

PATENT DEVELOPMENTS *

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I. OVERVIEW

Several significant case law developments have taken place in the patent law in the past year. Perhaps even more important developments are on the horizon. Together, they create a climate where the patent community today must *predict* the trend of the case law for business management decisions that will reach over the coming twenty years (as the patents filed today will only expire twenty years from now). This paper provides an overview of several current areas of discussion.

Claim construction is the most hotly debated and important area of controversy in patent law today. The United States today has by far the most arcane and complex set of rules to interpret patent claims of any major country of the world. This is to the great detriment of business certainty and Wall Street confidence in supporting investments in technology-dependent industries. *A fortiori*, the task of the trial court seeking to make sense of seemingly contradictory rules and conflicting panel opinions interpreting those rules has become geometrically more complicated. Yet, a continued absence of panel predictability and a “shuffling” of precedent may in the end be all that can be expected from the *en banc* decision expected perhaps fifteen months or so from now in the *Phillips* case. See § II, *Claims Practice Under The 2006 Phillips Case*.

No matter what the court decides in *Phillips*, the trend of the case law will continue to place a premium upon drafting claims that will be *literally infringed*. They must also be precisely honed so that ambiguities do not lead to a narrow construction under the current trend of the law. The simple mistake of the wrong preposition – an “at” instead of a “to” – can lead to a

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nonsensical claim construction that the mainstream court will not disturb, leading to a valueless patent right. See § II-A, *Focus Upon Clear and Literally Infringed Claims*. More senior practitioners may have felt that it was sufficient that a commercial embodiment be *disclosed* in a patent; if there is some glitch in claim wording so that literal infringement is avoided, surely, the doctrine of equivalents will come to the rescue: This is no longer true, thanks to the judicially created new Federal Circuit “disclosure-dedication” rule. See § II-B, *The Need to Claim All Disclosed Embodiments*.

As a prophylactic against the difficulties of claim construction doctrines at the Federal Circuit, it is imperative as a matter of best practices patent management to refocus patent drafting and procurement efforts on *simple* patent applications; the focus must be on crafting a reasonable number of *simple* claims in an uncomplicated and straight-forward style. Care must be taken to read *and reread* patent applications both in the drafting stage and during procurement to catch problems in definitions – or the *absence* of definitions. See § II-C, *A Frills Free Application And Post-Filing Diligence*. Above all, patent applicants are warned: Use means-plus-function claiming at your own peril! See § II-D, “*Means-Plus-Function*” *Claiming At One’s Own Peril*.

The globalization of prior art and a movement toward European “absolute novelty” has already been felt in Japan where that country has moved away from the practice of exclusion of foreign public use and sale of prior art to enthusiastically and statutorily embrace a more global framework; there, any public disclosure – written or oral – in *any* country may create patent-defeating prior art; even a public internet posting is now statutory prior art in Japan. The United States is now judicially moving in that direction. See § III, *Global Prior Art Trends*. The latest chapter is found in the creation of patent-defeating “prior art” based upon a “publication” which does not have an enabling disclosure, but where there is *foreign* public use or sale that bootstraps the absence of such enablement in the “publication”. It is only a matter of time before a test case reaches the Federal Circuit where the “publication” in question is a simple e-mail exchange to members of the trade that has no hint or suggestion of an enabling disclosure, but where there is a concurrent foreign public use or sale. See § III-A, *Foreign Activity As “Prior Art” (Elsner)*. The move toward *any* public display of an invention as prior art has accelerated as well where one case has found that a simple *display* of a poster may create a

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patent-defeating “publication”. See § III-B, *Eliminating the Indexing Requirement for a “Printed Publication”*.

Another hot area of controversy is the challenge of adapting to the global reality that internet technology may be practiced in part outside the United States but impact domestic commerce. Claims therefore need to be tailored to provide for infringement by a party in the United States. Yet, claims are before the courts where they have been drafted to recite at least one element that is to activity outside the United States. See § IV, *Extraterritorial Acts as Patent Infringement*. Expected before the end of 2004 is a key case in this area, the *Blackberry* case. See § IV-A, *Combination with an Offshore Element (Blackberry)*. A different issue is involved where an American patentee failed to obtain foreign patent coverage but seeks to bootstrap claims to foreign infringement through the special export infringement provision of § 271(f). See § IV-B, *Eolas § 271(f) Offshore Assembly of Patented Combination*.

Perhaps the most important procedural case to be decided in some time relating to practice before the U.S. Patent and Trademark Office (PTO) is the *Star Fruits* case: If the PTO’s position is affirmed, it will provide a Federal Circuit imprimatur of acceptance of the controversial “Rule 105”. This heretofore arcane provisions of the *Rules of Practice in Patent Cases* authorizes the PTO to require “information” from an assignee; this “information” demand may go beyond the persons involved in the procurement of the patent application. The “information” sought may reach issues far outside the scope of “material” information under the now familiar “duty of disclosure”. See § V, *Rule 105 “Information” (Star Fruits)*.

Recently, the Federal Circuit has returned the issue of willfulness awards in patent infringement to the discretion of the trial courts under a “totality of the circumstances” test under *Knorr-Bremse*. See § VI, *Willful Infringement (Knorr-Bremse)*.

Coinventorship continues to be a problem for post-grant attempts by third parties to add an inventor who has not assigned his patent rights to the original assignee. By naming the additional coinventor, the assignee from that coinventor then has a free right to practice the invention independent of the rights of the original patentee or any original “exclusive” licensee. See § VII, *Coinventorship to Exploit Invention (Excechem)*.

For emerging technologies such as nanotechnology as well as the more mature biotechnology and chemical areas, the potential blockbuster case for 2005 may be the Fisher attempt by a biotechnology applicant to have the court find statutory utility under 35 USC § 101 based upon a nebulous statement of usefulness that is contrary to the controlling precedent of the 1967 split opinion in the Kirk case. See § VIII, *Patent-Eligibility “Useful[ness]” (Fisher)*.

Continuing on a back burner for now, but festering and a continued sense of aggravation and uncertainty in the chemical industry, is the special panel-dependent requirement for “possession” of an invention as a species of the “written description” requirement. See § IX, *Possession Requirement for Priority*.

II. CLAIMS PRACTICE UNDER THE 2006 *PHILLIPS* CASE

Patent managers cannot wait until 2006 for the *en banc* opinion in *Phillips* to retool their overall patent procurement regimes to deal with the results of that case; the legal standards that are likely to emerge from *Phillips* are dealt with elsewhere.¹ Much can *already* be seen that must be done and *should* be done “today”.

A. Focus Upon Clear and Literally Infringed Claims

While *Phillips* may be up to eighteen months or so from a decision, what *is* clear already is that the trend of the past several years toward a strict construction of claims against a careless patentee will continue. Thus, even under the mainstream approach of the *Liebel-Flarsheim* case, the best that the patentee can hope for from an infringement claim construction determination is that claims will be given their ordinary meaning *if* they are clearly drafted. But, even under *Liebel-Flarsheim*, clearly worded claim may well be given a diminished scope of if there is an unequivocal argument surrendering a certain scope of protection. Even if the terminology is clear, the use of the wrong two letter preposition – “to” instead of “at” as in *Chef*

¹See Wegner, **Claim Construction** [Foley & Lardner LLP pdf: www.foley.com] (2004)(160 pp.).

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America.² – may lead to a nonsensical interpretation that makes the claim worthless; a simple spelling mistake of one word – “from” instead of “for” – has led to the same result as in *Teknowledge*.³ With the notable exception of one of the twelve members of the court who has shown a continuing attitude of liberality as manifested in *Merck v. Teva*,⁴ the majority of the court – including the mainstream followers of *Liebel-Flarsheim* – follows the strict and unforgiving approach of *Chef America*. If *Liebel-Flarsheim* and *Chef America* represent the center of the court, and *Merck v. Teva* represents a solitary vote at one end of the bell shaped curve, the other end toward an *even stricter* interpretation of patents is represented by the panel opinion in

² *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371 (Fed. Cir. 2004)(Schall, J.). The *specification* disclosed a baking process that included a step of heating dough *at* a temperature of up to 850 F. for a period of at little as 10 seconds to set the batter. But, the *claim* instead stated a limitation of “heating the ***dough *to* a temperature in the range of about 400 F. to 850 F. for a period of time ranging from about 10 seconds to 5 minutes” for the purpose of setting the batter. Obviously, the examples did not disclose creating a dough product at 850 degrees – a temperature so high that a self-cleaning oven (that *incinerates* residue in an oven) is automatically locked at such a high temperature to safeguard the kitchen user; the temperature would transform any bakery product into a charcoal-like product. Yet, the claim called for heating *to* a temperature of 800 degrees, a totally nonsensical result.

³ *Teknowledge Corp. v. Akamai Technologies, Inc.*, 2004 WL 2042864 (N.D.Cal. 2004)(Illston, J.). A typographical error created a nonsensical meaning for an internet business claim where a part of the process concerns “objects fetched *for* [the] clients”; but, the claim calls for “objects fetched *from* [the] clients”. Finding this nonsensical claim construction not infringed – and the claim itself fatally indefinite and thus invalid – the court said it followed “[t]he clear line of Federal Circuit authority dictates that this Court may not re-draft claims to change their ordinary meaning, even if the ordinary meaning produces a nonsensical result.” *Id.*, citing *Chef America Inc.*, 358 F.3d at 1374; *Process Control Corp. v. Hydrexclaim Corp.*, 190 F.3d 1350, 1357 (Fed.Cir.1999). Thus, “even assuming that this was a typographical error, the Court cannot redraft the claim to render it operable. *** The purpose of claim language is to ‘put[] competitors on notice of the scope of the claimed invention’, and to ‘prevent[] unduly burdening competitors who must determine the scope of the claimed invention based on an erroneously drafted claim.’” *Id.*, citing *Hoganas AB v. Dresser Industries, Inc.*, 9 F.3d 948, 951 (Fed.Cir.1993); *Process Control Corp.*, 190 F.3d at 1357.

⁴ *Merck & Co., Inc. v. Teva Pharmaceuticals USA, Inc.*, 347 F.3d 1367 (Fed. Cir. 2003)(Newman, J.)(reading a claim limited to a specific “acid” to reach the chemically absurd result that it is considered to be a “salt” to save the patentee who failed to claim the acid *and derivatives* of the acid).

Phillips. Whereas the mainstream center of the court in *Liebel-Flarsheim* looks to the specification and prosecution history generally only for the contextual setting of claim wording, the vacated majority opinion in *Phillips* looks to the specification as a major and *primary* source for claim construction, even at the expense of the ordinary meaning of the wording of the claims.

The various briefs *amici curiae* in the *Phillips* case embrace either the *Liebel-Flarsheim* middle road while a minority endorses the even stricter view of the *Phillips* panel; but, *nobody* endorses the holistic and unstructured approach of *Merck v. Teva*.

The bottom line for industry is that the harsh limits of claim construction that have existed for the past few years will either continue or be made severe; there is *no* trend toward a liberality to earlier days when the court was far more forgiving of patentee mistakes, omissions – or simply the tunnel vision or lack of 20-20 hindsight appreciation of the need for broader claims.

Industry in the nineties clamored for greater certainty in claim construction as the notice function of patents became of paramount importance. The ultimate reach of the notice function of the mainstream Federal Circuit necessarily is at a price to patentees who do *not* provide fair notice for the invention they disclose but do not properly claim in their patents. The result is a hardball claim construction regime by the mainstream of the Federal Circuit that in its most extreme is perhaps best exemplified in *Chef America*. The patent community has in essence *asked* that the court provide the regime of *Chef America*, and now the flip side of the question is how to adapt patent drafting and prosecution regimes to the realities of such a hardball approach.

B. The Need to *Claim All Disclosed Embodiments*

It is extremely important that when a patent is drafted that the claims are carefully checked against the important *disclosed* embodiments to make sure that the claim wording is broad enough to cover the *disclosed* embodiments.

