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Patent Prosecution Update

May 2011

Patent Profanity and Its Haunting Effects

The claims of a patent determine the limits of its enforceable property right. However, the scope of a patent's claims often is a highly contested issue. When a patent is the subject of a lawsuit, courts begin their assessment of the case by interpreting the contested claim language. The Patent Act lends little guidance to the interpretation. Instead, courts have broad discretion, guided by Federal Circuit precedent, in giving meaning to claim terms. To identify the meaning of a particular claim term, courts typically look to the specification and the prosecution history. Once the court determines the metes and bounds of a claim, it then can begin its infringement analysis. [More](#)

USPTO Program Gives Applicants More Time to Decide on Pursuing a Patent

The U.S. Patent and Trademark Office (USPTO) recently began piloting an Extended Missing Parts Program (Program). According to the USPTO, the Program is expected to benefit applicants by inexpensively permitting additional time for determining if patent protection should be sought, thereby allowing applicants to focus resources on commercialization efforts during the extended period. The Program benefits the USPTO and the public at large by (1) removing from the USPTO's backlog those applications for which examination is no longer desired and (2) adding publications to the body of prior art. See Pilot Program for Extended Time Period to Reply to a Notice to File Missing Parts of Nonprovisional Application, 75 Fed. Reg. 76,401 (Dec. 8, 2010). [More](#)

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Patent Profanity and Its Haunting Effects

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As a result of looking beyond the claims, however, some words and phrases, when used in the patent specification or in communications with the U.S. Patent and Trademark Office (USPTO), can inadvertently lead a court to attach an unintended (and sometimes unfavorable) meaning to a claim term.

While perfectly appropriate for day-to-day conversations, when used in a patent specification, these words and phrases are considered “patent profanity.” Using “patent profanity” opens the door for reading limitations into patent claims and limiting the range of protection afforded by the patent.

Accused infringers can use instances of “patent profanity” in the asserted patent to suggest a narrow claim scope to the court. For example, T-Mobile USA, Inc. (T-Mobile) escaped an infringement verdict due to its opponent’s use of the phrase “very important feature” in its patent. In that case, the patentee described a direct parallel bus interface of its invention as a “very important feature” in the patent specification. This allowed T-Mobile to argue that because its product did not contain this “very important feature,” it did not infringe the patent-at-issue. Persuaded by T-Mobile’s arguments, the court limited the scope afforded by the patent’s claims to include direct parallel bus interfaces and found in favor of T-Mobile. *Inpro II Licensing, S.A.R.L. v. T-Mobile USA, Inc.*, 450 F.3d 1350 (Fed. Cir. 2006).

Courts can also look to communications with the USPTO to interpret claim scope. In a recent case, Mylan Pharmaceuticals, Inc. (Mylan) persuaded the court to limit Pharmacia & Upjohn Company’s (Upjohn) claim scope based on Upjohn’s use of “patent profanity” in a communication with the USPTO. Mylan pointed out that in a response to a prior art rejection, Upjohn argued that “the use of spray-dried lactose is a critical feature of the present invention,” and that “the key feature of the present invention is the particular type of lactose employed in the composition.” After considering Mylan’s arguments for a narrow reading of the claims due to Upjohn’s use of the terms “critical feature” and “key feature,” the court interpreted Upjohn’s claim to require spray-dried lactose. Because Mylan’s product lacked this “key feature,” the court found no infringement on Mylan’s behalf. *Pharmacia & Upjohn Co. v. Mylan Pharm., Inc.*, 170 F.3d 1373 (Fed. Cir. 1999).

Another recent case demonstrates that care must be taken when amending patent claims. Upon amending its claims, Biovail Corporation International (Biovail) included the term “necessarily” in its associated remarks to the USPTO. Biovail’s opponent, Andrx Pharmaceuticals, Inc. (Andrx), capitalized on the use of the term “necessarily” to argue for a narrow claim construction. Andrx argued that Biovail’s patent should be limited based on an argument made in response to a rejection that a bead produced by

the claimed extrusion-spheronization process “is necessarily a homogeneous bead composition.” The court agreed with Andrx, causing Biovail to lose priority for a later-filed application and allowing Andrx to escape infringement. *Biovail Corp. Int’l v. Andrx Pharm., Inc.*, 239 F.3d 1297 (Fed. Cir. 2001).

The Federal Circuit once again highlighted the effects of “patent profanity” in *Research Corp. Technologies, Inc. v. Microsoft Corp.*, 627 F.3d 859 (Fed. Cir. 2010). In this recent case, Research Corporation Technologies, Inc. (Research Corp.) filed a patent seeking to claim priority of earlier-filed parent applications. However, Microsoft Corporation (Microsoft) argued that Research Corp.’s use of the characterizations “the present invention” and the “objects of the invention” in the specification of the parent applications strongly suggested that the claimed invention is limited in scope. Because of these assertions, the court sided with Microsoft and read the claims narrowly.

