Computers and the Law
Legal Environment

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CLASS 7

Patents pt. 3;
Domain Names pt. 1
Questions

- What does a patent application or patent include?
- How do you infringe a patent?
- What is the AIA and how did it change patent law?

Prosecution

- How do I go from patent application to patent?

Prosecution

- The process of negotiation with the United States Patent and Trademark Office (USPTO) in an attempt to obtain issuance of a patent application.

Prosecution Overview

- Step 0 – Prepare an invention disclosure form
- Step 1 – Identifying person to draft (and likely prosecute) patent application
  - Applicant
  - Patent attorney or agent
- Step 2 - Prior Art search
  - Not required… but highly recommended
- Step 3 – Determine whether an application should be filed
  - Provisional
  - Nonprovisional
- Step 4 – Prepare and file the application
- Step 5 – Prosecution
- Step 6 – Issuance or Abandonment
- Step 7 – Continuation Applications?
Types of Applications

Five Types of Applications
• Original
• Continuation
• Continuation-in-Part (CIP)
• Divisional
• Provisional

What is Prosecution?

• Negotiation by inventors or their representatives as by patent counsel or patent agent with a patent examiner & other PTO officials administratively in procedures involving the patent application, examination, amendment, continuing procedures and patent grant.

Examination of non-provisional applications (“utility applications”) steps at PTO:
• A patent examiner takes up the application in order from a queue of cases
• Examiner begins an examination of the application
• Examiner considers whether the application is in condition to examined

Examination by Patent Office

• For formal requirements
• Required inventor(s) declaration
• Necessary fees
• All necessary parts & papers
• A description and at least one claim
• That drawings meet specific requirements
• No drawings sometimes in chemical cases

Examiner conducts search of the prior art
• In classes and subclasses considered pertinent
• Patents both domestic and foreign
• Technical publications available to examiner to a limited degree
• Include technical journals and texts
• Usually some patents are cited

Examiner’s review of application

• Examiner considers whether application (with its claims)
  – Meets requirements of Patent Laws
• Examiner considers whether claims of application meet certain requirements:
Examiner considers whether claims of application--

• Define patentable inventions (35 USC 101)
• Define inventions that are novel (35 USC 102) over prior art (P/A)
• Define inventions that are unobvious (35 USC 103) over P/A
• Examiner then writes a summary of the examination called an “Official Action” or “Office action” (OA)
• Provides OA to applicant or representative.

Office Action

Summarizes the findings of examiner

• As to each claim specifically
• I.e., rejects each claim or allows it or indicate allowable if amended
• As to each objection to drawings
• As to each objection to specification

Office Action date & response

Has a date of mailing and from that date sets a date for response by applicant:

• Typically 3 mo. for substantive rejections or
• Shorter (e.g., 1 mo.) for informal requirements such as requiring applicant to elect between different species of claimed inventions regarded by examiner as independent (e.g., method and apparatus)

Response by applicant to Office Action

• Must address each point of rejection.
• May argue that rejection was improper.
• May present amendments to overcome rejections.
• May amend claims, as by limiting them to avoid P/A.
• Must be submitted within period allowed.
• Extensions (with fees) permitted but with risk of shortening statutory term of patent.

Further Office Action possible

• Might be a Notice of Allowability.
• Might allow some claims.
• Might apply other objections, as based on further search.
• Might be a final rejection.

Further response by applicant

• Could put some other claims into allowable condition.
• Could provide further arguments and/or amendments.
• Cannot add additional claims.
• May not raise new issues.
• Could be valuable even if not successful (“not entered”) by opening the possibility of amendments in a continuing application.
If further response by applicant successful--

- Notice of Allowability and Issue Fee Due will follow
- Issue Fee and Publication Fee will be due and payable by a date certain
- Patent will then issue typically some few weeks (e.g., ~3 mo.) after payment of issue fee.

