




MAY 15, 2023

USPTO UPDATES

[Update on USPTO Advanced Notice of Proposed Rulemaking \(ANPRM\)](#)

BY RICHARD D. KELLY

Our April 20, 2023 blog post reported on the USPTO's proposed rulemaking [here](#). Director Vidal was questioned by Congress on the advance notice. In an April 27 hearing, Director Vidal stated it was not proposed rules but for discussion purposes. That provoked a response by Representative Lofgren that "I think it's really a surprise that the PTO – that is publishing the proposed rules – is now saying it's not their proposed rules. If we got it wrong, we can revisit it, but it's not up to the PTO to try and make the law and redo it in their rulemaking process." Representative Lofgren went onto express concern with the proposed approach to creating an exception to discretionary denial if an inter partes review (IPR) petition is led within six months in the ANPRM, rather than the statutorily prescribed one year. Lofgren went on further to ask why the Office was proposing something inconsistent with the statute. Director Vidal denied it contradicted the statute. Chairman Issa requested the names of everyone consulted in compiling the advanced notice (ANPRM) to allow the subcommittee to understand the Office's deliberative process.



Representative Johnson asked the Director:

The degree of change in PTAB proceedings under different Directors has done nothing to allay my fears. The patent system is not meant to be subject to frequent and unpredictable fluctuations. The point of a 20-year patent is to allow for planning, investment and realization of new inventions. I'm concerned we've allowed the law to become too subjective and too subject to the particular views of different administrations. This is not the stable basis on which our country's innovation ecosystem should rest.

Chairman Issa asked why not go directly to rule making:

Many of the things in your 'proposed proposed rulemaking' include items which have become part of an unofficial operating procedure at the PTO. In other words, you've been doing them as though they were rules for a period of time, and now they're out there as comment. Do you think it's appropriate to put them out for further comment when in fact you're already doing them, or should they have gone directly to rulemaking, since you're already doing them without going through the statutory process that we on this side of the dais have legislated for you?

Director Vidal replied that putting out guidance first provides the 230 PTAB judges with clarity since they exercise the Director's discretion. She claimed it was meant to simply memorialize

current practice ignoring that the practice had varied. The USPTO is in the hot seat because of its history of ignoring the Administrative Procedures Act.

JPO UPDATES



[AIPLA Visits the JPO to Exchange Opinions](#)

BY KASUMI KANETAKA

On April 17th, the members of the American Intellectual Property Law Association (AIPLA) visited the Japan Patent Office (JPO) and had a meeting with the JPO Commissioner, Mr. Koichi HAMANO. During the meeting, which was postponed for three years due to COVID-19, the JPO introduced the Green Transformation Technologies Inventory (GXTI) and other latest developments to the AIPLA members. Please

see the pictures from the meeting [here](#).

[JPO's Official LinkedIn Account](#)

BY KASUMI KANETAKA

JPO has launched its official LinkedIn Account. To follow them, the account can be found [here](#), or please search "Japan Patent Office" in the search bar on LinkedIn.

FEDERAL CIRCUIT UPDATES



[Anticipation Under the Public Use Bar](#)

BY MARINA I. MILLER

Minerva Surgical, Inc. sued Hologic, Inc. and Cytoc Surgical Products, LLC in the District of Delaware for infringement of U.S. Patent No. 9,186,208. After discovery, the district court granted summary judgment that the asserted claims were anticipated under the public use bar of pre-AIA 35 U.S.C. § 102(b). Minerva appealed, arguing that its "mere display" of the Aurora device at AAGL 2009 did not rise to the level of "public use."

The Court of Appeals for the Federal Circuit (the Court) affirmed, agreeing with the district court that the patented technology was "in public use" because, before the critical date, Minerva disclosed fifteen devices having the patented technology at a public event, the industry's "Super Bowl", which included attendees who were critical to Minerva's business, potential investors and physicians, and Minerva had every incentive to showcase the Aurora devices to the attendees. The Court further noted that "public use may also occur where, as here, the inventor used the device such that at least one member of the public without any secrecy obligations understood the invention." [Read more](#).

[Does "A" Mean 'Only One' or 'One or More'](#)

BY DONALD R. McPHAIL

In a pair of precedential opinions, the Federal Circuit addressed the construction of the indefinite article "a" when used in the claims of a patent.

In the first case, *Salazar v. AT&T Mobility LLC*, No. 2021-2320 (April 5, 2023) (Stoll*, Schall, Stark), the patent at issue related to technology for wireless and wired communications. Claim 1 of that patent, which was representative of the asserted claims, included the following terms: "a *microprocessor for generating*"; "*said microprocessor creating*"; "*retrieved by said microprocessor*"; and "*said microprocessor generating*."