The ultimate goal in patent drafting and prosecution is to afford inventors an opportunity to realize the full scope of protection for their intellectual property. The use of “patent profanity” during application drafting and prosecution, however, can undermine that opportunity by leading to narrow interpretations of claim terms. To prevent some of the outcomes described above, patent drafters and prosecutors should minimize the use of words of characterization when describing the invention. These types of words include, but are not limited to, chief, majority, critical, essential, necessary, solely, only, main, significant, principal, important, fundamental, and vital. Doing so will help to prevent future unintentionally narrow interpretations of claims.

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USPTO Program Gives Applicants More Time to Decide on Pursuing a Patent

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The Program, which extends through December 8, 2011, establishes procedures for requesting a nonextendable twelve-month time period in which to perfect the filing of a nonprovisional application that claims the benefit of an earlier-filed provisional application. Participation in the Program effectively extends the twelve-month provisional period by providing an applicant with an additional twelve months after the filing of a nonprovisional application in which to decide whether to pay the necessary search, examination, and any excess claims fees, and pursue the nonprovisional application.

To take advantage of the additional twelve-month period, an applicant must file an original nonprovisional application within twelve months of the filing of a provisional application and directly claim the benefit of the provisional application. The nonprovisional application should satisfy all of the requirements for claiming the benefits of priority to the nonprovisional application. Simultaneously with the nonprovisional filing, the applicant also must submit a certification and request to participate in the Program, preferably by using Form PTO/SB/421, entitled "Certification and Request for Extended Missing Parts Pilot Program." In addition, the applicant must not have filed a nonpublication request, and the application should include all of the parts necessary to receive a filing date and be in condition for publication.

Among other things, submission of the basic filing fee, an executed oath or declaration, and any required application size fee are required to place an application in condition for publication.

If an application is deemed not to be in condition for publication because, e.g., it was not filed with the basic filing fee or a declaration, and the applicant has submitted a certification and request to participate in the Program, the USPTO will accept the applicant's request. However, the USPTO will issue a Notice to File Missing Parts of Nonprovisional Application that sets an extendable two-month period for correcting the application filing to place it in condition for publication. In addition, the Notice will set a nonextendable twelve-month period for submitting the search, examination, and any excess claims fees.

If the applicant did not pay the search and examination fees at the time of filing, a surcharge of \$130.00 (\$65.00 for small entity) will be required when paying those fees. Otherwise, no additional fees are necessary to participate in the Program.

It is worth noting that the change in missing parts practice has no effect on the twelve-month priority period provided under the Paris Convention for the Protection of Industrial Property. Thus, all foreign applications intended to rely on the provisional application must still be filed within twelve months of the provisional application filing date. The same would also apply to applications that are to be filed in

countries requiring filing within twelve months of the earliest application filing.

Additional information about the USPTO Extended Missing Parts Pilot Program may be found at <http://edocket.access.gpo.gov/2010/pdf/2010-30822.pdf>.

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Rule Review

Rule 1.47 provides a mechanism for filing a patent application when one or more inventors refuse to join in the application or cannot be found or reached after diligent effort. According to subpart (a), an application may be filed by a co-inventor on behalf of himself or herself and any nonsigning inventor by submitting (1) an oath or declaration executed by the co-inventor, (2) a petition including proof of the pertinent facts, (3) a fee of \$200.00, (4) and the last known address of the nonsigning inventor. The Rule also affords the nonsigning inventor an opportunity to later join in the application by submitting an appropriate oath or declaration.

If all of the inventors refuse to execute an application, or cannot be found or reached after diligent effort, subpart (b) allows an assignee or other entity that shows sufficient proprietary interest to file the application on behalf of and as agent for all of the inventors. In this instance, the oath or declaration in the application must be accompanied by (1) a petition including proof of the pertinent facts, (2) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, (3) the \$200.00 fee noted above, and (4) the last known addresses of all of the inventors. Here again, any inventor may later join the application by submitting an appropriate oath or declaration.

Upon receipt of all necessary materials, the U.S. Patent and Trademark Office (USPTO) will notify all nonsigning inventors of the application filing at the addresses provided in the petition accompanying the oath or declaration. In addition, the USPTO will publish notice of the application filing in the *Official Gazette*.

Finally, continuing and divisional applications may be entitled to the benefits afforded under Rule 1.47 to their parent applications upon submission of a copy of the declaration and the USPTO decision according Rule 1.47 status to the parent case. However, a new declaration and petition are required for continuation-in-part applications.

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The Federal Circuit Says

A method claim is directly infringed only if each step of the claimed method is performed by a single party. In *McKesson Technologies Inc. v. Epic Systems Corp.*, No. 2010-1291 (Fed. Cir. Apr. 12, 2011), the Federal Circuit found that Epic Systems Corporation (Epic) did not infringe McKesson Technologies Inc.'s (McKesson) patent because no single party performed every step of the asserted method claims.

