

35 U.S.C. 135—Gateway to Priority and Derivation Determinations by the BPAI

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Priority disputes find their basis under 35 U.S.C. § 102(g), whereas derivation disputes find their basis under 35 U.S.C. §102(f). However, both disputes are primarily litigated as “interferences” before the Board of Patent Appeals and Interferences (BPAI) pursuant to 35 U.S.C. § 135(a). In *Price v. Symsek*,¹ the Federal Circuit observed:

Although derivation and priority of invention are akin in that both focus on inventorship and both may be resolved by the board in an interference action, they are distinct concepts. *Applegate v. Scherer*, 332 F.2d 571, 573 & n.1, 141 U.S.P.Q. 796, 798 & n.1 (CCPA 1964). A claim that a patentee derived an invention addresses originality—who invented the subject matter of the count? *Hedgewick v. Akers*, 497 F.2d 905, 907, 182 U.S.P.Q. 167, 168 (CCPA 1974). Under this attack on a patent or patent application, the proponent asserts that the patentee did not “invent” the subject matter of the count because the patentee derived the invention from another. *Davis v. Reddy*, 620 F.2d 885, 882 n.2, 205 U.S.P.Q. 1065, 1068 n.2 (CCPA 1980). To prove derivation in an interference proceeding, the person attacking the patent must establish prior conception of the claimed subject matter and communication of the conception to the adverse claimant.²

Priority and derivation cases at the US Patent and Trademark Office (PTO) offer many advantages over counterpart district court actions, including:

1. *Experience*—the BPAI is comprised of administrative patent judges (APJs) armed with technical backgrounds and vast experience with the patent laws.
2. *Cost*—the rules governing contested cases severely limit discovery.³
3. *Time*—the pendency of an interference before the BPAI is normally no more than two years.⁴

However, 35 U.S.C. § 135(a) provides the PTO a sword and 35 U.S.C. § 135(b) a shield to limit access to administrative determinations of priority and derivation. The sword comes in the form of the language in 35 U.S.C. § 135(a) asserting that “an interference *may* be declared,”⁵ which provides the Director of the PTO discretion to determine when to declare an interference.⁶ The one year statute of repose is provided by 35 U.S.C. § 135(b).

Armed with the sword and shields of 35 U.S.C. §§ 135(a) and 135(b), among other things, the PTO has reduced the inventory of interferences from over 300 interferences in 1998 to currently under 100 interferences. This accomplishment is noteworthy. However, the two-way obviousness test for determining whether an interference-in-fact exists, established by the Director pursuant to 35 U.S.C. § 135(a), results in an underutilization of the BPAI's resources.

With 35 U.S.C. § 135(b)(2) having been enacted in 2002, the long standing one year statute of repose applicable to claims of an issued patent (35 U.S.C. § 135(b)(1)) now has limited application to claims presented in published applications. 35 U.S.C. § 135(b) presents many pitfalls for applicants that should be avoided.

If either of the current patent reform bills becomes law, then priority disputes as we currently know them will no longer continue to exist. However, derivation proceedings will be maintained albeit limited by a 35 U.S.C. § 135(b)-type statute of repose and constrained to the PTO.

35 U.S.C. § 135(a)—the Sword

Pursuant to 35 U.S.C. § 135(a), the BPAI has discretion to establish the criteria for determining when an interference is declared. 35 U.S.C. § 135(a) provides that “[w]henever an application is made for a patent which, in the opinion of the Director, would interfere with any pending application, or with any unexpired patent ... an interference may be declared” In *Eli Lilly & Co. v. Board of Regents of the University of Washington*,⁷ the Federal Circuit concluded:

that the Board shall determine questions of priority once an interference proceeding is declared. This authority for the Board to determine questions of priority, however, does not vitiate the Director’s discretion to begin or discontinue an interference once declared. See 35 U.S.C. § 135(a). Accordingly, the mandatory language only instructs the Board of its jurisdiction over an active interference.⁸

Armed with the Director’s discretion to declare an interference, the BPAI has (1) changed the long standing threshold test for whether an interference should be declared from a one-way obviousness test⁹ to a two-way obviousness test;¹⁰ and (2) elected not to declare or modify an interference when an application would be involved and both parties would additionally have an involved patent.¹¹

Regarding the former, in *Slip Track Systems Inc. v. Metal-Lite Inc.*,¹² the Federal Circuit required district courts in 35 U.S.C. § 291 actions to apply the threshold test enunciated by the PTO for declaring an interference, stating:

In order to provoke an interference in district court under § 291, the interfering patents must have the same or substantially the same subject matter in similar form as that required by the PTO pursuant to 35 U.S.C. § 135.¹³

Thus, the discretion provided to the Director to establish the criteria for determining when an interference should be declared directly translates to a requirement for district courts in 35 U.S.C. § 291 actions. The two-way obviousness threshold test cannot be avoided.

