

OBLON

IP UPDATES

NOVEMBER 20, 2023

USPTO UPDATES

[EFS-Web and Private PAIR Retired](#)

BY GRACE E. KIM

Starting November 15, 2023, the Patent Center system fully replaced EFS-Web and Private PAIR. The Director noted that the Patent Center will pull all the steps of filing and managing a patent application together into one central system, and includes the following features to streamline the application process:



- No need to create a new account: you can use the USPTO.gov accounts and sponsorships that you've already created for EFS-Web and Private PAIR.
- The ability to upload your patent application specification, claims, abstract, and drawings in a single DOCX document without having to manually separate sections.
- The ability to upload multiple documents at once using the drag and drop interface.
- The ability to download multiple documents at one time in a single PDF or ZIP file.
- The ability to confirm the status of submitted documents and successful payments with separate submission and payment receipts.
- In addition, if you want to get familiar with Patent Center's features without actually submitting anything, you can explore Training Mode, an interactive simulation to safely practice filing DOCX and PDF documents. You'll also receive real-time feedback.

You may access an [on-demand recording of a previous Patent Center Training session](#) to learn more about filing and managing patent applications and the [Top 25 questions and answers](#) from prior sessions held August 1, 2023 through November 2, 2023.

[USPTO Creates a Separate Design Practitioner Bar](#)

BY DAVID M. LONGO

The USPTO issued a final rule in the Federal Register on November 16, 2023, to create a separate design patent practitioner bar for practice in design patent proceedings only. Importantly, according to the USPTO, the new design patent practitioner bar "does not impact the ability of those already registered to practice in any patent matters before the USPTO to continue to practice in any patent matters, including design patent matters, before the Office."

The USPTO indicated that to “ensure applicants to the design patent practitioner bar have the requisite knowledge of USPTO rules and regulations, the USPTO also requires them to take and pass the current registration examination” (in addition to undergoing and passing a moral character evaluation). Nevertheless, the USPTO emphasized that “admitted design patent practitioners may practice in design patent matters only” and reminded the patent community that per ethics Rule 11.101, “all practitioners, including design patent practitioners, are requested to provide competent representation to their clients. According to the USPTO, “design patent practitioners will receive a particular registration number series to distinguish them from those practitioners who are authorized to practice in all patent matters.” Read our detailed blog post [here](#). The Notice is published in the Federal Register [here](#).

JPO UPDATES



[JPO-USPTO Bilateral Meeting Held](#)

BY KASUMI KANETAKA

JPO Commissioner Hamano Koichi held a meeting with Director Kathi Vidal of the USPTO on October 3, 2023, while attending the 41st Trilateral Heads of Office meeting in Munich, Germany. During the meeting, the two patent offices held discussions on matters including the Green Transformation Technologies Inventory (GXTI),

Diversity and Inclusion in the field of intellectual property, and examination practices of inventions related to AI.

[JPO's Views on AI and Inventive Step](#)

BY KASUMI KANETAKA

On November 7, 2023, the Government of Japan held the third Intellectual Property Rights Study Group in the AI Era. During the meeting, the Japan Patent Office (JPO) presented a view that inventions such as new products that utilize AI are “human inventions” because humans are involved to a certain extent. Current patent law only considers cases of human creation when it comes to the subject matter of intellectual property rights. In order to invent and obtain a patent, it is necessary to have an unprecedented “inventive step.” The JPO also expressed an idea that, as AI becomes more widespread and everyone becomes capable of advanced creation, the examination standards for determining inventive step will need to be changed in line with the progress of AI. At the next meeting in December, the Government is aiming for sorting out the points at issue.

