FICPI SEMINAR SERIES

New developments for IP practitioners

Singapore, 22 November 2019

FÉDÉRATION INTERNATIONALE DES CONSEILS EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION VON PATENTANWÄLTEN

FICPI

ACTING FOR THE IP PROFESSION WORLD WIDE

Introduction of FICPI

Julian Crump
FICPI President

FICPI is a global community of independent IP attorneys built on trusted relationships

FICPI is an international business family

Independent IP attorneys
Exclusive to private practice
More than 5500 members
More than 85 countries and regions
39 national groups
Like-minded professionals
Common interests/priorities
Regular opportunities to meet

Membership in FICPI makes IP attorneys more effective

Membership in FICPI strengthens your practice

Quality events

Dual focus: IP law and practice management

Beneficial relationships

Insight and a wider perspective

Qualifications/experience

Code of conduct

Benefits for clients

FICPI believes the work of independent IP attorneys is important

Independent IP attorneys help clients develop new technology, build trusted brands and create wealth

Build IP value

Protect and manage IP effectively

Support companies creating wealth/jobs

Advocacy with IP organisations

Key Initiatives

The IP Attorney – Adding Value to Innovation?

Asking IP offices to promote use of IP professionals

Supporting national FICPI groups

Engaging younger FICPI members

Key Initiatives

Improvements to FICPI events

Improvements to FICPI's communications

Increased activity in Asia

Strengthening membership in the United States

Patent drafting training for students in South and Southeast Asia, LatAm and Europe

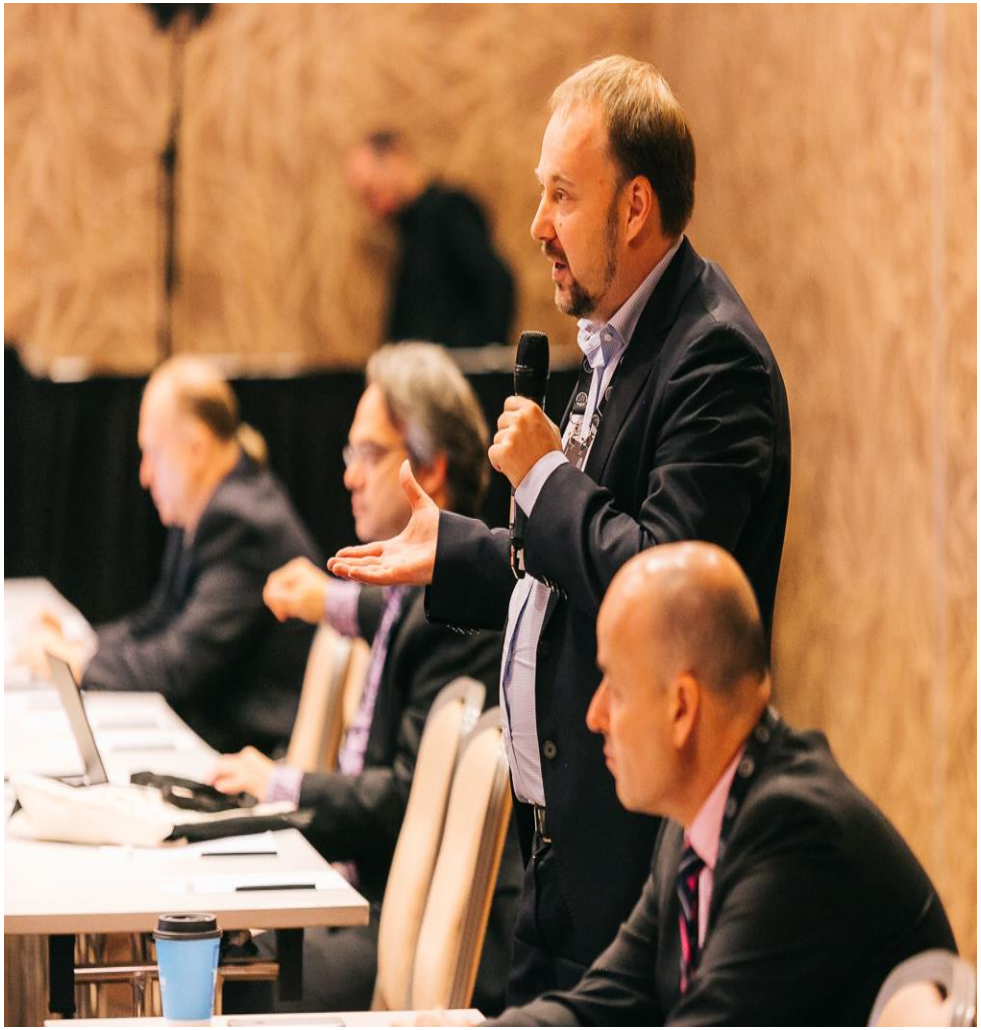
Get involved

Attend the FICPI Korea Symposium, Seoul, 22-24 April 2020

Attend the FICPI 19TH Open Forum, Cannes, France, 7-10 October 2020

Join a sub-group of FICPI's Study & Work Committee (CET)

Join FICPI's Professional Excellence Committee



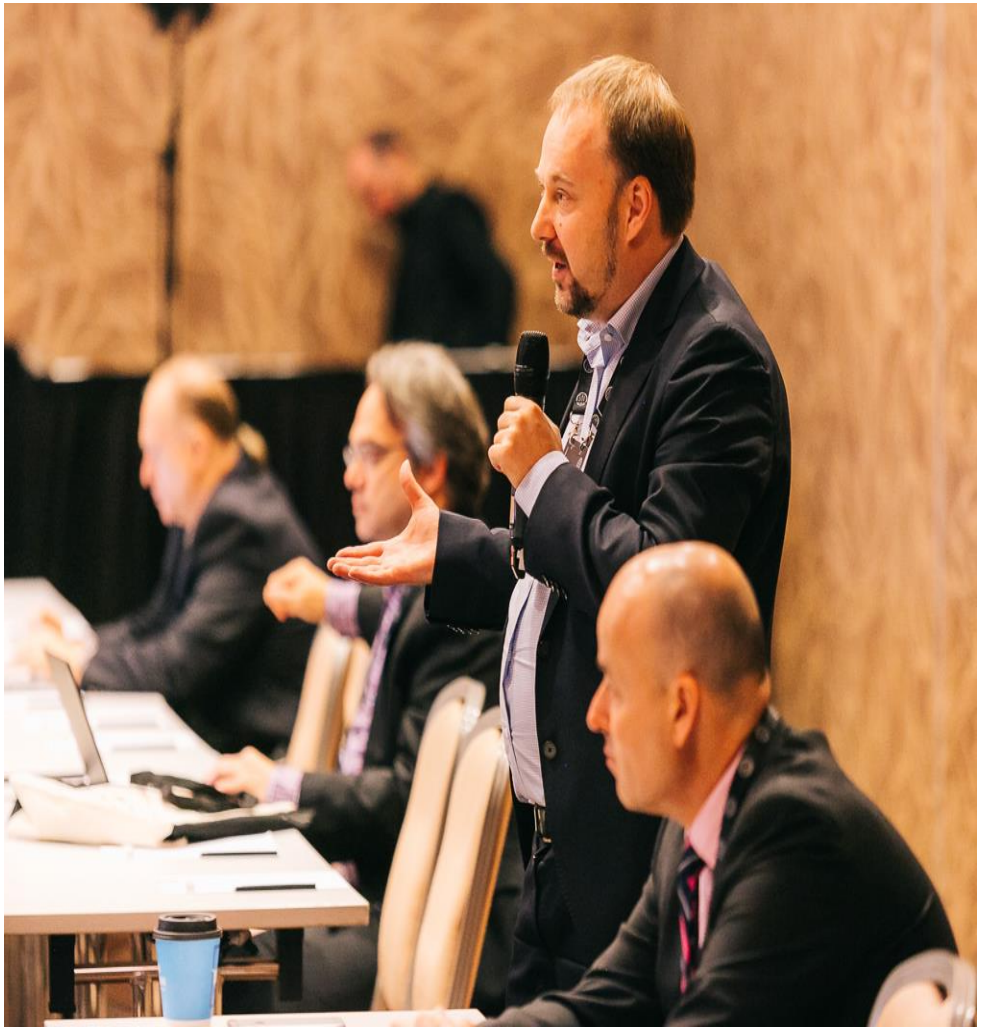
Get involved

Attend meetings of a national or regional FICPI group

Write a post for FICPI's blog

Write an article for FICPI's monthly newsletter

Update your biographical information on ficpi.org



Session 4 - Keynote: Most interesting Developments of 2019 in European and US IP Practice

Moderator

Julian Crump

FICPI President

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Italian and European Patent, Trademark and Design Attorney
M.Sc. in Electronic Engineering, Politecnico di Milano

Expertise in the field of mechanics, electronics and software.

Hold seminars and lectures, also at university level, on many aspects of IP, in particular on the patent protection in Europe (European and Unitary patents).

Antonio is enrolled with the Register of Court-Appointed Experts on Industrial Property of the Court of Milan, one the largest Courts with a specialized IP section in Europe. He also acts as ex-parte expert in patent litigation.

