

Rules Implemented from 7/1/2003 to 1/20/2004 and Corresponding Treaty and Statutory Changes, and Some Judicial Developments on Claim Construction Arlington VA January, 2004

- Richard A. Neifeld, Ph.D. Patent Attorney
- Neifeld IP Law, PC - www.Neifeld.com
- Rneifeld@Neifeld.com

OUTLINE

- I. Introduction - Basis for the Rule Changes, Include treaty and statutory revisions
- II. Notice by Notice Review of Rules Changed from 7/1/2003 to 1/20/2004, and Review of Corresponding Treaty and Statutory Changes
- Practice Tips

INTRODUCTION - Basis for the Rule Changes

- During the period 7/1/2003 to 1/20/2004 the USPTO published 16 separate notices relating to patents for either Final Rules, waivers of rules, or special notices including:
- 68 FR 38611; 68 FR 48286; 68 FR 59881; 68 FR 67805; 68 FR 69881; 68 FR 70996; 8/5/2003 OG Notice entitled “Information Disclosure Statements ...”; 8/5/2003 OG Notice entitled “Revision of Patent Fees...”; 9/16/2003 OG Notice entitled “Customer Number Bar Code...”; 9/23/2003 OG Notice entitled “Amendments Permitted ...”; 12/23/2003 OG Notice entitled “Notice of Plan to Cease Providing Copies...”; 12/30/2003 OG Notice entitled “Notice Concerning European Patent Office...”; Pre OG Notices signed 10/1/2003 entitled “Centralized Delivery ... Correspondence”; waiver notice signed 12/18/2003 entitled “Copies of File Contents...”; Flyer entitled “Revised Amendment Practice ...” for mailing with all office actions dated 6/30/03.

INTRODUCTION - Basis for the Rule Changes

1. REVIEW OF CHANGES TO U.S. AMENDMENT PRACTICE – SLIDE 5
2. PCT RULE CHANGES AND PCT AMENDMENT ISSUES – SLIDES 9
3. US RULE CHANGES RELATED TO PCT RULE CHANGES, INCLUDING THE INVENTOR *AUTHORIZATION* PROBLEM - SLIDE 24
4. INTER PARTES REEXAM – REVIEW AND RULE CHANGES – 49
5. MISCELLANEOUS NOTICES – SLIDE 73
6. SOME JUDICIAL DEVELOPMENTS – SLIDE 78

68 FR 38611 – COVERED IN PRIOR POWER POINT NOW POSTED ON THE WEB SITE

- SEE http://www.neifeld.com/NewRulesPublished_030630_files/frame.htm (* see slides 36, 37, and 42)
- Dramatic changes to U.S. amendment practice
- Impact on incorporation by reference to priority application

68 FR 38611 – COVERED IN PRIOR POWER POINT NOW POSTED ON THE WEB SITE

- Advise - Incorporate priority application by reference
- Advise – Provide the U.S. attorney with a text editable copy of the specification and claims to facilitate amendments

68 FR 48286 - Reorganization of Correspondence And Other General Provisions

- **EFFECTIVE DATE:** September 12, 2003
- Primarily removes all references to trademarks from rules for patents.
- Adds corresponding rules to 37 CFR 2 for trademarks.

68 FR 48286 Reorganization of Correspondence And Other General Provisions

- Adding a new § 2.191 (trademarks) - Business with the Office must be transacted in writing, and that no attention will be paid to any alleged oral promise, stipulation, or understanding.
- NOTE: Keep in mind identical language exists in 1.2 (patents). **NEVER** rely upon verbal communication from PTO personnel.

68 FR 59881 - January 2004 Revision in Response to Changes in PCT Procedure

- **EFFECTIVE DATE:** January 1, 2004.
- “amending the rules of practice to conform them to certain amendments made to the Regulations under the Patent Cooperation Treaty (PCT) that will take effect on January 1, 2004.”