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Failure to obtain *literal* coverage may mean a failure to obtain *any* coverage at all under the *Johnson & Johnston* “disclosure-dedication” rule;⁵ it holds that “when a patent drafter discloses but declines to claim subject matter ... this action dedicates that unclaimed subject matter to the public. Application of the doctrine of equivalents to recapture subject matter deliberately left unclaimed would ‘conflict with the primacy of the claims in defining the scope of the patentee’s exclusive right.’”⁶

While the patentee in *Johnson & Johnston* had *intentionally* refrained from literally claiming the disclosed equivalent, the court in *Toro* expressly held “that intent is not part of the *Johnson & Johnston* disclosure-dedication analysis”.⁷

The patent drafters of *Merck v. Teva* made a simple mistake that occurred not infrequently in previous years, without penalty. Merck owned a patent to an acid that could be administered in the form of its salts, and specifically disclosed such salts in the specification. The patentee *should* have claimed the specific “acid and pharmaceutically acceptable salts thereof”. Instead, the patentee merely claimed the acid, per se.

The salts are clearly *equivalent* to the acid, so that anyone with even a fundamental knowledge of chemistry would understand that the salts are *disclosed equivalents* and – until recently – should be found to be covered under the doctrine of equivalents. But, with the *en banc* ruling in the *Johnson & Johnson* case,⁸ it is better to *fail* to disclose an unclaimed equivalent because a *disclosed equivalent* is now barred from being considered an infringing equivalent.

⁵ *Toro Co. v. White Consolidated Industries, Inc.*, 2004 WL 2026407 (Fed. Cir. 2004)(Linn, J.).

⁶ *Id.*(quoting *Johnson & Johnston*, 285 F.3d at 1054 (quoting *Sage Prods. Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1424 (Fed.Cir.1997)).

⁷ *Id.* The court also quotes with approval “[t]he language of *Johnson & Johnston* [which] is clear: ‘The patentee’s subjective intent is irrelevant to determining whether unclaimed subject matter has been disclosed and therefore dedicated to the public.’” *Id.*, quoting *Johnson & Johnston*, 285 F.3d at 1053 n. 1.

⁸ *Johnson & Johnston Associates v. R.E. Service Co.*, 285 F.3d 1046 (Fed.Cir.2002) (en banc).

C. A Frills Free Application and Post-Filing Diligence

1. Focus upon the Claim Drafting Exercise

Patent attorneys must concentrate their patent drafting focus upon the claims and providing definitions and other support for the claims.

Often, patent attorneys who are “stumped” by trying to figure out the scope of an invention disclosure will idle their mental gears by describing the prior art known to them, creating problems, “objects” and other background information that has *nothing to do with support for claims under 35 USC § 112, ¶ 1*. This patent garbage has no place in an original provisional (or perhaps other) application. If anything, it can hurt the patentee if the true state of the art later develops to include closer prior art, if an “object” is not met by all aspects of the invention, or a faux statement of criticality is created that can either be used by an opponent to seek to narrow the scope of protection or to create an issue of inequitable conduct. *None of this patent “garbage” need be in an application, even if accurate.*⁹

2. Simple Claim Language

Claim language should be extremely simple. The elements of the claim should be worded as simply as possible. The default should be for an open transition such as “comprising”.

3. A Limited Number of Claims

It is far better to provide five to ten or so crisply worded and clearly defined claims than to have 100 claims that are difficult to piece together and understand.

4. A Simple Summary with Definitions

⁹To be sure, the applicant *must* comply with his duty of disclosure under 37 CFR § 1.56. Yet the duty is *not* to have a general (or other) *characterization* of the prior art but only to *identify* the prior art.

The “Summary” in the specification should start with a *verbatim* copy of “claim 1” (and include other generic descriptions from other claims as well), modified by adding a verb.

Definitions of terms should follow.

It is also important that before the application is filed, after it has had a chance to “sit” for a few days or so, that the claims be reviewed from the perspective of a third party who may not understand the claim language; if there is any ambiguity or term that requires a definition when the claim is read from this perspective, the definition section can be used to fill in such gaps of understanding.

5. Avoiding a Court Imposed Dictionary Definition

It is too early to tell precisely what the Federal Circuit will end up saying in *Phillips* about the role of any particular dictionary in the claim construction analysis, whether it will be a “primary” tool, evidence on a par with “intrinsic” evidence, or merely a secondary tool to help educate the court in the claim construction inquiry.

Yet, the problem of a court relying upon a dictionary is due in large part to the failure of the patent draftsman to have *anticipated* the problem.

Beyond the obvious suggestion that clear and unambiguous language should be used, there are some things that can be done today to avoid whatever problems may continue to be present in the wake of *Phillips*.

a. Definitions in the Patent Specification Itself

The drafter of a patent application who has worked on the document through several drafts, without pause, is perhaps the least likely person to see a defect in claim wording in terms of either ambiguity or lack of a definition.

If the draft of the application can be left to “sit” for several days, then the draftsman can review the case with a fresh approach. Words in the claim that are ambiguous, if not replaced or the claims entirely redrafted, can be

defined in the specification. Here, the patentee acts as his own lexicographer and trumps any dictionary or ordinary meaning to the contrary.

b. Nomination of a Dictionary or Review Article

Often, a patent attorney is working with one particularly useful review article or a certain edition of a particular scientific dictionary. Here, the original specification may include a citation to the particular work as the arbiter of any definitional disputes.

6. Continual Review of the Claim Language During Procurement

a. Review in the First 18 Months from First Filing

One of the best safeguards against mistakes in draftsmanship is that an invention be maintained in secrecy for the full eighteen months from the time of the provisional (or other) application filing and the automatic publication of the patent application. If a mistake in draftsmanship is found that would be fatal *if the patent were granted* and if there is no basis to redraft the claims based upon the original specification, then if there is a secrecy throughout this period it is possible to file a *new* application.¹⁰

It is extremely important within the first year from filing to have a complete and careful review of all aspects of the application because of the need to have a “perfect” patent application to file via the Patent Cooperation Treaty (PCT) for foreign protection (or otherwise via the national route). *Changed* definitions or scope in the PCT application should never be the general rule, because a *changed* definition or scope that is not supported in the original application may stand naked as of the *actual* PCT filing date. Rather, the better approach is to *maintain* all original definitions and have claims keyed to the original definitions (which will then enjoy priority) and to *add* additional definitions and claims (that will stand as of the later date). To only have a *changed* definition and to *delete* definitions from the earlier

¹⁰It is possible to defer the U.S. “new” filing until up to 30 months from the original date because the statutory bar under 35 USC § 102(b) based upon the inventor’s publication takes effect only one year after publication. But, if one waits beyond the publication date, then any chance to use the new patent application for *foreign* purposes will be swept aside, as the publication of the application will create an immediate bar in Europe and Japan where there is no grace period based upon the publication of the patent application by the government (or any grace period at all in Europe).

case as part of the PCT filing *nullifies* the original disclosure for purposes of the PCT application to the extent it is not carried forward into the later case.

b. Review as Part of an Integrated, Global Procurement

The same person who drafted the original application should also prosecute the application *and also the foreign counterpart applications*. Every office action – whether from Alexandria or Munich or Tokyo or elsewhere – may provide a clue as to an ambiguity or a formal problem in the language used, an immediate trigger to study whether there is a fundamental problem in the underlying document to require a refiling of the case (unless a statutory bar already exists) or whether claim wording can be modified to overcome the problem. Only if the same person handles *all* aspects from drafting to domestic and foreign procurement will the opportunity to catch mistakes of this nature be optimized. To the extent that foreign procurement is segregated to a different unit, this then creates a Pandora’s box of problems for inconsistent definitions and arguments as well. Even worse is the segregation of the drafting process to a unit or person who never sees the application after it has been returned to corporate headquarters for prosecution.¹¹

c. Pre-Grant, Post-Allowance Review of the Patent Claims

At some point downstream in the procurement process not later than the review of an application after a Notice of Allowance, at least the independent patent claims should be carefully reviewed from the standpoint of literal coverage and clarity of claim draftsmanship. This should be part of an integrated review to make sure that merely because an embodiment is *disclosed* in the specification, it must also be *literally claimed*. As part of this review, the attorney should play devil’s advocate to find loopholes in the

¹¹ In the era before *Chef America* and *Johnson & Johnston*, a climate of cheap patent procurement developed in some arts where the entire patent drafting process could be shipped out to the Sun Belt to retired patent attorneys on a case by case basis or to firms with large pools of patent agents or draftsmen who never had face to face contact with the inventors; a different pool of generally in house patent lawyers would then pick up a case for the first time to consider the merits after an Examiner’s first action, an entirely different set of eyes out of tune with both the inventor as well as the person at a remote location who drafted the patent application.

coverage for obvious embodiments that are outside the literal coverage range.¹²

d. Post-Grant Review (within Two Years)

Seemingly simple mistakes must be caught early. Minor mistakes in wording can often be corrected without a problem of new matter or “written description” basis in the specification, but if they are proposed in a reissue application more than two years after the grant date they may be barred under 35 USC § 251 that proscribes filing a reissue for a claim broader than found in the original patent.

D. “Means-Plus-Function” Claiming at One’s Own Peril

An anti-“means-plus-function” claiming trend started with the twin *en banc* opinions ten years ago in *Donaldson*¹³ and *Alappat*¹⁴ and continues today through the recent cases of *Gemstar*¹⁵ and *Lighting World*.¹⁶

¹²This does not mean that the case must be refiled and the current case abandoned. To the contrary, the norm today is to file a “Vogel trailer”. See Panel discussion, *The End Of Equivalents? Examining The Fallout From Festo*, 13 Fordham Intell. Prop. Media & Ent. L.J. 727, 742 (2003) (discussing the “Vogel Trailer” and implications of *In re Vogel*, 422 F.2d 438 (C.C.P.A. 1970)). Before the grant of the patent, a continuation application is filed to cover miscellaneous embodiments that could not be fit within the claims as allowed by the Examiner. A terminal disclaimer is required for such a case with overlapping claim coverage.

¹³*In re Donaldson Co.*, 16 F.3d 1189 (Fed. Cir. 1994) (en banc)(Rich, J.).

¹⁴*In re Alappat*, 33 F.3d 1526 (Fed.Cir.1994) (en banc)(Rich, J.).

¹⁵*Gemstar-TV Guide Intern., Inc. v. International Trade Com'n*, 2004 WL 2059279 (Fed.Cir. 2004)(Linn, J.).

¹⁶*Lighting World, Inc. v. Birchwood Lighting, Inc.*, 2004 WL 1949762 (Fed.Cir. 2004)(Bryson, J.).

1. Domestic Pitfalls of Means Claiming

As explained in *ACTV v. Disney*, there are two *separate* hurdles for the patentee to surmount in the use of “means” claims: “In construing a means-plus-function limitation drafted in accordance with § 112, ¶ 6, [first,] the *recited function within that limitation* must first be identified. Then, [second] the written description must be examined to *determine the structure that corresponds* to and performs that function. When identifying the claimed function, this court has noted that § 112, ¶ 6 ‘does not permit limitation of a means-plus-function claim by adopting a function different from that explicitly recited in the claim.’ Correctly identifying the claimed function is critical, because ‘an error in identification of the function can improperly alter the identification of the structure ... corresponding to that function.’”¹⁷

Patentees in the past would often ignore the second requirement to provide structure that corresponds to the function. They do so at their own peril. As pointed out in *Utah Medical*, “[e]ven though paragraph six of section 112 allows the use of means-plus-function language in a claim, ‘one is still subject to the requirement that a claim ‘particularly point out and distinctly claim’ the invention found in the second paragraph of section 112.’ See *In re Donaldson Co.*, 16 F.3d 1189, 1195 (Fed.Cir.1994) [(en banc)]; 35 U.S.C. § 112 (2000). The statute permits claims in the abbreviated language of means-plus-function terminology. With regard to that claim format, this court has stated: ‘Structure disclosed in the specification is ‘corresponding’ structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim. This duty to link or associate structure to function is the quid pro quo for the convenience of employing § 112, ¶ 6.’”¹⁸

¹⁷ *ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1087 (Fed. Cir. 2003)(Linn, J.)(emphasis added)(multiple citations omitted to *Generation II Orthotics, Inc. v. Medical Tech., Inc.*, 263 F.3d 1356, 1363 (Fed.Cir.2001)(Linn, J.)).

¹⁸ *Utah Medical Products, Inc. v. Graphic Controls Corp.*, 350 F.3d 1376, 1384(Fed. Cir. 2003)(Rader, J.)(quoting *B. Braun Med., Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424 (Fed.Cir.1997).