Provisional versus Nonprovisional

<table>
<thead>
<tr>
<th>Provisional</th>
<th>Nonprovisional</th>
</tr>
</thead>
<tbody>
<tr>
<td>Smaller Filing fee</td>
<td>Larger Filing fee</td>
</tr>
<tr>
<td>Less preparation time</td>
<td>More preparation time</td>
</tr>
<tr>
<td>Can not amend</td>
<td>Amendments are possible</td>
</tr>
<tr>
<td>No claims required</td>
<td>Must have at least 1 claim</td>
</tr>
<tr>
<td>Not examined</td>
<td>Examined</td>
</tr>
<tr>
<td>Informal</td>
<td>More formal</td>
</tr>
<tr>
<td>Valid for only 1 year</td>
<td>Application valid until abandoned or patent issued</td>
</tr>
</tbody>
</table>

Provisional applications -- steps at PTO

- Application receives a filing date and serial number
- Application is considered only for identification of names and addresses of inventors, and for payment of fee
- Application will not be examined
- Application drawings may be informal
- Application need not include claims
- No substantive prosecution

Selecting the type of patent application

- Provisional Patent Application ("PPA") – a simplified set of requirements
- Non-provisional (Utility) Patent Application ("UPA" or "NPA")

Term of patent

- Patent will issue to be in effect 20 years from:
  - Date of first filing of this or parent application
  - Or as limited by delays of applicant during prosecution
  - E.g., extensions of time required by applicant
  - Or as limited by the lapse of a parent application
  - Or where terminal disclaimer was submitted to overcome a double patenting rejection
- Patent is subject to maintenance fees payable 3.5, 7.5 & 11.5 years after issuance

Continuation Possibilities

- Continuation – might claim other aspects disclosed but not claimed, or claimed in the same way as rejected claims
- Request for Continuing Examination (RCE) – removes finality of the office action (e.g., pay to play)
Other Continuation Possibilities

- Divisional Application (CPA)
  - To prosecute claims on independent invention
  - Examiner restricted cls. to independent invention
- Continuation-in-Part (CIP) Applicant
  - To add matter not present in earlier application
  - Where part or all of earlier application is present
- Timing of Filing of Continuation(s)
  - Before termination of proceedings in parent
  - Before payment of issue fee in parent

Choices other than continuation(s)

- Petition the Assistant Commissioner of Patents
  - Petition based on contended examiner error
  - Petition when examiner procedural error in question
  - Further appeal possible to U.S. District Court (District of Columbia)

Choices Other Than Continuation(s)

- Appeal to PTAB
  - Appeal is statutory (35 USC 134)
  - Issues re examiner's rejection of claims when level of invention &/or interp. of art in question
  - Tribunal is three senior examiners; considers:
    - Applicant's Brief on Appeal
    - Examiner's Brief on Appeal
    - Decides/remands to exam'r for further exam'n
  - Further appeal poss. to Fed. Cir. Ct. of Appeals

Publication of patent applications

- 18 months after filing unless applicant requests otherwise upon filing & certifies has not & won't be subject of an application filed in a foreign country
- Provisional rights available to patentees to obtain reasonable royalties if others make, use, sell, or import inv. in the period between publication and grant
- Applicant can consider if foreign counterparts will be sought after all, after non-publ. request (NPR).
- If applicant then files for foreign patent, must notify PTO in US application within 60 days & withdraw NPR. Application then is published ASAP
- PRIOR ART effect for published appls –Sec.102(e)

Inventorship

- Applications must be filed in the name of the true inventors
- Inventors must sign a declaration or an oath stating that they believe they are the first inventors.
- Joint inventorship of an invention is possible.

Joint Inventorship

- To avoid possible invalidity due to failure to name inventors make sure to name all inventors
- Inventive entities can be different for different claims:
  - A, B & C can have invented claim 1.
  - B & C can be inventors of claims 2 and 3, respectively.
  - A & C can be inventors as to claims 4 & 5, and so forth.
Important Right of Joint Inventors
• "In the absence of an agreement to the contrary, each of the owners of patent may make, use, offer to sell, or sell the patented invention with the United States, or import [it], without the consent of and without accounting to the other owners." [Section 262 of Patent Statutes (35 U.S.C. 262)]

Noninventors
• Supplies a component used with the invention
• "Hands of the Inventor" but did not conceive the invention
• Validity is compromised by misnomer of a person who is not an inventor

Duty of Disclosure
• Persons that are under the Duty of Disclosure include:
  ▪ Inventors
  ▪ Applicant
  ▪ Attorneys