In FICPI, Antonio is currently Chair of CET Group 4 (European and Unitary patents, Unified Patent Court).

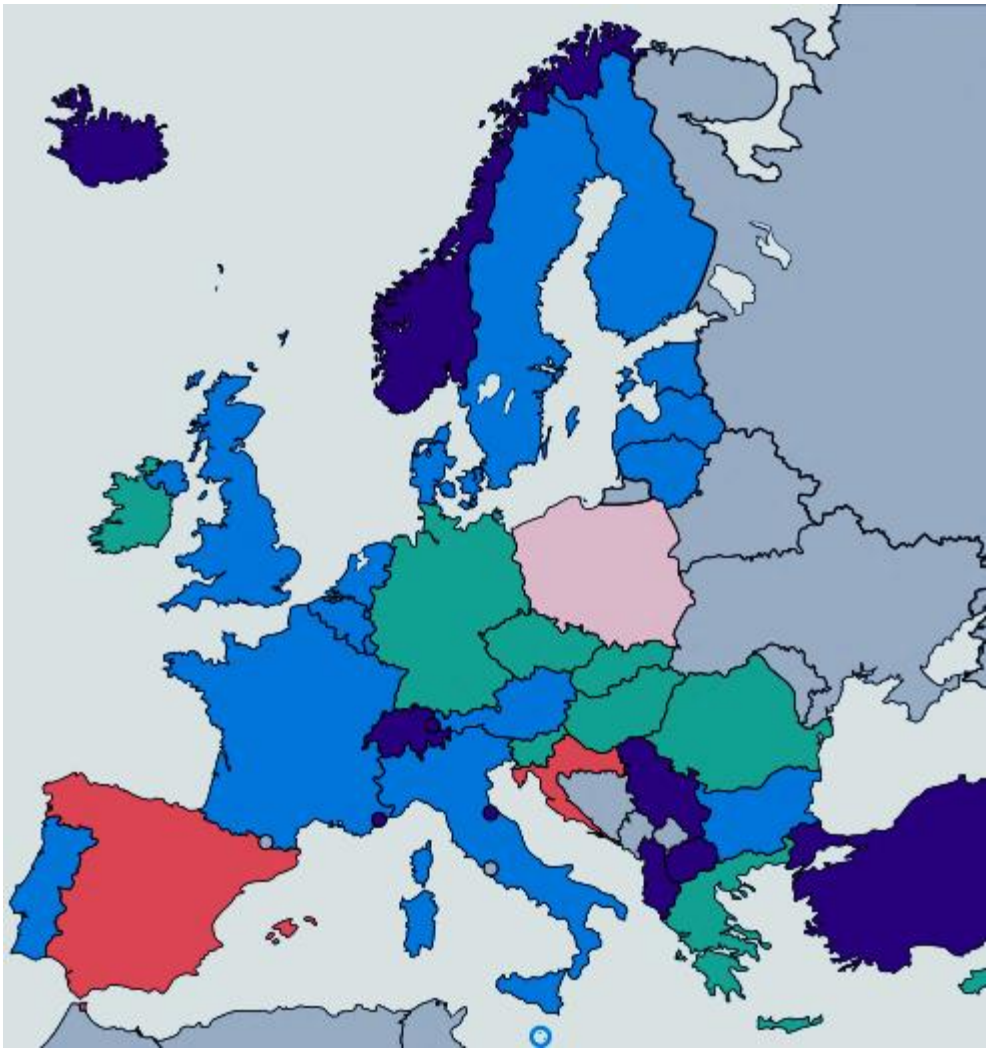
Recent developments in the European patent practice

Singapore, 22 November 2019

Antonio Mario Pizzoli

Chair CET Group 4

EPC, EU and UPC member states



Source: Wikipedia

10 EPC states

3 EPC + EU states

9 EPC + UPC states

16 EPC + UPC states + ratification

Total: 38 EPC states

+ 2 extension states (BA, ME)

+ 4 validation states (MA, MD, TN, KH)

Entry into force of the UPC

Art. 1 UPC: […] The Unified Patent Court shall be a court **common to the Contracting [European Union] Member States** and thus subject to the same **obligations under [European] Union law** as any national court of the Contracting [European Union] Member States.

Art. 7(2) UPC: The central division shall have its seat in Paris, with sections in **London** and Munich.

June 2016: Brexit referendum

Art. 89 UPC: This Agreement shall enter into force […] on the first day of the fourth month after the deposit of the […] instrument of ratification [of **the Federal Republic of Germany**] […].

June 2017: Constitutional complaint against the UPC Agreement filed with the German Federal Constitutional Court (still pending)

Recent decisions of the Enlarged Board of Appeal

G 1/18: If an appeal (opposition) is not filed/paid in time, then the appeal (opposition) fee must be refunded

G 1/19 (pending): Patentability of computer implemented simulations

G 2/19: third parties submitting observations have no right to appeal and Haar is a suitable location for oral proceedings

G 3/19 (pending): Patentability of plants and animals exclusively obtained by means of an essentially biological process

FICPI submitted **amicus curiae briefs**

EPO Strategic Plan 2019-2023

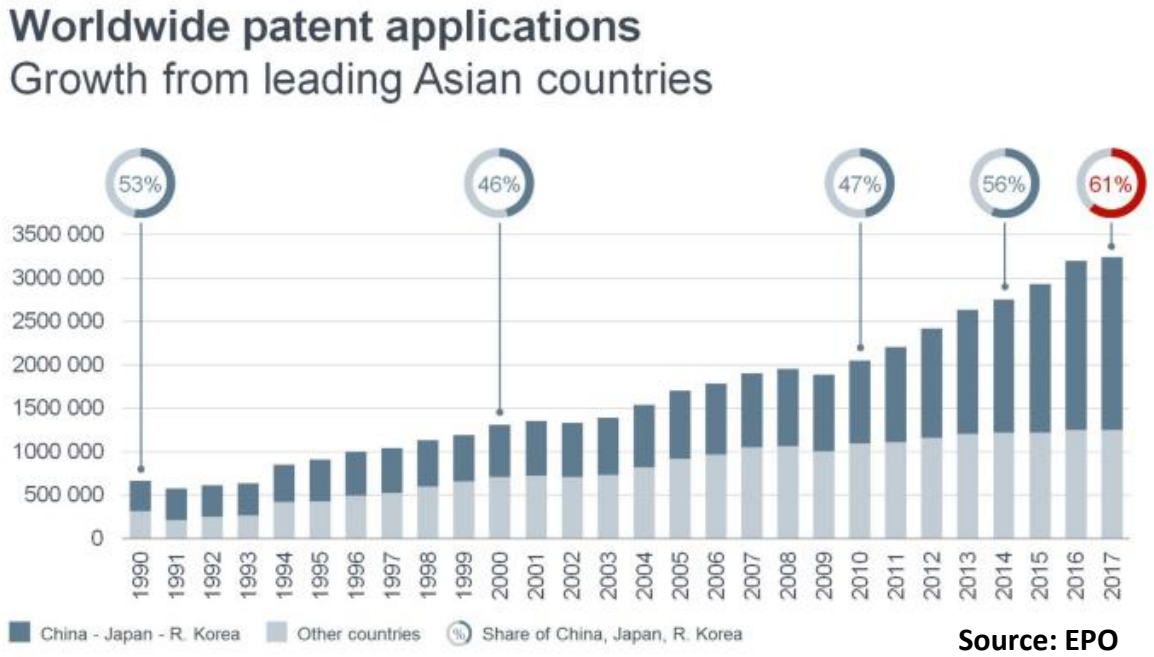
January 2019: Public consultation of the EPO (FICPI filed a detailed response) with questions on **3 topics**:

1. Evolution of the patent system and future challenges
2. Delivering high quality products and services
3. Social responsibility and transparency

June 2019: Adoption of the Strategic Plan (130 pages), with **5 goals**:

1. Build an engaged, knowledgeable and collaborative organisation
2. Simplify and modernise EPO IT systems
3. **Deliver high-quality products and services efficiently**
4. Build a European patent system and network with a global impact
5. Secure long-term sustainability