68 FR 59881 - January 2004 Revision in Response to Changes in PCT Procedure

- **Purpose – Conform U.S. rules to recent changes in PCT procedure that provide “(1) ... enhanced international search and preliminary examination system; (2) simplify the PCT by changing the concept and operation of the designation system and the fee system; and (3) simplify signature and other filing requirements.”**

Changes in PCT Regulations

- **PCT changes Enabled by PCT Articles 17 and 34:**
- **Article 17 – Procedure Before the International Searching Authority**
- **Article 34 - Procedure Before the International Preliminary Examining Authority**
- **Art. 17 and 34 *specify that* search and examination procedure “shall be governed by the provisions of this Treaty, the Regulations, and the agreement which the International Bureau shall conclude, subject to this Treaty and the Regulations, with the said Authority.”**

Changes in PCT Regulations

- **AUTOMATIC INCLUSIVE DESIGNATIONS**
- **PCT Rule 4.9 Designation of States; Kinds of Protection; National and Regional Patents**
- **“(a) The filing of a request shall constitute: ... [automatic designation of all States, for all types of protection, and for both regional and national patents]”**
- **RULE 4.9 subject to any conflict with existing national law (as specified in PCT art. 45(2))**

Changes in PCT Regulations

- **PCT Rule 26.2bis – Formal Requirements of the Request**
- ***Request need only be signed by one applicant***
- **Request need only provide residence address and nationality of one applicant**
- **NOTE: *beware or adverse consequences in U.S. national stage – see below***

Changes in PCT Regulations

- **PCT Rule 51bis.1(a) – National Requirements**
- **National offices may require inter alia inventorship information and signatures in the national stage proceedings**

Changes in PCT Regulations

- **PCT Rule 90.4(d) and (e) – Powers of Attorney Waivers**
- **“any receiving Office, any International Searching Authority, any International Preliminary Examining Authority and the International Bureau may waive the requirement under paragraph (b) that a separate power of attorney be submitted....”**
- **Effect - Representative specified in a Request or a Demand will be recognized**

Changes in PCT Regulations

- **PCT Rule 90.4(e) – Where Powers of Attorney Are Required**
- **A separate signed POA is required for:**
- **Withdrawal of application**
- **Withdrawal of priority claim**
- **Withdrawal of Demand**
- **Withdrawal of Designation**
- **Withdrawal of Election**

Changes in PCT Regulations

- **PCT Rule 43bis – IRS/WO**
- The **ISA** shall prepare a *written opinion* on novelty, inventive step, and industrial applicability when it establishes the ISR
- The written opinion shall become the written opinion of the IPEA if a Demand is filed, unless:
- The IPER opts out of PCT Rule 43bis
- The applicant amends the claims
- See Rule 66.1bis “Written Opinion of the International Searching Authority”

PCT Amendments Issues

- Should the applicant amend prior to national stage proceedings? - FACTORS
- Differences in claim format between USPTO and EPO
- Jepson claim construction
- Different law: 35 USC 102(e)/103; problem solution versus obviousness; utility
- *Amendments in the PCT likely will limit scope of claim as construed in the U.S. courts. Cf. Microsoft v. MultiTech (Fed. Cir. 2/3/2004) on narrowing trend.*

PCT Amendments Issues

- Impact on doctrine of Equivalents
- Current U.S. judicial test on equivalents for amended claims is “foreseeability.” Festo (2002)
- Microsoft v. MultiTech (Fed. Cir. 2/3/2004) on narrowing trend indicates that it is more likely that amendments in *the international stage* will limit doctrine of equivalents under the current judicial “foreseeability” standard or any subsequent judicial standard

Changes in PCT Regulations

- **PCT Rules 44bis and 44ter –**
- The ISA/WO shall be kept confidential until 30 months from the PCT application's priority date
- If no Demand is filed, the IB shall define the WO to be the IPRP and send the IPRP to the designated offices

Changes in PCT Regulations

- **PCT Rule 54bis - Time Limit for Making a Demand**
- A Demand must be made prior to:
 - (i) three months from the date of transmittal to the applicant of the ISR and WO; or
 - (ii) 22 months from the priority date.
- **PCT Rule 53.7 *Election of States***
- “The filing of a demand shall constitute the election of all Contracting States which are designated and are bound by Chapter II of the Treaty.”