The test requires that the subject matter of at least one claim of a party, when treated as prior art, render obvious the subject matter of at least one claim of the opposing party *and vice-versa*. Application of the two-way obviousness test to a claim drawn to a genus (party A) and a claim drawn to the species of the genus (party B) can result in both parties obtaining patents to the chagrin of third parties. Anecdotal evidence suggests that the primary reason that the number of declared interferences has dramatically decreased from over 300 interferences in 1998, to currently fewer than 100 interferences, is the application by the PTO of the two-way obviousness test.

35 U.S.C. 135(b)—the Shield

The Legislative History of 35 U.S.C. § 135(b)

35 U.S.C. § 135(b) is a statute of repose. 35 U.S.C. § 135(b)(1) protects issued patents and states:

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

35 U.S.C. § 135(b)(2) is also a statute of repose, but it differs significantly from 35 U.S.C. § 135(b)(1). It protects published patent applications and states:

A claim which is the same as, or for the same or substantially the same subject

matter as, a claim of an application published under section 122(b) of this title may be made in an application filed after the application is published only if the claim is made before 1 year after the date on which the application is published.

The CCPA reviewed the legislative and case law history of 35 U.S.C. § 135(b) (now 35 U.S.C. § 135(b)(1)) in *Corbett v. Chisholm*.¹⁴ As reported by the CCPA in *Corbett*, the Supreme Court in *Chapman v. Wintroath*:¹⁵

articulated the proviso that laches could not be found prior to the expiration of the time period set in the statutory predecessor to 35 USC § 102(b) for the establishment of the patent from which the claims were copied as a statutory bar, then two years.¹⁶

In 1939, as part of a series of amendments to the patent laws changing most of the statutory time periods from two years to one year, the statutory predecessor to 35 U.S.C. § 135(b) was amended to read as follows:

No amendment for the first time presenting or asserting a claim which is the same as, or for substantially the same subject matter as, a claim of an issued patent may be made in any application unless such amendment is filed within one year from the date on which said patent was granted.

The CCPA concluded in *Corbett* that the intent of Congress, regarding the above quoted statute, was to enact a statute of repose for issued patents. The statute was to be a “statue of limitations” on interferences, so that the patentee might be more secure in his property right.¹⁷ In 1952, 35 U.S.C. § 135(b) was codified in the language that is now in 35 U.S.C. § 135(b)(1) with no substantial shift intended by the changes in statutory language.¹⁸

No case prior to the non-precedential decision in *Ding v. Singer* (BPAI, Int. No. 105,436) had specifically addressed the provisions of 35 U.S.C. § 135(b)(2). Further, there is no pertinent informative discussion in the legislative history of the American Inventors Protection Act of 1999, where Section 135(b)(2) was enacted.

Applicability of 35 U.S.C. §§ 135(b)(1) and 135(b)(2)

It is clear from the language of 35 U.S.C. § 135(b) that Section 135(b)(1) is available to be applied (during *ex parte* examination¹⁹ or an *inter partes* proceeding) against a claim of any application. However, 35 U.S.C. § 135(b)(2) only applies to claims presented in applications “filed” after the publication date of an application having a comparable claim.

The reach of Section 135(b)(2) primarily depends on how the statutory term “filed” is construed.²⁰ If “filed” means the date on which the specification of an application and any required drawing are received in the PTO, then claims of an application targeted for an interference could be simultaneously “copied” in two related applications having different filing dates under 35 U.S.C. § 111(a)(4), but the same effective filing date under 35 U.S.C. § 120 with the following outcomes. The first application having a filing date under 35 U.S.C. § 111(a)(4) prior to the publication date of the subject application could present the “copied” claims without being subject to a Section 135(b)(2) analysis. However, the second application having a filing date under 35 U.S.C. § 111(a)(4) after the publication date of the subject application could not present the “copied” claims without being subject to a Section 135(b)(2) analysis.