2. The Catch 22 of Global Means Claiming

The patentee who *does* carefully use “means” claiming to fit the nuances and bumps of American patent law *may* find that he has a claim that is *somewhat* narrower than the literal scope of what he would otherwise be entitled to any may possibly avoid the dangers of the claim being too broad – to either read on subject matter that is outside the scope of enablement or which read on an embodiment that either lacks novelty or is obvious. But, even if this goal is achieved, the patentee is on the horns of an international patent dilemma in terms of *foreign* protection. This is because the unilaterally introduced “means” reform of the 1952 Patent Act was done without any thought to *foreign* protection: *No country of the world outside the United States follows the “means” mantra of the American law.*

On the one hand, the patentee *can* if he chooses file a foreign application that is means-free and has new claim wording that is adapted to this reality. But, if he does and if the strict standard for priority under Article 4H of the Paris Convention is not followed, then the foreign claims may stand naked without priority – and hence be anticipated by any public disclosure of the invention even a day before the *actual* filing date in the foreign country. On the other hand, most patentees who do use “means” claiming in their American home country application simply file a counterpart without significant editing: Their claims in foreign countries will thus be too broad and subject to the consequences of such unintended additional breadth.

3. Patentees Choose Means Claiming at their Own Peril

The court has recognized the penalties that a patentee pays for being subject to a “means” interpretation under 35 USC § 112, ¶ 6, and also the uncertainties of claim scope that are created for the public. Thus, the court has adopted a construction of claims to *exclude* a “means” interpretation *unless the major word “means” is used in the claim.*

Thus, on the one hand, a patentee who uses the magic phrase – “means ... for” generally triggers the limitations of 35 USC § 112, ¶ 6:

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“[A] claim limitation that employs the language ‘means ... for’ invokes a rebuttable presumption that § 112, ¶ 6 applies.”¹⁹

But, on the other hand, without this magic language, there is a strong presumption against invocation of ¶ 6. Thus, “a claim term that does not use ‘means’ will trigger the rebuttable presumption that § 112 ¶ 6 does not apply.” *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1369 (Fed.Cir.2002). The use of the term ‘means’ is ‘central to the analysis,’ *Personalized Media Communications, LLC v. Int’l Trade Comm’n*, 161 F.3d 696, 703 (Fed.Cir.1998), because the term ‘means,’ particularly as used in the phrase ‘means for,’ is ‘part of the classic template for functional claim elements,’ *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1427 (Fed.Cir.1997), and has come to be closely associated with means-plus-function claiming.”²⁰

While the presumption against a “means” interpretation is rebuttable, Federal Circuit “cases make clear, however, that the presumption flowing from the absence of the term ‘means’ is a strong one that is not readily overcome.”²¹

¹⁹*Gemstar-TV, supra*(citing *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1369 (Fed.Cir.2002)).

²⁰ *Lighting World, supra* (citing *Apex, Inc. v. Raritan Computer, Inc.*, 325 F.3d 1364, 1373 (Fed. Cir. 2003); *York Prods., Inc. v. Cent. Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1574 (Fed. Cir. 1996)).

²¹ *Lighting World* (citing *Al-Site Corp. v. VSI Int’l, Inc.*, 174 F.3d 1308, 1318-19 (Fed.Cir.1999); *Personalized Media Communications, LLC v. Int’l Trade Comm’n*, 161 F.3d 696, 703-05(Fed.Cir.1998)). As explained in *Lighting World*, “[t]he presumption that a limitation lacking the term ‘means’ is not subject to section 112 ¶ 6 can be overcome if it is demonstrated that ‘the claim term fails to ‘recite sufficiently definite structure’ or else recites ‘function without reciting sufficient structure for performing that function.’” *Id.* (citing *CCS Fitness*, 288 F.3d at 1369, quoting *Watts v. XL Sys., Inc.*, 232 F.3d 877, 880 (Fed.Cir.2000)).

III. GLOBAL PRIOR ART TRENDS

A. Foreign Activity As “Prior Art” (*Elsner*)

In *Elsner*, a panel has further eroded the definition of “prior art” insofar as previously there had been an exclusion of foreign use or sale as patent-defeating prior art.²² The historic proscription on foreign use or sale as “prior art” under American patent law is now one of the unique American peculiarities on the global patent scene, once Japan switched camps to move in the direction of the French absolute novelty standard; this had become the common denominator for Europe in 1978 with the implementation of the Munich Patent Convention as the cornerstone treaty for the European patent system. There has been much discussion whether the United States should unilaterally adopt this system or whether it should hold out for a balanced treaty with other states – using its now unique position on prior art as a “bargaining chip”. See § III-A-1, *One of the Last “Bargaining Chips”*. Yet, without any citation of authority whatsoever from any of the public policy debates in support of such a radical change – or citation of any scholarly or other writing, a panel of the Federal Circuit in *Elsner* has on its own judicially legislated a move to repeal the territoriality limitation. See § III-A-2, *Judicial Legislation from Madison Place*. The court dismisses the retroactivity aspect of its judicial legislation, with the advice – too late for patentees and applicants who have already filed or who are outside the new time bar – that “avoidance of a bar [merely requires] a timely filing at the PTO.” See § III-A-3, *You Should Have Filed Earlier*. Beyond the damage of retroactivity and the necessary destabilization and cries of panel uncertainty and unpredictability that are created by judicial legislation of this nature, one clear point is that when the United States does make a statutory change to inevitably codify the change made in *Elsner*, it will be clear that whatever “bargaining chip” value there had been in the limitation of territoriality, the judiciary unilaterally swept the rug out from under our negotiating teams. See § III-A-4, *March to End Prior Art Territoriality*.

1. One Of The Last “Bargaining Chips”

Use or sale of an invention in Europe or Japan or anywhere outside the United States is not – under most aspects of the statute – patent-defeating

²² In re *Elsner*, ___ F.3d ___ (Fed. Cir. August 16, 2004)(Lourie, J.).

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against an original innovator under most aspects of the patent law.²³ This is due to the territorial limitations of United States patent law which bar grant of a patent if the same invention has been “in public use or on sale in this country[.]”²⁴ Should the United States internationalize its patent law to conform to the goals of the scholar critics and the international patent community that do not have such a geographic limitation? Should the United States do so unilaterally in the interests of the American innovative community? Should the United States hold out for a harmonization treaty using his disparity with international practice as a “bargaining chip” to gain concessions from European and Asian negotiating partners in the international fora?

Scholars have been highly critical of the geographic limitations on prior art including Professors Takenaka²⁵ and Bagley.²⁶ Professor Takenaka presents a comparative trilateral view of the geographic restrictions in American law in the context of patent harmonization and the need for the United States to eliminate the geographic restrictions under 35 USC § 102(b).²⁷ She points out that “[a]n adoption of [the Substantive Patent Law Treaty] will require the United States to remove the geographical

²³There has been some erosion of this principle in the context of limited reliance upon foreign activity under 35 USC § 102(g).

²⁴35 USC § 102(b) bars a patent to an “invention [] patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States[.]” (emphasis added). Additionally, an invention is unpatentable if “the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent” under 35 USC § 102(a) (emphasis added).

²⁵ Toshiko Takenaka, *The Best Patent Practice or Mere Compromise? A Review of the Current Draft of the Substantive Patent Law Treaty and a Proposal for a "First-To-Invent" Exception for Domestic Applicants*, 11 Tex. Intell. Prop. L.J. 259, 305-06 (2003).

²⁶ Margo A. Bagley, *Patently Unconstitutional: The Geographical Limitation on Prior Art in a Small World*, 87 Minn. L. Rev. 697 (2003).

²⁷Takenaka at 305 (discussing the Draft Substantive Patent Law Treaty, World Intellectual Property Organization, Standing Committee on the Law of Patents, 6th Session, Sept. 24, 2001, Article (1) (6th Session)).

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restrictions that limit the definition of prior art.²⁸ She also notes the more sweeping change that even unwritten foreign activities will be prior art.²⁹ Perhaps more importantly, Internet-keyed information is clearly “prior art” under the treaty,³⁰ a point that has already been domestically addressed in Japan with a revision of local patent law five years ago.³¹ Professor Moy states that “particularly modern [authorities] assert the major justification [for the geographic limitation on prior art] to be largely administrative.”³² Professor Moy counts as critics several writers who have criticized the American policy including Professor Bagley,³³ Kadidal³⁴ and Bliss,³⁵ as well

²⁸ Takenaka at 305. She notes that “Article 8(1) defines the prior art as all information that has been made available to the public anywhere in the world in any form. WIPO Draft Substantive Patent Law Treaty (7th Session), *supra* note 93, art. 8(1). SPLT Regulation Rule 8 explains any form that includes oral communication, display, and use of the invention. WIPO Draft Regulations and Practice Guidelines (7th Session), *supra* note 135, rule 8.” *Id.* at 305 n. 372.

²⁹ *Id.* at 305. “The current U.S. system discriminates between written and unwritten information and removes from the prior art unwritten information that is available only in foreign countries. This distinction introduces unnecessary complexity in examination at the USPTO.” *Id.* (footnote deleted).

³⁰*Id.* at 305.

³¹ *Id.* at 305 n. 374 (“Japanese patent law was revised to remove geographical restriction on non-documentary prior art in Article 29, § 1, and made foreign public use and knowledge as the prior art for rejecting an application regarding both novelty and inventive step. Law to Revise Part of Patent Law and Other Industrial Property Laws, Law No. 41 of 1999 (Japan).”).

³² Moy’s Walker on Patents, § 8:192 (2004) (citing William LaMarca, *Reevaluating the Geographical Limitation of 35 U.S.C. § 102(b): The Policies Considered*, 22 U. Dayton L. Rev. 25 (1996)). See also President’s Commission on the Patent System, “To Promote the Progress of the . . . Useful Arts” in *An Age of Exploding Technology* 5 (1966).

³³ Moy’s Walker on Patents, § 8:192 n.1 (2004)(citing Bagley, *supra*).

³⁴ *Id.*, citing Shayana Kadidal, *Subject-Matter Imperialism? Biodiversity, Foreign Prior Art and the Neem Patent Controversy*, 37 IDEA 371 (1997).

³⁵ Daniel H. Bliss, *Bridge Over Troubled Water: Extending the Public Use Bar to Foreign Countries*, 1987 Detroit C. L. Rev. 65 (1987).

as an advocate for elimination of the geographical limitation more than a full generation ago, Donald Chisum.³⁶

2. Judicial Legislation from Madison Place

In an act of judicial legislation, a panel of the Federal Circuit in the *Elsner* has swept the negotiating chips off the table and unilaterally and retroactively started the United States down the slippery slope toward elimination of the geographic limitation on public use or sale. The technical issue before the court was whether a nonenabling prior art reference is an anticipation, which obviously is not the case.³⁷ But, there was foreign activity of use or sale that was admitted for the claimed subject matter, but there was no nexus between the nonenabling prior art reference and that foreign activity. Nevertheless, the court held that since there was a foreign use or sale this meant that one skilled in the art could practice the invention with the basis of this foreign knowledge.

The court at first acknowledged that, “[o]rdinarily, foreign sales of an invention in combination with a publication will not constitute a bar because such a result would circumvent the established rules that neither non-enabling publications nor foreign sales can bar one’s right to a patent.”³⁸ Indeed, that has been the law.

³⁶ Donald S. Chisum, *Foreign Activity: Its Effect on Patentability Under United States Law*, 11 IIC 26 (1980).

³⁷ The facts involved publication of plant breeders rights certificates in *Elsner* and a companion *Zary* case that qualified as 35 USC § 102(b) prior art, but which clearly did not enable practice of the invention under *In re LeGrice*, 301 F.2d 929 (CCPA 1962). Thus, [“appellants ***assert that, because foreign sales are not prior art under the patent statute, they may not be considered within the knowledge of one of skill in the art and cannot be used to enable an otherwise non-enabled publication. They claim that the published [prior art] applications are not enabled because it is impossible to recreate the claimed plants from the textual descriptions alone, and they assert that the published applications are therefore not effective as § 102(b) references.” The court says that “[t]he particular question thus before us is whether evidence of the foreign sale of a claimed reproducible plant variety may enable an otherwise non-enabled printed publication disclosing that plant, thereby creating a § 102(b) bar. On that issue of first impression, we hold in the affirmative.”

³⁸ *Elsner*, ___ F.3d at ___.