Changes in PCT Regulations

- NOTE – PCT Article 22 “**holdout countries**” still exist. For those countries, the Demand must still be filed by 19 months from the priority date to be entitled to enter their national stage proceedings up to 30 months from the priority date.
- “**Holdout country**” – A country that has not acceded to the change in Article 22 entitling a PCT applicant to enter the national stage from PCT chapter I up to 30 months from the priority date.

Changes in PCT Regulations

- **Docketing Reminders for Demands:**
- 18 months for holdout countries
- Later of 22 months or 3 months from receipt of ISR/WO for all other countries

Revision of US Rules Relating to PCT Applications

1.14(g)(1)(ii)

**Amended to preclude the ISA/WO from being
available to the public**

Revision of *US Rules* Relating to PCT Applications

US rule 1.413(c) – US ISA

**The PTO's ISA duties are expanded to include
preparing the ISA/WO**



Revision of US Rules Relating to PCT Applications

US rule 1.421(b):

“for the purposes of the designation of the United States, an international application ... will be accepted ... for the national stage **only if filed, by *the inventor....***”?!!!!!!!!!!!!!!!!!!!!



Revision of US Rules Relating to PCT Applications

Treaties are not self implementing in the U.S.

Laws in the U.S. must be passed or changed to implement treaties

No *law* was changed to implement the change in PCT rule 26.2bis



Revision of US Rules Relating to PCT Applications

35 USC 373 (law) requires the USPTO to reject national stage processing of any PCT application not filed by a person authorized under U.S. law to file a U.S. national application



Revision of US Rules Relating to PCT Applications

US NATIONAL LAW:

35 USC 115 defines the *applicant* to mean the *inventor*

35 USC 111 requires *authorization* from the applicant/inventors to prepare and file an application for their invention

Revision of US Rules Relating to PCT Applications

- **35 USC 373 Improper applicant.**
- An international application designating the United States, **shall not be accepted by the Patent and Trademark Office for the national stage** if it was filed by anyone not qualified **under chapter 11 of this title** to be an applicant for the purpose of filing a national application in the United States.
- **Chapter 11 sections:**
- 35 USC 115 **defines** "applicant" to be the inventor, stating "Oath of applicant. The applicant shall make oath that he believes himself to be the original and first inventor of [the invention]..."
- 35 USC 111(a)(1) makes it clear that preparation and filing of a patent application must be authorized by the inventor/applicant, stating that "Written application. An application for patent shall be ***made, or authorized to be made***, by the inventor...."



Revision of US Rules Relating to PCT Applications

Therefore, 35 USC 373 requires:

- (1) ***authorization*** from the inventors
- (2) ***when*** filing their PCT application
- (3) in order for the USPTO to subsequently accept the application for U.S. national stage processing



Revision of US Rules Relating to PCT Applications

- **Consequences of lack of Power from Inventor:**
- No evidence of “authorization from the inventor”
- Possible/probable lack of actual “authorization”
- Will the USPTO enforce 35 USC 373?
- Will the courts enforce 35 USC 373 against US issued PCT patents?
- Consider: hostile inventor; inventor unavailable; inventor witness issues, quality and cost of proofs

Revision of US Rules Relating to PCT Applications

1.421(g):

“ Requests for withdrawals ... shall be made in accordance with PCT Rule 90*bis* and must be signed by all applicants [or by an attorney having a] ... separate power of attorney from the [sic; all] applicants “

NOTE: Withdrawal arises wrt dropping priority claims

Revision of US Rules Relating to PCT Applications

Rule 1.432 - Default Designations

- “The filing of an international application request shall constitute ... designation of all Contracting States[, request] ... for the grant of every kind of protection[, and a request] ... for the grant of a regional patent and also, unless PCT Article 45(2) applies, a national patent.”

Revision of US Rules Relating to PCT Applications

Rule 1.434(d) – The request

- “(d) For the purposes of the designation of the United States of America, an international application shall include: (1) The name of the inventor; and (2) A reference to any prior-filed ... application ... if the benefit of the filing date for the prior-filed application is to be claimed. “
- Does not require “signature of the inventor” as in the prior version of rule 434(d).

Revision of US Rules Relating to PCT Applications

Rule 1.434(e) - An international application may also include in the Request an Inventors declaration (PCT Rule 4.17(iv) – The USPTO will accept this declaration.