Duty of Disclosure
• Types of Materials to be Disclosed:
  ▪ Known Prior Art
  ▪ Prior Art in Related US Matters
  ▪ Prior Art in Related Foreign Matters
  ▪ Advise PTO of related matters

Current Method of Disclosure
• Applicants submit one or more information disclosure statements (IDS) during prosecution to make the USPTO aware of any prior art

Timely IDS Submission
• Before a first office action: may be submitted without certification or fee
• After a first office action: may be submitted with a timeliness certification or a fee
• After allowance: may be submitted with a timeliness certification and a fee
• After payment of issue fee: may be withdrawn from issue, admission of unpatentability of at least one claim, and an amendment with explanation giving reasons why claim(s) patentable
Failure to Disclose

- Failing to disclose known prior art may result in a finding of inequitable conduct. An inequitable conduct finding makes a patent unenforceable even if the patent would otherwise be valid. In addition, an inequitable conduct finding may result in the patent attorney being liable for malpractice.

Critical points about candor & inequitable conduct

PTO relies on voluntary disclosure of information by an applicant, who has an uncompromising duty to disclose material facts to ensure that a patent issues free from fraud or inequitable conduct.

Critical points about candor & inequitable conduct

Candor and duty to disclose are at the heart of our U.S. patent system. The applicant has a duty to disclose material information bearing on patentability. All persons substantively involved in the patent application, preparation or prosecution must make such disclosures to the PTO.

Therasense, Inc. v. Becton, Dickinson & Co.

- Case History
  - D.C. – unenforceable due to inequitable conduct
  - En Banc Federal Circuit – vacates and remands

Therasense, Inc. v. Becton, Dickinson & Co.

- Invention
  - Disposable blood glucose test strips for diabetes management

Therasense, Inc. v. Becton, Dickinson & Co.

Claim 1
A single use disposable electrode strip for attachment to the signal readout circuitry of a sensor to detect a current representative of the concentration of a compound in a drop of a whole blood sample comprising:
  a) an elongated support having a substantially flat, planar surface, adapted for releasable attachment to said readout circuitry;
  b) a first conductor extending along said surface and comprising a conductive element for connection to said readout circuitry;
  c) an active electrode on said strip in electrical contact with said first conductor and positioned to contact said whole blood sample;
  d) a second conductor extending along said surface comprising a conductive element for connection to said readout circuitry; and
  e) a reference counterelectrode in electrical contact with said second conductor and positioned to contact said whole blood sample, wherein said active electrode is configured to be exposed to said whole blood sample without an intervening membrane or other whole blood filtering member.
Therasense, Inc. v. Becton, Dickinson & Co.

• After problems during prosecution, new claims were presented to the Examiner based on a new sensor that did not require a protective membrane for whole blood.
• The Examiner required an affidavit that, at the time of the invention, the prior art required a membrane for whole blood.

Therasense, Inc. v. Becton, Dickinson & Co.

• US patent counsel – “optionally, but preferably” language is patent phraseology and not a technical teaching
• European counsel – “It is submitted that this disclosure is unequivocally clear. The protective membrane is optional, however, it is preferred when used on live blood in order to prevent the larger constituents of the blood, in particular erythrocytes from interfering with the electrode sensor.”

Therasense, Inc. v. Becton, Dickinson & Co.

• D.C. – ‘551 patent unenforceable “for inequitable conduct because Abbott did not disclose to the PTO its briefs to the EPO filed on January 12, 1994 and May 23, 1995.”
• DC also found invalidity and nonfringement for the ‘551 patent and another patent at suit.

Therasense, Inc. v. Becton, Dickinson & Co.

• Panel on Fed. Cir – upheld with a dissent
• “Recognizing the problems created by the expansion and overuse of the inequitable conduct doctrine, this court granted Abbott’s petition for rehearing en banc and vacated the judgment of the panel.”

Therasense, Inc. v. Becton, Dickinson & Co.

• Effect of Inequitable Conduct – Defense to patent infringement – Bars enforcement of a patent when found
• Historical Inequitable Conduct – “egregious misconduct, including perjury, the manufacture of false evidence, and the suppression of evidence.” – “deliberately planned and carefully executed scheme[s] to defraud” not only the PTO but also the courts.

Therasense, Inc. v. Becton, Dickinson & Co.