Interpreting the term “filed” to mean the 35 U.S.C. § 111(a)(4) filing date leads to incongruous and irreconcilable results. If both B_{parent} and B_{child} are pending after the critical date, why should B_{child} be subject to 135(b)(2) but not B_{parent} ? (See Exhibit 1.)

Moreover, construing the statutory term “filed” to mean the effective filing date of the application is: (1) consistent with the legislative intent of 35 U.S.C. § 135(b)(1); (2) consistent with the manner in which filing dates are determined for prior art analysis under 35 U.S.C. §§ 102(b) and 102(e); (3) analogous to 37 C.F.R. §§ 41.202(d) and 41.207(a)(2); and (4) a construction that would substantially address the interference bar’s concerns regarding premature copying of published claims.

35 U.S.C. § 135(b) Is Analogous to 35 U.S.C. § 102(b)

Section 102(b) is akin to a statute of limitations “within which an inventor, even though he has made a patentable invention, must act on penalty of loss of his right to patent.”²¹ As discussed, Section 135(b)(1) has also been interpreted as a statute of limitations on copying claims for the purpose of instigating interferences. It is “a statutory requirement, like the statutory time bar of Section 102(b), the application of which is mandatory.”²² Further, application of Section 135(b) is appropriate not only in the interference context, but also as a basis for rejection in an *ex parte* context.²³ Under 35 U.S.C. § 102(b), an applicant receives benefit of his effective filing date under 35 U.S.C. §§ 119(e)(1) and 120 when determining whether prior art is time-wise available. The same should be true under Section 135(b)(2).

Supplemental Benefits Provided to Patentees in Exchange for Publishing Applications

In exchange for early publication of the disclosure of an application, prior to issuance of a patent, owners of patents that matured from published applications may qualify for provisional rights under 35 U.S.C. § 154(d).²⁴ Provisional rights are supplemental to the rights to exclude, as legislated in 35 U.S.C. § 271(a), and afford the patent owner the right to obtain a reasonable royalty for acts of infringement during the period beginning on the date of publication of the application if certain conditions are satisfied during the examination process.

In the same manner that provisional rights under Section 154(d) are supplemental to the right to exclude under Section 271(a), Section 135(b)(2) provides supplemental security to a patentee. The patentee’s patent rights cannot be challenged via an interference preceding by a party (a) that may have had the benefit of seeing the patentee’s published application and (b) that, in response to seeing the published application, filed a new application without an effective filing date earlier than the publication date of the patentee’s published application. A lone exception arises when that party copies the claims of the published application within one year of the publication date of the patentee’s published application.

That is, construing the 35 U.S.C. § 135(b)(2) term “filed” to mean the effective filing date of the application requires a potential new applicant (*i.e.*, an applicant not receiving the benefit of an earlier effective filing date), having had the opportunity to glean from the published application the significance (value) of an invention, to present claims in a timely manner to preserve the right to pursue an interference. Consistent with the proposed effective filing date construction are the two-tiered evidentiary standard for interferences articulated in 37 C.F.R. § 41.207(a)(2) and the requirement to show priority pursuant to 37 C.F.R. 41.202(d)(1) in order to provoke an interference. 37 C.F.R. § 41.207(a)(2) states:

Priority may be proved by a preponderance of the evidence except a party must prove priority by clear and convincing evidence if the date of its earliest constructive reduction to practice [roughly translated to “effective filing date”] is after the issue date of an involved patent or the publication date under 35 U.S.C. 122(b) of an involved application or patent.

Similarly, 37 C.F.R. 41.202(d)(1) states:

When an applicant has an earliest constructive reduction to practice that is later than the apparent earliest constructive reduction to practice for a patent or published application claiming interfering subject matter, the applicant must show why it would prevail on priority.

As can be seen from 37 C.F.R. § 41.207(a)(2), a party having filed an application presumptively with the benefit of having seen an issued patent or a published application has a higher burden (clear and convincing evidence) during the interference. Similarly, under 37 C.F.R. § 41.202(d)(1), a presumptive junior party attempting to provoke an interference has a higher burden of proof than a presumptive senior party.

In short, there is a sliding scale of difficulty in provoking and litigating an interference. Presumptive

senior parties have a lesser burden when compared to presumptive junior parties. Hence, under the Rules of the BPAI, tougher obstacles are placed before late filing parties, regarding the burden of proof in provoking an interference during *ex parte* prosecution and the burden of proof *re* showing priority in an *inter partes* interference. Section 135(b)(2) should be interpreted as functioning in a similar matter.