NOTE: The USPTO has informally indicated to me that the US/RO will also retain a conventional 35 USC 111 combined inventor's declaration and power of attorney for use in a subsequent U.S. national stage proceeding

Revision of US Rules Relating to PCT Applications

- Neifeld forms text editable and downloadable from www.Neifeld.com:
- German and English Language Inventors Declaration and Power of Attorney:
http://www.neifeld.com/web_download/NeifeldForms/GermanDecPOA.pdf
- Assignment of Application:
- http://www.neifeld.com/web_download/NeifeldForms/Assignment_040206.pdf

Revision of US Rules Relating to PCT Applications

- English: http://www.neifeld.com/web_download/NeifeldForms/EnglishDecPOA.pdf
- Chinese: http://www.neifeld.com/web_download/NeifeldForms/ChineseDecPOA.pdf
- French : http://www.neifeld.com/web_download/NeifeldForms/FrenchDecPOA.pdf
- Italian : http://www.neifeld.com/web_download/NeifeldForms/ItalianDecPOA.pdf
- JP: http://www.neifeld.com/web_download/NeifeldForms/JapaneseDecPOA.pdf
- KR: http://www.neifeld.com/web_download/NeifeldForms/KoreanDecPOA.pdf
- RU: http://www.neifeld.com/web_download/NeifeldForms/RussianDecPOA.pdf
- ES: http://www.neifeld.com/web_download/NeifeldForms/SpanishDecPOA.pdf
- SE: http://www.neifeld.com/web_download/NeifeldForms/SwedishDecPOA.pdf

Revision of US Rules Relating to PCT Applications

Rule 1.445 International application filing fees

1. Transmittal fee \$300
2. Search fee:

\$300 if a “corresponding prior [filed] United States National application” is identified

\$1000 otherwise

Revision of US Rules Relating to PCT Applications

Rule 1.445 International application filing fees

3. Supplemental search fee \$1000 (for each additional invention lacking unity of invention)
4. Processing fee - \$300
5. International filing fee - \$1035 + page costs

Revision of US Rules Relating to PCT Applications

- **§ 1.455 Representation in international applications.**
- “(b) Appointment of an agent, attorney or common representative (PCT Rule 4.8) must be effected either in the Request form, signed by applicant, in the Demand form, signed by applicant, or in a separate power of attorney....”

Revision of US Rules Relating to PCT Applications

- **§ 1.480 Demand for international preliminary examination**
- “(d) The filing of a Demand shall constitute the election of all Contracting States which are designated and are bound by Chapter II of the Treaty on the international filing date (PCT Rule 53.7).”

Revision of US Rules Relating to PCT Applications

- **§ 1.480 Demand for international preliminary examination**
- (e) Any Demand filed after the expiration of the applicable time limit set forth in PCT Rule 54*bis*.1(a) shall be considered as if it had not been submitted (PCT Rule 54*bis*.1(b)).

Revision of US Rules Relating to PCT Applications

- **§ 1.482 International preliminary examination fees**
- (i) USPTO/ISA - \$600
- (ii) Other ISA - \$750
- (iii) Each additional invention - \$600

Revision of US Rules Relating to PCT Applications

- **1.484 Conduct of international preliminary examination**
- 1.484(e) – The USPTO/IPEA will adopt the ISA/WO as the IPEA/WO
- 1.484(g) – The USPTO/IPEA will establish an “IPER” (yes, IPER, not IPRP)
- 1.484(h) – Interview with the Examiner prior to the IPER is “of right”

Revision of US Rules Relating to PCT Applications

- **PRACTICE POINT** – Establishment of the WO in the search phase enables effective use of interview and amendment practice. One personal interview with the examiner is “of right” upon payment of the Demand, and may be used to help place the claims in allowable form prior to entering national stages. **(Two bites are better than one, both in PCT and national phase proceedings! – Benefit of proximity to the USPTO)** *

Revision of US Rules Relating to PCT Applications

- **PRACTICE POINT – Reducing fees**
- Do not concurrently file a U.S and a PCT application having the same disclosure.
- Do file the U.S. application 1 day in advance in order to benefit from the \$700 discrepancy in search fees under 37 CFR 1.445.