• Evolution of Inequitable Conduct – “[E]mbrace[d] a broader scope of misconduct, including not only egregious affirmative acts of misconduct intended to deceive both the PTO and the courts but also the mere nondisclosure of information to the PTO.” – “[U]nenforceability of the entire patent rather than mere dismissal of the instant suit.”
Therasense, Inc. v. Becton, Dickinson & Co.

- "[I]nequitable conduct came to require a finding of both intent to deceive and materiality."
- "In the past, this court has espoused low standards for meeting the intent requirement, finding it satisfied based on gross negligence or even negligence."
- "This court has also previously adopted a broad view of materiality, using a 'reasonable examiner' standard based on the PTO's 1977 amendment to Rule 56."
- Sliding scale approach

Therasense, Inc. v. Becton, Dickinson & Co.

- Effects
  - Full disclosure
  - "[I]nequitable conduct has become a significant litigation strategy. A charge of inequitable conduct conveniently expands discovery into corporate practices before patent filing and disqualifies the prosecuting attorney from the patentee's litigation team."

Therasense, Inc. v. Becton, Dickinson & Co.

- "Unlike other deficiencies, inequitable conduct cannot be cured by reissue"
- "[T]he taint of a finding of inequitable conduct can spread from a single patent to render unenforceable other related patents and applications in the same technology family."
- "With [] far-reaching consequences, it is no wonder that charging inequitable conduct has become a common litigation tactic."

Therasense, Inc. v. Becton, Dickinson & Co.

- "This court now tightens the standards for finding both intent and materiality in order to redirect a doctrine that has been overused to the detriment of the public."

Therasense, Inc. v. Becton, Dickinson & Co.

- "To prevail on a claim of inequitable conduct, the accused infringer must prove that the patentee acted with the specific intent to deceive the PTO. ... A finding that the misrepresentation or omission amounts to gross negligence or negligence under a 'should have known' standard does not satisfy this intent requirement."
Therasense, Inc. v. Becton, Dickinson & Co.

• “[T]he accused infringer must prove by clear and convincing evidence that the applicant knew of the reference, knew that it was material, and made a deliberate decision to withhold it.”

Reissue/Reexamination

Correction of Substantive Errors

• Reissue – applicants correction of more significant errors affecting the validity and enforceability of an issued patent
• Reexamination – allows applicants or third parties to request that the PTO reconsider the validity of the patent

What I can do with Patented Articles?

• Repair – permissible
  – “Precedent has classified as repair the disassembly and cleaning of patented articles accompanied by replacement of unpatented parts that had become worn or spent, in order to preserve the utility for which the article was originally intended.”
• Reconstruction – impermissible
  – Reconstruction requires a more extensive rebuilding of the patented entity.
  – “The unrestricted sale of a patented article, by or with the authority of the patentee, ‘exhausts’ the patentee’s right to control further sale and use of that article by enforcing the patent under which it was first sold.”

Correction

• What if I need to fix my patent?
How Might Infringement Occur?

Infringement Inquiries

- First Inquiry - Does a device or method literally infringe one or more claims of a patent?
- Second Inquiry - Does a device or method infringe one or more claims of a patent under the doctrine of equivalents (DOE)?

Literal Infringement

- Inquiry - Does a device or method literally infringe one or more claims of a patent?

Markman v. Westview Instruments, Inc.

- Procedural Background
  - Federal Circuit en banc decision; Supreme court unanimously affirms this decision.
- Factual Background
- Issue:
  - Who determines claim construction—a jury or the court?

“Claims must be read in view of the specification, of which they are apart.”
“... [A] patentee is free to be his own lexicographer ... [but] any special definition must be clearly defined in the specification.”
Court may also consider:
- Prosecution history (if in evidence)
Markman v. Westview Instruments, Inc.

- "Extrinsic evidence may demonstrate the state of the prior art at the time of the invention."
- "Extrinsic evidence consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises ... and may demonstrate the state of the art at the time of the invention."

Markman v. Westview Instruments, Inc.

- "An infringement analysis entails two steps. The first step is determining the meaning and scope of the patent claims asserted to be infringed. The second step is comparing the properly constructed claims to the device accused of infringing."
- "... [I]n a case tried to a jury, the court has the power and obligation to construe as a matter of law the meaning of language used in the patent claim."