AI UPDATE

[White House Executive Order on AI Accelerates USPTO Guidance on Generative AI and AI-Inventorship Issues](#)

BY SAMEER GOKHALE

On October 30, 2023, President Joe Biden released an executive order on the safe, secure, and trustworthy development and use of artificial intelligence (AI). Included in the order is a directive to the U.S. Patent and Trademark Office Action to accelerate guidance to USPTO patent examiners and applicants “addressing inventorship and the use of AI, including generative AI, in the inventive process,



including illustrative examples in which AI systems play different roles in inventive processes and how, in each example, inventorship issues ought to be analyzed.” The order states that such guidance shall be published within 120 days from the date of the order.

The order also states that within 270 days from the date of the order, the USPTO shall issue additional guidance to USPTO patent examiners and applicants to address other considerations at the intersection of AI and IP, which could include updated guidance on patent eligibility to address innovation in AI and critical and emerging technologies.

The order further calls for the USPTO to work with the U.S. Copyright Office to issue recommendations addressing the scope of protection for works produced using AI and the treatment of copyrighted works in AI training.

A copy of the order can be found here: <https://www.whitehouse.gov/briefing-room/presidential-actions/2023/10/30/executive-order-on-the-safe-secure-and-trustworthy-development-and-use-of-artificial-intelligence/>

FEDERAL CIRCUIT UPDATES



Federal Circuit Considers the Meaning of "A"

BY RICHARD D. KELLY

“A” is a simple word often used in claims but is also the source of disputes as to its meaning. Does it refer to a single it or to one or more? The Federal Circuit in *ABS Glob., Inc. v. Cytonome/St, LLC*, No. 2022-1761, 2023 WL 6885009 (Fed. Cir. Oct. 19, 2023) had yet another opportunity to opine on the issue. Opinion [here](#). The word has variously been interpreted as meaning “one or more” and “one” depending on the context. Even the Supreme Court has anguished over its meaning, see *Niz-Chavez v. Garland*, 141 S.Ct. 1474 (2021), in which the Court, in a 5-3 decision, held that “a” meant “one.” The Court considered the meaning in the context of the government sending “a notice” to appear. The Court considered that in the context of a statute it had been routinely interpreted to mean one. The Court looked to the normal legal meaning of notice plus other sections of the Illegal Immigration Reform and Immigrant Responsibility Act of 1996, which used language describing a single notice, “the” notice.

In *ABS Global*, the claim of U.S.P. 10,583,439 reads:

1. A microfluidic assembly for use with a particle processing instrument, the microfluidic assembly comprising:

a substrate; and a flow channel formed in the substrate, the flow channel having:

an inlet configured to receive *a sample stream*; *a fluid focusing region configured to focus the sample stream*, the fluid focusing region having a lateral fluid focusing feature,

The reference in the claim to “the sample stream” was used by the PTAB to interpret “a fluid focusing region” to be limited to one stream. The Federal Circuit disagreed by considering the description in the specification. The description defined “[F]or the purposes of the present disclosure, the term ‘a’ or ‘an’ entity refers to one or more of that entity. As such, the terms ‘a’ or ‘an,’ ‘one or more’ and ‘at least one’ can be used interchangeably herein.” ’439 patent, col. 18, lines 27–30.” The use of “a” before the subject in an open claim requires “a” to be interpreted as “one or more” unless the context sufficiently indicates to the contrary. The term “the” was simply referencing back (to a sample stream) and takes its meaning from “a”. Thus if “a” means “one or more” so does “the.”

More convincing is claim 2 which depends on claim 1, reciting the “lateral fluid focusing feature” of claim 1 be “configured to *introduce* focusing fluid into the flow channel symmetrically with respect to a *centerline* of the sample stream.” *Id.*, col. 18, lines 64–67 (emphases added). Claim 2 explicitly requires 2 streams which is excluded by the PTAB’s interpretation.

The PTAB’s claim interpretation is difficult to explain. It is important for patentees and patent applicants to carefully consider claim interpretation and assemble all factors supporting the desired claim interpretation.