68 FR 70996 – Changes to Implement the 2002 *Inter Partes* Reexamination and Other Technical Amendments to the Patent Statute

- **EFFECTIVE DATE OF NEW RULES:** January 21, 2004.
- **Provisions relating to reexamination, publication, appeals**

Changes to Implement the 2002 *Inter Partes* Reexamination and Other Technical Amendments to the Patent Statute

- **Purpose** – To implement the patent-related provisions in the intellectual property title of the 21st Century Department of Justice Appropriations Authorization Act

Technical Amendments to the Patent Statute

- 1.13(b) – PTO will provide certified copies of published patent applications
- 1.14(g)(2) – PTO will provide copy of English translation of published PCT filed in the USPTO
- 1.78(a)(3) – Amended to enable a petition to add an unintentionally omitted priority claim in *an abandoned PCT application*.

Technical Amendments to the Patent Statute

- **1.197(c)(2) - Action following decision on appeal to the Board**
- Date of termination of proceeding ends pendency of the application
- Termination cuts off ability to file continuation be of co-pendency requirement for continuation

Technical Amendments to the Patent Statute

- **1.197(c) - Action following decision on appeal**
- Proceedings ARE NOT terminated by decision on appeal where “claims stand allowed” or “further action required by examiner”
- Proceedings ARE terminated in all other circumstances on (1) the date appeal dismissed or (2) the date on which time for appeal or civil action expires

Technical Amendments to the Patent Statute

- **1.197(c) - Action following decision on appeal**
- Proceedings ARE terminated for an appeal or civil action when that proceeding terminates
- An appeal to the U.S. Court of Appeals for the Federal Circuit is terminated when the mandate *is issued* by the Court. *Note the change!*
- A civil action is terminated when the time to appeal the judgment expires.

Background - Inter Partes Reexamination

- **1999 AIPA provides for inter partes reexamination of patents**
- Third party may request
- Prior art evidence limited to published prior art: patents and printed publications.
- Estoppel applies against third party
- Originally, no third party right of appeal

Background - Statutory Changes to Inter Partes Reexamination in 2002

- AIPA amended to provide:
- (1) Third party right of appeal to CAFC
- (2) Effective date changed to make third party reexamination available against all patents

Background – Procedural Overview of Inter Partes Reexamination

- 1.913 - Request filed by third party
- Request must show “substantial new question of patentability”
- 1.923 - Examiner issues determination on request (and mails both an order initiating reexam and an office action) within 3 months
- (compare reexam to interference timing)

Background – Procedural Overview of Inter Partes Reexamination

- 1.933 – Duty to disclose applies to patentee
- 1.937 - Reexam conducted with “special dispatch”
- Claims can only be narrowed
- 1.943 - Page limits on submissions by patentee and requestor

Background – Procedural Overview of Inter Partes Reexamination

- 1.935-947 - Examiner issues office action
- Patentee files response, third party files comments on response
- 1.949 - Second office action normally final
- Final office action shall include in addition to rejections, *determinations not to make rejections*. That is, the examiner's reasoning for and against patentability on issues raised must be reduced to writing.

Background – Procedural Overview of Inter Partes Reexamination

- 1.951 – Patentee files comments in response to final action, and requester files comments on patentee’s comments
- 1.953 – Examiner issues “Right of Appeal” notice, then either or both parties can appeal or cross-appeal from an appeal, to the Board.
- Patentee appeals on claims rejected, cross appeals on appeal of claims allowed
- Requestor appeals on claims allowed, cross appeals on appeal of claims rejected

Background – Procedural Overview of Inter Partes Reexamination

- 1.959 – Appellant (each appellant) files a brief, respondent files a respondent brief, and Examiner files an Examiner's answer in response to all briefs
- Then, Appellant files a rebuttal brief directed only to respondent brief and Answer

Background – Procedural Overview of Inter Partes Reexamination

- Under revised law, all Appellants and Respondents in the Board proceeding can appeal from a final decision of the Board, to the CAFC.
- Parties that did not maintain an appeal or cross-appeal, cannot appeal to the CAFC

· **Inter Partes Reexamination Amendments to the Patent Rules**

- 1.301 Appeal to U.S. Court of Appeals for the Federal Circuit
- Amended to specify that appeals by third party controlled by 1.983
- 1.302 – Specifies that notice of appeal controlled by 1.903, which in turn refers to 1.248, which specifies conventional service and certification requirements

