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IP UPDATES

OCTOBER 30, 2025

USPTO UPDATE

USPTO Announces Two New Pilot Programs to Expedite Prosecution

BY SAMEER GOKHALE

On October 8th, the USPTO announced the Automated Search Pilot Program. This program will send an Automated Search Results Notice (ASRN) to the Applicant prior to examination so the Applicant can learn about potential prior art issues in the application. The automated search will be conducted using an artificial intelligence (AI) tool. The USPTO began accepting petitions for this program on October 20th and they will accept petitions for at least 1600 applications. For more information, see the Federal Register Notice **here**.

On October 27th, the USPTO announced the Streamlined Claim Set Pilot Program to evaluate how having a limited number of claims under examination impacts pendency and examination quality. Under the pilot program, certain pending utility patent applications that have no more than one independent claim and no more than ten total claims may be eligible for expedited examination. An applicant may comply with the claim requirements of the pilot program by filing a preliminary amendment before or with a petition to make special under the pilot program. For more information, see the Federal Register Notice **here**.

CAFC UPDATE

Federal Circuit Holds Prosecution History Disclaimer Applicable to Design Patents in *Top Brand v. Cozy Comfort*

BY SANA TAHIR and ANDREW OLLIS

On June 17, 2025, the Federal Circuit reversed a jury's finding that Top Brand LLC had infringed Cozy Comfort Company's U.S. Patent No. D859,788 and trademarks. *Top Brand LLC v. Cozy Comfort LLC*, No. 2014-20191. In a precedential decision, the Federal Circuit held the

principle of prosecution history disclaimer applies to design patents. The Federal Circuit noted that it had previously held in *Pacific Coast Marine Wind-shields Ltd. v. Malibu Boats, LLC*, 739 F.3d 694 (Fed. Cir. 2014) that disclaimer (surrender of subject matter) as a result of *amendments* made during prosecution of a design patent. The Court found that a similar logic should apply to *arguments* made during prosecution of a design patent and concluded that "a patentee may surrender claim scope of a design patent by its representations to the Patent Office during prosecution."

Cozy Comfort's design patent is directed to an "enlarged over-garment with an elevated marsupial pocket." During prosecution, to gain allowance of the design, Cozy Comfort Company focused on specific features to distinguish its design from the prior art. Specifically, Cozy Comfort contended its design patent claimed a different pocket size and shape, armhole placement and hem slope than that of the prior art references cited by the Examiner. When considering the issue of infringement in light of this prosecution history, the Federal Circuit found "multiple significant aspects of the accused products are the same ones Cozy Comfort disclaimed during prosecution, and they cannot be relied on to show design similarity between the accused and patented designs." Because Cozy Comfort only pointed to disclaimed features as being similar between Top Brand's accused product and Cozy Comfort's design, the Court found a "hypothetical ordinary observer" could not find infringement. Consequently, the Court overturned the jury's infringement finding and reversed the district court's denial of judgement of no infringement as a matter of law.

The Court's opinion can be found **here**.

AI UPDATE

Ex parte Desjardins Bolsters Patent Eligibility for AI-related Inventions as Appeals Review Panel Vacates Board's 101 Rejection

BY NICHOLAS ROSA, PHD

On September 26, 2025, the Appeals Review Panel of the Patent Trial and Appeal Board ("PTAB") published a decision reviewing the PTAB's denial of rehearing in *Ex parte Desjardins*. The Review Decision authored by new Director Squires is expected to send shockwaves through the PTO in regard to eligibility for Artificial Intelligence ("AI") and Machine Learning ("ML") applications. The Review Decision is available **here**.

The Review Panel reversed the PTAB's decision to institute a new ground of rejection under 35 U.S.C. §101 and stated that the claims at issue provided an improvement to technology or a technical field. Notably, Director Squires stated that "[c]ategorically excluding AI innovations from patent protection in the United States jeopardizes America's leadership in this critical emerging technology."

For more on this important decision, please see our post at the AI Patent Blog **here**.

USPTO Launches AI-Based Image Search Tool for Design Patent Examination

BY SAMEER GOKHALE

On July 17, 2025, the U.S. Patent and Trademark Office (USPTO) announced it is launching DesignVision, the first artificial intelligence (AI)-based image search tool for design patent examiners to use via the Patents End-to-End (PE2E) search suite. DesignVision will help streamline and modernize examination and reduce application pendency.

