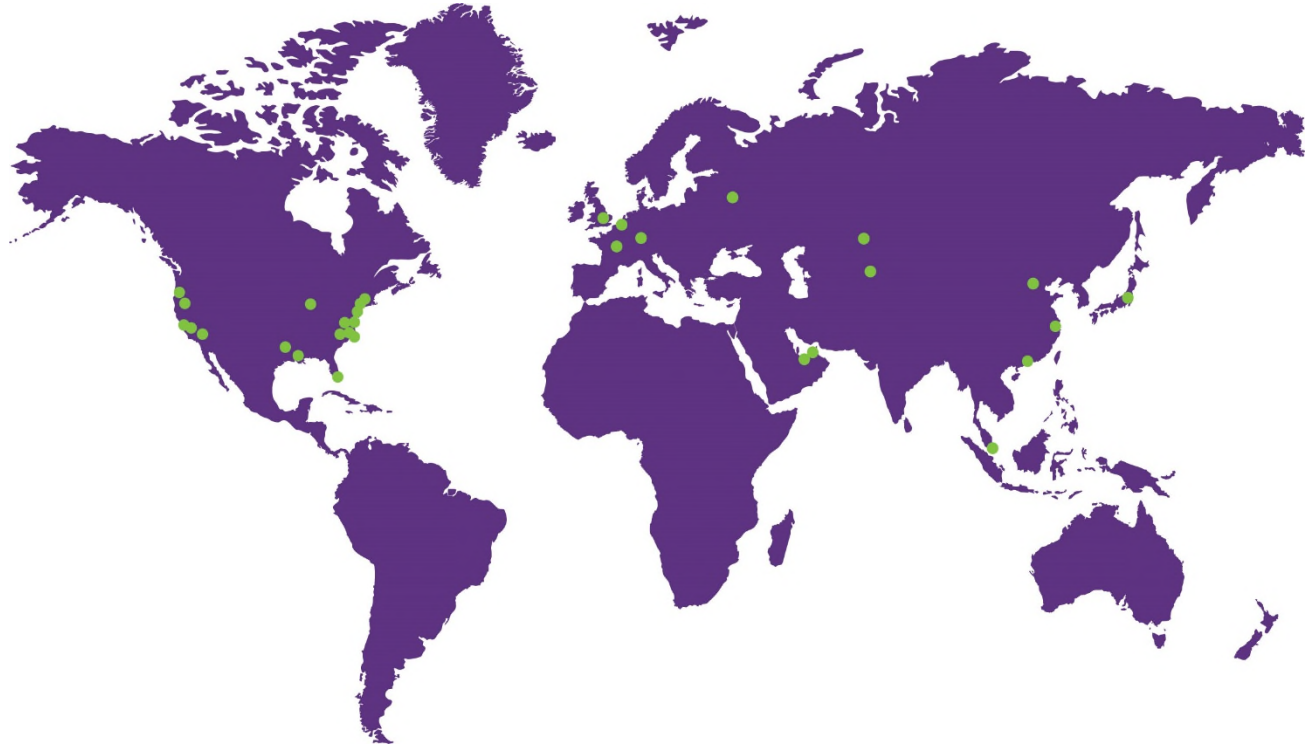
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