· **Inter Partes Reexamination Amendments to the Patent Rules**

- 1.303 – Right of Civil Action
- Appeal to CAFC waives right to civil action in those cases (pre AIPA proceedings) where such right exists
- No right to civil action in any reexamination filed after November 29, 2001

Inter Partes Reexamination Amendments to the Patent Rules

- 1.303(b) – Right of Civil Action
- Appeal to CAFC by patentee in *pre-AIPA* reexamination to CAFC waives right to civil action
- NOTE: Does not apply to post AIPA reexaminations

Inter Partes Reexamination Amendments to the Patent Rules

- 1.304 Time for appeal or civil action expires
- 2 months from later of Board decision in the appeal and Board decision on request for rehearing
- Time for filing a cross-appeal expires the later of 14 days from service of notice of appeal or summons and complaint or 2 months from Board decision
- NOTE: Times also apply to interferences

Inter Partes Reexamination Amendments to the Patent Rules

- 1.417 – Translation of the published PCT application must be filed instead of the actual published PCT application in order to obtain the benefit of the right to a reasonable royalty specified in 35 USC 154(d)
- Must be clearly marked as 35 USC 154(d) submission, or it will be treated as a new application!

Inter Partes Reexamination Amendments to the Patent Rules

- **1.913 – Persons eligible to file request for inter partes reexamination**
- Clarifies that only third parties may request *inter partes* reexamination
- “any person other than the patent owner or its privies may file a request for inter partes reexamination”

· **Inter Partes Reexamination Amendments to the Patent Rules**

- 1.959 – Appeal in an Inter partes reexamination
- Amended to provide both parties one and only one opportunity to correct a defect in a notice of appeal
- 1.965/967/971 – Briefs in appeal in inter partes reexamination
- Amended to provide both parties one and only one opportunity to correct a defect in Briefs

· **Inter Partes Reexamination Amendments to the Patent Rules**

- Section 1.977(g) – Post Board Decision Action
- Precludes an extension of time for the patent owner to request rehearing
- Allows an extension of time for the patent owner to prepare and file an amendment
- (Conforms procedure to general streamlined procedure of inter partes appeals)

Inter Partes Reexamination Amendments to the Patent Rules

- Section 1.979(f) – Termination of proceedings in inter partes appeal
- “Upon termination of an appeal, *if no other appeal is present*, the reexamination proceeding will be terminated and the Director will issue a certificate under §1.997.”
- “Dismissal of one party “ does not terminate proceedings!

Inter Partes Reexamination Amendments to the Patent Rules

- **1.983 Appeal to the United States Court of Appeals for the Federal Circuit in inter partes reexamination**
- *Must have been a party of appeal to the Board*
- (b) Other parties must elect to participate in any appeal or cross appeal
- File notice with the Director
- Copy to the CAFC
- Serve all other parties

OG Notices: 05 August 2003

- Information Disclosure Statements May Be Filed **Without** Copies of U.S. Patents and Published Applications **in Patent Applications filed after June 30, 2003**
- (Since the USPTO maintains an electronic copy of all such applications, and examiners review only electronic documents in those applications)

OG Notices: 23 December 2003

- **The USPTO plans to cease mailing copies of U.S. patent references in U.S. and PCT national stage proceedings**

Pre OG Notice - Effective 1 December 2003

- **CENTRALIZED DELIVERY AND FACSIMILE TRANSMISSION REQUIREMENTS FOR PATENT APPLICATION RELATED CORRESPONDENCE**
- FAX: (703) 872-9306.
- Delivery: Customer Window. (Plaza 2)

Pre OG Notice - Effective 12 December 2003

- Partial waiver of 37 CFR 1.19(b)(1), (b)(2) and (b)(3) to permit the sale of patent applications-as-filed or patent file histories on any media (*e.g.*, paper or CD) irrespective of whether the source material is from CDs, IFW electronic storage or paper