Markman v. Westview Instruments, Inc.

- Ruling
  - Affirmed the judgment of the noninfringement.
- Holding
  - "... [W]e conclude that the interpretation and construction of patent claims, which define the scope of the patentee's rights under the patent, is a matter of law exclusively for the court."
- Dicta

Markman v. Westview Instruments, Inc.

- Supreme Court
  - Judges are better suited to interpret the patents
  - Uniformity of interpretation

Trial procedure effect of Markman?

- Resolution of meaning of disputed patent terms by use of a Markman hearing and ruling by judge can be binding on litigants and may have effect of a final determination so that a full-blown trial before a jury may never occur.

Markman v. Westview Instruments, Inc.

- This means JUDGE not JURY will construe the language of claims.
- Can have major effect on the way patent infringement trials are conducted
- Before case is presented to jury, which must decide issues of FACT
- Judge may decide issues of LAW by construing claim language.
Trial procedure changed by Markman

- Or effect of Markman will leave a clearer set of issues of fact which are to be decided by jury at trial. But ...
- Ultimately the jury factually determines whether there is infringement unless the claims have been so construed by judicial ruling after Markman hearing as to preclude an infringing interpretation. The overall effect of Markman v. Westview Instruments has had the practical effect of making patent infringement suits a multistage affair in which the Markman hearing often determines the outcome of the litigation before trial before jury occurs.

Claim Construction

- Intrinsic
  - Claims
  - Specification
  - Prosecution History
- Extrinsic
  - Inventor testimony
  - Dictionaries
  - Learned treatises

Teva Pharmaceuticals USA v. Sandoz

- Supreme Court 2015
- History
  - D.C. – claim sufficiently definite and patent valid
  - Fed. Cir. – molecular weight indefinite and patent invalid

Teva Pharmaceuticals USA v. Sandoz

- Issue
  - By what standard should claim construction of the district court be reviewed on appeal?

Teva Pharmaceuticals USA v. Sandoz

- “Federal Rule of Civil Procedure 52(a)(6) states that a court of appeals ‘must not . . . set aside’ a district court’s ‘[f]indings of fact’ unless they are ‘clearly erroneous.’ In our view, this rule and the standard it sets forth must apply when a court of appeals reviews a district court’s resolution of subsidiary factual matters made in the course of its construction of a patent claim.”

Teva Pharmaceuticals USA v. Sandoz

- “When describing claim construction we concluded that it was proper to treat the ultimate question of the proper construction of the patent as a question of law in the way that we treat document construction as a question of law. . . But this does not imply an exception to Rule 52(a) for underlying factual disputes.”
Teva Pharmaceuticals USA v. Sandoz

- “[T]he Federal Circuit will continue to review de novo the district court’s ultimate interpretation of the patent claims … [S]ubsidiary fact finding is unlikely to loom large in the universe of litigated claim construction.”

Additional Claim Interpretation Notes

- “To literally infringe, an accused product or process must include each and every limitation of a claim. Therefore the omission of any limitation is fatal to literal infringement.”
- “… [W]here the patent documents are unambiguous, expert testimony regarding the meaning of a claim is entitled to no weight.”

Other Types of Infringement

**INDIRECT INFRINGEMENT**

- Active Inducement ([§271(b)])
  - “Whoever actively induces infringement of a patent shall be liable as an infringer.”
- Contributory Infringement ([§271(c)])
  - “Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.”

Patent Reform Analysis

- H.R. 1249 Leahy-Smith America Invents Act or AIA
  - Status – Passed
  - Further reforms still being discussed
- Rules Implementing Passage of AIA
  - Status – Rules are passed
- Case Law
  - Status – To be developed

Form of Patent Reform
When Do the Provisions of AIA Go Into Effect?