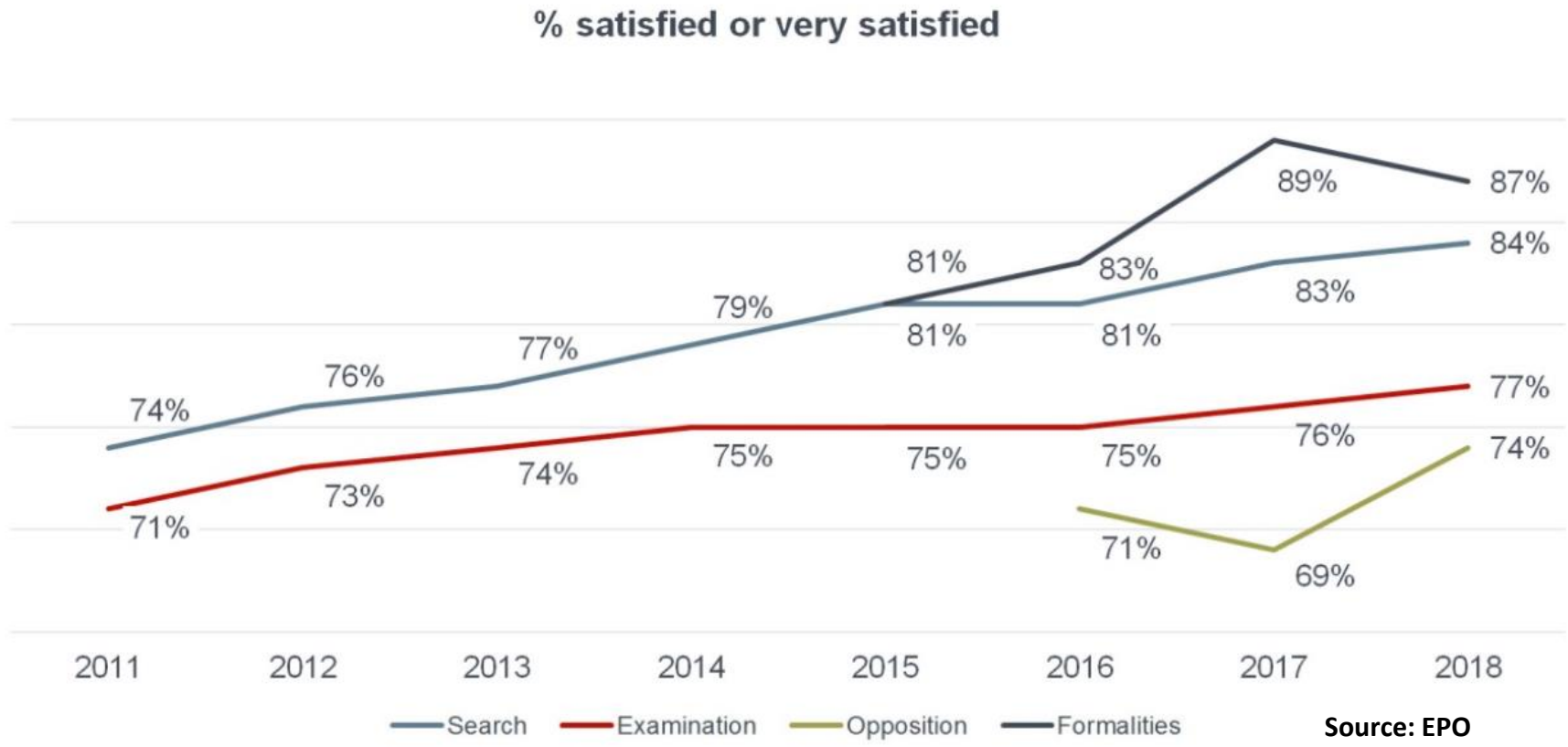
Key Initiative 1: Master the prior art



"**About 48%** of the EPO's search reports currently include an Asian-origin patent citation, and **approximately 23%** of the patent citations in EPO search reports contain at least one Asian citation that is only available in the original language"

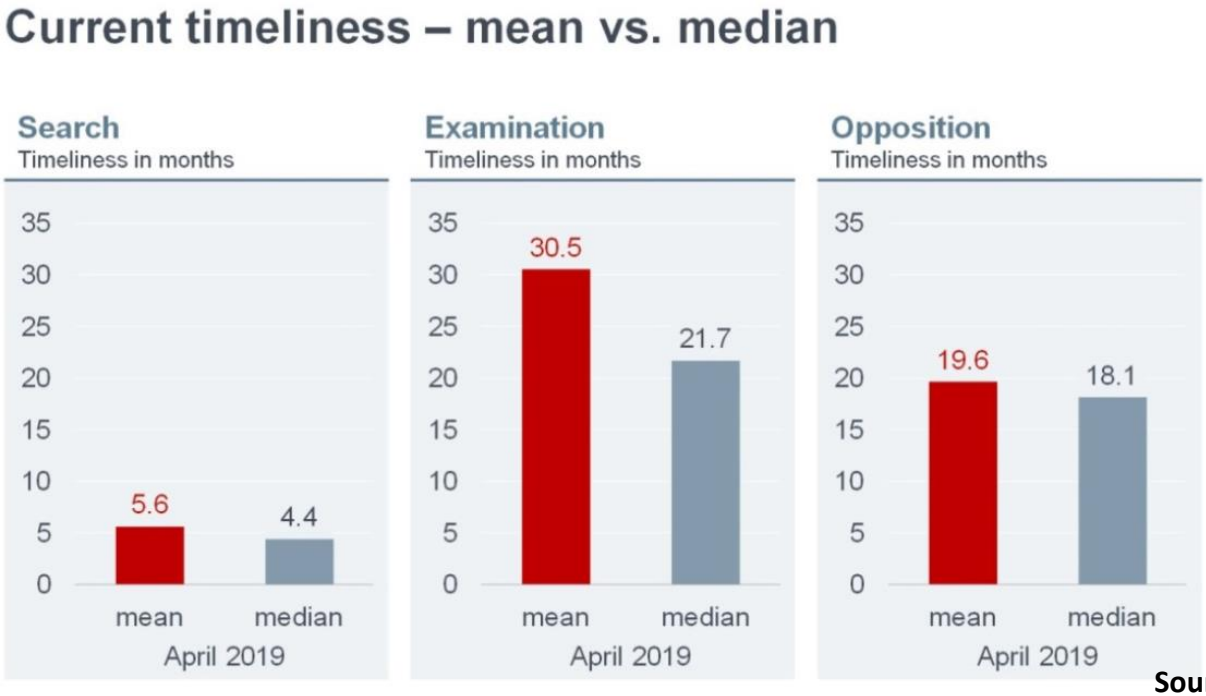
Key Initiative 2: Improve quality

User satisfaction survey



Source: EPO

Key Initiative 3: Offer a more flexible patent grant process



Source: EPO

“Accelerated" examination: 6 to 12 months
“Standard" examination: 12 to 24 months
Maximum examination time: no longer than 36 months
Opposition: around 15 months

Further initiatives of the EPO

- Optional search and written opinion delivered **in one week**
- **Pre-filing search** for an initial assessment of patentability
- Access to comprehensive user's portfolio with **estimated dates** for next actions
- Review and streamlining of the **EPO fees**
- Single tool to support an **end-to-end** electronic granting process (XML)
- Improving and expanding the **EPO databases** (Espacenet, Register)
- Harmonisation and convergence of practices **within the IP5**

FICPI's proposals

- Introducing a **grace period** of a safety-net type
- Definition and protection of **prior user rights**
- Reduction of the **pendency time** of European application
- Third parties may request **acceleration** of the examination
- No more **EPO communications to inventors** (Rule 19 EPC)
- No need to **amend the description** to cite the prior art (Rule 42 EPC)
- Deletion of the **duty of disclosure** (Rule 141 EPC)
- Materially **reducing the claims fees** (235 euro per claim)
- Materially **reducing the appeal fees** for appeals after examination (1880/2255 euro)
- Full **digitalization** of the communications to/from the EPO

EPO meetings on patent quality

October 2019: FICPI is invited to meetings (SACEPO-WPQ) at the EPO to discuss and study the quality of the European patents (with examples) and the EPO services. Some issues discussed:

- new prior art cited at a later stage in about 30% of the cases, due to:
  a) improvement in the search tools
  b) sharing of search results within the IP5 offices
  c) new classification of documents
- substantive amendments made by the examiner at grant (Rule 71(3) EPC)
- stricter criteria to assess added subject-matter (Art. 123(2) EPC) in opposition proceedings

The “according to claim 1” issue

At the meeting the EPO remarked that **combinations of US-style claims** are often **rejected** by the examiners since they add subject-matter to the initial (e.g. PCT) applications.

Example:

Disclosure + drawings: features A + B + C + D

Claim 1: feature A

Claim 2: claim 1 + feature B

Claim 3: claim 1 + feature C

Claim 4: claim 1 + feature D

Amended claim 1: feature A + feature B + feature D: **not allowable!**

Revised Rules of Procedure of the Boards of Appeals

February 2018: 1st draft

April 2018: user consultation (FICPI responded)

November 2018: 2nd draft (not so different)

December 2018: conference at the EPO (FICPI attended)

July 2019: final version (almost identical to the 2nd draft)

January 2020: entry into force, also **for all pending appeals**

Remittal

Art. 11 RPBA: The Board **shall not remit a case** to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so. As a rule, **fundamental deficiencies** which are apparent in the proceedings before that department constitute such special reasons.

Basis of appeal proceedings

Art. 12(2) RPBA: In view of the primary object of the appeal proceedings to **review the decision under appeal in a judicial manner**, a party's appeal case shall be directed to the requests, facts, objections, arguments and evidence on which the decision under appeal was based**.**

Art. 12(4) RPBA: Any part of a party's appeal case which does not meet the requirements in paragraph 2 is to be **regarded as an amendment**, unless the party demonstrates that this part was admissibly raised and maintained in the proceedings leading to the decision under appeal. Any such amendment may be admitted only **at the discretion of the Board**.

Amendment to an appeal case

Art. 13(1) RPBA: Any amendment to a party's appeal case after it has filed its grounds of appeal or reply is subject to **the party's justification for its amendment** and may be admitted only **at the discretion of the Board**.