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Yet, “[w]hat sets this case apart is that it deals with plant patents[.]”³⁹ Distinguishing the body of law that clearly otherwise bars use of foreign activity as a statutory bar, the court affirmed the foreign activity to create a statutory bar under 35 USC § 102(b), “[b]ecause we perceive a difference between plants and statutorily distinct inventions[;] we disagree with Appellants’ contention that this holding will operate to create a printed publication bar whenever a non-enabling publication and a foreign sale are involved.”⁴⁰

The court cites no Federal Circuit precedent for its distinction of “plants” versus other patents in connection with the scope of prior art under 35 USC § 102(b) and therefore implicitly recognizes that the distinction it has drawn is one without meaning.

Judge Clevenger at oral argument had posed the hypothetical question whether an announcement in a “Finnish” paper about a new “Nokia” product that was not enabling could be converted into a statutory bar against a later filing to that product if the “Nokia” product were available in Finland. Indeed, one can well imagine that there could be countless trade papers, e-mails to the industry, website postings and the like that could be technically a “printed publication” much as the prior art in the *Elsner* case, and yet be just as equally nonenabling. The author of *Elsner* would distinguish Judge Clevenger’s hypothetical case on the basis that *Elsner* claimed a plant. But, there is nothing in 35 USC § 102(b) on which to draw such a distinction.

Elsner is just the latest in a series of cases in which a panel of the court has judicially expanded the scope of prior art that includes *Kathawala*⁴¹ and *OddzOn*.⁴²

³⁹ *Id.*

⁴⁰ *Id.*

⁴¹ *In re Kathawala*, 9 F.3d 942 (Fed. Cir. 1993)(Lourie, J.) (transforming the forfeiture provision for novelty only for what is claimed into a prior art basis for obviousness under 35 USC § 103(a) including the unclaimed teachings of the patent). Cf. Moy’s Walker on Patents § 8:278 (2004)(“The issue under paragraph 102(d) is whether patenting would result in United States industry being unfairly constrained in relation to

3. “You Should have Filed Earlier”

In terms of retroactivity of the law, the court is similarly not bothered: “In any event, the inventor is in control of the activities relating to his invention, and avoidance of a bar is accomplished by making a timely filing at the PTO.” Certainly, this is good prospective advice. To the patent applicant with a case already on file who relied upon the law at the time he filed his case, this is small solace.

4. March to end Prior Art Territoriality

The “bargaining chip” value *vel non* of the unique American viewpoint had in terms of gaining reforms of European and Asian laws as a price for the internationalization of American law has now been largely spent. Surely, the United States Congress will eventually codify the change that has taken place in *Elsner*. Whether it was wise for the court to have judicially jumped the legislative gun will now be for the scholars to debate.

B. Eliminating the Indexing Requirement for a “Printed Publication”.

In *Klopfenstein*, the court faced the question whether the display of a poster describing an invention at a meeting including workers in the art could constitute a “printed publication” for purposes of 35 USC § 102(b), even though the poster was removed after the exhibition and was never indexed.⁴³ The court acknowledged that prior precedent “support[s] the view that distribution and/or indexing is required for something to be considered a ‘printed publication.’⁴⁴

the industry of the foreign country. This requires reference, not to the foreign patent's ability to teach the art, but to its preclusive effect.”).

⁴²*OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396 (Fed. Cir. 1997)(Lourie, J.)(transforming the bar based upon derivation into prior art for obviousness under 35 USC § 103(a)).

⁴³ *In re Klopfenstein*, 380 F.3d 1345, 1348 (Fed. Cir. 2004)(Prost, J.). Insights for this section from George C. Best, Esquire, are acknowledged with appreciation, particularly, the hypothetical question of the “camera cellphone”, discussed *infra* in this section.

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The court explained the prior case law requiring indexing as being keyed to “public accessibility”, which is the core requirement for a “printed publication”. Thus, “throughout our case law, public accessibility has been the criterion by which a prior art reference will be judged for the purposes of § 102(b). Oftentimes courts have found it helpful to rely on distribution and indexing as proxies for public accessibility. But when they have done so, it has not been to the exclusion of all other measures of public accessibility. In other words, distribution and indexing are not the only factors to be considered in a § 102(b) ‘printed publication’ inquiry.”⁴⁵

The court found that indexing is not always required, and in the facts of the case found the necessary public accessibility: “Given that the [poster] was never distributed to the public and was never indexed, we must consider several factors relevant to the facts of this case before determining whether or not it was sufficiently publicly accessible in order to be considered a “printed publication” under § 102(b). These factors aid in resolving whether or not a temporarily displayed reference that was neither distributed nor indexed was nonetheless made sufficiently publicly accessible to count as a “printed publication” under § 102(b). The factors relevant to the facts of this case are: [(1)] the length of time the display was exhibited, [(2)] the expertise of the target audience,[(3)] the existence (or lack thereof) of reasonable expectations that the material displayed would not be copied, and [(4)] the simplicity or ease with which the material displayed could have been copied. Only after considering and balancing these factors can we determine whether or not the Liu reference was sufficiently publicly accessible to be a “printed publication” under § 102(b).”⁴⁶

Today, there is hardly a conference that goes by without a few if not most of the participants having cellphones which, more and more, are camera cellphones. Thus, in the context of the Klopfenstein case, if participants at the conference have camera cellphones then if a participant is

⁴⁴ *Klopfenstein*, 380 F.3d at 1348 (citing *In re Cronyn*, 890 F.2d 1158 (Fed.Cir.1989); *In re Hall*, 781 F.2d 897 (Fed.Cir.1986), *Massachusetts Institute of Technology v. AB Fortia*, 774 F.2d 1104 (Fed.Cir.1985), and *In re Wyer*, 655 F.2d 221 (CCPA 1981)).

⁴⁵ *Klopfenstein*, 380 F.3d at 1350.

⁴⁶ *Id.*

able to view the poster or other display, then if the participant is merely able to snap the shutter of the camera cellphone, this would permit *utter* “simplicity or ease with which the material displayed could have been copied.”⁴⁷

IV. EXTRATERRITORIAL ACTS AS PATENT INFRINGEMENT

Two very high profile internet infringement cases are in the pipeline for ultimate resolution at the Federal Circuit. Expected at any time is a decision by the court in the Blackberry patent litigation.⁴⁸ Not yet docketed at the Federal Circuit is any appeal in the \$ 521 million Eolas case, where the trial court awarded \$ 521 million in damages.⁴⁹ Each case involves an issue of patent extraterritoriality.

A. Combination with an Offshore Element (*Blackberry*)

Internet patent claims are often to a combination of elements, and often where a crucial act takes place outside the United States. The Blackberry patent litigation involves a claim to an internet-based combination (system); a question is whether such a claim is infringed if one of the elements of that combination is offshore (in Canada). A key ground for noninfringement relates to the offshore practice of at least one element of the combination.⁵⁰

⁴⁷ *Klopfenstein*, 380 F.3d at 1350.

⁴⁸ *NTP, Inc. v. Research in Motion, Ltd.*, Federal Circuit App. No. O3-1615 . The appeal was argued more than three months ago (June 9, 2004).

⁴⁹ *Eolas Technologies, Inc. v. Microsoft Corp.*, 274 F.Supp.2d 972 (N.D. Ill. 2003).

⁵⁰ In *Blackberry*, is a claim to an internet-based system or combination infringed if one of the elements of that combination is practiced outside the United States – here, in Canada? *NTP, Inc. v. Research in Motion, Ltd.*, Federal Circuit App. No. O3-1615 (Blackberry Patent Litigation). [Oral argument was held June 7, 2004 before a panel of Michel, Schall, Linn, JJ.].

In *Pellegrini*,⁵¹ the Federal Circuit put another nail in the extraterritoriality coffin against patentees who either failed to properly claim their inventions to provide for a domestic act of infringement – or simply failed to obtain foreign patent protection to cover foreign patent infringement.

B. Eolas § 271(f) Offshore Assembly of Patented Combination

In *Eolas*,⁵² a question raised for a substantial portion of the \$ 500,000,000.00 plus damages at the trial court is whether the export from the United States of a “golden master” disk containing software to be recreated and assembled offshore to there create a patented combination an act of patent infringement?

In both *Eolas* and *Pellegrini* a claimed combination was assembled offshore with a component that was made offshore. The difference between the two cases is that whereas the component in *Pellegrini* was physically made offshore as a “thing”, the component at issue in *Eolas* was software that was made or recreated offshore – but from a “golden master” that was shipped to the offshore site from the United States.

C. The *Pellegrini* Case

1. *Pellegrini* Extraterritoriality

In *Pellegrini* – decided by a panel also including Circuit Judges Rader and Bryson – the court considered that it was “present[ed] [with] the question whether components that are manufactured outside the United States and never physically shipped to or from the United States may nonetheless be ‘supplie[d] or cause[d] to be supplied in or from the United States’ within the meaning of 35 U.S.C. § 271(f)(1) if those components are designed within the United States and the instructions for their manufacture and disposition are transmitted from within the United States.”

⁵¹ *Pellegrini v. Analog Devices, Inc.*, 375 F.3d 1113 (Fed. Cir. 2004)(Lourie, J.).

⁵² *Eolas Technologies, Inc. v. Microsoft Corp.*, 274 F.Supp.2d 972 (N.D. Ill. 2003).

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35 USC § 271(f)(1) imposes patent infringement liability against anyone is liable as an infringer who “supplies or causes to be supplied *** from the United States all or a substantial portion of the components of a patented invention *** in such a manner as to actively induce the combination of such components outside the United States in a manner that would infringe the patent if such combination occurred within the United States ***.” Thus, it is necessary that the actual “components” be physically present and exported from the United States to meet the requirements of the statute.

The court traces the legislative history of 35 USC § 271(f) as having been “enacted in the wake of the United States Supreme Court’s decision in *Deepsouth Packing Co. v. Laitram Corp.*, 406 U.S. 518 (1972), in which the Court acknowledged that unauthorized manufacturers of patented products could avoid liability for infringement under the then-existing law by manufacturing the unassembled components of those products in the United States and then shipping them outside the United States for assembly.”

Citing *Rotec Indus., Inc. v. Mitsubishi Corp.*, 215 F.3d 1246, 1250 n.2 (Fed. Cir. 2000), “Congress enacted § 271(f) in order to close that loophole. The legislative history says that the bill is “to avoid encouraging manufacturers outside the United States” and to “prevent copiers from avoiding U.S. patents by supplying components of a patented product in this country so that the assembly of the components may be completed abroad.” (citation omitted).

No component in *Pellegrini*, however, is actually made in the United States, although the direction to make the components abroad (in Ireland and Taiwan) came entirely from the United States. (The patentee alleges that the accused infringer] is incorporated in the United States and has executive, marketing, and product line responsibilities for ADMC products; that [it] conceived and designed the ADMC products; that [it] is the exclusive manufacturer of ADMC products; that [it] makes all development and production decisions for ADMC products; that [it] is responsible for the fabrication, assembly, and testing of ADMC products; that ADMC uses, subcontracts with, and pays others for the express purpose of the proprietary fabrication, assembly, and testing of ADMC products; that [it]’s ADMC products are capable of motor control; that [it] sets budgetary pricing and

receives payment for ADMC products sold worldwide; and that [it] receives purchase orders from and invoices customers worldwide for ADMC products and increases production levels for ADMC products in response to those purchase orders.”)

The accused infringer defends simply on the basis that the actually components themselves were not made in the United States. According to the accused infringer in *Pellegrini*, these facts satisfy the ‘supplies’ requirement of § 271(f)(1) because they evidence acts of infringement occurring inside the United States.

2. The *Pellegrini* Affirmance of Non-Infringement

Affirming summary judgment of noninfringement, the Court notes that “the U.S. Supreme Court explained nearly 150 years ago in *Brown v. Duchesne*, 60 U.S. (19 How.) 183 (1857), that the U.S. patent laws ‘do not, and were not intended to, operate beyond the limits of the United States.’ *Id.* at 195; see also *Int’l Rectifier Corp. v. Samsung Elecs. Co.*, 361 F.3d 1355, 1360 (Fed. Cir. 2004).”

The court implicitly criticizes the patentee for having failed to seek foreign patent protection. Indeed, the accused infringer “points out that [the patentee] made a deliberate decision not to seek foreign patent protection for the invention ***, and he is bound by the obvious and foreseeable consequences of that decision.”

