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IP UPDATES

SEPTEMBER 30, 2024

USPTO UPDATE

PTAB Finds Method Involving "Growing, Selecting, and Crossing" Sufficient for Integrating Genome Estimation Data Set Into Practical Application

BY NICHOLAS ROSA, PhD

The Patent Trial and Appeal Board (PTAB) recently reversed a final rejection based on 35 U.S.C. §101 by finding that a method for selecting individuals for a breeding program that recited the steps of "growing, selecting, and crossing" did integrate an "optimized [genome] estimation data set" judicial exception into practical application. These actionable steps and the distinct advantages the method represented over conventional breeding methods involving other types of genomic prediction described in the specification were instrumental in the PTAB's findings. The inclusion of such actionable steps and description of the advantages of the subject matter of the application may be useful to support amendments that may be necessary to overcome § 101 rejections.

For more on this topic, please see the Life Science's blog [here](#).



CAFC UPDATE



CAFC Will Convene En Banc Rehearing on Damages in *EcoFactor Inc. v. Google LLC*

BY SAMEER GOKHALE

On September 25, 2024, it was announced that the full Federal Circuit will review a holding that Google must pay EcoFactor \$20 million for infringing a smart thermostat patent. The court will review an earlier panel decision from June in an appeal brought by Google. In the request for the rehearing, Google argued that the royalty calculation asserted by

EcoFactor was based on other settlement agreements that EcoFactor reached with other companies which included lump sum payments, instead of a royalty, to EcoFactor's entire patent portfolio.

The en banc rehearing will seek to clarify the manner in which damages are determined, and therefore it is expected that several amicus briefs will be filed in support of both sides in this dispute.

A copy of the order from the CAFC can be found [here](#).

JPO UPDATES

[Japan-ASEAN Joint Statement for IP 2024 Adopted](#)

BY KASUMI KANETAKA

On September 4, 2024, the 14th Japan-ASEAN Heads of Intellectual Property Offices Meeting was held in Brunei Darussalam. At the meeting, the Japan Patent Office (JPO) and ASEAN IP offices adopted [the Japan-ASEAN Joint Statement for IP 2024](#), which was the first adoption of a joint statement in the past five years. Specifically, the Joint Statement focuses on (1) securing the transparency of patent examinations for emerging technologies, such as AI and IoT, and (2) developing a system for correcting mistranslations of filed applications to avoid applicants' loss of IP rights.



In addition, the partner countries agreed that they will address a number of initiatives, including advancing the cooperation in accession of ASEAN Member States to the international application systems (Madrid Protocol/Hague Agreement), while continuing the ongoing Japan-ASEAN cooperation.

Please see [here](#) for the report (in English) from the Ministry of Economy, Trade and Industry, Japan and [here](#) for the report (in English) from the JPO.

[Detention of IP Infringing Goods](#)

BY KASUMI KANETAKA

On September 6, 2024, the Ministry of Finance, Japan published the status of detention of IP infringing goods in the first half of 2024. The number of imported goods seized was above 18,000, which hit a record high. As a background, the Trademark Act and Design Act in Japan were revised in 2021 by clarifying what would constitute the infringing acts of business persons abroad.

Please see [here](#) for the status (in Japanese) from the Ministry of Finance, Japan and [here](#) for the updates on the revised Acts (in Japanese) from the JPO.

AI UPDATE



[International Dialogue on Artificial Intelligence and Intellectual Property](#)

BY KASUMI KANETAKA

On September 9, 2024, the International Dialogue on Artificial Intelligence and Intellectual Property was hosted as a videoconference by the USPTO with attendees from the JPO, the IP offices of G7 members states (except the Italian Patent and Trademark Office), and

the European Patent Office (EPO). The meeting covered the inventorship of AI-related inventions and patent subject matter eligibility for AI-related inventions.

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

LIFE SCIENCES NEWS

[U.S. Chamber of Commerce - The Biden March-in Rights Guidelines Threaten Quantum Research in the U.S.](#)

BY RICHARD KELLY

The Biden “march-in-rights” proposal, which can cause a significant impediment to the use of university research funded in part by the Federal Government, has created significant opposition because of its chilling effect on the licensing of such technology by private industry. The Bayh-Dole Act created an atmosphere where cooperation between university research and private industry has a symbiotic relationship. The U.S. Chamber of Commerce warned in a recent blog posting that the quantum computing sector could grow to a \$1.3 trillion sector over the next 10 years based on university and private industry cooperation. The march-in-rights proposal could very well destroy the incentive for such cooperation; add to this the damage that will be done to medical research by creating uncertainty on the part of private industry as to the value of any license it might receive on university research which is often wholly or partially supported federal grants. The U.S. Chamber of Commerce notes that now is the time to support patent protections in quantum computing to encourage commercialization, not threaten developers in the space with the prospect of compulsory licensing.

Alber Link and Martin van Hasselt have an interesting view of the impact of the Bayh-Dole Act on university-industry cooperation in their article entitled, [“On the transfer of technology from universities: The impact of the Bayh–Dole Act of 1980 on the institutionalization of university research.”](#) In the article they demonstrate the impact of Bayh-Dole on the creation of Technology transfer offices at universities. The number of tech transfer offices went from about 25 at the time of enactment to over 150 today. These offices have been instrumental in seeing that federally-funded research is put into use by private industry. One can hope that the government will realize that possible university-industry cooperation helps drive the adoption of technology in this country.



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