DesignVision is an AI-powered tool that is capable of searching U.S. and foreign industrial design collections using image(s) as an input query. The tool provides centralized access and federated searching of design patents, registrations, trademarks, and industrial designs from over 80 global registers, and returns search results based on, and sortable by, image similarity.

The USPTO mentions that DesignVision will augment—not replace—other search tools and Examiners can continue using other PE2E search tools and non-patent literature when conducting their research.

The complete text of the official announcement can be found **here**

LIFE SCIENCES NEWS

Federal Circuit Weighs In On Claim Construction of Transition Phrases in *Eye Therapies v. Slayback Pharma*

BY SANA TAHIR and ANDREW OLLIS

On June 30, 2025, in a precedential decision, the Federal Circuit vacated a Patent Trial and Appeal Board (PTAB) final written decision from an *inter partes review* (IPR) that invalidated Eye Therapies U.S. Patent No. 8,293,742. *Eye Therapies, LLC v. Slayback Pharma, LLC*, No. 2023-2173. The Federal Circuit determined the PTAB decision was based on an erroneous claim construction of the transition phrase “consisting essentially of.” The Court acknowledged “consisting essentially of” is typically understood to permit inclusion of unlisted components so long as they do not “materially affect” the invention’s “basic and novel properties.” Here, the Court’s decision suggests a departure from this typical meaning of “consisting essentially of,” to include or exclude specific components, can be supported by a patentee’s arguments made during prosecution.

Eye Therapies patent is directed to “a method to reduce eye redness.” During prosecution, Eye Therapies replaced the transition phrase “comprising” with the phrase “consisting essentially of” to overcome a rejection that its claims were anticipated by prior art which described “administration of brimonidine with brinzolamide to treat ocular diseases.” Eye Therapies argued that the amendment overcame the rejection because the revised claims “[did] not require the use of any other active ingredients in addition to brimonidine.” During the IPR, Eye Therapies contended this prosecution history supported a narrow construction for “consisting essentially of” which specifically excluded other active ingredients. However, the Board rejected this argument holding “[t]o do so would construe the semi-open-ended transition … to have the same scope as the closed transition phrase ‘consisting of.’” Instead, relying on the patent’s specification, the Board determined “additional agents would not materially affect the basic and novel characteristics of the invention[,]” thus, the phrase “consisting essentially of” did not preclude the use of additional active agents. Therefore, the Board concluded the Eye Therapies patent was obvious over the prior art.

Here, however, relying on Eye Therapies' arguments made during prosecution, the Court determined a "more-restrictive-than-typical" interpretation of "consisting essentially of" was appropriate. The Court emphasized "[Eye Therapies] secured allowance of the amended claims by arguing that the claimed methods were novel because they *do not require the use of any other active ingredients*." Thus, the prosecution history "strongly evinces a restrictive meaning of 'consisting essentially of'." The Court acknowledged its construction of "consisting essentially of" would not embrace some embodiments in the patent's specification that described compositions containing active ingredients other than brimonidine but pointed out this was "hardly surprising" given the narrowing amendment. Consequently, the Court vacated the Board's judgement and remanded the case for further proceedings consistent with the construction provided.

The *Eye Therapies* decision highlights the significance that clear statements distinguishing over the prior art may have in later claim interpretation of an issued patent, and that these statements can even change the understanding of a well-established transition phrase like "consisting essentially of." That said, practitioners may still find it difficult to convince a patent examiner that "consisting essentially of" excludes any features beyond those clearly excluded by the text of the patent specification alone.

The Court's opinion can be found **here**.

JPO UPDATE

JPO Annual Report 2025

The Japan Patent Office (JPO) has released the "JPO Annual Report 2025" on July 7, 2025. The report discusses trends in numbers of Japanese patent applications; trends in numbers of PCT national phase applications; examination speed; and grant rate. The report includes the following key points:

- In 2024, the number of Patent applications increased compared to the previous year.
- Patent applications from China and Korea have risen, including a large increase in design registration application from China.
- Pendency for patent examination has reduced from the previous year.

For a copy of the report (in Japanese) see **here**.

For an English summary of the key points from the report, please see the Itoh firm's summary **here**.

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