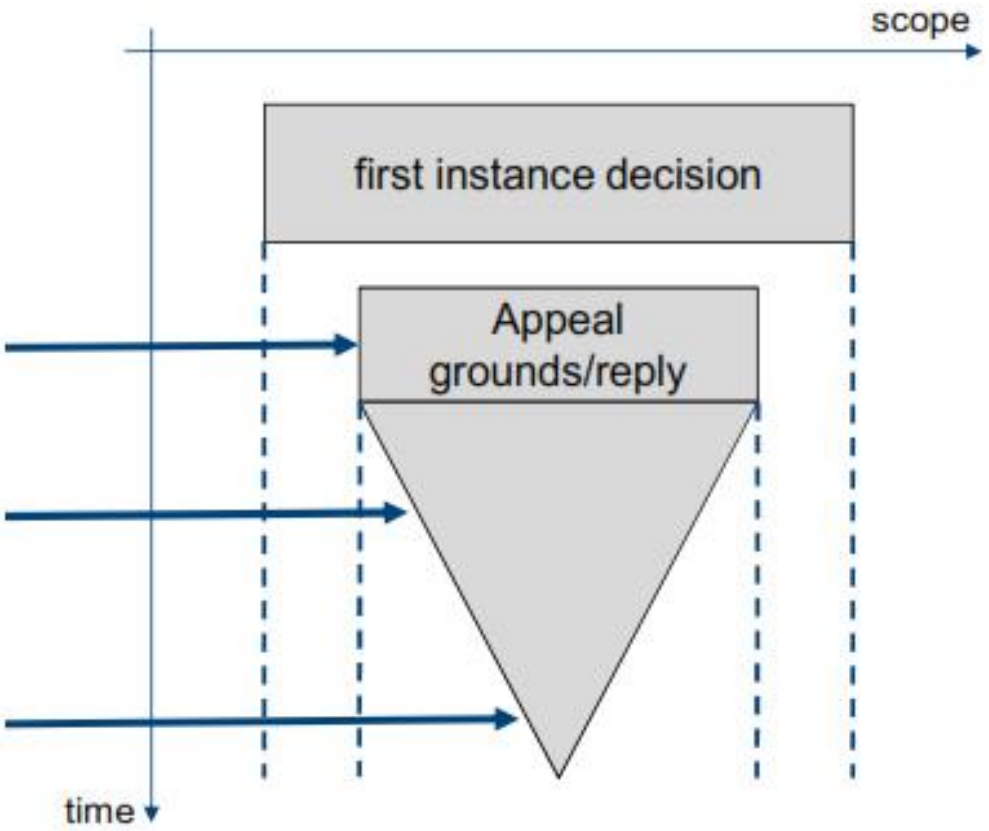
Art. 13(2) RPBA: Any amendment to a party's appeal case made after the expiry of a period specified by the Board in a communication under Rule 100, paragraph 2, EPC or, where such a communication is not issued, after notification of a summons to oral proceedings **shall, in principle, not be taken into account** unless there are **exceptional circumstances**, which have been justified with **cogent reasons** by the party concerned.

Convergent approach

Art. 12(4): Amendment **when filing/replying** to an appeal

Art. 13(1): Amendment **before** summons or time-limit expiry of a communication

Art. 13(2): Amendment **after** summons or time-limit expiry of a communication



Oral proceedings (1)

Art. 15(1) RPBA:

Without prejudice to Rule 115, paragraph 1, EPC, the Board shall, if oral proceedings are to take place, endeavour to give **at least four months'** notice of the summons. In cases where there is more than one party, the Board shall endeavour to issue the summons **no earlier than two months** after receipt of the written reply or replies referred to in Article 12, paragraph 1(c).

Oral proceedings (2)

Art. 15(1) RPBA:

A **single date** is fixed for the oral proceedings.

In order to help concentration on essentials during the oral proceedings, the Board shall issue a **communication drawing attention** to matters that seem to be of particular significance for the decision to be taken. The Board may also provide a **preliminary opinion**. The Board shall endeavour to issue the communication **at least four months** in advance of the date of the oral proceedings.

Change of date of oral proceedings (1)

Possible:

- oral proceedings before the EPO or a national court;
- serious illness;
- a death within the family;
- marriage or formation of a similar recognised partnership;
- military service or other obligatory performance of civic duties;
- holidays or business trips booked before notification of the summons.

Change of date of oral proceedings (2)

Not possible:

- filing of new requests, facts, objections, arguments or evidence;
- excessive work pressure;
- unavailability of a duly represented party;
- unavailability of an accompanying person;
- appointment of a new professional representative.

Suggestions

- **Review** all your pending appeals **by 31 December 2019** to see whether you should file amendments (e.g. new prior art or claim amendments), otherwise they might not be admitted starting from 1 January 2020
- Present all your arguments/requests **as soon as possible**, preferably **during examination/opposition** or, at the latest, when filing/responding to an appeal
- Submit **strong and detailed arguments** to explain and justify any amendment to the case and be prepared to discuss them
- Prepare oral proceedings with all due care, since they are **the final act** of the procedure

Thank you for your attention!

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Registered Patent Attorney
Member of the Federal Circuit and Supreme Court bars

Undergraduate degree in Behavioral Biology, from Johns Hopkins University in 1984

Studied Neuroscience of Virginia from 1984-86, and then received a Ph.D. in 1990 in Molecular Biology and Genetics from the Biochemistry, Cellular and Molecular Biology Program at the Johns Hopkins University School of Medicine.

Dr. Crane works in all aspects of biotechnology and pharmaceutical patent law, including patent preparation and prosecution, client counseling and opinions, post-grant proceedings and district court litigation.

She has written and lectured particularly on current issues in patent subject matter eligibility

Chair of the Biotechnology and Pharmaceutical working group (CET5) of Fédération Internationale des Conseils en Propriété Intellectuelle (FICPI).

FICPI Singapore
November 2019

Subject Matter Eligibility in the U.S.

Sharon E. Crane, Ph.D.
Chair, CET5 - Biotechnology and Pharmaceuticals

Intro: Sharon Crane

- Partner at Rothwell, Figg, Ernst & Manbeck P.C. for 10 years
- Specialty in biotechnology and chemical arts patent prosecution, patent interferences, post grant proceedings, post grant reviews, and appeals before the PTAB and Federal Circuit
- Ph.D. in Molecular Biology and Genetics

Part II — Standards concerning the availability, scope and use of Intellectual Property Rights

Section 5: patents

Article 27

Patentable Subject Matter

1. Subject to the provisions of paragraphs 2 and 3, patents shall be available for any inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application. [(5)]Subject to paragraph 4 of Article 65, paragraph 8 of Article 70 and paragraph 3 of this Article, patents shall be available and patent rights enjoyable without discrimination as to the place of invention, the field of technology and whether products are imported or locally produced.

35 U.S.C. § 101

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

U.S. Supreme Court Decisions relating to § 101

- *Bilski et al. v. Kappos*
- *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*
- *Association for Molecular Pathology v. Myriad Genetics, Inc.*
- *Alice Corporation Pty. Ltd. V. CLS Bank International et al.*

Bilski et al. v. Kappos

- The subject matter was a method of ”hedging” against the risk of price changes between commodity providers and commodity consumers.

- The Court held that the “machine-or-transformation” is not the sole test for patent eligibility under § 101, and while business methods may be patentable, these claims were merely reducing the concept of hedging to a mathematical formula that was merely an unpatentable abstract idea.

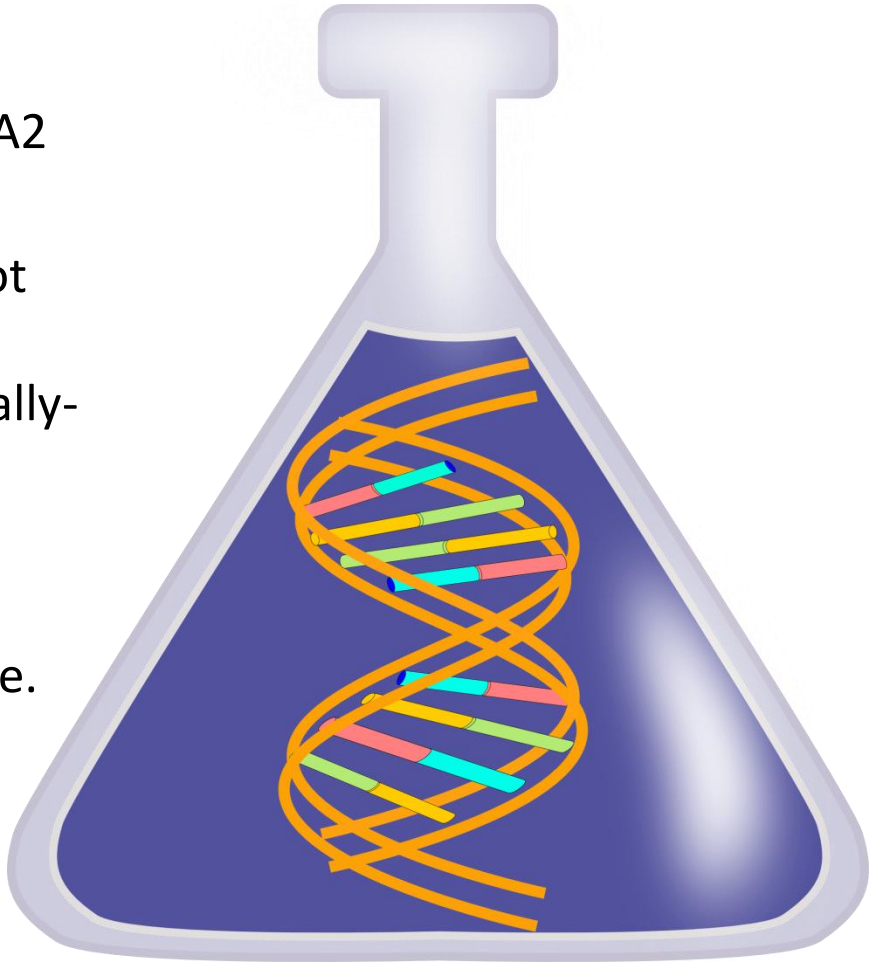
Mayo Collaborative Services v. Prometheus Laboratories, Inc.

