

OBLON

IP UPDATES

SEPTEMBER 3, 2026

USPTO UPDATES



Obviousness-type Double Patenting Case Designated as Precedential

BY SAMEER GOKHALE

In *Ex parte Baurin* (Appeal 2024-002920), an Appeals Review Panel (ARP) that included Director John A. Squires reversed a Patent Trial and Appeal Board (PTAB) decision and reinstated the examiner's rejection of claims for obviousness-type double patenting (OTDP). The ARP explained the statutory, precedential, and supporting commercial rationales underlying OTDP and determined that the Federal Circuit has recognized an anti-harassment rationale as a legitimate policy justification underpinning the OTDP doctrine, even absent evidence that patent issuance would extend the duration of an applicant's patent monopoly. The ARP, nonetheless, questioned whether a standalone anti-harassment rationale risks harming innovation and should be ultimately reconsidered by the court. The ARP also proposed a future framework designed to streamline and make more predictable the Office's handling of OTDP. See decision [here](#).

Markush Groupings Case Designated as Informative

In *Ex parte Chowdhury* (Appeal 2025-002261), the Board reversed an Examiner's rejection of claims for reciting improper Markush groupings. The decision holds that a Markush grouping is proper if it recites members of a subgenus and the specification describes those recited members as performing similar functions in the context of the invention. This decision has been designated as informative by the USPTO. See the decision [here](#).

U.S. Counsel Rule Takes Effect

A new rule took effect on July 20, 2026. It requires foreign-domiciled applicants and inventors to use a registered U.S. patent practitioner for filings. One of the key impacts of this rule is that non-U.S. applicants can no longer file or prosecute patent applications *pro se* (representing themselves) or rely solely on non-U.S. counsel.

CAFC UPDATES

CAFC Clarifies How to Determine if Provisional Application Establishes Earlier Filing Date in *Align Tech., Inc. v. Dental Monitoring SAS*

BY DOROTHY JONES, Ph.D



The Court of Appeals for the Federal Circuit (CAFC; Case No. 25-1752) vacated a Patent Trial and Appeal Board (PTAB)'s decision in IPR2023-01369 (*Align Tech., Inc. v. Dental Monitoring SAS*) that Claims 1-15 of U.S. Patent 10,755,409 ('409) were unpatentable as obvious.

The PTAB had concluded that a patent publication owned by Carrier qualified as prior art as of the provisional application's filing date since it satisfies the "ministerial requirements" of §§ 119 and 120 and it describes the subject matter relied upon.

In vacating the PTAB decision, the Court determined that the statute requires § 112(a) support for at least one of a prior art's published claims for that reference to obtain an earlier filing date for the purposes of prior art, and not just the satisfaction of "ministerial requirements."

Read more about this decision at our Life Sciences Blog [here](#).

CAFC Reverses Jury Decision in *Board of Regents of the University of Texas System v. Boston Scientific Corp.*

BY DAVID INGLEFIELD

The U.S. Court of Appeals for the Federal Circuit (CAFC) issued a precedential decision in *Board of Regents of the University of Texas System v. Boston Scientific Corp.*, reversing a jury trial verdict that found Boston Scientific Corporation (BSC) liable for infringing a Board of Regents of the University of Texas System (UT) owned patent for drug-releasing biodegradable fiber implants. In the reversal, the CAFC found that the '296 patent was anticipated by U.S. Patent No. 5,364,627 (the '627 patent, "Song") and that BSC was entitled to judgment as a matter of law (JMOL) on both anticipation and non-infringement, returning the \$49.4 million jury awarded damages to BSC.

Read more about this decision at our Life Sciences Blog [here](#).

IPL v. Sony: Federal Circuit Holds PTAB Did Not Violate Mandate Rule and Affirms Obviousness Determination

BY XIAOHUA (JOYCE) GUO, PhD

In *Intellectual Pixels Limited v. Sony Interactive Entertainment LLC*, the Federal Circuit affirmed a Patent Trial and Appeal Board decision holding claims 1-12 of U.S. Patent No. 10,681,109 unpatentable as obvious.

Intellectual Pixels Limited ("IPL") owned the '109 patent, and Sony Interactive Entertainment LLC ("Sony") petitioned for *inter partes* review. Sony originally challenged claims 1-18, but IPL statutorily disclaimed claims 13-18, leaving claims 1-12 at issue. In the Board's first final written decision, the Board held that Sony had not shown the challenged claims to be unpatentable. In the first appeal, the Federal Circuit vacated the Board's decision. The court held that substantial

evidence did not support the Board's finding that Wiltshire failed to disclose generating a new image.

On remand, the Board followed the Federal Circuit's prior decision and found that Wiltshire, by disclosing operation with a game like Doom, disclosed generating new updated images at the server. On appeal from the remand decision, IPL first argued that the Board had gone beyond the Federal Circuit's prior mandate.

The Federal Circuit rejected that argument. As to the first statement, the court explained that its earlier decision had already vacated the Board's finding that Wiltshire did not disclose the "generating" limitation. In the first appeal, the Federal Circuit held that Wiltshire disclosed applying its system to games like Doom, and the parties agreed that Doom required generating new images. Thus, on remand, the Board's finding that Wiltshire disclosed server-side generation of updated images was compelled by the Federal Circuit's prior mandate, not barred by it. Therefore, the Federal Circuit held that the Board did not violate the prior mandate, rejected IPL's substantial-evidence challenge, and affirmed the Board's decision that claims 1-12 of the '109 patent are unpatentable.

Read more about this decision at our Life Sciences Blog [here](#).

AI UPDATE



USPTO Provides Update on Plans for AI Implementation

BY SAMEER GOKHALE

During a "USPTO Hour" information session earlier this year, the Office provided an update on how the agency is driving artificial intelligence (AI) innovation and enabling opportunities to use AI tools to support their mission. A summary of that discussion is below and a link to the video recording can be found [here](#).

The USPTO is trying to become a leading federal agency in AI adoption, but its stated approach is controlled and evidence-based. The agency wants AI to handle routine research, drafting, classification, searching, and administrative work while employees retain responsibility for legal reasoning and final decisions.

The USPTO is testing its internal generative-AI system with supervisory patent examiners before expanding access. Potential future uses include:

- interpreting patent claims;
- summarizing inventions;
- checking priority dates;
- mapping claims to prior-art references;
- helping with novelty and obviousness analysis;
- structuring subject-matter eligibility analysis; and
- identifying possible clarity, written-description, or enablement problems.

The proposed system would provide editable drafts, source links, and confidence indicators. Examiners would remain the authors and final decision-makers. USPTO said it would expand the tools only when there is evidence that they improve quality and save time.

The Office emphasized that protecting intellectual property and agency data is the top priority. With regard to preparing employees, they are building an agency-wide AI change-management program.

Read more about this update at our AI Patent Blog [here](#).

NEWSLETTER EDITOR: **SAMEER GOKHALE**



Oblon | 1940 Duke Street | Alexandria, VA 22314 US

[Unsubscribe](#) | [Update Profile](#) | [Constant Contact Data Notice](#)



Try email marketing for free today!