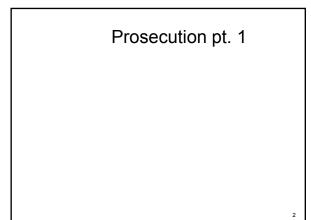
PATENT LAW

Randy Canis

CLASS 9

Prosecution pt. 1; Infringement pt. 1; ST: Interviewing Patent Applications



Overview of Patent Prosecution

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.

Prosecution in the United States

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General 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 (including possible appeal(s))
- Step 6 - Allowance or Abandonment
- Step 7 Continuation Applications (prior to issuance or abandonment)?

Pre-Examination by Administrator at the PTO

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

Examination of non-provisional applications steps at PTO:

- A patent application is classified and assigned to an art unit
- A SPE from the art unit assigns the patent application to an Examiner
- The assigned patent examiner takes up the application in order from a queue of cases
 - The order in which the application is dependent on a few different factors

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· Examiner begins an examination of the application

Examiner conducts search of the prior art

- Search Locations
 - In classes and subclasses considered pertinent plus key word searchings
 - Patents and patent applications both domestic and foreign
 - Technical publications, journals, and texts available to examiner to a limited degree

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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
- Define inventions that are unobvious (35 USC 103) over prior art
- The patent application meets 112 requirements including enablement, written description, and definiteness
- Examiner then writes a summary of the examination called an "Office Action"
- Office Action is mailed (electronically or in paper) to applicant

Office Action

Summarizes the findings of examiner

- · As to each claim specifically
 - each claim is rejected, allowed, objected to indicating allowable if rewritten in independent form
- Any objections to the drawings, specification, title, or abstract are included
- The office action could also include a double patenting rejection

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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 or 2 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 prior art.
- 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 rejections or objections, as based on a further search.
- · Might be a final rejection.

Response to Final Rejection

- · 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.
- · Filing an RCE restarts the process.

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If further response by applicant successful--

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- · 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 time (e.g., ~2 mo.) after payment of issue fee.

Types of Applications

- Provisional Patent Applications
- Nonprovisional Utility Patent Applications
- · Design Patent Applications

Provisional versus Nonprovisional

Examined

Application valid until

abandoned or patent issued

Provisional

- Less preparation time Nonprovisional · More preparation time
- Can not amend
- No claims required Amendments are possible · Must have at least 1 claim
- Not examined Informal
- More formal Valid for only 1 year; must timely file nonprovisional claiming priority

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

Provisional applications -- tips:

- Suggestion: include full scope of disclosure even though there is no examination
- · Representative claims, broad to narrow, are useful
- Why? Application serves as a priority in U.S.
- Provides priority also for foreign applications
- If foreign filing planned, provisional is priority
 Caution: Provisional will be scrutinized by opponent if non-provisional results in patent asserted against opponent; don't be shoddy

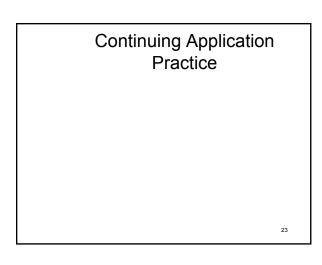
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Discussion of Example Prosecution

- · Select a patent
- Review prosecution in Public Pair

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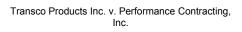


Types of NonProvisional Applications

Five Types of Applications

- Original
- Continuation
- Continuation-in-Part (CIP)
- Divisional

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- "An applicant may file a continuation, divisional, or a continuation-in-part (CIP) application of a prior application."
- These are all "continuing" applications under 35 U.S.C. 120.