During claim construction at the district court, the parties had disputed whether the claim required a single microprocessor to perform all of the recited functions or whether these functions could be divided among multiple microprocessors. The district court ultimately construed the term “a *microprocessor*” to mean “one or more microprocessors, at least one of which is configured to perform the generating, creating, retrieving, and generating functions.”

On appeal, Salazar, the patentee, argued that the district court had erred in construing the term “a *microprocessor*” and that the correct construction permitted his claims to cover a system where no single processor performed all of the recited functions. Rather, under the patentee’s interpretation, the asserted claims covered systems having one microprocessor capable of performing one or more of the claimed functions and another, different microprocessor capable of performing the other claimed function(s).

In an opinion by Judge Stoll, the panel disagreed and affirmed the district court’s construction. While noting both that the indefinite article “a” generally means “one or more” in patent claims that include the transitional phrase “*comprising*” and that the use of the term “*said*” does not change that general rule, the panel nevertheless found that “antecedent basis rule” meant that each reference to “*said microprocessor*” must necessarily refer back to the same “*microprocessor*” and not to different microprocessors. In other words, there could be more than one microprocessor in the claimed system, but one of those microprocessors had to be capable of performing all of the recited functions.

In the second case, *FS.Com Inc. v. International Trade Commission*, No. 2022-1228 (April 20, 2023) (Moore*, Prost, Hughes), one of the patents at issue related to fiber optic modules. Claim 14 of that patent, which was representative, recited, in part, “A *fiber optic module, comprising . . . a main body defining an inner chamber disposed between a front and a rear side; . . . a front opening disposed along a longitudinal axis in the front side; . . .*”

At the ITC, the Commission had interpreted the term “a *front opening*” to encompass one or more openings and, based on that construction, had concluded that FS’s modules infringed the claims. On appeal, FS argued that the proper construction of the term limited it to a single front opening and so its modules, which had multiple openings, did not infringe.

The panel, in an opinion by Chief Judge Moore, disagreed with FS. Reviewing the figures in the asserted patent, the panel noted that at least FIG. 14 and FIG. 15 depicted a front opening that was further subdivided into multiple openings with structural material separating them. The panel therefore declined to depart from the general rule that “a” means “one or more” and so affirmed the Commission’s decision

[PIV Notice Need Not Address All Claims to Preserve Rights](#)

BY RICHARD D. KELLY

In *Bausch Health Ireland v. Mylan Pharms.* N.D. WV., 1:22CV20 Bausch moved for judgment of infringement on the pleadings under Rule 12(c) to prevent Mylan’s launch of its generic equivalent to Bausch’s drug Trulance® for treating chronic idiopathic constipation and irritable bowel syndrome with constipation. Bausch’s motion was predicated on the failure of Mylan to assert in its Paragraph IV notice (PIV) non-infringement of two claims of the asserted patents. Bausch also moved to strike Mylan’s affirmative defenses under Rule 12(f). In its answer Mylan denied infringement of all asserted claims. The district court denied Bausch’s motion because the Federal Circuit has previously held that the notice provision “cannot be enforced by a private party in a patent infringement action.” [Read more.](#)

AI UPDATES

[Director of the USPTO Discusses the Role of Artificial Intelligence in a Balanced Patent System and Encourages Participation in RFCs and](#)

[ET Partnership Events](#)

BY EVAN SMITH



The Director of the USPTO published a blog post on April 18th, 2023, entitled “With artificial intelligence speeding the innovation process, what does that mean for invention and a properly balanced patent system?” This post discusses some of the ongoing initiatives taken by the USPTO and the Federal Government at large to incorporate Artificial Intelligence (AI) into administrative workflows and policy. The USPTO remains an active participant in its “AI and Emerging Technology (ET) Partnership” which serves to bring the entirety of the public and private sectors together to examine the role of AI in innovation and its potential to affect not only our lives but the U.S.’s competitiveness, economic prosperity, and national security.

The post outlines a variety of pertinent AI related patent questions such as “If AI inventors contribute as much as a human, is the resulting invention patentable?” and “Would allowing AI to be listed as an inventor, promote innovation?” Questions of this nature are being discussed within the USPTO which made a request for comments (RFC), originally published on February 14th, 2023 at [88 FR 9492](#). The Director emphasizes the importance of these questions by noting that 80,000 of the utility patent applications filed in 2020 involved artificial intelligence, representing a 150% increase from 2002, and AI currently appears in 18% of all utility patent applications and more than 50% of all the technologies examined at the USPTO. Accordingly, in addition to the RFC, two listening sessions about AI were held on April 25th and May 8th at the Office’s headquarters and Stanford University respectively. Recordings of those sessions will soon be made available, and planning has begun for another ET Partnership event which will be held later this summer. The Director encourages attendance at upcoming ET Partnership events and participation in the RFC which will remain open until May 15th. This April 18th post was published on the Director’s blog and is available [here](#).

