

OBLON

IP UPDATES

AUGUST 16, 2023

USPTO UPDATES

[USPTO Announces Revised Director Review Process](#)

BY RICHARD D. KELLY

On July 24, the USPTO announced a revised Director interim review process. Although the USPTO in July 2022 had requested comments on its director review process and the comment period was closed on October 19, 2022, the USPTO has still not formalized the process or published any proposed rules to implement it. Instead, it revised its interim review process. [Details here.](#)



[Denial of IPR Requests Relying on Prior Art Cited in an IDS](#)

BY RICHARD D. KELLY

In July, the PTAB considered five IPR petitions where one or more references in the petition were cited during the prosecution of the patent in an IDS. In each instance the PTAB considered the citation of the prior art on an IDS to be sufficient to trigger the 35 U.S.C. § 325 (d) provision that the Director can refuse to institute an IPR if the same or substantially the same prior art was presented to the Office. In all cases, the PTAB determined that the examiner erred in allowing the claims over the prior art cited in the IDS.

In these cases, the IDSs cited in one case over 900 references (IPR2023-00454 and IPR2023-00455), in another almost 100 references (IPR 2023-00539) and two others with fewer references cited (IPR2023-00462 and IPR2023-00512). The PTAB applied the test outlined in *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to Section III.C.5, first paragraph) which provides that when the prior art relied on in an IPR petition was cited during prosecution of the patent then the PTAB evaluates for the following non-exclusive factors:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art or patent owner distinguishes the prior art;

- (e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

In each instance, the Petitioners noted that the references were not used in a rejection and argued that the references, when taken with other prior art, provided a strong case of unpatentability in showing examiner error. In the -00454 and -00455 IPRs the large number of references cited on the IDS was not sufficient to avoid the need to make the showing of examiner error. The issue is whether the reference was presented to the USPTO. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential). However, the PTAB recognized the citation of 900 references made the examiner's consideration of the references unlikely but considered the statute to require only making them of record. The other decisions were similar.

The key to the decisions was the explanation by the petitioners why the references, if properly considered, would have resulted in the rejection of the claims by the examiner, proving examiner error.

JPO UPDATES



[Japan Patent Office Annual Report 2023](#)

BY KASUMI KANETAKA

The JPO published the Japan Patent Office Annual Report 2023 in July this year. The key contents are as follows:

- The number of patent applications increased slightly for the second year in a row.
- Regarding patent applications from abroad, the number of applications from the United States, Europe, China, and Korea increased from the previous year (see Figure 1 below).
- For trademarks, the average FA(First Action) pendency, and the total pendency, from the filing to the registration, were both shortened dramatically.

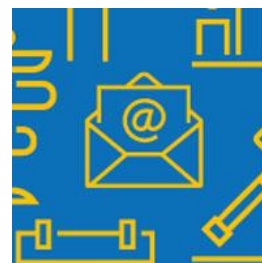
Additional information regarding the JPO Status Report can be found [here](#).

KIPO UPDATES

[Korean Intellectual Property Office Fee Revisions](#)

BY GRACE E. KIM

The Korean Intellectual Property Office has revised its fees, effective August 1, 2023. The fees for examination have increased, which is applicable to applications in which the Korean patent application date or the international application date for PCT applications, is on or after August 1, 2023. However, the registration fees and annual fees have been reduced, which are applicable to applications in which a registration decision date or payment date, respectively, are on or after August 1, 2023. Further, KIPO has now implemented additional fees for subsequent divisional applications on a progressive scale.



FEDERAL CIRCUIT UPDATES



[Pure AIA Patents and Applications Cannot Be Involved in Interferences](#)

BY DONALD R. McPHAIL

In *SNIPR TECHNOLOGIES LIMITED V. ROCKEFELLER UNIVERSITY*, No. 2022-1260 (July 14, 2023) (Chen,* Wallach, and Hughes), a panel of the Court addressed the issue of which patents and patent applications can be the subject of an interference.

SNIPR is the owner of five patents directed to methods of selectively killing bacteria in a mixed set of bacteria using CRISPR gene editing. All of the SNIPR patents claimed priority to a PCT application filed on May 3, 2016. Accordingly, all of the applications from which the SNIPR patents issued were deemed “pure AIA” applications and so examined and issued under the AIA’s first-inventor-to-file patentability requirements.

Rockefeller University had a pending application that was also directed to methods of selectively killing bacteria. Rockefeller’s application claimed priority to a PCT application filed on February 4, 2014, and a U.S. provisional application filed on February 7, 2013. Based on the filing date of Rockefeller’s provisional application, Rockefeller’s pending application was deemed a “pure pre-AIA” application.

The Board declared an interference between certain claims of Rockefeller’s pending application and all of the claims of the SNIPR patents. The Board initially identified Rockefeller as the senior party based on the February 2014 filing of the Rockefeller PCT application. SNIPR moved to terminate the interference on the grounds that interferences are unavailable to assess patents governed by the AIA. The Board subsequently redeclared the interference, but this time gave Rockefeller benefit of the pre-AIA filing date of the Rockefeller provisional application. SNIPR again moved to terminate the interference on the grounds that the AIA eliminated interferences for pure AIA patents and patent applications. The Board again denied SNIPR’s motion using the rationale that Rockefeller’s pending application, as a pure pre-AIA application, had to comply with the pre-AIA version of 35 U.S.C. § 102(g) (which required an interference under pre-AIA 35 U.S.C. § 135 between the claims of Rockefeller’s pending application and the claims of the SNIPR patents).