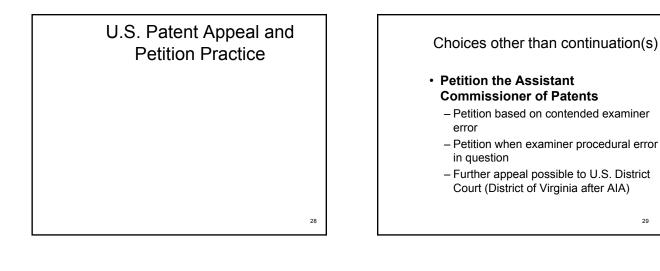
Continuation Possibilities

- 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 (DIV) - 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

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Choices Other Than Continuation(s)

Appeal to Patent Trial and Appeal Board (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 possible to Fed. Cir. Ct. of Appeals - http://www.uspto.gov/ip/boards/bpai/index.jsp

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Publication of Pending Applications

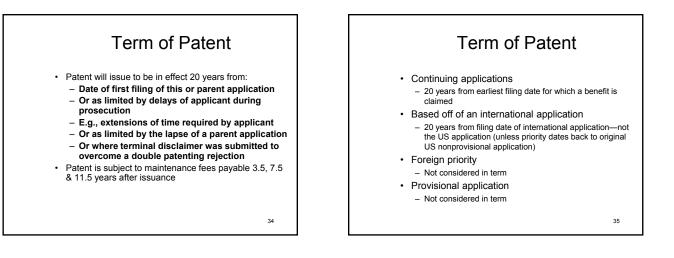
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Publication of patent applications

- 18 months after filing unless applicant requests otherwise <u>upon filing</u> & 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 invention in the period between publication and grant
- Applicant can consider if foreign counterparts will be sought after all, after non-publication request (NPR).
 If applicant then files for foreign patent must notify PT(
- If applicant then files for foreign patent, must notify PTO in US application within 60 days & withdraw NPR. Application then is published ASAP
 DPLOB ADT offect for sublished ASAP
- PRIOR ART effect for published applications --Sec.102(e)
- http://www.uspto.gov/web/offices/pac/mpep/s1120.html

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Patent Term 3



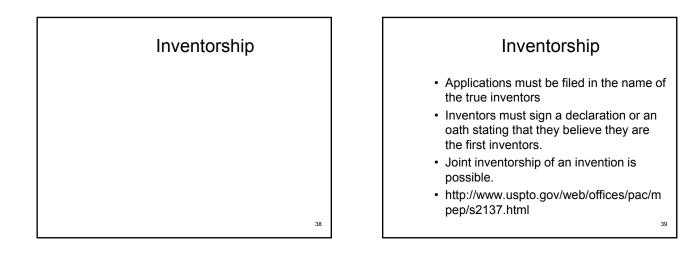
Term of Patent

- · 35 U.S.C. 154 Term Guarantees
- GUARANTEE OF PROMPT PATENT AND TRADEMARK OFFICE RESPONSES
- GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY.
- GUARANTEE OR ADJUSTMENTS FOR DELAYS DUE TO INTERFERENCES, SECRECY ORDERS, AND APPEALS.
- http://www.uspto.gov/web/offices/pac/mpe p/mpep-9015-appx-l.html#d0e303482

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Prosecution Abroad

- · Need for foreign counsel
- Deferred examination sometimes
 possible
- Allows for assignee filing (instead of inventors)



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], <u>without</u> <u>the consent of and without</u> <u>accounting to the other owners."</u>

[Section 262 of Patent Statutes (35 U.S.C. 262)]

Joint Inventors

Recommendation:

In light of Sec. 262, joint inventors:

- Should negotiate & enter into a joint venture or business organization agrmt.
- Should provide for mutual obligations for disposition of rights by any joint owner.
- Should cover sharing of proceeds of exploitation of invention.

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Omitted Inventors

- Inventors sometimes refuse to join in or cannot be found
- By submitting sufficient information, may proceed without the omitted inventor
 - The omitted inventor is still named
 - The omitted inventor may join later

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

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Joint Inventorship

How do you become a joint inventor?
 Contribute to the conception of at least 1 claim

Ethicon, Inc. v. United States Surgical Corp.

"A patented invention may be the work of two or more joint inventors. See 35 U.S.C. § 116 (1994). Because "[c]onception is the touchstone of inventorship," each joint inventor must generally contribute to the conception of the invention. ... Nevertheless, for the conception of a joint invention, each of the joint inventors need not "make the same type or amount of contribution" to the invention. 35 U.S.C. §116. Rather, each needs to perform only a part of the task which produces the invention... Furthermore, a coinventor need not make a contribution to every claim of a patent. See 35 U.S.C. § 116. A contribution to one claim is enough.... Thus, the critical question for joint conception is who conceived, as that term is used in the patent law, the subject matter of the claims at issue." Ethicon, Inc. v. United States Surgical Corp.