Reducing the Need for Copying Claims from Published Applications

Interpreting the term “filed” of Section 135(b)(2) to mean the Section 111(a)(4) filing date often requires copying of published claims before those claims have been examined in order to preserve the right to pursue an interference. The proposed effective filing date construction would reduce the number of applicants that will be required to “copy” claims. That is, if the effective filing date of the application predates the publication date of the subject application, then no “copying” is required. Only applicants, who presumably have filed applications in response to seeing the subject published, would be forced to present copied claims to preserve their interference rights.

Avoiding the Pitfalls of 35 U.S.C. § 135(b)

The most common pitfalls of Section 135(b) practice include:

- Failing to monitor issued patents (35 U.S.C. § 135(b)(1));
- Failing to monitor published applications (35 U.S.C. § 135(b)(2));
- Copying claims literally instead of presenting interfering claims for which the copier has support; and
- Amending timely (pre-critical date) copied claims after the one year critical period.

Failure to Monitor Published Applications and Issued Patents

Very few interferences are declared *sua sponte* by the BPAI. Most interferences are provoked by an applicant “copying” claims of a published application or an issued patent.

The primary consequence of failing to monitor published applications and/or issued patents is missing the opportunity to timely present a “copied” claim. Failure to present a timely “copied” claim reduces dramatically the likelihood of obtaining a claim directed to the same or substantially the same subject matter as an issued/published claim in satisfaction of Section 135(b). If a claim is not timely “copied,” then the applicant must establish entitlement to the presentation date of at least one pre-critical date claim to satisfy Section 135(b). This showing requires determination of whether each post-critical date claim recites material limitations of pre-critical date claims (if relevant pre-critical date claims exists). (*See* Exhibit 2.) A discussion of how to determine material limitations is given below.

Copying Claims

Literally copying targeted claims often leads to trouble. Because no two unrelated specifications are exactly alike, literal copying invites 35 U.S.C. § 112 arguments during prosecution and in the interference. Amending claims after the critical date in response to a Section 112 attack can also lead to a troublesome 35 U.S.C. § 135(b) scenario discussed below.

Best practice supports presenting two sets of claims, a literally copied set and a set based on terminology of applicant’s specification. When presenting the “copied claims,” the following point can never be over emphasized. Always inform the examiner where the claims are “copied” from in satisfaction of 37 C.F.R. § 1.56.

Amending Timely Copied Claims after the One Year Critical Period

In *Regents of the University of California v. University of Iowa Research Foundation*,²⁵ the Applicant relied on a claim that was originally presented before the critical date to satisfy 35 U.S.C. § 135(b), but which was subsequently amended after the critical date. The Federal Circuit concluded:

[T]he language of Section 135(b)(1) does not support California’s proposed construction. California’s construction would convert section 135(b)(1) into a statute of limitations that could be tolled by a single pre-critical date claim. In essence, California contends that the phrase “such a claim” in section 135(b)(1) means any earlier claim that might have given notice of an interference had the PTO declared such an interference. To the contrary, the statutory term “such a claim” refers to the claim that the potentially interfering party seeks to add, which is directed to the same or substantially the same subject matter as that claimed in a patent, regardless of whether that party earlier filed a different claim having the required identity with a patented claim. The statute requires “such a claim” to come before the critical date. Thus, section 135(b)(1) does not refer to some unrelated claim made earlier in prosecution even if accompanied by a request for interference. The language of the statute, “[a] claim ... may not be made ...unless such a claim is made prior to ...,” necessarily requires that in the event a party seeks to add any claim sharing identity with a patented claim, “such a claim” must appear before the critical date. When a party seeks to add a new claim, or to amend an existing claim, beyond the critical date for section 135(b)(1), this court applies the material differences test discussed in opinions like *Berger* to determine if “such a claim” is barred.²⁶

The primary issue raised by *California* is illustrated in Exhibit 3 as Question (1). Namely, does a post-critical date claim satisfy the material limitation test relative to a timely presented “copied” claim. In view of *California*, Question (1) must be answered yes. Consequently, amendments to pre-critical date claims or the addition of claims after the critical date can create a Section 135(b) issue. In order to avoid this issue, substantive amendments after the critical date should be avoided, when possible, by *ex parte* appeal to the BPAL.