The court denied the patentee’s appeal: “First, § 271(f) is clear on its face. It applies only where components of a patent invention are physically present in the United States and then either sold or exported ‘in such a manner as to actively induce the combination of such components outside the United States in a manner that would infringe the patent if such combination occurred within the United States.’ Secondly, as [the patentee] himself recognizes, we explained in *North American Phillips v. American Vending Sales, Inc.*, 35 F.3d 1576 (Fed. Cir. 1994), that ‘the ‘tort’ of patent infringement occurs where the offending act [making, using, selling, offering for sale, or importing] is committed and not where the injury is felt.’ *Id.* at 1579. There is no dispute that the ADMC chips are not made, used, sold, or offered for sale in the United States. The plain language of

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§ 271(f)(1) focuses on the location of the accused components, not the accused infringer.” (emphasis added).

The patentee points to the fact that the business activity and direction of all assembly comes from the United States. Denying relief, the court notes that “the language of [35 USC] § 271(f) clearly contemplates that there must be an intervening sale or exportation; there can be no liability under § 271(f)(1) unless components are shipped from the United States for assembly.” *** [A]lthough [the accused infringer] may be giving instructions from the United States that cause the components of the patented invention to be supplied, it is undisputed that those components are not being supplied in or from the United States.” (emphasis added).

Sales and offers of sales may well have been made in the United States. Denying infringement liability, the court notes that “there is no evidence of record that any of that manufacturing occurs in the United States or that Analog offers to sell those products in the United States. As the Supreme Court explained in *Dowagiac Mfg. Co. v. Minn. Moline Plow Co.*, 235 U.S. 641 (1915), ‘the right conferred by a patent under our law is confined to the United States and its territories, and infringement of this right cannot be predicated on acts wholly done in a foreign country.’ *Id.* at 650.”

D. Increased Focus on Patents that Pinpoint American Activity

Perhaps the most comprehensive consideration of extraterritorial issues in the context of computer software and internet infringement took place there years ago in Tokyo at the 2001 SOFTIC conference that included judges, practitioners and scholars from several countries including the United States.⁵³ As considered at that conference, great care was cautioned to provide claims that could be infringed under American law – or to provide claims in foreign territories that could be locally enforced. In terms of invention residing in a combination of elements where one element, e.g., a server, could be offshore, caution is required to claim an element that is practiced in the United States – which represents a potentially fatal problem

⁵³ See Harold C. Wegner, E-Business Patent Infringement: Quest For A Single Station Direct Infringement Claim Model, SOFTIC 2001 Symposium, November 20-21, 2001, Tokyo Prince Hotel, Tokyo, Japan [www.softic.or.jp/symposium/open_materials/10th/en/wegner-en.pdf].

for combination claims in the Blackberry case. Or, in the case of offshore assembly, claims that are infringed under foreign law are important.

Whatever arguments patentees may have had before, their cases have grown weaker in the wake of both the Pellegrini case, as well as one of the recent cases the court cites in Pellegrini, the case of *Int'l Rectifier Corp. v. Samsung Elecs. Co.*, 361 F.3d 1355 (Fed. Cir. 2004)(Linn, J.).

E. Focus on Specific, Domestically Infringed Claims

As pointed out by Judge Linn in *International Rectifier*, “it is well known that United States patent laws ‘do not, and were not intended to, operate beyond the limits of the United States.’ *Brown v. Duchesne*, 60 U.S. 183, 195, 19 How. 183 (1856); see also *Deepsouth Packing Co. v. Laitram Corp.*, 406 U.S. 518 (1972) (confirming that the patent system ‘makes no claim to extraterritorial effect,’ *id.* at 531, and that ‘it is not an infringement to make or use a patented product outside of the United States,’ *id.* at 527); *Rotec Indus., Inc. v. Mitsubishi Corp.*, 215 F.3d 1246, 1251 (Fed.Cir.2000) (holding that ‘extraterritorial activities, however, are irrelevant to the case before us, because the right conferred by a patent under our law is confined to the United States and its territories, and infringement of this right cannot be predicated on acts wholly done in a foreign country.’).”⁵⁴

V. RULE 105 “INFORMATION” (STAR FRUITS)

Under regulations that are just now being tested in the courts, the examiner has been given the powerful tool of “Rule 105”, a mechanism that permits the examiner to ask an extremely wide range of questions to obtain “information” for the patent examination process.⁵⁵ This scope of Rule 105 goes far beyond the “duty of disclosure” under Rule 56, extending to “any assignee” and covering information beyond materiality.

⁵⁴ *International Rectifier*, 361 F.3d at 1360 (internal citations omitted by the court).

⁵⁵ 37 CFR § 1.105(a)(1), Requirements for information. (“[T]he examiner *** may require the submission [from the inventor or attorney] or any assignee[] of such information as may be reasonably necessary to properly examine [the application].”).

A. The *Star Fruits* Test Case

The *Star Fruits* case that is now awaiting a decision from the Federal Circuit.⁵⁶ It is the first test case that may very well confirm the authority of the PTO to issue such “information” requirements under Rule 105.

In *Star Fruits*, just as in the *Elsner* case, the patent applicant sought plant patent protection for an invention that had been the subject of a printed publication – a foreign plant certificate – published more than one year before the application was filed. Because the plant certificate was clearly not enabling – as in *Elsner* – the examiner made an “information” requirement under Rule 105. Unlike *Elsner*, where the patent applicant complied with the request and challenged the rejection on the merits (albeit unsuccessfully), in *Star Fruits* the applicant refused to comply with the “information” requirement. From a holding of abandonment that was sustained by the Alexandria Division of the Eastern District of Virginia, the *Star Fruits* case was recently argued before the court and is now awaiting decision.

B. Foreign Use and Sale “Information” Requirements

The implications of *Star Fruits* in the first instance will focus upon requirements for information about foreign uses or sales by the inventors (or others) in connection with nonenabling publications – the factual setting both of *Star Fruits* as well as the substantively far more important *Elsner* case.

It may now be expected that skimpy “printed publications” relating to foreign use or sale of an invention will now be bootstrapped into major reasons for concern. At the oral arguments in *Elsner* and the companion *Zary* cases,⁵⁷ Judge Clevenger posed the question whether an affirmance in these cases would result in early foreign newspaper advertisements of new

⁵⁶ On September 9, 2004, the Federal Circuit (Newman, Clevenger, Dyk), heard the oral argument in *Star Fruits S.N.C. v. United States*, App. No. 04-1160, opinion below, 280 F.Supp.2d 512 (E.D.Va. 2003). Factually, the case started out in common with *In re Elsner*, ___ F.3d ___, 2004 WL 1811350 (Fed. Cir. 2004)(Lourie, J.).

⁵⁷ *Zary* and *Elsner* were argued sequentially before the same panel and consolidated into the single opinion now known as *In re Elsner*.

products (“printed publications”) would now create a statutory bar problem for applicants if there were an enabling foreign use or sale.⁵⁸ One can also imagine a brief, cursory explanation of a product on a website where that website posting is nonenabling yet still a “printed publication”: Is the existence of a foreign use or sale contemporaneous with such a website posting a patent-defeating event under 35 USC § 102(b).

C. A Far Broader Sweep than the Duty of Disclosure

1. Information from “the Assignee”

The Rule 105 sweep includes “the assignee”, which is far broader than the duty of disclosure under Rule 56. Thus, under Rule 105, “[i]n the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under [37 CFR] § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter[.]”⁵⁹

The broader sweep of Rule 105 versus the narrower scope of Rule 56 is justified in one simple statement that “[t]he scope of [Rule 105] is extended to any assignee because the information required may be known to some members of the assignee even if not known by the inventors.”⁶⁰

One can imagine a multinational conglomerate with several hundred patent professionals scattered over venues in several continents who collectively prepare and file several thousand patent applications per year and further unrelated research units in this multinational conglomerate who have absolutely nothing to do with the patenting process or any knowledge of patent law, yet “the assignee” sweep would literally require an inquiry of

⁵⁸Judge Cleverger raised the hypothetical question that “Nokia” places an add in a *Finish* paper about a new product and describes how to purchase that product in Finland. The question is whether this would create a patent-defeating anticipation under 35 USC § 102(b) under *Elsner*.

⁵⁹37 CFR § 1.105(a)(1); emphasis added.

⁶⁰MPEP § 704.10, Requirements for Information ([R-2] 8th ed. 2003).

perhaps thousands of persons with no knowledge of the application who are outside the sweep of the Rule 56 duty of disclosure.

Thus, in contrast, there is no duty of disclosure under Rule 56 that runs to “the assignee” apart from those with knowledge of the application. Thus, the Rule 56 duty of disclosure is limited to those persons with actual involvement or knowledge of the procurement process including inventors,⁶¹ the legal representatives who “prepare[] or prosecute[] the application”,⁶² and all others “substantively involved” with the procurement.⁶³

The Examiner also is given the authority to demand the patent attorney identify the field of search, or, according to the rule itself, “what was searched”.⁶⁴

2. Information Beyond Rule 56(a) “Material[ity]”

The scope of Rule 105 is far broader than merely permitting a requirement for information about foreign uses and sales, or information “material” to patentability.⁶⁵

The “information” obtainable under Rule 105 represents a true Pandora’s box for the average patent practitioner, as the “information” is extremely wide-ranging and far afield from the traditional duty of disclosure to provide the most relevant prior art or related information.

⁶¹37 CFR § 1.56(c)(1).

⁶²37 CFR § 1.56(c)(2).

⁶³37 CFR § 1.56(c)(3)(“Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.”).

⁶⁴37 CFR § 1.105(a)(1)(ii).

⁶⁵37 CFR §. 1.56(a) provides “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[.]”. (emphasis added).

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Rule 105 goes into the thought process of the patent attorney in his drafting of the patent application. For example, if the applicant has been faced with a patent infringement question and the problem of designing around a third party's patent, the Examiner has the right under Rule 105 to inquire about this thought process and to identify the third party's patent⁶⁶, even though it may be clearly irrelevant to the patent examination process.⁶⁷ While a patent attorney should cite a prior art patent used in this thought process or not where it is known that it is material to patentability, to have a rule that permits a sweep into the thought process to retrieve information that goes beyond material information is a step beyond what is relevant to the examination process.

If the Examiner is new to a field and does not know how to search the prior art on electronic databases, instead of making an inquiry of a senior examiner or other library resources within the PTO, he may instead now choose to question the patent attorney as to how he had the application searched. The examiner may even ask what literature or other documents of the inventor exist and also what documents were used in the drafting of the application. All such documents may be required to be produced.⁶⁸

⁶⁶37 CFR § 1.105(a)(1)(v) (“Information used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.”).

⁶⁷It is often the case that there will be a broad generic formula in a chemical case that may raise an infringement question but is so broad that it raises neither a question of anticipation nor obviousness of a species thereunder. See *In re Baird*, 1994. *In re Baird*, 16 F.3d 380, 382 (Fed. Cir. 1994)(Lourie, J.) (“The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious. *In re Jones*, 958 F.2d 347, 350 (Fed.Cir.1992)[(Rich, J.)](rejecting Commissioner's argument that ‘regardless [] how broad, a disclosure of a chemical genus renders obvious any species that happens to fall within it’).”)

⁶⁸37 CFR § 1.105(a)(1)(iii) (“Related information: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.”); 37 CFR § 1.105(a)(1)(iv) (“Information used to draft application: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.”).

VI. WILLFUL INFRINGEMENT (*KNORR-BREMSE*)

Willful infringement under 35 USC § 284 has survived the en banc clarification in *Knorr-Bremse* that returns the inquiry to a heavily factually based totality of the circumstances test for the sound discretion of the trial judge.

While many in the patent community thought that the Underwater Devices requirement of an affirmative duty to avoid infringement of a patent would be thrown out, the court voted 10-1 to maintain the standard that “where, as here, a potential infringer has actual notice of another's patent rights, he has an affirmative duty to exercise due care to determine whether or not he is infringing.”⁶⁹ All other aspects of the case were without dissent of any kind.⁷⁰

It may now be expected that there will be relatively few holdings of willful infringement at the trial level, and that the court will generally honor the determination of a trial judge who refrains from reaching a holding of willfulness in this highly fact-dependent inquiry.

A. “Totality of the Circumstances” Test for Willfulness

In essence, the court turned the clock back a generation to the pre-Markey era of the regional circuits where willfulness was judged by a “totality of the circumstances” test. En banc the court has now cited to *Read v. Portec*⁷¹ and stated that “[d]etermination of willfulness is made on consideration of the totality of the circumstances[.]”.⁷² This portion of the opinion was for a unanimous court.⁷³

⁶⁹ *Knorr-Bremse*, __ F.3d at __ (quoting *Underwater Devices, Inc. v. Morrison-Knudsen Co.*, 717 F.2d 1380, 1389 (Fed.Cir.1983)). Circuit Judge Dyk dissented on this issue.