Argument Not Presented in IPR Petition is Waived

BY RICHARD D. KELLY

The Federal Circuit in *Netflix, Inc. v. DivX, LLC*, Case Nos. 22-1203; -1204 (Fed. Cir. Oct. 25, 2023) (Linn, Chen, JJ.) (Dyk, J., dissenting) reminded practitioners that an argument not made in the petition was waived. Opinion [here](#).

DivX owns two media streaming patents. In streaming, content is typically stored as separate “streams” suitable for different device capabilities. A playback device must select the appropriate media from the available streams. The challenged patents discuss a method for automatically generating a top-level index that describe the location and content of a container having streams of media. An independent claim in each patent recites a method comprising “receiving” a request for content, “retrieving” a list of assets associated with the content, “altering” the list of assets using device capability, “generating . . . a top level index describing each asset in the filtered list of assets” and “sending the top level index file” to the playback device.

Netflix challenged both patents on two prior art combinations, Pyle and Marusi, and Lewis and Marusi. The PTAB found that Netflix had failed to prove the patents’ claims were unpatentable. Netflix did not challenge the PTAB’s substantive analysis but instead focused on the PTAB’s alleged failure to address Netflix arguments in its petitions.

The Patents at issue are U.S.P. 9,270,720 (‘720) and U.S.P. 9,998,515 (‘515), ‘515 is a continuation of ‘720 and the two patents had identical specifications. The primary difference between the patents was the ‘515 patent provides additional details regarding the level index limitation. The ‘720 patent claims required “filtering the list of assets” which Netflix argued was met by Pyle’s selection of a *pre-existing manifest*. Netflix also argued that to the extent Pyle does not teach or render obvious the filtering limitation’s “database of product identifiers and associated device capabilities,” Marusi’s database would. As for the “generating . . . a top level index file” limitation, Netflix argued that Pyle’s creation of a new manifest teaches this limitation.

Netflix argued that the PTAB had ignored its arguments raised in its petition. The Court disagreed. The Court noted the petition explained how the “filtering” limitation corresponded to Pyle’s selection of a *pre-existing* manifest. It saw no discussion in the petition’s “filtering” section, however, of how Pyle’s creation of a *new* manifest meets this limitation. The court concluded that it was reasonable for the PTAB to understand that Netflix was mapping Pyle’s pre-existing manifest embodiment, and not also its new manifest embodiment to the filtering limitation. On appeal Netflix pointed to a block quote from Pyle which stated that the new manifest can be optimized. The Court noted there was nothing in the blockquote which signaled to a reader that an optimized new manifest equates to “filtering the list of assets,” let alone that Netflix was advancing such an argument. The Court noted “[M]oreover, even in its appellate briefing and at oral argument, Netflix does not explain how the items selected to create Pyle’s new manifest could be regarded as “a list of assets” “wherein each asset is a different stream” associated with a piece of content, further underscoring the lack of clarity with Netflix’s new manifest argument.”

The Court relied on the language of “the petition made it quite clear Netflix was focused on Pyle’s pre-existing manifest” as teaching the “filtering the list of assets” limitation. When arguing

that Pyle’s selection of a pre-existing manifest met this limitation, Netflix specifically stated “Pyle . . . filters lists of assets by selecting from the various manifests an appropriate manifest to send.” J.A. 6046–47 (emphasis added). Netflix thus showed it knew how to put forward a clear mapping of Pyle to the filtering limitation, but never connected Pyle’s new manifest to that limitation like it did for Pyle’s selection of a pre-existing manifest. While it is not strictly necessary for a petition to use the exact words of a limitation when making an argument, in this instance, the Board appropriately understood Netflix’s “filtering” section of the petition to be devoted to relying solely on Pyle’s pre-existing manifest.

The Court’s and the PTAB’s decisions highlight the need for petitions to clearly introduce all arguments supporting unpatentability. One should not assume that the PTAB or the Court will make the leap for you.