• Day of Enactment Sept 16, 2011
• 10 Days Sept 26, 2011
• Oct 1, 2011
• 60 Days Nov 15, 2011
• 12 Months Sept 16, 2012
• 18 Months Mar 6, 2013

Best Mode

• “[T]he failure to disclose the best mode shall not be a basis on which any claim of a patent may be canceled or held invalid or otherwise unenforceable”
• Best mode is effectively dead
• However, there is still value in disclosing as claims may be narrowed during prosecution

Human Organism Prohibition

• “[N]o patent may issue on a claim directed to or encompassing a human organism.”
  – Contrast to claims on other microorganisms or organisms
• Applies to any application for patent that is pending on, or filed on or after, the date of enactment

Virtual Marking

• “Patentees, and persons making, offering for sale, or selling within the United States any patented article for or under them, or importing any patented article into the United States, may give notice to the public that the same is patented, either by fixing thereon the word “patent” or the abbreviation “pat.”, together with the number of the patent, or by fixing thereon the word ‘patent’ or the abbreviation ‘pat’, together with an address of a posting on the Internet, accessible to the public without charge for accessing the address, that associates the patented article with the number of the patent, or when …”
  • Allows an additional option for marking…

False Marking

• Denies standing for any false marking complainant who cannot prove a competitive injury
• Provision is retroactive
• Many false marking claims have already been dismissed

Prioritized Examination

• Track 1
  – $4,800 Examination fee (50% reduction for small entity)
  – Final disposition on average within 12 months from examination request grant
  – Must be filed by EFS-WEB
  – Max of 4 indep. and 30 total claims
• What if you want to expedite an already filed patent application?
Third Party Submission

- Allows third parties to submit printed publications of potential relevance to examination.
  - Provide a written explanation of the relevance of the submitted documents.
  - Pay a fee.
  - Include a statement affirming that the submission is being made in compliance with new 35 U.S.C. 122(e).
- Timing limitations on submission
- As an alternative, third parties can continue to provide prior art to the Applicant
- However, value of Examiner review of explanation versus possible prejudicial view of explanation in potential litigation should be considered

Supplemental Examination

- Filed by the patent owner to “consider, reconsider, or correct” information believed to be relevant to the patent.
- USPTO must conduct supplemental examination and conclude it by issuing a certificate indicating whether the information raises a substantial new question of patentability (SNQ) within three months of the supplemental examination request date.
- Probably being implemented to reduce the number of reexaminations conducted by a patent owner in anticipation of possible litigation
- Enables the USPTO to make a “pre-ruling”

Citation of Prior Art

- Any person at any time may cite prior art consisting
  - of patents and printed publications to the PTO if the reference has a bearing on patentability of a claim
  - statements of the patent owner filed in a proceeding before a Federal court or the Office in which the patent owner took a position on the scope of any claim of a particular patent
- Explanations of the prior art are also included in the file

Priority Examination

- Provides statutory basis for the Director to have the PTO prioritize examination of certain technologies “that are important to the national economy or national competitiveness” without recovering cost

Inter Partes Review

- On the date of enactment, the standard changed from a “substantial new question of patentability” to a higher standard of “a reasonable likelihood that the requestor would prevail”
- One after enactment, inter partes reexamination will become inter partes review, where the new standard will be adjudicated by the PTAB
  - Only 102 and 103 grounds; only patents and printed publications
  - Third party may submit petition after later of 9 months from issuance or termination of post grant, whichever is later
  - Director may limit during first four years

Post-Grant Review

- 9-month window for reviewing patentability
- Threshold – “more likely than not” that at least one of the challenged claims is unpatentable
- Generally limited to first-to-file patents
18 Months Mar 16, 2013

- First-to-File
- Derivation proceedings
- Repeal of Statutory Invention Registration

First-to-File

- First-to-file with one year grace period
- Prior public use or prior sale anywhere counts as prior art
- U.S. patents and patent application publications are effective as of priority date—even if international

Derivation Proceeding

- Conducted at the Board to determine whether (i) an inventor named in an earlier application derived the claimed invention from an inventor named in the petitioner’s application, and (ii) the earlier application claiming such invention was filed without authorization.
- An applicant:
  - Must be subject to the first-inventor-to-file provisions
  - Must file a petition to institute a derivation proceeding within 1 year of the first publication of a claim to an invention that is the same or substantially the same as the earlier application’s claim to the invention.
- Petition must be supported by substantial evidence that the claimed invention was derived from an inventor named in the application

Satellite Offices

- USPTO to create 3 or more satellite offices within 3 years
  - Examiners must work in D.C. but may participate in hoteling
- Detroit satellite office is up and running
- Other offices are Dallas, Denver, and Silicon Valley

First-to-File

- Focus is on a patent applicant's “effective filing date” and whether prior art existed before that date
- Eliminates current Section 102(g), interferences, and questions of conception, diligence, reduction to practice, abandonment, suppression, and concealment.