⁷⁰The twelfth member of the court who did not sit for this case was Circuit Judge Michel.

⁷¹ *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 826-27 (Fed. Cir. 1992)(Nies, C.J.).

⁷² *Knorr-Bremse*, __ F.3d at __.

⁷³Circuit Judge Michel did not participate in any aspect of the opinion.

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There are nine *Read v. Portec* factors which now should be at the center of attention for any willfulness inquiry:

“(1) [W]hether the infringer deliberately copied the ideas or design of another[.]”⁷⁴

“(2) [W]hether the infringer, when he knew of the other's patent protection, investigated the scope of the patent and formed a good-faith belief that it was invalid or that it was not infringed[.]”⁷⁵; and

“(3) [T]he infringer's behavior as a party to the litigation.”⁷⁶

“(4) Defendant's size and financial condition.”⁷⁷

“(5) Closeness of the case.”⁷⁸

⁷⁴ *Read v. Portec*, 970 F.2d at 827. A footnote adds that “[i]deas and ‘design’ would encompass, for example, copying the commercial embodiment, not merely the elements of a patent claim.”

⁷⁵Id.

⁷⁶Id.

⁷⁷ Id. Additionally, the court includes the following citations: “*St. Regis Paper Co. v. Winchester Carton Corp.*, 410 F.Supp. 1304, 1309 (D.Mass.1976) (‘[D]ouble damages [appropriate]. If defendant were the giant and plaintiff the small independent, I would make it treble....’); *Bott v. Four Star Corp.*, 229 USPQ 241, 254 (E.D.Mich.1985) (‘[a] threefold increase in damages would severely affect [defendant's] financial condition.’), vacated and remanded for clarification of damage amount, 807, F.2d 1567 (Fed.Cir.1986); *Lightwave Technologies, Inc. v. Corning Glass Works*, 19 USPQ2d 1838, 1849 (S.D.N.Y.1991) (Defendant ‘can withstand some increase in damages, but not treble damages.’); *Kori Corp. v. Wilco Marsh Buggies and Draglines, Inc.*, 561 F.Supp. 512, 533 (E.D.La.1982) (Exemplary damages ‘should not unduly prejudice the defendants’ non-infringing business.’), *aff’d*, 761 F.2d 649 (Fed.Cir.), *cert. denied*, 474 U.S. 902 (1985).”

The “closeness of the case” issue is related to Question (4) of the en banc briefing order concerning whether there is a substantial defense presented to the infringement charge. This is considered *infra* in more detail.

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“(6) Duration of defendant's misconduct.”⁷⁹

“(7) Remedial action by the defendant.”⁸⁰

“(8) Defendant's motivation for harm.”⁸¹

“(9) Whether defendant attempted to conceal its misconduct.”⁸²

B. No Adverse Inference

The court unanimously overruled earlier precedent to the extent that it may have held that there is an adverse inference where an opinion of counsel

⁷⁸ *Read v. Portec*, 970 F.2d at 827. The court additionally provides the following citation and analysis: “*Modine Mfg. Co. v. The Allen Group*, 917 F.2d at 543 (No abuse of discretion to award no enhanced damages on the ground that willfulness was ‘sufficiently close on the evidence.’); *Crucible, Inc. v. Stora Kopparbergs Bergslags AB*, 701 F.Supp. 1157, 1164 (W.D.Pa.1988) (‘[B]ecause the court still considers the [willfulness] question to be a close one ... double, and not treble damages are appropriate.’).

⁷⁹ *Id.* The court also adds: “*Bott v. Four Star Corp.*, 229 USPQ 241, 255 (E.D.Mich.1985) (For sales prior to the appellate court's affirmance of the liability judgment, damages increased by 20%; for sales after the affirmance, damages doubled.), *vacated and remanded for clarification of damage amount*, 807 F.2d 1567, 1 USPQ2d 1210 (Fed.Cir.1986).”

⁸⁰ *Id.* The court adds: “*Intra Corp. v. Hamar Laser Instruments, Inc.*, 662 F.Supp. 1420, 1439 (E.D.Mich.1987) (Damages only doubled because defendant ‘voluntarily ceased manufacture and sale of infringing systems during the pendency of this litigation....’), *aff'd without opinion*, 862 F.2d 320 (Fed.Cir.1988), *cert. denied*, 490 U.S. 1021 (1989).”

⁸¹ *Id.* The court adds: “*American Safety Table Co. v. Schreiber*, 415 F.2d 373, 379 (2d Cir.1969) (‘[D]efendants' infringing acts, although deliberate and with knowledge of plaintiff's rights, could not be termed pernicious due to prevailing ‘economic pressure in the form of customer dissatisfaction.’ ‘), *cert. denied*, 396 U.S. 1038 (1970).”

⁸² *Id.* The court adds: “*Russell Box Co. v. Grant Paper Box Co.*, 203 F.2d 177, 183 (1st Cir.) (Enhanced damages supported in part by findings ‘that the defendant had failed to preserve its records and had failed to cooperate as it should at the trial on the issue of damages.’), *cert. denied*, 346 U.S. 821 (1953).”

concerning infringement is not produced at trial. Instead, the court “h[e]ld that that no adverse inference that an opinion of counsel was or would have been unfavorable flows from an alleged infringer's failure to obtain or produce an exculpatory opinion of counsel.”

The court thus unanimously said “no” to the first question it had set forth in its briefing order: “When the attorney-client privilege and/or work-product privilege is invoked by a defendant in an infringement suit, is it appropriate for the trier of fact to draw an adverse inference with respect to willful infringement?”

The court also unanimously answered “no” to the second question: “When the defendant had not obtained legal advice, is it appropriate to draw an adverse inference with respect to willful infringement?”

C. Substantial Defense as a Basis to Avoid Willfulness

1. Substantial Defense is not a Per Se Basis to Avoid Willfulness

The court said that a substantial defense to an infringement charge should be considered by the court as one factor to consider, but answered “no” to a per se rule that was raised as the fourth question in the briefing order: “Should the existence of a substantial defense to infringement be sufficient to defeat liability for willful infringement even if no legal advice has been secured?”

2. Consideration as part of the *Read v. Portec* Factors

The court said that the case law “includes this factor with others to be considered among the totality of circumstances, stressing the ‘theme of whether a prudent person would have sound reason to believe that the patent was not infringed or was invalid or unenforceable, and would be so held if litigated,’ *SRI Int’l, Inc. v. Advanced Tech. Labs. Inc.*, 127 F.3d 1462, 1465 (Fed. Cir. 1997). However, precedent also authorizes the trier of fact to accord each factor the weight warranted by its strength in the particular case. We deem this approach preferable to abstracting any factor for per se treatment, for this greater flexibility enables the trier of fact to fit the decision to all of the circumstances. We thus decline to adopt a per se

rule.”⁸³ This may be considered one aspect of the fifth factor under the totality of the circumstances test of *Read v. Portec* is the “[c]looseness of the case.”⁸⁴

D. “An Affirmative Duty of Due Care”

The court said that “there continues to be ‘an affirmative duty of due care to avoid infringement of the known patent rights of others[.]’”⁸⁵

Yet, while there is a continued affirmative duty of due care, nevertheless “the failure to obtain an exculpatory opinion of counsel shall no longer provide an adverse inference or evidentiary presumption that such an opinion would have been unfavorable.”⁸⁶

VII. COINVENTORSHIP TO EXPLOIT INVENTION (*EXECHEM*)

The *Xechem* case⁸⁷ is a controversial panel opinion which is the latest chapter in the saga of unnamed coinventors being added or sought to be added to a patent to gain a right to exploit a patent, notwithstanding the exclusive rights of the patentee or an apparently exclusive licensee.

Historically, every claim in a patent required an inventive contribution of every inventor named on the patent. Yet, under the current and more liberal statute that was introduced twenty years ago⁸⁸ today a single person who has made an inventive contribution to any claim may be added to the patent as a coinventor. Thus, “[i]nventors may apply for a patent jointly

⁸³ *Knorr-Bremse*, ___ F.3d at ___.

⁸⁴ *Read v. Portec*, 970 F.2d at 827.

⁸⁵ *Knorr-Bremse*, ___ F.3d at ___ (quoting *L.A. Gear Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1127 (Fed. Cir. 1993)).

⁸⁶ *Knorr-Bremse*, ___ F.3d at ___.

⁸⁷ *Xechem Int'l, Inc. v. University of Texas M.D. Anderson Cancer Ctr.*, ___ F.3d ___, 2004 WL 1932653 (Fed. Cir. 2004)(Newman, J.).

⁸⁸ 35 USC § 116, amended, Nov. 8, 1984, Pub.L. 98-622, Title I, § 104(a), 98 Stat. 3384.

even though *** each did not make a contribution to the subject matter of every claim of the patent.”⁸⁹

A. The Seemingly Late Filing of a Coinventorship Suit

To the extent that “claim 102” recites a trivial modification of a generic concept where “claim 102” was the coinvention of a minor research employee or collaborator who was not named as an inventor and did not have an assignment obligation to the patentee, adding that coinventor of “claim 102” then permits that coinventor to transfer the right to make, use and sell all subject matter of all claims to a competitor of the patentee. This is because of the unique American default rule that gives this right to each coinventor.⁹⁰

The unique American rule has led to litigation to add an unnamed coinventor even many years after the patent has been granted, because if the move is successful, that coinventor may grant a license or transfer his right to anyone, even though the patentee may have been relying upon its exclusive rights under the patent, or there may be an exclusive license to a third party under the patent. The coinventor’s right trumps the exclusivity of the “exclusive” licensee.

B. Right to Seek Correction Years Later

In one case, the court permitted suit to correct inventorship several years after the omitted inventor knew or should have known of the possible error in inventorship nomination.⁹¹ A lenient rule for correction of inventorship for granted patents was announced.⁹²

⁸⁹Id., 35 USC § 116(3).

⁹⁰35 USC § 262 (“In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use, offer to sell, or sell the patented invention within the United States, or import the patented invention into the United States, *without the consent of and without accounting to the other owners.*”) (emphasis added).

⁹¹*Stark v. Advanced Magnetics, Inc.*, 29 F.3d 1570, 1573 (Fed. Cir. 1994)(Newman, J.)(The court reversed a claim of late filing where “[t]he district court granted summary judgment to AMI with respect to correction of inventorship. The [district] court held that Dr. Stark knew or should have known of the existence of the [] patent when he received the Annual Report in early 1989, and that he had not acted

C. State University Immunity from Federal Court Correction

Absent consent of all parties, the sole avenue for the correction of inventorship of a patent is through a Federal Court action. Yet, as held in the *Xechem* case, for an invention where the patentee is a state university, it can defend itself from correction in a federal court by pleading sovereign immunity.⁹³

D. State Court Resolution of Inventorship Changes in Patents

In bizarre dictum, while a panel has denied a right to correct inventorship of a state owned patent in *Xechem*, it has also provided obiter dictum that suggests that a state court may provide a remedy. The court suggests that a state court may have jurisdiction to resolve the inventorship dispute. But, by statute, only a federal court may order correction of an error under 35 USC § 256, second ¶ ("The error *** shall not invalidate the patent *** if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly.").

diligently in seeking the correction. The summary judgment was applied to all six patents. The state law tort claims were dismissed as barred by the three-year statute of limitations. The contract and unfair trade practice claims were also dismissed, the court ruling that Dr. Stark had one year from the date of dismissal to bring these claims in state court.”).

⁹² “[35 USC §] 256 does not limit the time during which inventorship can be corrected. *Advanced Cardiovascular Systems, Inc. v. SciMed Life Systems, Inc.*, 988 F.2d 1157, 1162 (Fed.Cir.1993) (‘Since the defense of patent invalidity based on incorrect inventorship can be raised at any time, correction of inventorship should be similarly available at any time.’) Section 256 thus serves the public policy of preserving property rights from avoidable forfeiture. See *Henderson v. Carbondale Coal & Coke Co.*, 140 U.S. 25, 33 (1891) (‘[F]orfeitures are never favored. Equity always leans against them, and only decrees in their favor when there is full, clear and strict proof of a legal right thereto.’)” *Id.*

⁹³ *Xechem* (citing *Florida Prepaid Postsecondary Education Expense Board v. College Savings Bank*, 527 U.S. 627 (1999); *College Savings Bank v. Florida Prepaid Postsecondary Education Expense Board*, 527 U.S. 666 (1999)).