SOME JUDICIAL DEVELOPMENTS

- Microsoft v. Multi-Tech (Fed. Cir. 2/3/2004)
- Statements characterizing the invention in a related case after the patent in suit issued held to narrow claim interpretation
- Issue - Telephone point-to-point connection OR telephone end points connection (allowing intermediate packet network transmission)

SOME JUDICIAL DEVELOPMENTS

- “In response to the examiner’s first office action, **Multi-Tech took the opportunity to provide a “summary of the invention” before addressing the § 103 rejection.** It stated:
- In their specification, Applicants disclose a communications system which **operates over a standard telephone line.** Such a telephone line is commonly referred to in the art as a “plain old telephone service” (POTS) line and establishes a point-to-point connection between telephone equipment on each end of the line. Applicants’ invention . . . transmits the packets across a POTS line to a remote site”

SOME JUDICIAL DEVELOPMENTS

- As a result, the Majority opinion stated that:
- an examination of the '627 patent's prosecution history confirms that Multi-Tech viewed its inventions as being limited to communications over a telephone line. *** That statement, which expressly related to the specification shared by all three patents and the communications system disclosed in all three patents, makes clear that Multi-Tech viewed the local and remote sites of its inventions as communicating directly over a telephone line.

SOME JUDICIAL DEVELOPMENTS

- As a result, the majority concluded that there was no infringement of a packet switched (no point-to-point connection) communications system.
- Prosecuting attorney made gratuitous (unnecessary) remarks. Those remarks resulted in holding of lack of infringement.
- How important were the attorneys remarks? Consider statement by Rader, J. ***dissenting:***

SOME JUDICIAL DEVELOPMENTS

- “This court today concludes that the invention claimed in any patent sharing the specification of the ’649, ’627, and ’532 patents cannot encompass the use of a packet-switched communications network like the Internet. **As all parties agree, the claim language in no way rules out the use of a packet-switched network. The specification also does not foreclose use of the Internet.** The prosecution history of the ’627 patent falls far short of a “clear and unambiguous” disclaimer of Internet coverage (as the majority finds), but rather suggests the contrary conclusion. “

SOME JUDICIAL DEVELOPMENTS

- Conclusions as to Microsoft case:
- Court is (more) narrowly construing claims.
- **Advise** –
- Do not give the Court **any** reason to narrow the claims – never characterize “the invention” other than as claimed. Carefully review draft prosecution statements for accuracy and clarity.
- As to U.S. practice, it is far better to add claims and appeal rejections than to amend.

SOME JUDICIAL DEVELOPMENTS

- **Sea change on claim construction**
- Markman (1995): “Claim construction is a question of law and is not the province of the jury.”
- Markman: ““To ascertain the meaning of claims, we consider three sources: The claims, the specification, and the prosecution history. **** Extrinsic evidence ... including expert and inventor testimony, **dictionaries, and learned treatises** *may* be helpful” citations omitted.”

SOME JUDICIAL DEVELOPMENTS

- **Sea change on claim construction**
- Markman apparently ruled out dictionaries as important primary authority on claim construction

SOME JUDICIAL DEVELOPMENTS

- Sea change on claim construction
- Compare Markman (1995) to Intellectual Property Development, Inc. v. UA-Columbia Cablevision of Westchester, Inc., (2003):

SOME JUDICIAL DEVELOPMENTS

- “As we have noted, “[c]onsulting the written description and prosecution history as a threshold step in the claim construction process, before any effort is made to discern the ordinary and customary meanings attributed to the words themselves, **invites a violation of our precedent** counseling against importing limitations into the claims.” Tex. Digital, 308 F.3d at 1204 (citations omitted).”

SOME JUDICIAL DEVELOPMENTS

- “In fact, we have noted that **dictionaries, encyclopedias, and treatises**, publicly available at the time the patent is issued, are objective resources that serve as reliable sources of information on the established meanings that would have been attributed to the terms of the claims by those of skill in the art”

SOME JUDICIAL DEVELOPMENTS

- **Conclusion** – Contrary to guidance in Markman, the Court, now, clearly now places **dictionary** definitions as of primary importance in construing terms in claims
- **Advise** – Consult dictionary definitions when drafting specifications and claims

THE END

- **THANK YOU**
- Rick Neifeld, Neifeld IP Law, PC
- Email: rneifeld@Neifeld.com