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- "[E]ach co-inventor presumptively owns a pro rata undivided interest in the entire patent, no matter what their respective contributions."
- "[J]oint inventions may become joint property without some express agreement to the contrary."

Shukh v. Seagate Teachnology, LLC

 2015 Panel Fed. Cir. of <u>Moore</u>, Wallach, and Taranto

Issue

 Inventorship related claims

Shukh v. Seagate Teachnology, LLC

• "Dr. Shukh's time at Seagate was undisputedly tumultuous. His performance evaluations indicated that he did not work well with others due to his confrontational style."

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Shukh v. Seagate Teachnology, LLC

· "This lawsuit stems, in part, from Dr. Shukh's allegations that Seagate has not properly credited him for his inventions. Specifically, Dr. Shukh alleges that during his tenure at Seagate, Seagate wrongfully omitted him as an inventor from six patents (U.S Patent Nos. 7,233,457; 7,684,150; 6,525,902; 6,548,114; 6,738,236; and 7,983,002) and four pending patent applications, all relating to semiconductor technologies. He also claims that Seagate discriminated against him and wrongfully terminated him both on the basis of his national origin and in retaliation for complaining about the discrimination."

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Shukh v. Seagate Teachnology, LLC

"Today, we hold that concrete and particularized reputational injury can give rise to Article III standing. As we noted in Chou, 'being considered an inventor of important subject matter is a mark of success in one's field, comparable to being an author of an important scientific paper.' 254 F.3d at 1359. We reasoned that [p]ecuniary consequences may well flow from being designated as an inventor.' Id. This is particularly true when the claimed inventor is employed or seeks to be employed in the field of his or her claimed invention. For example, if the claimed inventor can show that being named as an inventor on a patent would affect his employment, the alleged reputational injury likely has an economic component sufficient to demonstrate Article III standing."

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Shukh v. Seagate Teachnology, LLC

• "A trier of fact could conclude that Dr. Shukh's omission from the disputed patents had a concrete impact on his reputation in his field. There is significant evidence that the number of patents an inventor is named on influences his reputation in the field of the patents."

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Correction of Inventors' Names

35 U.S.C. 256 Correction of named inventor.

- Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.
- a certificate correcting such error. The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly.

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Correction of Inventors' Names

- · The request to correct inventorship must include: (1) Where one or more persons are being added, a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on his or her part;
 - (2) A statement from the current named inventors either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change;
 - (3) A statement from all assignees of the parties agreeing to the change of inventorship in the patent; and

(4) A fee

Double Patenting



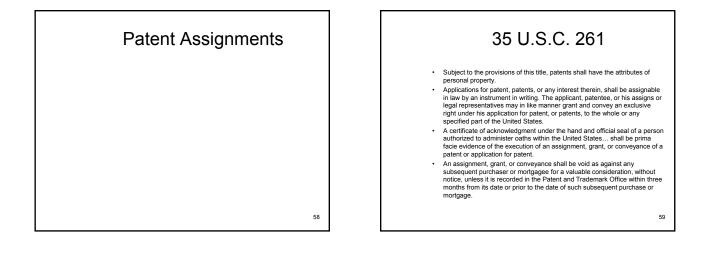
Sec. 101 of Patent Statutes permits "a"[read "single"] patent for any new and useful invention

- Can arise when multiple patent applications are submitted by same entity on closely related inventions
- Statutory v. Nonstatutory-Type
- http://www.uspto.gov/web/offices/pac/m pep/s804.html

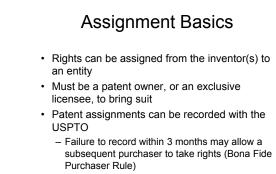
Non-Statutory Double Patenting

- In such instances issues of double patenting often overcome by use of terminal disclaimer:
- Term of second patent after expiration of first patent is disclaimed.
- Both patents then expire on the same date.
- Both patents must remain commonly owned.