Although McKesson conceded that neither Epic nor its customers performed the first step of the asserted claims, it accused Epic of indirect infringement by inducement. However, the Court explained that a finding of indirect infringement still requires the existence of a direct infringer. To this end, the Court noted that direct infringement of a method claim requires a single party to perform each step of the claimed method.

The asserted McKesson claims are directed to a method of communication between a healthcare provider (e.g., a doctor) and a number of users (e.g., patients) serviced by the provider. Among other things, the asserted method requires "initiating a communication by one of the . . . users to the provider." The accused Epic product is the MyChart software. The MyChart software allows healthcare providers and patients to exchange information and communicate through a personalized web page assigned to each patient. While Epic does not use the MyChart software, it licenses the software to healthcare providers. "These licensed healthcare providers choose whether to offer MyChart as an option for their patients' use and none of these healthcare providers requires their patients to actually use the MyChart software." Slip op. at 3. If a patient chooses to utilize the MyChart option, that patient "initiates a communication" to the provider.

Recognizing that neither Epic nor its customers performed the "initiating step," McKesson attempted to attribute the actions of MyChart users to the MyChart providers (i.e., Epic's customers). In particular, McKesson argued that the special nature of the doctor-patient relationship was sufficient to provide attribution. The Court, however, found that the doctor-patient relationship neither gives rise to an agency relationship nor imposes any contractual obligations on the patients. That is, a patient is not required to follow a doctor's orders. The actions of the MyChart users can only be attributed to Epic's customers if (1) Epic's customers exercised "control or direction" over the MyChart users or (2) Epic's customers imposed a contractual obligation on their patients. Based on the evidence, the Federal Circuit found neither.

Relying on its previous ruling in *Akamai Technologies, Inc. v. Limelight Networks, Inc.*, 629 F.3d 1311 (Fed. Cir. 2010), the Federal Circuit concluded that the MyChart users acted principally for their own

benefit, under their own control, and were in no way agents of Epic's customers. Thus, the Court found that the actions of MyChart users were not attributable to Epic's customers and there was no single direct infringer. Absent direct infringement, the Court held that Epic was not liable for indirect infringement.

To support its holding, the Federal Circuit reasoned that "in patent law, unlike in other areas of tort law, the patentee specifically defines the boundaries of his or her exclusive rights and provides notice to the public to permit avoidance of infringement. This stands in sharp contrast to the circumstances surrounding a joint tort where the victim has no ability to define the injurious conduct upfront and where, absent joint liability, the victim would stand uncompensated as a consequence." *McKesson*, slip op. at 10. Thus, the Court effectively advocated for better claim drafting as a potential solution to joint infringement scenarios.

Notwithstanding the *McKesson* decision, the Federal Circuit granted an en banc rehearing in the *Akamai* case on April 20, 2011. In doing so, the Court requested the parties brief the following issue: If separate entities each perform separate steps of a method claim, under what circumstances would that claim be directly infringed and to what extent would each of the parties be liable?

Arguments made by Judge Newman in her dissent in the *McKesson* case will likely be at the forefront of this rehearing. In that dissent, Judge Newman argued that the rulings of the *McKesson* and *Akamai* cases contradict both statute and precedent by rendering claims requiring actions of multiple parties useless even though they otherwise meet statutory guidelines. Judge Newman reasoned that a patent that can never be infringed is not a patent in the definition of the law because a patentee owning such patent does not have the "right to exclude."

While the law may change at the en banc rehearing of *Akamai*, for now, applicants should carefully draft claims directed to only one entity's activities to avoid joint infringement situations. When dealing with patents that have already issued, a pending continuation application or a reissue application may be used to secure claims directed toward a single infringer. Doing so will likely simplify the efforts needed to prove infringement.

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Did You Know?

Once a patent application publishes, the U.S. Patent and Trademark Office (USPTO) expressly prohibits third-party submissions without the express written consent of the applicant. See M.P.E.P. § 1134. The USPTO does, however, allow third parties to submit patents or publications for consideration in a published application, with no further comment or explanation, pursuant to 37 C.F.R. § 1.99. See M.P.E.P. § 1134.01. Thus, any third-party activity that is not pursuant to 37 C.F.R. § 1.99 in a published application in which the applicant has not provided express written consent is considered to be inappropriate. Such activity includes third-party inquiries into the timing of future actions and even third-party suggestions that the USPTO withdraw from issue an unpatentable claim. To this end, the USPTO instructs its examiners to (1) not reply to any third-party inquiry or other submission in a published pending application; (2) not act upon any third-party inquiry or other submission in a published application, except where the submission complies with 37 C.F.R. § 1.99 or the applicant has provided consent; and (3) decline to accept oral or telephone comments or submissions about published applications from third parties. Further, the USPTO may refer prohibited contacts by registered practitioners in published applications to the Office of Enrollment and Discipline for appropriate action. See M.P.E.P. § 1134.

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