It has heretofore been crystal clear that only a federal court can order correction of an inventorship under 35 USC § 256.⁹⁴

VIII. PATENT-ELIGIBILITY “USEFUL[NESS]” (*FISHER*)

The Fisher appeal that is expected to be argued and decided in 2005⁹⁵ reopens a controversy dating back to a controversial 1967 split opinion of a predecessor court in Kirk: Does patent-eligibility reside in a chemical or biotechnology invention to a new entity where that new entity has no established or purported specific utility? The case has the potential of being either the single most important pharmaceutical patent case in recent years – or a yawn, as the court is presented with the challenge of review of debates over patent-eligibility of pharmaceutically uncharacterized new bio and chemical entities.

A. The 1991 NIH Attempt to Patent Thousands of ESTs.

Thousands of mostly uncharacterized ESTs were the subject of a controversial 1991 patent application filed by the National Institutes of Health (NIH). In 1991, it filed a single patent application for literally thousands of ESTs.⁹⁶

⁹⁴The PTO, alone, is without authority to correct inventorship where the State hides behind its sovereign immunity and refuses to join in a PTO correction action: “[T]he Director may, on application of all the parties and assignees, *** issue a certificate correcting [the inventorship] error.” 35 USC § 256, ¶ 1; emphasis added.

⁹⁵ *In re Fisher*, Fed. Cir. App. No. O4-1465, docketed July 14, 2004, proceeding below, *Ex parte Fisher*, App. No. 2002-2046 (PTO Bd. App. & Int. March 31, 2004)(Adams, APJ).

⁹⁶Stephen B. Maebius, *Novel DNA Sequences and the Utility Requirement: The Human Genome Initiative*, 74 J. Pat. & Trademark Off. Soc’y 651 n.2 (1992)(citing *Geneticists and Religious Leaders Ponder Implications of the Human Genome Project*, Genetic Engineering News, April 15, 1992, p. 29). See also Leora Ben-Ami, Patricia A. Carson & Kurt M. Rogers, *Biotech Patent Law Developments* in PLI's Fifth Annual Institute for Intellectual Property Law 555, 558 (PLI Order No. G0-007N 1999)(footnotes omitted)(“ In 1991 and 1992 the NIH provoked a blizzard of criticism from scientists when it filed patent applications covering thousands of ESTs. At that time, the patentability of ESTs seemed dubious on several grounds, not the least of which was the requirement that the invention must have utility. The leading case concerning utility,

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It was pointed out by a biotechnology patent examiner that the NIH itself had admitted that "[a]bout 83 % [of the claimed ESTs] are unrelated to any previously known sequences, as determined by homology comparisons to nucleotide databases."⁹⁷ Patent eligibility of a naked EST, without more, was widely questioned. It was widely thought that an EST, alone, did not have statutory utility under 35 USC § 101.⁹⁸

Three years later, Professors Eisenberg and Merges – two of the leading patent academics of the day – published a famous open letter criticizing patenting of the ESTs.⁹⁹ They also challenged the patent-eligibility of such ESTs.

Contemporaneous with the NIH attempt to patent ESTs, a Ph.D. scientist-lawyer expressed doubt about any degree of predictability for EST

Brenner v. Manson[, 383 U.S. 519 (1966)], suggested that ESTs would not be patentable. In that case, the Supreme Court held that a process useful solely as a step in further research failed to meet the statutory requirement of being ‘useful’ and a process or product with no known use, or that is useful only in the sense that it may be the subject of scientific research, is not patentable. Opponents of EST patents argued that ESTs, with no known function or associated protein, had no use beyond being the subject of scientific research.”).

⁹⁷ Stephen B. Maebius, *Novel DNA Sequences and the Utility Requirement: The Human Genome Initiative*, 74 J. Pat. & Trademark Off. Soc’y 651, 653 (1992)(quoting the NIH patent application itself). Mr. Maebius resigned from the PTO in 1991, before the authorship of this paper.

⁹⁸ Leora Ben-Ami, Patricia A. Carson & Kurt M. Rogers, *Biotech Patent Law Developments* in PLI's Fifth Annual Institute for Intellectual Property Law 555, 558 (PLI Order No. G0-007N 1999)(“ The [Human Genome Project or] HGP exploits the fact that in a given genome, only a small percentage of the DNA present actually codes for proteins. Under this approach random sequences of the coding DNA are ‘fished out’ often without any knowledge of what the DNA encodes. The DNA sequences produced by this technique are referred to as expressed sequence tags or ‘ESTs.’ Although ESTs may be useful as probes in locating particular genes, *they may not identify the function of the gene or any associated protein.*”)(emphasis added).

⁹⁹ Rebecca S. Eisenberg & Robert P. Merges, *Opinion Letter as to the Patentability of Certain Inventions Associated with the Identification of Partial cDNA Sequences*, 23 AIPLA Q.J. 1 (1995).

utility based upon the state of the art at that time,¹⁰⁰ thus supporting the view of critics of the NIH patent application that it should be denied on the basis that the subject matter did not meet the patent-eligibility test of 35 USC § 101.

B. The Emerging Face of Predictable Functionality

Stripping away the policy arguments of Profs. Eisenberg and Merges and focusing solely on the patent-eligibility issue of 35 USC § 101, the PTO's then-leading legal expert in biotechnology, Associate Solicitor Chambers, foresaw a different picture. He saw the day when ESTs would be able to pass patent muster with sufficient utility. Nearly ten years ago he said that "[i]f the patent applicant provide[s] precise chromosomal map locations for each of the EST fragments, sufficient utility for 35 U.S.C. § 101 might be present. Numerous scientific articles have stated that precise marker locations are very important to the Human Genome Project ('HGP') (citing Mark D. Adams et al., *Complementary DNA Sequencing: Expressed Sequence Tags and Human Genome Project*, 252 *SCIENCE* 1651 (1991); Maynard Olson et al., *A Common Language for Physical Mapping of the Human Genome*, 245 *SCIENCE* 1434 (1989)). This project represents a 3-5

¹⁰⁰ Lorance L. Greenlee, *Biotechnology Patent Law: Perspective Of The First Seventeen Years, Prospective On The Next Seventeen Years*, 68 *Denv. U. L. Rev.* 127 (1991). Greenlee has a Ph.D. from Duke University, 1962 and was a Research Fellow at both Duke University and the California Institute of Technology. He stated in the same year as the NIH filing on ESTs that, "[a]t present, models of protein structure are not sufficiently developed to predict accurately three-dimensional configurations of a given sequence. The functional properties of a given amino acid sequence are almost never predictable from sequence alone. One can analyze sequence data in probability terms. Homologous sequences are more likely to have a common function than unrelated sequences. However, a single amino acid change at a critical locus can nullify the function, or can result in creating a new function. It is possible, through trial and error mapping experiments, to locate regions of sequence which tolerate a relatively wide range of sequence variation without affecting function. Through comparison of common functions in different sequences, certain sequence motifs are identifiable as associated with specific attributes. However, the level of predictability afforded by such information is rather crude, analogous to being able to identify which end of an automobile is the front." Greenlee, 68 *Denv. U. L. Rev.* at 136 n.48; emphasis added.

billion dollar market. Any element that is fundamental to a \$3 billion market has utility.”¹⁰¹

Indeed, at the relatively primitive time in the evolution of the science in 1995, Chambers noted that “[t]he use of EST markers as probes for genetic lesions represents a [] [statutory] utility. Many diseases have been localized to very precise cytological locations on the chromosome. Providing researchers with a large battery of probes permits them to rapidly choose probes that correlate closely with the disease locus, thereby speeding the development of diagnostic probes. It is faster and easier to create a diagnostic probe when the molecular biology profession is armed with an arsenal of molecular entities having known genomic locations.”¹⁰² Chambers also points out that “[p]resently, [in 1995,] researchers can identify a disease by looking at a large family and determining what part of what chromosome is in common for all individuals with the disease. This research gives a chromosomal ‘MAP’ position. However, a MAP position is determined either cytologically (i.e., with a microscope) or by an analysis of crossover frequency (i.e., pedigree analysis). MAP positions are many orders of magnitude more gross than a molecular location. Thus, there is no way to tell what DNA or gene is at a precise MAP location on the chromosome. In contrast, the EST markers can identify the precise location of their corresponding DNAs. There is a natural fit between the cytological and molecular types of research because each needs the other: a perfect fit for cross licensing. If we patent ESTs, then researchers can simply go to the [patent] databases *** and determine if any potential markers are known.”¹⁰³

C. Sequence Motifs and Computer Biochemistry

It is now more than ten years since the NIH filings with naked utility disclosures for the functionally unidentified ESTs. Now, much has changed. Patentees are now routinely defining their ESTs in terms of their “structure motifs”, the unique amino acid patterns within genes that are seen to provide a specific biological function. Where there are multiple structure motifs

¹⁰¹ Scott A. Chambers, *Comments on the Patentability of Certain Inventions Associated with the Identification of Partial cDNA Sequences*, 23 AIPLA Q.J. 53, 55-56 (1995).

¹⁰² Chambers, 23 AIPLA Q.J. at 56.

¹⁰³ Id.

present that can be linked to a specific utility, the utility of an otherwise uncharacterized EST may very well have a highly predictable utility. One expert opines that “[i]n the not too distant future, it is possible to imagine a time in which virtually all of discovery research is conducted [via computers], with traditional laboratory research following only to confirm results predicted from electronic analysis. Today, it is already possible for scientists with access to public human genome data to use existing EST datasets and commercially available gene prediction software to electronically identify genes within the genome. The putative function of the genes to identified can be assigned using homology analysis, which compares the structure of known genes to that of the gene(s) being studied, and confirms the existence of common patterns, or ‘motifs’, that are thought to be associated with specific classes of genes. *** Data *** can be used to identify genes that play roles in disease processes, providing additional assistance in identifying genes that may be particularly suitable as drug targets, ‘markers’, or diagnostic tests[] for a particular disease. *** As these information technologies mature, it is easy to imagine a time, in the near future, when the first actual ‘wet lab’ experimentation with a gene, protein, antibody, or small molecule drug will occur when it is time to confirm the predicted results using an assay or drug screen.”¹⁰⁴

Attwood discussed a database, “PRINTS”, that comprises “protein ‘fingerprints’ that can be used to diagnose family relationships in newly-determined sequences (e.g., from genome projects). Fingerprints exploit groups of conserved [sequence] motifs within sequence alignments to build characteristic family signatures; an uncharacterized sequence that matches all motifs can thus be readily assigned to a particular family. The diagnostic power of fingerprints, and the extent of documentation manually attached to each database entry, has lent PRINTS a significant role in protein sequence analysis and, ultimately, genome annotation.”¹⁰⁵

¹⁰⁴ Lee Bendekgey, *The Transition to E-Research in Pharmaceutical Research and Development: Public Policy Implications*, p. viii, in A1 Workshop Participants and Contributed Papers in Managing IPR in a knowledge-based economy – Bioinformatics and the influence of Public Policy, September 11-12, 2001, Brussels, [<https://europa.eu.int/comm/research/era/pdf/ipr-bioinformatics-workshopreport.pdf>].

¹⁰⁵ Teresa K. Attwood, *Mobile, metamorphosing academic databases – capturing IP on the move*, p. iv, in A1 Workshop Participants and Contributed Papers in Managing IPR in a knowledge-based economy – Bioinformatics and the influence of Public Policy,

The use of sequence motifs in patents has now become a widespread practice, with at least 1500 references to a “sequence motif” having been used in United States patents and patent applications published within the past year.¹⁰⁶ Thus, if there are several common sequence motifs in a particular DNA vis a vis several known DNA sequences having a particular utility there are varying degrees of predictability that the new fragment will share the same utility in common. Computer banks of information already have the existing knowledge in an electronic storeroom that makes the determination of the common utility a matter of simple determination.

D. Three Levels of EST Utility

1. No Specific Utility (NIH)

As in both the case of the NIH patent application and the Fisher case, there remain some patent applicants who are seeking protection on naked ESTs with no particularized utility statement. This is a classic Larson case in biotechnology clothing and hardly distinguished from the bulk of the ESTs which were the subject of the 1991 NIH application.