- The subject matter was a method of optimizing the therapeutic efficacy for treatment of an immune-mediated gastrointestinal disorder by administering a drug to a subject, and determining the level of the drug in the subject, wherein a particular amount of the drug indicates a need to increase or decrease the amount of the drug administered.

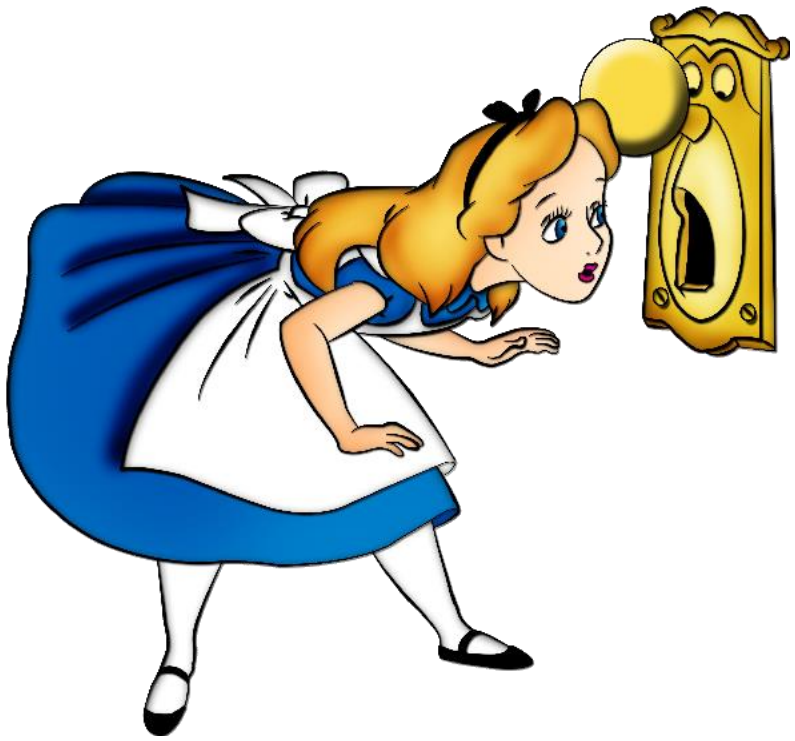
- The Court held that the claims were nothing more than instructions that "add nothing specific to the laws of nature other than what is well-understood, routine, conventional activity, previously engaged in by those in the field."

Association for Molecular Pathology v. Myriad Genetics, Inc.

- The subject matter was isolated DNA related to the human BRCA1 and BRCA2 cancer susceptibility genes.
- The Court held that isolated DNA is not patent-eligible because claims to such subject matter read on isolated naturally-occurring DNA that is a "product of nature."
- The Court held that cDNA was not a product of nature and is patent eligible.



Alice Corporation Pty. Ltd. V. CLS Bank International et al.



- Methods and data processing systems for exchanging obligations between parties in financial transactions
- Court found that “the method claims, which merely require generic computer implementation, fail to transform that abstract idea into a patent eligible invention.”

The Supreme Court has Warned Against the Over-application of their Holdings

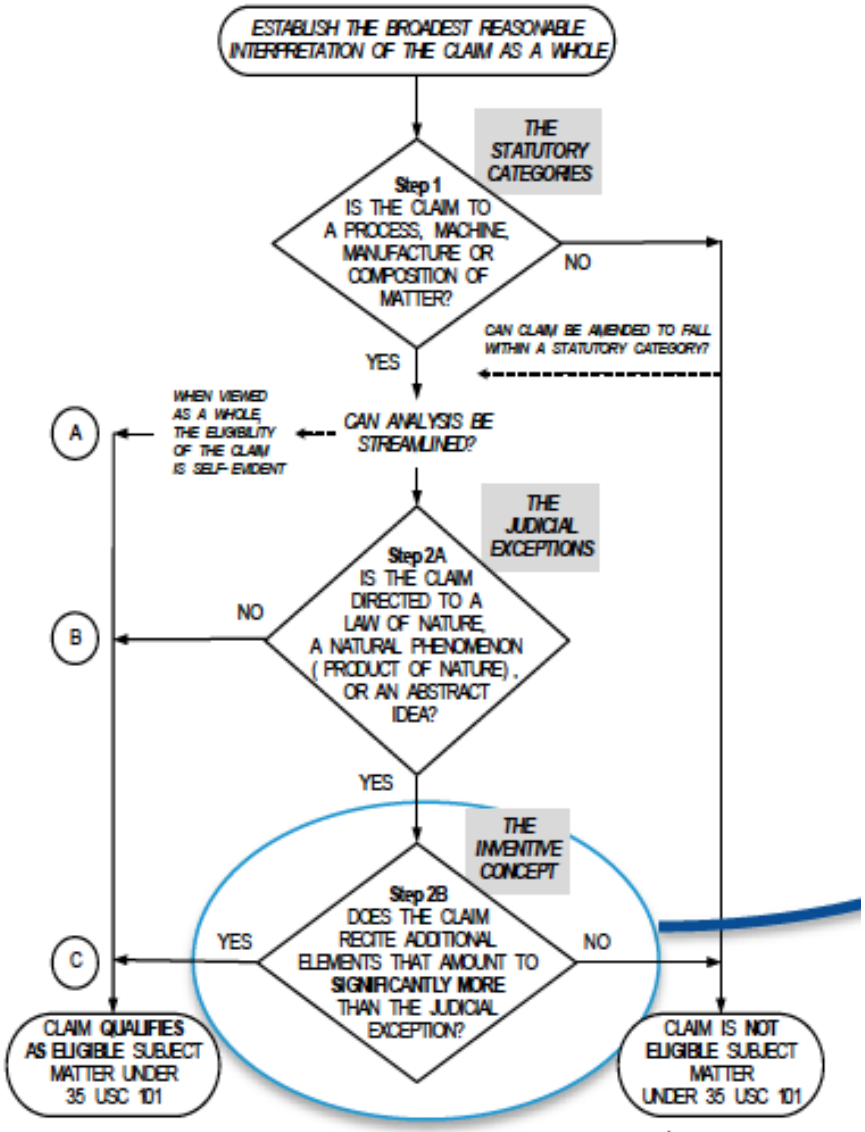
- "Everything that happens may be deemed 'the work of nature'…" – *Funk Bros. Seed Co. v. Kalo Inoculant Co.*

- "all inventions at some level embody, use, reflect, rest upon or apply laws of nature, natural phenomena, or abstract ideas" and "too broad an interpretation of this exclusionary principle could eviscerate patent law." - *Mayo*

The Supreme Court has Warned Against the Over-application of their Holdings (con't)

- Patent protection strikes a delicate balance between creating "incentives that lead to creation, invention, and discovery" and "imped[ing] the flow of information that might permit, indeed spur, invention." – *Myriad*
- "At the same time, we tread carefully in construing this exclusionary principle lest it swallow all of patent law." – *Alice, citing Mayo*