New 102 After AIA

(a) NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—
(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or
(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.
New 102 After AIA

• (b) EXCEPTIONS.—
  • (1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.—A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—
    • (A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or
    • (B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

• (2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.—A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—
  • (A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;
  • (B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or
  • (C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

New 102 After AIA

• (c) COMMON OWNERSHIP UNDER JOINT RESEARCH AGREEMENTS.—Subject matter disclosed and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person in applying the provisions of subsection (b)(2)(C) if—
  • (1) the subject matter disclosed was developed and the claimed invention was made by, or on behalf of, 1 or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention;
  • (2) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and
  • (3) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

New 102 After AIA

• (d) PATENTS AND PUBLISHED APPLICATIONS EFFECTIVE AS PRIOR ART.—For purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), such patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application—
  • (1) if paragraph (2) does not apply, as of the actual filing date of the patent or the application for patent; or
  • (2) if the patent or application for patent is entitled to claim a right of priority under section 119, 365(a), or 365(b), or to claim the benefit of an earlier filing date under section 120, 121, or 365(c), based upon 1 or more prior filed applications for patent, as of the filing date of the earliest such application that describes the subject matter.

How Does the Grace Period Work?

• Inventor must disclose the invention publicly first
  – Less than one year before filing
  – Before a third-party discloses
• How will proof of disclosure be measured?
  – Don’t know
• Is experimental use still a viable exception?
  – Don’t know

Domain Names pt. 1
Domain Names

• Identifying what is a domain name
• Determining domain name availability
• Determining domain name ownership
• Registering a domain name
• Domain Name Disputes (UDRP & ACPA)

DOMAIN NAMES

• A domain name is a string of characters acting as an Internet identifier that simplifies the Internet location of an entity's web site, such as MyWebsite.com.
• http://www.yahoo.com is a uniform resource locator (URL) that includes a domain name, a server accessed at the domain name, and the protocol being used to access the domain name.

ESSENTIAL DEFINITIONS

• Registrar – a company that sells available domain names to end consumers pursuant to its relationship with one or more domain name registries
• Registry – an entity responsible for allocating unique domain names within a particular country code or top level domain
• WHOIS record – a record that provides detailed information for a particular domain name, which typically includes a registrant and an administrative contact

DOMAIN NAME AVAILABILITY

• The availability of a domain name may be determined by trying to obtain a WHOIS record for a desired domain name or by entering the domain name into the registration request page at a domain name registrar or an applicable registry.
• Certain registrars have automated tools to determine availability of domain names from gTLDs and ccTLDs

DOMAIN NAME OWNERSHIP

• Domain name ownership may be determined by accessing a WHOIS record for the domain name.
• Certain registrars have automated tools to create a report of domain names incorporating one or more terms and associated WHOIS records.

• The registrant is really the domain name owner, even if he/she/it is not the person using the domain name.
• The administrative contact has the power to modify the domain name, including changing registrant information and accepting change of registrars.
OBTAINING A WHOIS RECORD

• The WHOIS records for some domain name extensions (e.g., .com and .net) are decentralized.
• To obtain the WHOIS records for decentralized extensions, you may need to visit the registry to first identify the registrar associated with the domain name and then visit the registrar to obtain the WHOIS record.
• To obtain the WHOIS records for centralized extensions (.us, .info, and .biz), visit the registry.
• Several sites such as the WHOIS available at Network Solutions and ALLWhois.com contain a number of WHOIS records from a variety of registries and registrars.

