

IIPLA VIRTUAL IP SUMMIT 2020

Patents: Safeguarding your Intellectual Property Rights

Some Non-typical Aspects of U.S. Patent Law
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Note: This presentation does not constitute legal advice to any person or entity. It covers a disparate number of subjects at a high level. No attempt is made to discuss all details a practitioner would need to consider. Nor is it comprehensive in scope. It provides only as a starting point for further analysis and research.

U.S. Provisional Patent Applications

Goal is to temporarily hold a filing date for what is disclosed and enabled therein

- Has specification and drawings, but claims not required
- Reduced formalities
- Not examined
- Expires after one year
- Before expiration of the one year, must file non-provisional, PCT, or other application claiming priority to provisional application
- Multiple provisional applications may be filed within the one year
- May not claim priority to another application
- Possible restoration of right of priority if one-year deadline is missed is beyond the scope of this presentation

Non-enabled/Secret Sales:
35 USC 102(b)

[a] person shall be entitled to a patent unless—

- (1) the claimed invention was patented, described in a printed publication, or in public use, **on sale**, or otherwise available to the public before the effective filing date of the claimed invention; or
- (2) ****

On Sale:

An invention is “on sale” if

- (a) It is the subject of an offer of sale; and
- (b) It is ready for patenting.

Helsinn Healthcare v. Teva Pharmaceuticals USA, Inc., 139 S. Ct. 628 (2019)

Addressed issue raised by America Invents Act (2013)

“[W]e hold that an inventor’s sale of an invention to a third party who is obligated to keep the invention confidential can qualify as prior art under §102(a).”

- Sale was not secret but confidentiality agreement required purchaser to keep invention secret. Thus, non-enabling sale.
- Undecided: What if sale itself were secret?

Note: Whether some types secret commercial exploitation or non-enabling uses may be a “public use” under the “public use” prong of current Section 102(b) is beyond the scope of this presentation.

DUTY OF CANDOR:

§ 1.56 Duty to disclose information material to patentability.

(a) *** Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. ***

However, **no patent will be granted** on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

(1) Prior art cited in search reports of a foreign patent office in a counterpart application, and

(2) The closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

DUTY OF CANDOR (Continued)

- Applies to inventors, attorneys
- What is “material to patentability?”
- Disclosure of prior art is performed with information disclosure statements filed with the USPTO.
- In patent litigation in the courts, a finding of inequitable conduct may result in invalidation of patents. Details beyond the scope of this presentation, but see e.g. *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276 (Fed. Cir. 2011) (en banc).

Functional claiming and Avoiding Means plus Function Claiming

35 USC 112(f): An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and **such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.**

- For infringement, scope is often narrower than functional claims that are not means plus function.
- If use means plus function claim for a computer-implemented invention, must disclose algorithm for performing function or risk invalidity as indefinite under 35 USC 112(b).
- Rebuttable presumption that 112(f) invoked by language such as “means for” or “step for.”
- Rebuttable presumption that 112(f) not invoked if “means for” or “step for” not recited.
- Nonce words – module, mechanism, element, device, Tatamount to “means for.”
- See, *Williamson v Citrix Online*, 792 F.3d 1339 (Fed. Cir. 2015) (where 112(f) invoked by use of nonce word module and algorithm not provided, claim invalid).