Subject Matter Eligibility Test

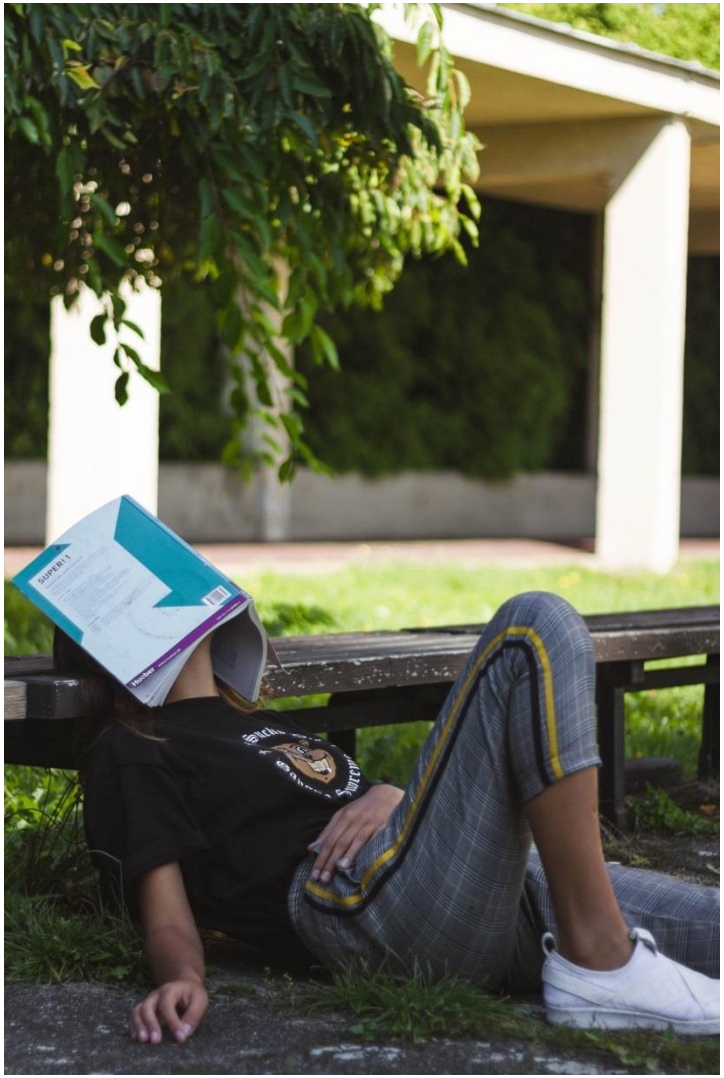


What is "significantly more"?

- Improvements to the functioning of a computer *MPEP 2106.05(a)*;
- Improvements to any other technology or technical field *MPEP 2106.05(a)*;
- Applying the judicial exception with, or by use of, a particular machine *MPEP 2106.05(b)*;
- Effecting a transformation or reduction of a particular article to a different state or thing *MPEP 2106.05(c)*;
- Adding a specific limitation other than what is well-understood, routine, conventional activity in the field, or adding unconventional steps that confine the claim to a particular useful application *MPEP 2106.05(d)*; or
- Other meaningful limitations beyond generally linking the use of the judicial exception to a particular technological environment *MPEP 2106.05(e)*.

What is NOT "significantly more"?

- Adding the words “apply it” (or an equivalent) with the judicial exception, or mere instructions to implement an abstract idea on a computer *MPEP 2106.05(f)*;
- Simply appending well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception *MPEP 2106.05(d)*;
- Adding insignificant extra-solution activity to the judicial exception *MPEP 2106.05(g)*; or
- Generally linking the use of the judicial exception to a particular technological environment or field of use *MPEP 2106.05(h)*.



Berkheimer v. HP Inc., 881 F.3d 1360 (Fed. Cir. 2018)

- Invention related to digitally processing and archiving files in a digital asset management system
- Federal Circuit held that whether certain claim limitations represent activities that were well-understood, routine, and conventional to a skilled artisan at the time of the patent is a factual issue, precluding summary judgment that all of the claims at issue were not patent eligible.

What is “well-understood, routine, conventional”?

- Element must be widely known or in common use
- This question is meant to be distinct from a §§102 and 103 analysis

Memo re *Berkheimer*

- Examiner can rely on:
  - an express statement in a specification or during prosecution that an element was well-understood, routine and/or conventional;
  - a citation to one or more court decisions discussed in MPEP § 2106.05(d)(II) stating that an element was well-understood, routine and/or conventional;
  - a citation to a publication demonstrating that an element was well-understood, routine and/or conventional
  - a statement that the Examiner is taking official notice that an element was well-understood, routine and/or conventional – only if certain from his/her own personal knowledge

- Elements of the claim must be considered individually and in combination to determine whether a claim includes significantly more than a judicial exception

- The combination must also be well-understood, routine and conventional

Vanda Pharmaceuticals v. West-Ward Pharmaceuticals, 887 F.3d 1117 (Fed. Cir. 2018)

- June 7, 2018 memo by USPTO
- Evaluate the claim as a whole – claim is not "directed to" the abstract idea of the natural relationship between the patient's genotype and disrupted heart rhythm
- Inclusion of the treatment step removes the claims from implications under *Mayo* and *Myriad*
- No need to determine whether treatment step is routine or conventional because claim was eligible under step 2A of the eligibility analysis

HR 6264

- Bill introduced by Representatives Thomas Massie (R-KY, 4th dist.) and Marcy Kaptur (D-OH, 9th dist.)
- Proposes numerous changes to effectively reverse much of AIA
- Including returning to "first to invent", abolish IPRs and PGRs, dissolve PTAB and return to BPAI, restore grace period provisions, end 18 month publication, restore best mode as infringement defense
- Amends 35 USC 101
- Effectively abrogates *Alice*, *Impression Products v. Lexmark* and *Ebay Inc. v. MercExxchange*)
- Unlikely to ever see a vote

2019 Revised Patent Subject Matter Eligibility Guidance

- Maintains Step 1 of the subject matter eligibility test (MPEP § 2106) - claims must be directed to a process, machine, manufacture of composition of matter
- Breaks previous Step 2A into two "prongs"
  - Prong One - 3 groupings of abstract idea exceptions: (a) mathematical concepts; (b) certain methods of organizing human activity; and (c) mental processes
  - Prong Two – If there is an exception in Prong One, then Examiner must "**evaluate whether the claim as a whole integrates the recited judicial exception into a practical application of the exception**."
  - Should limit the over-application of § 101 rejections or obviate the need to provide proof that the claim is "significantly more" than what is a "well-understood, routine, conventional activity" in Step 2B.

Federal Circuit Has Not Followed PTO Guidance

- In ***Cleveland Clinic Foundation v. True Health Diagnostics, LLC***, the Federal Circuit declined to consider a claim's similarity to Example 29 of the USPTO's eligibility guidance, but rather considered the claim to be "strikingly similar" to the claim found by the Federal Circuit to be ineligible in *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*

- In ***ChargePoint, Inc. v. SemaConnect, Inc.***, the Federal Circuit found that an apparatus was merely an abstract idea because it was based upon "communicating requests to a remote server and receiving communications from that server..." The Federal Circuit appeared to ignore the fact that the claim was directed to an apparatus (i.e., a "new and useful machine" under 35 U.S.C. § 101), and did not "evaluate whether the claim as a whole integrates the recited judicial exception into a practical application of the exception."

Federal Circuit Has Asked Congress to Intervene

United States Court of Appeals for the Federal Circuit

AATRIX SOFTWARE, INC.,
Plaintiff-Appellant

v.

GREEN SHADES SOFTWARE, INC.,
Defendant-Appellee

2017-1452

Appeal from the United States District Court for the Middle District of Florida in No. 3:15-cv-00164-HES-MCR, Senior Judge Harvey E. Schlesinger.

ON PETITION FOR REHEARING EN BANC

LOURIE, *Circuit Judge*, with whom NEWMAN, *Circuit Judge*, joins, concurring in the denial of the petition for rehearing en banc.

I concur in the court's declining to rehear this case en banc. There is plausibility to the panel holding that there are fact issues potentially involved in this case concerning the abstract idea exception to patent eligibility. And the panel, and the court, are bound to follow the script that the Supreme Court has written for us in § 101 cases.

However, I believe the law needs clarification by higher authority, perhaps by Congress, to work its way out of what so many in the innovation field consider are § 101 problems. Individual cases, whether heard by this court or the Supreme Court, are imperfect vehicles for enunciating broad principles because they are limited to the facts presented. Section 101 issues certainly require attention beyond the power of this court.

Federal Circuit Has Asked Congress to Intervene

United States Court of Appeals for the Federal Circuit

INTERVAL LICENSING LLC,
Plaintiff-Appellant

v.

AOL, INC., APPLE, INC., GOOGLE LLC, YAHOO!, INC.,
Defendants-Appellees

2016-2502, 2016-2505, 2016-2506, 2016-2507

Appeals from the United States District Court for the Western District of Washington in Nos. 2:13-cv-00263-MJP, 2:13-cv-00264-MJP, 2:13-cv-00265-MJP, 2:13-cv-00266-MJP, Judge Marsha J. Pechman, Senior Judge Barbara Jacobs Rothstein.

PLAGER, *Circuit Judge*, concurring-in-part and dissenting-in-part.

When the lawyers and judges bring to the Supreme Court a shared belief in the uselessness of the abstract notion of 'abstract ideas' as a criterion for patent eligibility, we can hope that the Court will respond sensibly. In light of the statutory criteria for patent validity established in the Patent Act, there is no need, and indeed no place in today's patent law, for this abstract (and indefinable) doctrine. Something as simple as a declaration by the Court that the concept of 'abstract ideas' has proven unworkable in the context of modern technological patenting, and adds nothing to ensuring patent quality that the statutory requirements do not already provide, would remove this distraction from the salutary system of patent issuance and enforcement provided by the Congress in the 1952 Patent Act.

The problem with hoping for this solution is that there is no particular incentive for the Supreme Court to immerse itself again in this intellectual morass. The Court, unlike this court, is not called upon daily to address the consequences of an incoherent doctrine that has taken on a life of its own. It will take a special effort by the judges and the patent bar to gain the Court's attention. Failing that, a legislative fix is a possibility, though waiting for that may be the ultimate test of patience.

