OBLON

IP UPDATES

JUNE 24, 2024

USPTO UPDATE

USPTO and the UK IP Office Agree to Collaborate on Policies Related to Standard Essential Patents (SEPs)

BY SAMEER GOKHALE

The USPTO issued a memorandum of understanding (MOU) that was signed on June 3, 2024 by USPTO Director Kathi Vidal and the Chief Executive Officer of the United Kingdom Intellectual Property Office (UKIPO) Adam Williams. The memo establishes a method of cooperation between the two offices on policies relating to standard essential patents (SEPs). SEPs are patents that have been declared essential to a given technical standard.

In the official summary of the memo found **here**, under the terms of the agreement, the USPTO and the UKIPO will:

- Cooperate on activities to facilitate collaboration and exchange of information on policy matters concerning SEPs, to better ensure a balanced standards ecosystem.
- Explore means to educate small and medium-sized enterprises seeking to implement or contribute to the development of technical interoperability standards on fair, reasonable, and non-discriminatory terms.
- Examine ways of improving transparency in the fair, reasonable, and non-discriminatory licensing of technical interoperability standards.
- Engage in outreach to stakeholders to raise awareness of issues related to SEPs.
- Discuss means to incorporate additional jurisdictions into the USPTO's and the UKIPO's activities concerning SEPs, including exploring a venue for such broader discussions.

The agreement will be in effect for five years.

JPO UPDATES

JPO Participated in the Annual Meeting of the INTA

BY KASUMI KANETAKA

From May 18-22, the Japan Patent Office (JPO) participated in the 146th Annual Meeting of the International Trademark Association (INTA), held in Atlanta, Georgia. The meeting is one of the largest global trademarks events with around 10,000 intellectual property experts worldwide attending this year.

As reported in our **May Newsletter**, the JPO prepared for the Five Trademark Offices (TM5)/INTA Joint Workshop for the **User Involvement Project**. On May 20, the JPO led a workshop on the theme of "How to determine the likelihood of confusion at the examination stage" and gave presentations with the TM5 offices (the JPO, the USPTO, the EUIPO, the CHIPA, and the KIPO).

Along with the workshop, the JPO hosted a session to introduce latest developments of industry associations and agent associations, held a panel discussion on anti-counterfeiting measures, and ran an anti-counterfeiting booth throughout the event.

Please see the full report **here**.

JPO Promoting Diversity and Inclusion

BY KASUMI KANETAKA

Based on an idea that it is important to leverage the diversity of human resources, including women and youth, to promote innovation, in 2023, the JPO launched "Diversity and Inclusion Team."

Comprised of cross-organizational members, **the team** has interviewed IP specialists and compiled a collection of messages in helping the development of positive career visions.

Please see the updates **here** and a report summary of Gender Diversity and Inclusion in the IP Ecosystem **here**.

AI UPDATES

Virtual Assistant Technology in Litigation News for Microsoft, Apple and Amazon

BY SAMEER GOKHALE

On June 18th, Microsoft announced a settlement with IPA Technologies following a $242 million verdict awarded to IPA by a jury in Delaware District Court (IPA Technologies Inc. v. Microsoft Inc., case number 1:18-cv-00001). The case was based on the now abandoned virtual assistant "Cortana" that was previously packaged with the Windows 10 operating system. The patent at issue (7,069,560) was bought from a company that developed Apple's Siri software. Details on the settlement are not yet public.

Speaking of Apple and Siri, on June 11th, the Patent Trial and Appeal Board (PTAB) has invalidated a majority of claims in a series of Zentian Ltd. patents related to voice recognition technology but upheld some claims in challenges from Apple and Amazon. Apple and Amazon joined forces in a series of Inter Partes Review challenges to the Zentian patents (see case numbers IPR2023-000331, IPR2023-00034, IPR2023-00035, IPR2023-00036 and IPR2023-00037). Zentian sued Apple and Amazon in February 2022 over their respective Siri and Alexa

virtual assistants. The Amazon portion of the litigation is ongoing in the Western District of Texas while Apple had successfully transferred their portion to the Northern District of California.

We will follow these cases closely to see how they affect practices and strategy with regard to two important subsets of AI: Virtual Assistants and Speech Recognition.

LIFE SCIENCES NEWS

Teva Inhaler Patents Ordered Removed from Orange Book and Antitrust Claim Allowed to Proceed

BY RICHARD D. KELLY

The saga of Orange Book patent listings continues. On June 10, 2024, Judge Chesler of the New Jersey District Court ordered five Teva patents removed from the Orange Book for ProAir® HFA (albuterol sulfate) Inhalation Aerosol ("ProAir® HFA") in Teva Branded Pharmaceutical Products R&D, Inc. et al. v. Amneal Pharmaceuticals of New York, LLC, Cv No. 23-20964 (SRC). The counterclaims for the patent were all directed to an inhaler medical device, for a counter structure for counting doses. None of the patents either claimed the drug or the use of the inhaler to administer the aerosol or even described the drug. Teva moved for dismissal of Amneal's patent delisting counterclaims and its antitrust counterclaims. Teva's motion was denied in its entirety. For its motion requesting dismissal of Amneal's delisting counterclaims Teva relied on the FDA's definition of drug, 21 USC § 321(g)(1):

> The term "drug" means (A) articles recognized in the official United States Pharmacopoeia, official Homoeopathic Pharmacopoeia of the United States, or official National Formulary, or any supplement to any of them; and (B) articles intended for use in the diagnosis, cure, mitigation, treatment, or prevention of disease in man or other animals; and (C) articles (other than food) intended to affect the structure or any function of the body of man or other animals; and (D) articles intended for use as a component of any article specified in clause (A), (B), or (C).

The Court dismissed this argument because the broad definition does not meet the requirements of 21 USC § 355(b)(1)(A)(viii)(I) "that the patent claim ***the*** drug for which the applicant submitted ***the*** application." Opinion at p. 11, emphasis in original. Judge Chesler followed the opinion in *Cesar Castillo, Inc. v. Sanofi-Aventis U.S., LLC (In re Lantus Direct Purchaser Antitrust Litig.),* 950 F.3d 1, 3 (1st Cir. 2020), which determined that injector pen without claims to a drug, or its method of use, was improperly listed in the Orange Book.

In seeking dismissal of Amneal's antitrust counterclaims Teva asserted they were barred under the *Trinko* doctrine, *Verizon Communs., Inc. v. Law Offices of Curtis V. Trinko, LLP*, 540 U.S. 398, 398-99 (2004). In *Trinko* the Court denied a separate antitrust claim because the underlying action asserted as the antitrust violation, not aiding a competitor, was not a recognized antitrust act. The statute imposed the requirement that Verizon share its network with competitors, i.e., it upset a monopoly practice. Here the statute imposes no burden on the NDA holder other than the patent listing requirement, and does not provide for any remedy for a failure to comply. The listing requirement and the FDA has no enforcement authority regarding Orange Book listings which would be usurped by the antitrust claim.

The court concluded by granting Amneal's motion for judgment on the pleadings granting Amneal's request for delisting of Teva's injector patents from the Orange Book and denying Teva's motion to dismiss Amneal's antitrust counterclaims.

To date, all of the decisions involving Orange Book Listing and FTC warning letters have involved claims which do not identify an approved drug. In listing patents in the Orange Book

one should select only patent which discuss the claim subject matter in connection with an approved drug -- preferably claim the use of the device to administer the approved drug.

NEWSLETTER EDITOR: **SAMEER GOKHALE**