REGISTERING A DOMAIN NAME

• First come, first served
• Select a registrar
• Access an established account or create a new account
• Identify the registrant, contacts, and hosting information
• Select any desired additional services
• Enter credit card information
• Print a receipt
• Print out a copy of the WHOIS record

DOMAIN NAME PORTFOLIO MANAGEMENT

• Determine what domain names your company owns
• Assess the need for registering additional domain names
• Consolidate the domain names with a single registrar
• Determine whether any conflicting domain names are owned by third parties

DETERMINING DOMAIN NAMES OWNED BY YOUR CLIENT

• Obtaining ownership information for a company that owns more than a few domain names may be impractical.
• Conduct a domain name term search to identify domain names that may be associated with your client (and possibly third parties)
• Conduct a reverse WHOIS search to identify domain names registered in the name of your company

DOMAIN NAME TERM SEARCH

• Domain name term searches provide a listing of domain names in at least the major domain name extensions that contain the term searched. The search can be a useful tool for locating potentially conflicting domain names that may not be otherwise uncovered.
• A key term or terms should be used to run one or more domain name term searches. In addition, variations and shortened versions of the terms should be used to locate domain names that have been registered with misspellings. A service that may be used for domain name term searches is provided by MarkMonitor.com (charge depending on plan, more advanced).

REVERSE WHOIS SEARCH

• A reverse WHOIS search on a term of interest (e.g., a trademark) may identify entities that have adopted the term as part of their entity name. Typically, a reverse WHOIS search is used to identify the domain names associated with a particular registrant.
• However, there are some limitations on the ability to conduct reverse WHOIS searches. First, there are no free tools to perform reverse WHOIS searches. In addition, the searches may be performed on some out-of-date and incomplete records.
REGISTERING ADDITIONAL DOMAIN NAMES

• Existing holes
• New domain name extensions
• Defensive domain name registrations

EXISTING HOLES

• You may wish to verify that your company has registered its company name and trademarks (with and without relevant generic terms and variations thereof) in all desired extensions.
• MarkMonitor.com and other domain name service providers offer services that can prepare such reports.

NEW DOMAIN NAME EXTENSIONS

• When a new domain name extension is launched, you may wish to advise your company of the new extension and determine a strategy for domain name registrations.
• The strategy should contemplate the domain names currently being used by the company, a number of defensive domain names, and any desired generic domain names.

DEFENSIVE DOMAIN NAME REGISTRATIONS

• Domain names that are registered and will not be used are considered defensive domain name registrations.
• While an aggressive defensive domain name strategy may limit the amount of future domain name disputes, there is no effective way to eliminate such disputes because it is also possible to make character derivations, add additional generic terminology, or register domain names in additional extensions.

DEVELOPING A STRATEGY

While contemplating a defensive domain name strategy for a particular company, consider the following:
• Current and previous domain name conflicts; what domain names were of interest to cybersquatters
• Desirability to a third party of a domain name consisting of a company’s trademark or domain name in combination with a geographic region associated with the company or a generic or descriptive word for the goods and/or services provided by the company
• Geographic areas in which the company operates
• Current cybersquatting problems based on extensions (e.g., .com domain name)
The benefits of consolidation include:

- Ease of access to domain name portfolio
- Ease of modifying domain name contact information
- Reduced cost in managing domain names
- Advantageous and fixed pricing for domain name registrations and renewals
- Multiple user access to a single registrar account
- Customer service support
- Account customization
- Specialty services

Companies may not initially want to spend the time or incur the expense to consolidate domain names. However, once a company experiences a problem associated with renewing, transferring, or dispute ownership of a domain name it may then be able to justify consolidation. Other companies may wish to consolidate domain names as they come due for renewal. While this process may be more cost effective, it may not catch domain names due for renewal that have a problem with the administrative contact information (e.g., change in e-mail address, former employee, etc.).

Domain names may be consolidated with any registrar. However, when enhanced tools are desired such as customer service support, fixed pricing, multiple user access to a single account, specialty services, domain name service providers must be evaluated to determine the types, cost, and quality of services offered.

Some domain name service providers may better meet the needs of clients with large portfolios based on an amount of services provided, discounts offered, and the like, while other domain name service providers may be better for small domain name portfolios because of a lower cost and ease of use.

Once a domain name service provider has been selected at which the domain names will be consolidated, existing domain names associated with your company should be transferred from other domain name registrars to the consolidated account. In addition, your company may ask you to transfer domain names recovered in domain name disputes.

The domain names must be unlocked in order to facilitate the transfer. If an electronic transfer of a domain name is not possible (or not desired), transfer requests may be submitted in writing. Contact a person in customer service from the registrar at which the domain name will ultimately reside to obtain the necessary documentation.

Some domain name transfers, such as registrar transfers, incur a sixty day wait period where no further transfers are possible until the wait period has expired.