Draft Outline of Section 101 Reform

Keep existing statutory categories of process, machine, manufacture, or composition of matter, or any useful improvement thereof.

• Eliminate, within the eligibility requirement, that any invention or discovery be both “new and useful.” Instead, simply require that the invention meet existing statutory utility requirements.

• Define, in a closed list, exclusive categories of statutory subject matter which alone should not be eligible for patent protection. The sole list of exclusions might include the following categories, for example:

o Fundamental scientific principles;
o Products that exist solely and exclusively in nature;
o Pure mathematical formulas;
o Economic or commercial principles;
o Mental activities.

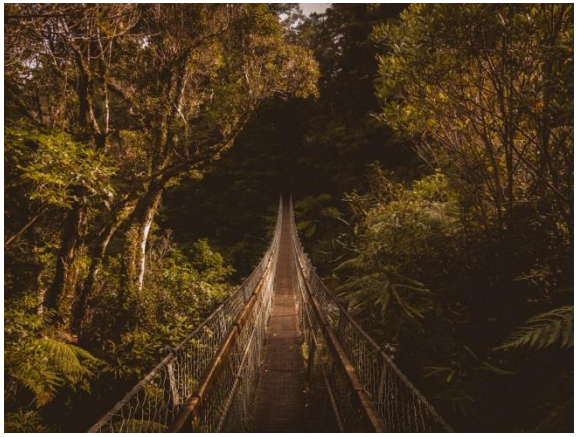
Draft Outline of Section 101 Reform (con't)

• Create a "practical application" test to ensure that the statutorily ineligible subject matter is construed narrowly.

• Ensure that simply reciting generic technical language or generic functional language does not salvage an otherwise ineligible claim.

• Statutorily abrogate judicially created exceptions to patent eligible subject matter in favor of exclusive statutory categories of ineligible subject matter.

• Make clear that eligibility is determined by considering each and every element of the claim as a whole and without regard to considerations properly addressed by 102, 103 and 112.

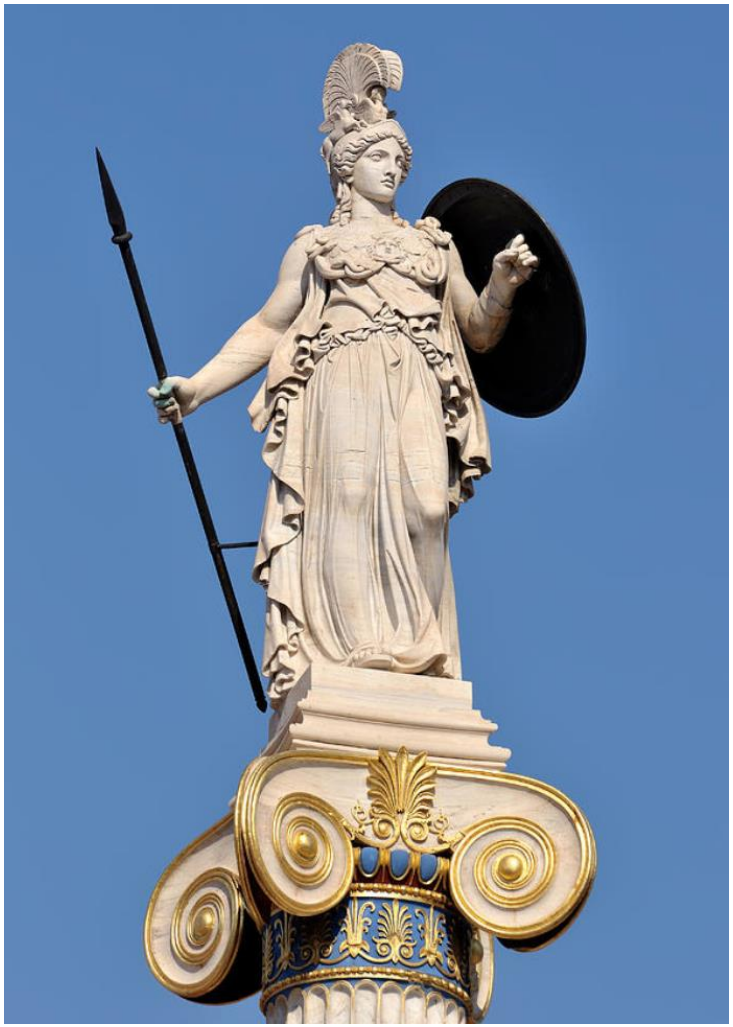


Senate Judiciary Committee Subcommittee on IP Hears Testimony on Proposed Changes to 35 U.S.C. § 101

- Hearings were held on June 4, 5 and 11 of 2019
- Various witnesses including former Chief Judge of the Federal Circuit, Paul Michel, former USPTO Directors David Kappos and Todd Dickinson testified for an against the proposed changes
    - In general, those from the life sciences spoke in favor of the changes, while those from the high-tech industries spoke against
- Legislation may be stalled due to accompanying changes to 35 U.S.C. § 112(f) "means plus function" claim construction

Supreme Court could clarify previous holdings if it grants *certiorari* to hear the appeal of *Athena Diagnostics v. Mayo*

- Federal Circuit decided against Athena on claims drawn to diagnosing myasthenia gravis (MG) by detecting antibodies to muscle-specific tyrosine kinase (MuSK)
  - A dissent by Judge Newman references "strong concerns for the consequences of biomedical diagnostics"
- Federal Circuit denied rehearing *en banc*
  - *Concurrence by Judges Lourie, Reyna and Chen, by Hughes, Prose and Taranto and by Dyk, Hughes and Chen, and separately by Judge Chen*
  - *Dissent by Judges Moore, O'Malley, Wallach and Stoll, by Newman and Wallach, by Stoll and Wallach and by O'Malley*
- Athena petitioned for *certiorari* on October 2, 2019

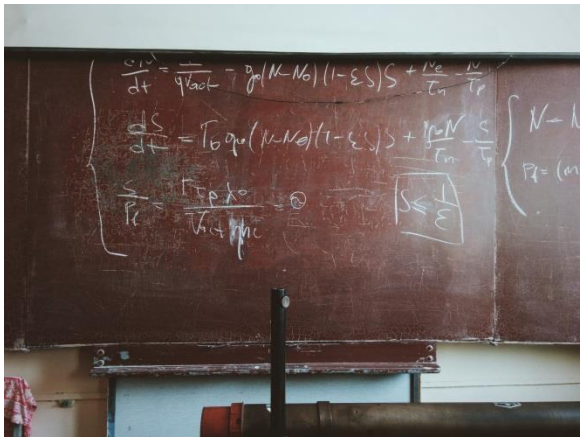


USPTO issues October 2019 Update on Subject Matter Eligibility

- Claim “reciting” a judicial exception can either ”set forth” or “describe” the exception
  - Claim does not need to explicitly use the words of the exception
- Examiner’s burden of establishing ineligibility
  - Examiner must explain how a specific limitation falls within one of the enumerated groupings of abstract ideas
  - Examiner should identify additional claim elements to determine if the judicial exception is integrated into a practical application
- Judicial Exception Integrated into a Practical Application
  - Technology to improve a device or system

USPTO issues October 2019 Update on Subject Matter Eligibility (con't)

- Clarifies grouping of abstract ideas
  - Mathematical concepts
    - Claim does not recite a mathematical concept if it is merely based on or involves a mathematical concept
    - May be expressed in words or mathematical symbols
  - Methods of organizing human activity
    - limited to fundamental economic principles or practices, commercial or legal interactions, managing personal behavior, and relationships or interactions between people
  - Mental processes
    - claims do not recite a mental process when they do not contain limitations that can practically be performed in the human mind



USPTO Subject Matter Eligibility Webpage

- https://www.uspto.gov/patent/laws-and-regulations/examination-policy/subject-matter-eligibility

Thank you! Any Questions?

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Eleni earned her LL.B. in Athens, Greece and her LL.M. masters degree with distinction in Heidelberg, Germany, where she continued with her doctoral studies in German unfair competition law and electronic commerce.

Expertise in trademark prosecution and litigation, domain name disputes resolution and e-commerce cases.

Co-Chair (European Trade Marks) in the CET 1 FICPI Commission.

Eleni represents FICPI in the EUIPO ECP4 Working Group on the Convergence Analysis Project

Non-traditional trademarks in the EU: a new challenge for the EUIPO?