Identifying Material Limitations

Judge Rich stated in *Corbett* that a material limitation is a limitation “necessary to patentability....” Those limitations include:

1. Limitations added by a patentee to avoid prior art.
2. Limitations relied upon to distinguish over prior art.
3. Limitations identified by an examiner’s reasons for allowance.

Once the material limitations have been identified for a claim, a second claim defines substantially the same subject matter under 35 U.S.C. § 135(b) if the material limitation(s) of the first claim is (are) present “explicitly, implicitly, or inherently” in the second claim.²⁷

The Future of Section 135(a) Priority and Derivation Proceedings

Congress is considering extensive patent reform legislation that will, among other things, change the US patent system from a first-to-invent system to a first-inventor-to-file system. Consequently, priority disputes (*i.e.*, interferences) may become a thing of the past in the near future. Derivation actions before the PTO, on the other hand, will continue to be available under limited circumstances pursuant to an amended 35 U.S.C. § 135.

Section 135(a) of S.1145, as reported out by the Judiciary Committee of the Senate on July 20, 2007, states:

(1) INSTITUTION OF DERIVATION PROCEEDING- An applicant may request initiation of a derivation proceeding to determine the right of the applicant to a patent by filing a request which sets forth with particularity the basis for finding that an earlier applicant derived the claimed invention from the applicant requesting the proceeding and, without authorization, filed an application claiming such invention. ***Any such request may only be made within 12 months after the date of first publication of an application containing a claim that is the same or is substantially the same as the claimed invention.*** must be made under oath, and must be supported by substantial evidence. Whenever the Director determines that patents or applications for patent naming different individuals as the inventor interfere with one another because of a dispute over the right to patent under section 101, the Director shall institute a derivation proceeding for the purpose of determining which applicant is entitled to a patent.²⁸

35 U.S.C. 135(a)(1)(A) of H.R. 1908, as reported out by the Judiciary Committee of the House on July 19, 2007, states:

(A) REQUEST FOR PROCEEDING.—An applicant may request initiation of a derivation proceeding to determine the right of the applicant to a patent by filing a request that sets forth with particularity the basis for finding that another applicant derived the claimed invention from the applicant requesting the proceeding and, without authorization, filed an application claiming such invention. Any such request—

(i) may only be made within 12 months after the earlier of —

(I) the date on which a patent is issued containing a claim that is the same or substantially the same as the claimed invention; or

(II) the date of first publication of an application containing a claim that is the same or substantially the same as the claimed invention...²⁹

As an unintended (or intentional?) consequence, however, it appears from both the Senate bill and the House bill that the validity of a patent will not be challengeable in a post-grant cancellation proceeding for failing to identify the correct inventive entity. Additionally, a defendant in an infringement action will not have a potential defense on the basis that the subject patent fails to identify the correct inventorship—whether or not the defendant was the actual inventor of the subject matter in dispute. That is, neither the Senate bill nor the House bill has the equivalent of 35 U.S.C. § 102(f) as a condition for patentability. Section 102(a) of the Senate bill is limited to publicly available prior art and states:

35 U.S.C. 102(a) Novelty; Prior Art—A patent for a claimed invention may not be obtained if—

(1) the claimed invention was patented, described in a printed publication, or in public use or on sale—

(A) more than one year before the effective filing date of the claimed invention; or

(B) one year or less before the effective filing date of the claimed invention, other than through disclosures made by the inventor or a joint inventor or by others who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(2) the claimed invention was described in a patent issued under section

151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

Section 102(a) of the House bill uses very similar language. In contrast thereto, 35 U.S.C. § 102(f) (as currently enacted) states:

A person shall be entitled to a patent unless—. . .
(f) he did not himself invent the subject matter sought to be patented

Thus, as the Federal Circuit concluded in *OddzOn Products Inc. v. Just Toys Inc.*,³⁰ 35 U.S.C. § 102(f) does not “pertain only to public knowledge, but also applies to private communications between the inventor and another which may never become public.” Without comparable language to Section 102(f), neither the House bill nor the Senate Bill explicitly provide a basis for a post grant cancellation or a defense to an infringement action on the basis that the subject patent is invalid for failing to identify the proper inventorship of the claimed subject matter—as does current law.³¹ Moreover, as reflected by the 35 U.S.C. § 135 provisions of both the Senate and House bills, in order to participate in a derivation proceeding, a party will be required, among other things, to have an involved application and avoid the pitfalls of failing to present timely “copied” claims as discussed above.