The Board therefore entered judgment against SNIPR and cancelled all of the claims of all of the SNIPR patents. SNIPR then appealed.

In an opinion by Judge Chen, the panel reversed the Board’s decision and held that first-inventor-to-file patents and patent applications exclusively governed by the AIA, *i.e.*, pure AIA patents and applications, cannot be subject to an interference. The panel first reviewed the statutory language of AIA § 3(n) and concluded that only pure pre-AIA and “mixed” patents and patent applications (*i.e.*, patents and applications that contain (or contained at any time) at least one claim with a pre-AIA effective filing date and at least one claim with a post-AIA effective filing date) may be part of an interference. The panel therefore concluded that the AIA bars pure AIA patents from being subject to an interference. The panel then turned to the language of pre-AIA 35 U.S.C. § 135(a) and concluded that the language “any unexpired patent” did not include pure AIA patents. The panel noted that interpreting “any unexpired patent” in the manner proposed by Rockefeller and the Director (who had intervened) would undermine “a central purpose” of the AIA, which was to do away with the first-inventor-to-file system and interferences for future applications. Read our full article [here](#).

[Claim Construction and a 35 U.S.C. § 101 Motion to Dismiss](#)

BY RICHARD D. KELLY

When infringement defendants believe that the asserted patent claims lack patent eligibility, they will often file a Rule 12(b)(6) motion to dismiss before even filing an answer. A patentee may want to defend on the basis the motion is premature because a claim construction is necessary. Sometimes, a patentee may also assert that fact discovery is necessary. In *Trinity Info Media, LLC v. Covalent, Inc.*, Case No. 22-1308 (Fed. Cir. July 14, 2023), Covalent moved to dismiss under Rule 12(b)(6) on the grounds of patent ineligibility, stating the asserted claims were directed to an abstract idea. In *Trinity*, the district court granted Covalent's motion and dismissed the action.

Trinity had opposed the motion on the merits because there had not been a claim construction or any fact discovery. Trinity's opposition argued that a claim construction was necessary before the motion could be decided since determining patent eligibility requires a full understanding of the claims, citing *Aatrix Software, Inc. v. Green Shades Software, Inc.*, 882 F.3d 1121, 1128 (Fed. Cir. 2018). Trinity also contended that Covalent had argued that Trinity had imported details into its arguments not in the claims, stating that a claim construction was necessary to decide if Covalent's argument was accurate or not. Finally, Trinity argued that discovery was necessary to determine if the facts were well understood.

At no point did Trinity identify the claim terms which needed construction nor its proposed claim construction. Without this information there was no way for the court to know claim construction would affect the § 101 analysis. As for the requested discovery, Trinity identified no facts which would affect the § 101 analysis. Trinity's requests seem strange since before filing its complaint it needed to perform a claim construction to determine infringement, and as to the facts, why couldn't its expert opine on them since presumably, they were not secret information known only to Covalent.

The district court denied Trinity's request for a claim construction and fact discovery because "Trinity does not provide any concrete claim construction dispute or fact discovery issue that would preclude the dismissal of the Asserted Claims. Accordingly, the Court finds that Trinity's conclusory requests are unavailing. See *Simio, LLC v. FlexSim Software Prod., Inc.*, 983 F.3d 1353, 1365 (Fed. Cir. 2020) ("The main problem with that argument is that Simio has not explained how it might benefit from any particular term's construction under an Alice § 101 analysis.")"

When faced with a § 101 motion to dismiss one should consider whether a claim construction is necessary to demonstrate the claims are not subject to one of the judicial exceptions. Simple general assertions are not enough – one must explain how the construction will defeat the motion to dismiss.

LIFE SCIENCES NEWS

[No Motivation to Modify Product-Specific Method with Method Features for Different Products](#)

BY DEREK LIGHTNER

On July 10, 2023, the Patent Trial and Appeal Board (PTAB) reversed an examiner's finding of obviousness on the basis of a failure to show a motivation to modify the prior art and a lack of a reasonable expectation of success. The main appealed claim recited a process for producing a meal fraction of *Brassica carinata* oilseed having reduced sinigrin content. During prosecution, the examiner rejected the claims over Verkoeijen (US 2013/0101723 A1), Yuan ("Analysis of Oilseed Glucosinolate and Their Fate During Pressing or Dehulling"), and Helling (US 2010/0234569). The PTAB noted that Helling pertains to canola or rapeseed press cake, not to *carinata*, that Yuan is the only reference discussing the potential use of *carinata* press cake, but states that *carinata* seed meal has the highest sinigrin content of any of the *carinata*-derived materials tested in Yuan, and observes that this "might suggest that this material may not be the best candidate as feed for farm animals." On this basis, the PTAB concluded that no motivation to combine Verkoeijen, Yuan, and Helling to arrive at the claimed



invention was supported by the evidence of record. The PTAB also found that the examiner failed to cite any prior art description that there would have been a reasonable belief that the meal fraction produced by Verkoeijen's process, as modified in view of Yuan and Helling, would have a reduced sinigrin content. The PTAB held that the examiner had not established a *prima facie* case of obviousness. To find reasons to modify a product-specific process the prior art should all be directed to a process for the same or similar product. [Read more here.](#)

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