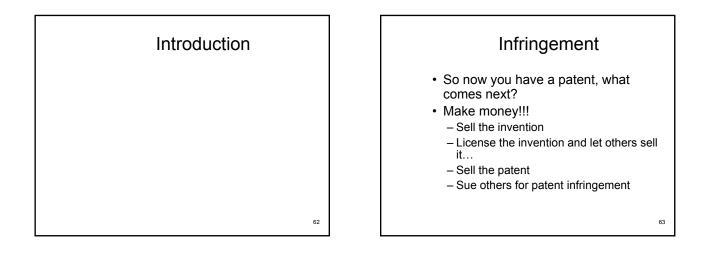
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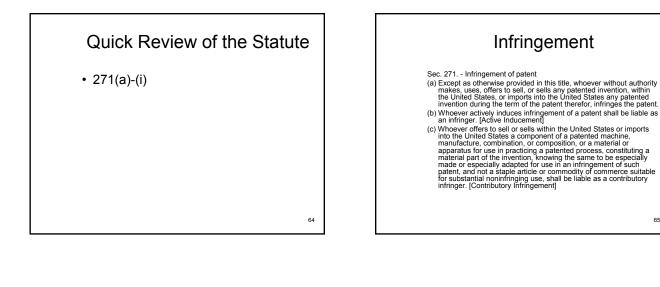


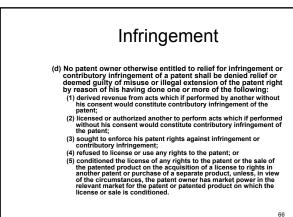
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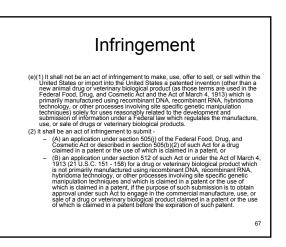
Infringement pt. 1

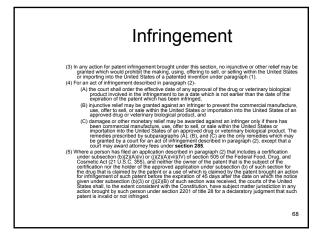


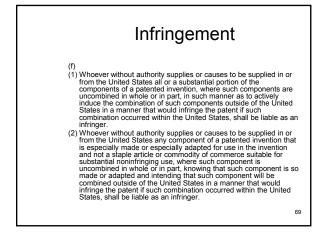












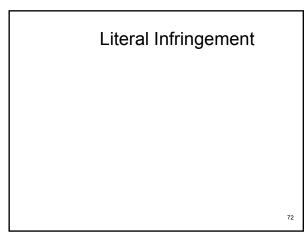
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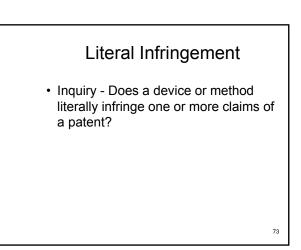
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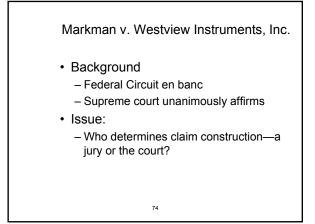
Requirements?

- Statute does not require

 Any proof of access to inventor's work
 Any intent to infringe
- Courts ultimately required claims to determine patent scope...







Markman v. Westview Instruments, Inc.

• "To ascertain the meaning of claims, we consider three sources: The claims, the specification, and the prosecution history. ... Expert testimony, including evidence of how those skilled in the art would interpret the claims, may also be used."

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Markman v. Westview Instruments, Inc.

- "Claims must be read in view of the specification, of which they are apart."
- "For claim construction purposes, the [specification] may act as a sort of dictionary, which explains the invention and may define terms used in the claims."
- "... [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)

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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."

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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."

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Markman v. Westview Instruments, Inc.

 "... [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."

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.

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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. he 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

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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."

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How are claims to be construed by a court?

- 1. Narrow Construction to Save Validity
- 2. Ordinary vs. Contextual Meaning
- 3. Contextual Meaning May Trump Ordinary Meaning
- 4. The "Lexicographer" Rule
- 5. Disclaimer of Subject Matter
- 6. Claim Differentiation: Contextual Meaning From Other Claims
- 7. Purpose or Goal of the Invention

Narrow Construction to Save Validity

- "[W]hen two interpretations are plausible, choose the one that preserves the validity of the patent the narrower interpretation."
- Last resort...