2. Prophetic Specific Utility (Sequence Motifs)

Yet, the state of the art has progressed geometrically to provide a much higher degree of predictability of specific utility, thanks to the collection of vast amounts of information and the creation of databases with sequence motifs that fingerprint the functional identity of the new ESTs. Thus, there have been more than 1500 American patents and patent applications published in just the past year that refer to a “sequence motif”. To the extent that the state of the art has progressed to the particular point in a particular art that a specific utility can be fairly and reasonably predicted, then, here, prophetic statements of utility are equally applicable for ESTs as they are for classic organic molecules.

September 11-12, 2001, Brussels, [<https://europa.eu.int/comm/research/era/pdf/ipr-bioinformatics-workshopreport.pdf>].

¹⁰⁶ A search on September 17, 2004, on Lexis database for all domestic patents (and patent applications) for the past year having the term “sequence motif” yielded 1513 hits, of which 29 used the terminology in at least one claim.

Thus, if there are several common sequence motifs in a particular DNA vis a vis several known DNA sequences having a particular utility, there are varying degrees of predictability that the new fragment will share the same utility in common. Computer banks of information already have the existing knowledge in an electronic storeroom that makes the determination of the common utility a matter of simple determination.

3. “Wet Lab” Confirmation of Utility

The third level of confirmation of through the “wet lab” tests that will commence only after there has been a clear conception of the invention, as one expert “imagine[s] a time *** when the first actual ‘wet lab’ experimentation with a gene, protein, antibody, or small molecule drug will occur when it is time to confirm the predicted results using an assay or drug screen.”¹⁰⁷

E. Case Law Evolution Since the 1967 Kirk Opinion

1. The Kirk 3-2 CCPA Holding

Since the controversial split opinion in Kirk,¹⁰⁸ there has been a controversial United States policy that a new entity must have a disclosure of a specific utility to meet the patent-eligibility requirements of 35 USC § 101 as to provision of a “useful” invention. And, a fortiori, absent such a disclosure, there is no disclosure of “how to *** use” the invention under 35 USC § 112, ¶ 1.

2. Modern Pronouncements from the Court

The Kirk case was distinguished in the *Brana* case, whilst the court noted the lack of specificity of the teaching of utility as a basis for denial in Kirk.¹⁰⁹

¹⁰⁷Bendekgey, *supra*.

¹⁰⁸ *In re Kirk*, 376 F.2d 936 (CCPA 1967)(Worley, C.J.).

¹⁰⁹ *In re Brana*, 51 F.3d 1560, 1565 (Fed. Cir. 1995)(Plager, J.) (“In *Kirk* applicants claimed a new class of steroid compounds. One of the alleged utilities

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Under classic principles of patent law, any statutory utility suffices to meet the requirement for patent-eligibility: “The threshold of [statutory] utility [under 35 USC § 101] is not high: An invention is ‘useful’ under section 101 if it is capable of providing some identifiable benefit.”¹¹⁰

As pointed out by Judge Clevenger, “[f]or over 200 years, the concept of utility has occupied a central role in our patent system. See *Brenner v. Manson*, 383 U.S. 519, 529 (1966). Indeed, ‘[t]he basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility.’ *Id.* at 534. Consequently, it is well established that a patent may not be granted to an invention unless substantial or practical utility for the invention has been discovered and disclosed.”¹¹¹

In the context of a reduction to practice, the court has emphasized that any activity may establish patent-eligibility: “In the pharmaceutical arts, our court has long held that practical utility may be shown by adequate evidence of any pharmacological activity.”¹¹² The court quotes with approval from the *Campbell v. Wettstein* case in the context of establishment of a reduction to practice: “[U]nder well-established precedent, evidence establishing substantial utility for any purpose is sufficient to show reduction to

disclosed in the specification was that these compounds possessed ‘high biological activity.’ [*In re Kirk*, 376 F.2d 936, 938 (CCPA 1967).] The specification, however, failed to disclose which biological properties made the compounds useful. Moreover, the court found that known specific uses of similar compounds did not cure this defect since there was no disclosure in the specification that the properties of the claimed compounds were the same as those of the known similar compounds. *Id.* at 942.”)

¹¹⁰ *Juicy Whip, Inc. v. Orange Bang, Inc.*, 185 F.3d 1364, 1366 (Fed. Cir. 1999)(Bryson, J.)(citing *Brenner v. Manson*, 383 U.S. 519, 534 (1966); *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571 (Fed.Cir.1992)(“To violate § 101 the claimed device must be totally incapable of achieving a useful result”); *Fuller v. Berger*, 120 F. 274, 275 (7th Cir.1903) (test for utility is whether invention “is incapable of serving any beneficial end”)).

¹¹¹ *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1563 (Fed. Cir. 1995)(Clevenger, J.)(citing *Cross v. Iizuka*, 753 F.2d 1040, 1044 (Fed.Cir.1985)).

¹¹² *Fujikawa*, 93 F.3d at 1564 (citing *Nelson v. Bowler*, 626 F.2d 853, 856 (CCPA 1980); *In re Krimmel*, 292 F.2d 948, 952-53 (CCPA 1961)).

practice.”¹¹³ Thus, “[s]uch activity constitutes a practical utility because ‘[i]t is inherently faster and easier to combat illnesses and alleviate symptoms when the medical profession is armed with an arsenal of chemicals having known pharmacological activities. Since it is crucial to provide researchers with an incentive to disclose pharmacological activities in as many compounds as possible, we conclude that adequate proof of any such activity constitutes a showing of practical utility.’”¹¹⁴

F. “Bet the Company” *Fisher* Test Case

The utility statement for modern EST patent applications is today often quite complete insofar as the sequence motifs that are disclosed are the basis for a reasonable prediction of a statutory utility that does meet the Kirk standard. Yet, the Fisher case is a throwback to the earliest EST applications.

If Fisher is to be a frontal assault on the Kirk standard, it represents a difficult test case vis a vis one with a better utility disclosure. To the extent that the Fisher case is affirmed, this could well translate into a much more difficult time for patent applicants seeking any kind of EST patent.

IX. POSSESSION REQUIREMENT FOR PRIORITY

A. Necessity of a Common Standard of Disclosure for Priority

Priority for an invention based upon an earlier application requires that the same invention be disclosed in that earlier application, generally, in a manner to permit the invention to be reproduced by the art-skilled worker.

It is extremely important that there be a harmonious standard for what constitutes the same invention for purposes of priority because the bulk of patent filings around the world claim priority based upon an earlier “home country” or other first filing. If that home country has a *different* standard,

¹¹³ Id., quoting *Campbell v. Wettstein*, 476 F.2d 642, 646-47 (CCPA 1973).

¹¹⁴ Id., quoting *Nelson*, 626 F.2d at 856; see also *Krimmel*, 292 F.2d at 952-53.

then this upsets the international patent regime no matter whether that standard is higher or lower.

If the standard for disclosure is *higher* in the home country, then as a general rule the original filing will be delayed somewhat as the application will more likely be filed when the disclosure requirements of the home country are met: While this does not hurt the applicant in the later country from a standpoint of meeting the disclosure requirements, if the priority date is deferred this may mean that an intervening third party may obtain superior rights.¹¹⁵

If the standard for disclosure is *lower* in the home country than in the United States, then a perfectly proper United States application that is filed based upon a perfectly proper foreign application disclosing the same invention may be denied priority. This is precisely the problem that was dealt with thirty years ago in the notorious *Kawai* case where a Japanese applicant filed a United States application fully meeting the statutory requirements of 35 USC § 112, ¶ 1, based upon a Japanese application fully meeting the statutory requirements of Japanese law at the time. But, under the internationally notorious *Kawai*, priority was denied.¹¹⁶ *Kawai* sparked retribution in the Japanese courts to deny priority in Japan for a Japanese application fully meeting Japanese disclosure requirements where the home country priority application met the local country law requirements but not a unique Japanese requirement.¹¹⁷

B. The Unique American Parent “Possession” Rule

¹¹⁵Under the patent laws of most countries, if a third party files an application in any country that *discloses* the same invention with a priority date under the Paris Convention before a first-to-invent but second-to-file competitor, then (absent derivation), the publication of the third party’s application constitutes a novelty-defeating absolute bar against the first-to-invent but second-to-file competitor. (The United States does not follow the international rule on this point of law; instead, under the notorious *Hilmer* rule, it denies a patent-defeating date as of the Paris Convention priority date. *In re Hilmer*, 359 F.2d 859 (CCPA 1966).)

¹¹⁶*Kawai v. Metlesics*, 480 F.2d 880 (CCPA 1973).

¹¹⁷T. Aoyama, *The Hoechst Case - A New Kawai*, 59 J. PAT. OFF. SOC'Y 263 (1977); Lutz Walter, *Comment to the Hoechst Case*, 8 INT'L REV. INDUS. PROP. AND COPYRIGHT L. 566, 570 (1977).

As with all other countries, the United States has historically had a requirement that for priority the same invention must be disclosed in the original, priority application (and in a manner to permit an art-skilled worker to carry out the invention). But, exceptionally, renegade panels of the Federal Circuit have imposed an *additional* requirement for priority: There must also be “possession” of the full scope of the generic invention in the priority application *even if there is an identical disclosure of a generic invention in the priority application*.

The Federal Circuit has refused as an *en banc* court to consider this issue; most recently, the court failed by a 7-5 vote to take the matter *en banc* in the notorious *Rochester* case.¹¹⁸ This domestic law and the merits of the issues are considered exhaustively elsewhere.¹¹⁹

C. American Violation of the Paris Convention

The American priority requirement keyed to *Rochester* “possession” goes beyond the maximum requirement for priority that is stated in the Paris Convention: “Priority [for] elements of the invention [requires] that the [priority] application documents as a whole specifically disclose such elements.”¹²⁰ Thus, provided an invention is “specifically disclose[d]” in the parent priority application, this is the end of the inquiry. The *Rochester* possession requirement goes beyond this treaty requirement and creates the very disharmony amongst the patent laws that the Paris Convention proscribes.

¹¹⁸ *Univ. of Rochester v. G.D. Searle & Co.*, 375 F.3d 1303 (Fed. Cir. 2004)(denying *en banc* reh’g), *panel opinion*, 358 F.3d 916 (Fed. Cir. 2004)(Lourie, J.).

¹¹⁹ See Stephen B. Maebius, Sean A. Passino & Harold C. Wegner, “*Possession*” *Beyond Statutory Enablement, The Remains of the Day after Rochester*, Foley & Lardner IP Roundtable, July 21, 2004, Osaka, Japan, http://www.foley.com/files/tbl_s88EventMaterials/FileUpload587/106/Rochester.pdf.

¹²⁰ Paris Convention, Art. 4H (Stockholm Rev. 1967)(“Priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims formulated in the application in the country of origin, provided that the application documents as a whole specifically disclose such elements.”)

Endnote: Biographical Information

Harold C. Wegner is the former Director of the Intellectual Property Law Program and Professor of Law at the George Washington University Law School. He commenced his academic career in 1974 as a *Wissenschaftliche Mitarbeiter* at what is today the Max-Planck-Institut für Geistiges Eigentum; he then moved from Munich to Kyoto as a *Kenshuin* at the Kyoto University Law Faculty under Professor Zentaro Kitagawa; he then assisted in the creation of the Kyoto Comparative Law Center. More recently, he has been a Visiting Professor at Tokyo University. His continued affiliation with George Washington includes unique comparative patent law courses on Japan (Spring 2005) and China (Spring 2006).

In 1987 he helped created the only American private nonprofit research organization accredited by WIPO as a patent NGO, the Center for Advanced Studies and Research in Intellectual Property (CASRIP), on which he served as a founding director. In 1992, he founded the Dean Dinwoodey Center for Intellectual Property Studies; in 1994, continuing as Director of the Dinwoodey Center, he was a founder of the Asia Pacific Legal Institute which sent several delegations of scholars, judges and practitioners to Beijing, Shanghai and other cities in the Peoples Republic of China. He has been invited on U.S. State Department missions to San Jose (Costa Rica), Malaysia, Singapore, Hong Kong and Taipei.

Professor Wegner's career commenced in 1965 as a Patent Examiner; his principal patent practice has centered on a boutique practice, most recently the firm founded in 1980 as Wegner & Bretschneider; in 1994, his practice was merged into Foley & Lardner LLP, where Prof. Wegner has recently helped open a Tokyo Office and now heads the firm's China Initiative.

Professor Wegner currently is Inn Counselor of the Giles Sutherland Rich American Inn of Court and a founding Fellow of the American Intellectual Property Law Association.

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