LIFE SCIENCES NEWS

[FTC Alleges Misuse of Orange Book Listings: Puts 10 Pharma Companies on Notice](#)

BY RICHARD D. KELLY

The FTC announced that it is cracking down on companies it asserts is improperly or inaccurately placing drugs on the list of FDA-approved products, known as the Orange Book. The challenge may result in removal of products from the Orange Book. In a six-page policy statement, found [here](#), the FTC advised that it was putting “market participants on notice that the FTC intends to scrutinize improper Orange Book listings to determine whether these constitute unfair methods of competition in violation of Section 5 of the Federal Trade Commission Act.”



The FTC asserted that some brand companies were exploiting the Orange Book listing process to prevent or delay marketing of generic drugs. According to published reports, 10 companies, including AbbVie, AstraZeneca, and GSK are now in scrutiny by the FTC for improperly or inaccurately listing items in the Orange Book ostensibly to hold off generic competition. The patents challenged by the FTC include those covering inhalable asthma treatments from AstraZeneca and Boehringer Ingelheim; epinephrine autoinjectors from Mylan; and the AbbVie dry eye drug Restasis. The other companies who received FTC notice letters are Impax Laboratories, Kaleo, and subsidiaries of GSK and Teva Pharmaceutical. Read our full blog post [here](#).

[Assignments to be Filed in the EPO Require Handwritten Signatures](#)

BY RICHARD D. KELLY

Today it is common for legal documents to be electronically signed including patent assignment documents. However, it is important to recognize that each jurisdiction may have its own rules regarding the type of documents that can be electronically signed. The European Patent Convention (EPC), Article 72, requires “the signature of the parties to the contract” which seems innocent enough. However, a recent decision of the Board of Appeal of the European Patent Office (EPO) held that a signature must be handwritten, by hand, to record an assignment with the EPO.

The decision arose from a case where a party sought to record an assignment on the European Patent Register which had been electronically signed using the */signature/* convention as in the USPTO. The EPO Legal Division refused to record the assignment and required it to be resubmitted with either a handwritten signature or a verifiable electronic signature such as that available from Adobe and other vendors. The company refused and instead appealed the decision. The issue was what did “signature” mean in Article 72 and whether it includes

unverified electronic signatures. The Board decided that although Article 2(2) had been interpreted to allow for electronic signatures for formalities, this does not apply to Article 72 which the Board interpreted as requiring a sufficient level of authenticity of the assignment document.

Until the Administrative Council of the EPO takes up the question, one is advised to have any document which purports to assign patent rights to be hand signed. It also serves as a reminder that different jurisdictions have different rules and procedures.

[EPO Relaxes Requirements for Successfully Claiming Priority to an Earlier Application](#)

BY RICHARD D. KELLY

Until this recent decision the EPO has claimed that the application claiming priority to an earlier application must be filed by the same applicant or its successor in interest. In recent years the opponents in opposition proceedings have successfully attacked the benefit of a priority application if the applicants in the two applications are not identical. Losing priority will often result in the EPO application being held unpatentable over intervening prior art. This has led to the demise of high-profile patents, including the Broad, MIT and Harvard patent for the CRISPR technology, see decision T 0844/18 decided in January 2020. The enlarged Board of Appeals in consolidated cases G 1/22 and G 2/22 decided it was a rebuttable presumption that under the autonomous law of the EPC that the applicant claiming priority under Article 88(1) is entitled to claim priority. This effectively overrules the prior practice of denting priority if the applicant claiming priority and the priority application had different applicants. In its October 10, 2023, press release the EPO described the order:

In a situation where a PCT application is jointly filed by parties A and B, (i) designating party A for one or more designated States and party B for one or more other designated States, and (ii) claiming priority from an earlier patent application designating party A as the applicant, the joint filing implies an agreement between parties A and B allowing party B to rely on the priority, unless there are substantial factual indications to the contrary.

EPO applicants are not completely out of the woods as when the EPO patent goes national, the national law will control, and some countries have priority claiming requirements more stringent than those of the recent decision. A copy of the press release is [here](#) and the full text of the decision is [here](#).

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