Ordinary vs. Contextual Meaning

 "Claim interpretation often seems to hinge on disputes about whether to give language an 'ordinary' meaning or a special 'contextual' meaning derived from particular usage in the patent, but the distinction is not sharp."

Contextual Meaning May Trump Ordinary Meaning

 Sometimes more narrow definitions than ordinary meaning may be given to words in the claim based on the specification.

The "Lexicographer" Rule

 "Courts often say that patentees are free to be their own lexicographers i.e., to define claim terms in any way they wish. These definitions are typically set forth in the specification. Yet, even when the patentee does define a term, the definition may be ambiguous."

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Disclaimer of Subject Matter

• "A corollary of the lexicographer rule is that the patentee's statements in the specification or, more commonly, in the prosecution history may limit or disclaim apparently broad claim language."

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Claim Differentiation

• Presence of dependent claim that narrows provides support that the claim from which it dependents

Purpose or Goal of the Invention

• Supply meaning to the claim term from a purpose or goal of an invention

Cybor Corp. v. FAS Technologies, Inc.

• "[W]e conclude that the Supreme Court's unanimous affirmance in Markman v. Westview Instruments [] of our in banc judgment in that case fully supports our conclusion that claim construction, as a purely legal issue, is subject to de novo review on appeal."

Cybor Corp. v. FAS Technologies, Inc.

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• "[W]e review claim construction de novo on appeal including any allegedly fact- based questions relating to claim construction. Accordingly, we today disavow any language in previous opinions of this court that holds, purports to hold, states, or suggests anything to the contrary."

Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.

- Supreme Court 2015
- Issue
 - What is the claim construction standard of review when claim construction includes factual underpinnings?

Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.

- "We hold that the appellate court must apply a 'clear error,' not a *de novo*, standard of review."
- · What applies to this standard?

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Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.

Invention

- a drug used to treat multiple sclerosis.
- Issue
 - Indefiniteness
 - "The reason that the phrase is fatally indefinite, Sandoz argued, is that, in the context of this patent claim, the term 'molecular weight' might mean any one of three different things."

Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.

- District Court

 patent claim was sufficiently definite;
 patent valid
- Federal Circuit

 the term "molecular weight" was indefinite; patent invalid

Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.

• "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.' ... when reviewing the findings of a "district court sitting without a jury, **appellate courts** must constantly have in mind that their function is **not to decide factual issues** *de novo.*""

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Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.

"We [] held [in Markman] that claim construction falls 'exclusively within the province of the court,' not that of the jury. ... [W]e 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, Inc. v. Sandoz, Inc.

 "[S]ometimes, say when a written instrument uses 'technical words or phrases not commonly understood,' [] those words may give rise to a factual dispute. If so, extrinsic evidence may help to 'establish a usage of trade or locality.' [] And in that circumstance, the 'determination of the matter of fact' will 'preced[e]' the 'function of construction.' ... This factual determination, like all other factual determinations, must be reviewed for clear error."

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Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.

 "[W]e referred to claim construction as a practice with 'evidentiary underpinnings,' a practice that 'falls somewhere between a pristine legal standard and a simple historical fact.' [] We added that sometimes courts may have to make 'credibility judgments' about witnesses. ... [W]e recognized that courts may have to resolve subsidiary factual disputes. And, as explained above, the Rule requires appellate courts to review all such subsidiary factual findings under the 'clearly erroneous' standard."

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Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.

 "In some cases [] the district court will need to look beyond the patent's intrinsic evidence and to consult extrinsic evidence in order to understand, for example, the background science or the meaning of a term in the relevant at during the relevant time period. ... In cases where those subsidiary facts are in dispute, courts will need to make subsidiary factual findings about that extrinsic evidence. These are the 'evidentiary underpinnings' of claim construction that we discussed in Markman, and this subsidiary factfinding must be reviewed for clear error on appeal."

Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.

• "The appellate court can still review the district court's ultimate construction of the claim *de novo*. But, to overturn the judge's resolution of an underlying factual dispute, the Court of Appeals must find that the judge, in respect to those factual findings, has made a clear error. Fed. Rule Civ. Proc. 52(a)(6)."

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Phillips v. AWH Corporation

- Issue
 - To what extent should the specification be relied on when ascertaining the scope of the claims? How should dictionaries be used in claim interpretation?