Non-traditional marks: the current status in the EU

Included in the EU trademark reform package 2015:

- EU Regulation 2017/1001 (EUTMR)
- EU Directive 2015/2436 (TMD)
- Implementation of the TMD still ongoing (not yet: Greece, Cyprus, Latvia, Romania, Slovenia. With delay: Croatia, Italy, Finland, Malta, Poland)

Non-traditional marks: the current status in the EU

MS IPOs: Common communication on the representation of new types of trademarks in June 2017:

- types of marks to be accepted
- definitions
- means of representation of new types of marks
- electronic file formats (sound, motion, multimedia and hologram marks)

Current convergence efforts in the EU: CP11

Two work-streams:

- Examination of formal requirements and absolute grounds for refusal or invalidity

- Examination of relative grounds for refusal or invalidity

Examination of formal requirements: issues

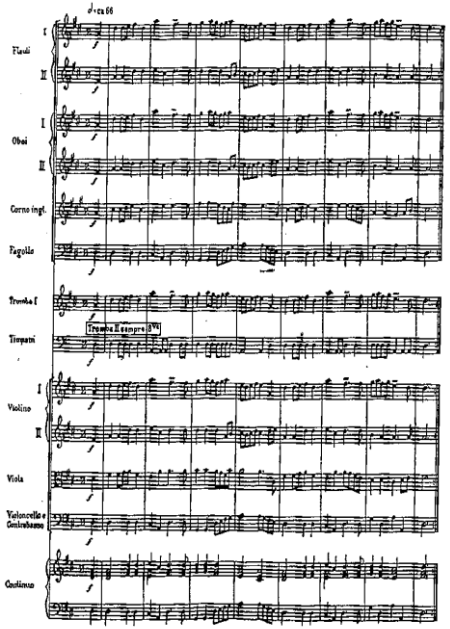
Definitions:

- Sound marks=any sign represented in an audio file and containing one or more sounds
- Motion marks=movement or change in motion, represented by audio file or sequential still images
- Multimedia marks=combination of image and sound, represented by audio-visual file
- Hologram marks=image that changes its appearance when looked at from different angles, represented by video file or series of images

Examination of formal requirements: issues

Sound marks: definition and representation

EUTM 000907527/14.08.1998



Examination of formal requirements: issues

Sound marks: definition and representation

EM500000017897782 (3).mp3

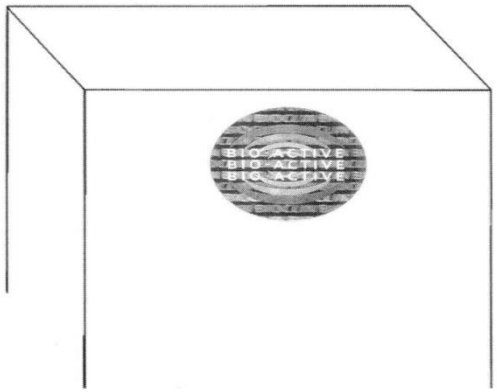
EM500000017932277.mp3

EM500000017995026.mp3

Examination of formal requirements: issues

Hologram marks: definition and representation

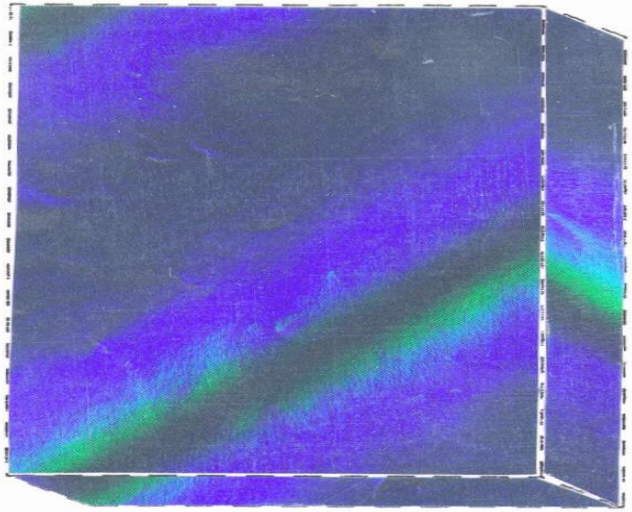
EUTM 001787456/01.08.2000



Examination of formal requirements: issues

Hologram marks: definition and representation

EUTM 002559144/01.02.2002



Examination of formal requirements: issues

Motion marks: definition and representation

Motion mark 1.mp4

Motion mark 3.mp4

Motion mark 4.mp4

Examination of formal requirements: issues

Multimedia marks: definition and representation

Multimedia mark 1.mp4

Multimedia mark 2.mp4

Multimedia mark 3.mp4

Multimedia mark 4.mp4

Issues with examination of formalities:

- Description of the mark: what if the description is not in line with the representation of the mark? Extension of scope?
- Verbal elements included in the new types of marks: extension of the scope of protection of the mark?
- Conflict or discrepancy between the representation of the mark and the type or the description

Issues with examination of formalities

- Graphical representation of sound marks (musical notations): sound mark or figurative mark?
- Graphical representation of motion marks as a sequence of still images: motion mark or figurative mark?

The priority claims issue

Clear case: identical subject matter of protection and same type of mark

- Second filing of a different type but with identical subject matter
- Second filing with a different subject matter (e.g. melody played by different instruments, two filings with clapping images but the second also includes sound, first filing with image and sound whereas second only sound or image)

The priority claims issue

Same type of marks, represented differently:

- Two sound marks, first filing in musical notation and second in audio file
- Two sound marks, first filing in audio file and played with specific instrument and second filing is a musical notation not containing the instrument
- Motion marks: first filing as a sequence of still images and second as video file (explanation of the sequence? duration, speed, repetitions?)

Examination of absolute grounds

- Assessment of clarity and precision of new types of marks: technically accessible? intelligible? concept not important
- Required degree of distinctiveness for sound marks: shortness of sound mark? sound overly complex in sound mark? recognizable as a badge of origin for consumers? exclusively non-distinctive elements?

Examination of absolute grounds

- Assessment of distinctiveness of motion marks: overly complex motion not capable of conveying a message that consumers may remember? shortness of video file? banality of the element included in the motion mark? exclusively non-distinctive elements?
- Assessment of distinctiveness of multimedia marks: both image and sound overly complex? banality of image and sound? shortness of video?

Examination of absolute grounds

Examination of descriptiveness:

Link between the sound and the goods easily made in sound marks?

If the elements in the motion mark show a realistic depiction of the goods or services?

If the depiction, though, is unconventional?

Both image and sound descriptive in multimedia mark?

New types of trademarks

- New challenges for Offices
- New challenges for IP practitioners
- Interesting work for FICPI!

Thank you for your attention!

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Expertise in the pharmaceutical and industrial chemistry sectors. His extensive experience in the pharmaceutical sector focuses on working with clients engaged in drug discovery and development. He has advised on the protection of numerous drugs from initial discovery, many of which are in clinical trials, and one which is approved in many jurisdictions, and on strategies to further protect these commercial drugs across the globe. He also advises on design protection.

Robert was President of FICPI-UK from 2011 to 2015 and is currently Vice-President of FICPI's Work and Study Commission (CET) in which capacities he has met with the European Commission, EPO, EUIPO, WIPO and other patent offices.

BREXIT update

Robert Watson
Singapore November 2019
Immediate Past-President, FICPI-UK
Vice-President, Work & Study Group

Latest Extension

- The most recent extension of the Article 50 (departure) process is until 31 January 2020

- Three scenarios (still)
  - No-deal Brexit
    - European Union (Withdrawal) Act 2018 governs
  - Deal Brexit
    - Withdrawal Agreement governs
  - Future-relationship Brexit

UK Political Situation

- Political Deadlock in UK Parliament has led to continuous delays in the BREXIT process
  - No majority government since June 2017
- General Election happening on 12 December 2019
  - Outcome *may* determine how the future process will play out
- Some of the dates may change again!

No Deal EUTMs/RCDs

- EUTM/RCDs will give rise to a comparable UK right on BREXIT day
  - Retaining {seniority,} priority and filing dates
  - No official fees
  - Possibility of opting-out of re-registration

No Deal EUTMs/RCDs

- Licence continues to have effect in UK
- Existing injunction continues to have effect in UK
- Pending proceedings in a Community Court in UK will only have effect on the re-registered UK trade mark
- Use in the EU of EUTM before will count as relevant use for protection against revocation for non-use of comparable UK trade mark

No Deal EUTMs/RCDs

- Number allocated to the comparable mark will be the last 8 digits of the EUTM prefixed with UK009
  - EUTM = 017867542 → UKTM = 00917867542
- Number allocated to the comparable design will be full RCD number prefixed with 9
  - RCD = 0040480985-0004 → UK Des = 900404809850004

No Deal EUTMs/RCDs

- Pending EUTM/RCD applications need to be refiled
  - Within 9 months
  - Treated as a new UK application (fees payable)
  - Retain {seniority,} priority and filing date

- EUTMs/RCDs which are part of a Madrid/Hague Registration will also give rise to a UK comparable right

UCDs – No-deal

- Existing Unregistered Community Designs (UCDs) become “continuing unregistered Community Designs”
  - Same rights as UCD, but enforced in a UK court
- New right created – “supplementary unregistered designs”
  - Based on the UCD, but for the UK only

Patents

- European Patents
  - No change (EPO not an EU institution)
- Unitary Patents
  - Future still unclear
- Supplementary Protection Certificates (SPCs)
  - System continues
  - Term of new SPCs will run from first marketing in UK or EEA (to mirror existing UK SPCs)

Representation Rights

- EPO (Patents)
  - No change
- EUIPO (Trade Marks/Designs)
  - UK-based/nationality representatives will lose rights (no-deal and current deal)
  - Many UK firms now how EU27 offices, to represent in UK and EU

BREXIT update

Robert Watson

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