[Legal Protection from Generative AI in Japan](#)

BY KASUMI KANETAKA

In the April 29, 2023 article, the Yomiuri Shimbun reported that a group of creative artists met with government official to discuss legal protections from generative artificial intelligence (AI) tools such as ChatGPT, as Japanese regulations are considered to be the loosest among advanced nations. In the meeting, the group told the official that using copyrighted material to train AI without permission was “having a negative impact” on their activities. Additionally, the group raised other issues that Article 30-4 of the Copyright Law, which permits the use of a copyrighted work for machine learning, does not include procedures for gaining permission in advance from copyright holders. The article permits the use of copyrighted material such as text and images to train AI, regardless of whether the model is for commercial use. Under the current law, it is legal to train AI with copyrighted material even if the data was obtained illegally. The article contains a provision stating that such material cannot be used if it would “unreasonably prejudice the interests of the copyright owner,” but there are only limited examples provided to describe the “unreasonable prejudice.” Read our full blog post [here](#).

LIFE SCIENCES UPDATES

[Amgen v. Sanofi - Impermissible Functional Claiming?](#)

BY RICHARD D. KELLY

On April 28 the Supreme Court heard oral arguments on Amgen’s petition of the Federal Circuit’s decision affirming the district court’s decision on JMOL that Amgen’s antibody claims lacked an enabling disclosure. Much of the argument revolved around what was the quantum of experimentation that was too much for a claim to be enabled. At the end of Sanofi’s argument its



counsel cited the Morse case where the Supreme Court invalidated Morse claim 8 which defined the transmission of symbols in solely functional terms.

Amgen's claims were similar:

1. An isolated monoclonal antibody, wherein, when bound to PCSK9, the monoclonal antibody binds to at least one of the following residues: S153, 1154, P155, R194, D238, A239, 1369, S372, D374, C375, T377, C378, F379, V380, or S381 of SEQ ID NO:3, and

wherein the monoclonal antibody blocks binding of PCSK9 to LDLR.

Since Morse is a Supreme Court decision it seems reasonable that the Court would seize upon it to decide the Amgen case and avoid the metaphysical consideration of how much experimentation is too much under the *Wands* factors, *In re Wands*, 858 F.2d 731, 736-37 (Fed. Cir. 1988). Further by the late 19th century it was black letter law that one could not claim what an invention did but only what the invention was, *Robinson on Patents*, §518, Book 3, page 131. Means plus function claims encompass only the means disclosed in the specification and their equivalents are very limited in scope.

Since the purpose of the patent system is to advance the progress of the useful arts, how is that furthered by a claim which identifies the invention not by its structure but by what it does. One cannot know if what he has made infringes or not until he has made it and tested it. The claim scope is not found in the claim but is based on later developments. How does this further innovation if another holds a dominant patent by virtue of it claiming what the invention does rather than what it is. In the case of antibodies it is the antibodies sequence. The evidence was there – three antibodies developed by three groups, each antibody very different from the other two and from the sequences disclosed in the Amgen patent. [Read full article here.](#)

[Broadest Reasonable Interpretation, not Broadest Possible Interpretation](#)

BY SARA PISTILLI

On May 2, 2023, the PTAB reversed the Examiner's rejection of a claim directed to a method of creating an immobilized DNA library while preserving contiguity information of a target nucleic acid as being both anticipated and obvious (Appeal 2023-000053). Claim 1 is directed to a method of preparing a library of barcoded DNA fragments of a target DNA comprising steps (a)-(d), which are carried out in a single reaction compartment. The PTAB centered its analysis on whether the Examiner's interpretation of a "single reaction compartment" was reasonable within light of the specification. During prosecution, the Examiner interpreted a "single reaction compartment" to mean any compartment where a reaction may occur such as "the earth' 'the ocean' or 'a laboratory'". The PTAB held that while the specification did not provide a separate definition for "single reaction compartment," the specification did not allow the Examiner to interpret a "single reaction compartment" to be so broad. This case serves as a reminder that the broadest *reasonable* interpretation of a claim does not equate to the broadest *possible* interpretation. Our blog post on the case can be found [here](#).

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