Phillips v. AWH Corporation

- Invention
 - Modular steel panels that are welded together to form walls
 - Specification described baffled deployment at an angle other than 90 degrees to wall face to create interlocking
- D.C. no infringement b/c at 90 degrees
- Panel affirmed; baffles at non 90 angle enable deflection of bullets

Phillips v. AWH Corporation

Claims

- define invention to which the patentee is entitled the right to exclude
- "...the words of a claim 'are generally given their ordinary and customary meaning." ...

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Phillips v. AWH Corporation

• "We have made clear, moreover, that the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application."

Phillips v. AWH Corporation

 "[T]he person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification."

Phillips v. AWH Corporation

- Apply well-accepted meaning of commonly understood words
- Examine terms that have a particular meaning in a field of art

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Phillips v. AWH Corporation

- "Quite apart from the written description and the prosecution history, the claims themselves provide substantial guidance as to the meaning of particular claim terms. ...
- "To begin with, the context in which a term is used in the asserted claim can be highly instructive. ...
- "Other claims of the patent in question, both asserted and unasserted, can also be valuable sources of enlightenment as to the meaning of a claim term."

Phillips v. AWH Corporation

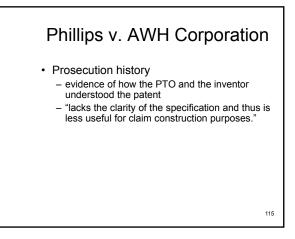
• "[T]he presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim."

Phillips v. AWH Corporation

- Claims must be read in terms of the specification
- "Our cases recognize that the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor's lexicography governs.... In other cases, the specification may reveal an intentional disclaimer, or disavowal, of claim scope by the inventor. In that instance as well, the inventor has dictated the correct claim scope, and the inventor's intention, as expressed in the specification, is regarded as dispositive....

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Phillips v. AWH Corporation

- "[W]e have also authorized district courts to rely on extrinsic evidence, which 'consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises.'
- "[W]hile extrinsic evidence 'can shed useful light on the relevant art,' we have explained that it is "less significant than the intrinsic record in determining 'the legally operative meaning of claim language."

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Phillips v. AWH Corporation

- · Extrinsic evidence
 - Less reliable
 - What five reasons did the court give?
 - "unlikely to result in a reliable interpretation of patent claim scope unless considered in the context of the intrinsic evidence"

Phillips v. AWH Corporation What happened in <u>Texas Digital</u>? Too much reliance on dictionaries (and other extrinsic sources)

Phillips v. AWH Corporation

• "Moreover, we recognize that the distinction between using the specification to interpret the meaning of a claim and importing limitations from the specification into the claim can be a difficult one to apply in practice."

Interviewing Patent Applications

Interviews with the Patent Office

§ 1.133 Interviews.

- (a)(1)Interviews with examiners concerning applications and other matters pending before the Office must be conducted on Office premises and R-95 Rev. 8, July 2010 within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director.
- (2)An interview for the discussion of the patentability of a pending application will not occur before the first Office action, unless the application is a continuing or substitute application or the examiner determines that such an interview would advance prosecution of the application.

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Interviews with the Patent Office

- (3)The examiner may require that an interview be scheduled in advance.
- (b)In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office actions as specified in §§ 1.111 and 1.135.

Interviews Before Final

- What can you do and when can you do it?
 - Pre-examination
 - At Examiner's discretion
 - First Action Interview Pilot Program
 - http://www.uspto.gov/patents/init_events/faip p_landing.jsp
 - Prior to a final action

After Final Examiners may grant one interview after final rejection. See MPEP § 713.09. After Final Consideration Pilot 2.0 http://www.uspto.gov/patents/init_events/afcp.jsp Post-Prosecution Pilot (P3) Program https://www.uspto.gov/patent/initiatives/post-prosecution-pilot

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Interviewing Patent Applications

- How conducted
 - In-Person in Washington, D.C. (or other location)
 - Telephonically
 - Video conference
- Time allotted 30 or 60 minutes
- · Who is present
 - Attorney
 - Examiner that prepared the office action
 - Supervising Examiner?
 - Inventor or client representative?



