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IP UPDATES

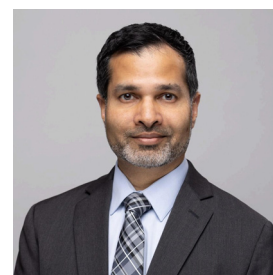
OCTOBER 31, 2024

USPTO UPDATE

USPTO Director Kathi Vidal Answers Questions at the Annual AIPLA Meeting

BY SAMEER GOKHALE

On October 24, 2024, USPTO Director Kathi Vidal answered questions before attorneys at the American Intellectual Property Law Association (AIPLA) annual meeting. She covered topics including the data leak that occurred for trademark applicants and how the USPTO is planning to use AI to assign applications to examiners and to assist prior art searches. She further discussed how the USPTO will address the backlog of patent and trademark applications, which may include hiring more Examiners. She further acknowledged that she has heard feedback on the burdens of the recent USPTO proposed rule change regarding Terminal Disclaimers. Under the proposed rule, to overcome double patenting, the patentee would need to agree that the patent with the terminal disclaimer will be enforceable only if the patent is not tied and has never been tied, through one or more terminal disclaimers, to a patent in which any claim has been finally held unpatentable or invalid over prior art. We will stay on top of any further developments from the USPTO related to the above topics.



JAPAN IP UPDATE



Trilateral Heads of Office Meeting Held

BY KASUMI KANETAKA

On October 14, 2024, the 42nd Trilateral Heads of Office meeting was held in Tokyo, Japan. The Trilateral Heads of Office are the heads of the Japan Patent Office (JPO), the United States Patent and Trademark Office (USPTO), and the European Patent Office (EPO). The meeting was preceded by a Trilateral Heads of Office with Trilateral Industry meeting with the Trilateral User Groups (IT3: Industry Trilateral - Japan Intellectual Property Association (JIPA), American Intellectual Property Law Association (AIPLA), Intellectual Property Owners Association (IPO), Business Europe (BE)) from Japan, the United States, and Europe. These meetings included discussions on how IP offices can support the strategic integration of IP and management under the theme of Goal 9 of SDGs, "Industry, Innovation, and Infrastructure."

Please see the full report [here](#).

Comic Explaining Non-Disclosure of Patent Applications

BY KASUMI KANETAKA

As discussed in our [March 2024 Newsletter](#) and [May 2024 Newsletter](#), the System for Non-Disclosure of Patent Applications was applied from May 1, 2024. The JPO has already published a [Q&A](#) (in Japanese) about the System. To make the System easier to understand for those who are not patent experts, the JPO has created a comic to explain the main points of the System. Please see [here](#) for the comic (in Japanese).

LIFE SCIENCES NEWS

Missing Feature Overcomes Obviousness but Cautions Succinct Claiming and Argument

BY DEREK LIGHTNER, PH.D.

On September 25, 2024, in *Ex parte Sim*, the Patent Trial and Appeal Board (PTAB) overturned the obviousness position of primary examiner, John Chu, supported by Supervisory Patent Examiners Mark Huff and Christine Tierney, in US Appl. No. 16/176,245 (Appeal 2023-003254, Technology Center 1700). *Ex parte Sim* involved a disagreement on the meaning of recitation regarding a copolymer structure.



Read more on the Life Sciences Blog [here](#).

Myrbetriq® Patent Invalidated on Grounds Not Asserted by Any Party Violating Party Presentation Principle

BY RICHARD D. KELLY

In *Astellas Pharma Inc. v. Sandoz Inc., et al*, following a five-day patent claims bench trial, the court found asserted claims 5, 20, and 25 invalid under 35 U.S.C. § 101 even though Sandoz had not asserted 101 as defense at any time during the case. Read more on the Life Sciences Blog [here](#).

UPCOMING WEBINAR



Using the Amgen-Sanofi Methodology to Identify the Historic Treatment of Patent Eligibility Issues: Today's 35 U.S.C. 101 Issues

CO-HOSTED BY RICHARD D. KELLY AND LUCAS KOZIOL

Please join us for this webinar in which we discuss the *Amgen* enablement decision and how it illustrates the importance of performing thorough legal research on the case law on patent law issues. For your convenience, we will be presenting at two different times. Please click on the link here to register:

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