In view of the difficulties in avoiding the pitfalls of 35 U.S.C. § 135(b) and the nature of some derivation cases (or, cases involving alleged “thievery”), it is peculiar that the patent reform bills maintain the arcane statute of repose for derivation cases and limit the venue for hearing such cases. Because inventorship and ownership of patents are intertwined, it would seem prudent to offer parties, at the very least, an opportunity to defend an infringement action, on the basis that the subject patent is invalid for failing to identify the proper inventorship of the claimed subject matter.

¹ Price v. Symsek, 988 F.2d 1187, 26 U.S.P.Q.2d 1031 (Fed. Cir. 1993).

² *Id.* at 1190, 26 U.S.P.Q.2d at 1033.

³ 37 C.F.R. § 41.150.

⁴ 37 C.F.R. § 41.200(c).

⁵ Emphasis supplied.

⁶ That discretion is, in actuality, administered by the APJs.

⁷ *Eli Lilly & Co. v. Board of Regents of the Univ. of Washington*, 334 F.3d 1264, 67 U.S.P.Q.2d 1161 (Fed. Cir. 2003).

⁸ *Id.* at 1267, 67 U.S.P.Q.2d at 1163.

⁹ *Id.* at 1272–1274, 67 U.S.P.Q.2d at 1167–1168 (Lourie, J. dissenting) (“I believe the Board’s action constitutes an abuse of discretion because the language of [37 C.F.R.] 601(n) plainly describes a one-way test and does not support a two-way test.”).

¹⁰ *Id.* at 1268–1270, 67 U.S.P.Q.2d at 1164–1165.

¹¹ *Louis v. Okada*, 57 U.S.P.Q.2d 1430 (BPAI 2000).

¹² *Slip Track Sys. Inc. v. Metal-Lite Inc.*, 304 F.3d 1256, 64 U.S.P.Q.2d 1423 (Fed. Cir. 2002).

¹³ *Id.* at 1263, 64 U.S.P.Q.2d at 1428.

¹⁴ *Corbett v. Chisholm*, 568 F.2d 759, 196 U.S.P.Q. 337 (CCPA 1977) (Rich, J.).

¹⁵ *Chapman v. Wintroath*, 252 U.S. 126 (1920).

¹⁶ *Chisholm* at 764, 196 U.S.P.Q. at 342 (Footnote omitted).

¹⁷ *Id.* at 765, 196 U.S.P.Q. at 342.

¹⁸ *Id.*

¹⁹ *In re McGrew*, 120 F.3d 1236, 1237–1238, 43 U.S.P.Q.2d 1632, 1635 (Fed. Cir. 1997) (Rich, J.).

²⁰ Arguments regarding the statutory construction of 35 U.S.C. § 135(b)(2) provided herein are substantially the same as those arguments provided in *Ding v. Singer* on behalf of the party Singer in Singer’s Opposition 2 in interference No. 105,436.

²¹ *In re Foster*, 343 F.2d 980, 987–988, 145 U.S.P.Q. 166, 173 (CCPA 1965), *cert. denied*, 383 U.S. 966, *reh. denied*, 384 U.S. 934 (1966).

²² *Corbett*, 568 F.2d at 765; 196 U.S.P.Q. at 342.

²³ *See supra* n.19.

²⁴ *See* Chisum on Patents § 11.02[4][e] at p.11-226.

²⁵ *Regents of the Univ. of Calif. V. University of Iowa Research Found.*, 455 F.3d 1371, 79 U.S.P.Q.2d 1687 (Fed. Cir. 2006).

²⁶ *Id.* at 1375, 79 U.S.P.Q.2d at 1690.

²⁷ *In re Berger*, 279 F.3d 975, 983, 61 U.S.P.Q.2d 1523, 1528 (Fed. Cir. 2002).

²⁸ Emphasis supplied.

²⁹ Emphasis supplied.

³⁰ *OddzOn Prods. Inc. v. Just Toys Inc.*, 122 F.3d 1396, 43 U.S.P.Q.2d 1641 (Fed. Cir. 1997).

³¹ *See*, for example, *Checkpoint Sys. Inc. v. All-Tag Security S.A.*, 412 F.3d 1331, 75 U.S.P.Q.2d 1200 (Fed. Cir. 2005).