How to Challenge a Patent Before it Issues

By Richard A. Wolf and Luis Carrion

A patent application is said to take on a “gold-plated hue” once it has matured into a patent. This is because a granted patent has a presumption of validity in District Court litigation, where challengers must prove that each patent claim is invalid by clear and convincing evidence—the highest burden of proof in U.S. civil litigation.1 This is unwelcome news when you are challenging a competitor’s patent. Therefore, in some instances, it may be beneficial to take a more proactive approach by challenging a competitor’s patent application before it issues as a patent and ensuring that the Examiner has the best prior art that can potentially limit the competitor’s patent claims.

There are generally three procedures that can be used to submit prior art during the pendency of another’s patent application—pre-issuance submissions, public protest, and submission of an information disclosure statement via the applicant. This article is the first of a three-part series that will focus on these procedures. In Part I, we will initially focus on pre-issuance submissions, including some of their advantages and potential pitfalls.

Part I: Pre-Issuance Submissions

Overview: In a pre-issuance submission,2 any third party may submit any patent, published patent application, or other printed publication that may be relevant to the examination of a pending patent application. The submission must also include a statement concerning the relevance of the submitted publication along with a copy of the document if it is not a U.S. patent document and an English translation if applicable. The pre-issuance submission is applicable to non-provisional utility, design and plant applications—including continuation, divisional, and continuation-in-part applications—but it is not applicable to issued patents, reissues or reexaminations.3

Although submissions must be in the form of a printed publication, challenges are not limited to issues of anticipation or non-obviousness. For example, challenges may be based on 35 U.S.C. § 112 issues, such as ambiguity in a claim term to support an indefiniteness rejection, or the validity of a priority claim based upon a parent application. The printed publication does not need to be patent literature; nor does it even need to be prior art. Non-patent publications such as articles, websites, posters, dictionary definitions, or the like may be provided in a pre-issuance submission. A submission that complies with all of the requirements will be considered by the Examiner and included in the record of the pending patent application.

Timing: Pre-issuance submissions must be timely filed or they will be rejected by the USPTO. A third-party submitter must file its submission before the earlier of (1) a notice of allowance for the pending application; or (2) the later of: a first rejection of any pending claim on the merits or 6 months after publication of the U.S. application. Notice that this is a fairly tight window of time that could easily be missed if the potential third-party challenger does not become aware of the patent application publication on time. Potential third-party submitters may consider monitoring competitors’ publications in order to act quickly upon publication.

The submission must be filed prior to, not on, the above-mentioned dates. The pre-issuance submission is considered filed as of the date of receipt at the USPTO. Also, a first Office action not on the merits such as a restriction requirement or an
Ex Parte Quayle action will not end the time period. Similarly, a non-U.S. publication such as a WIPO publication will not start the six month clock. Only a U.S. publication will. Finally, the filing of a request for continued examination (RCE) will not reset the time period for filing a pre-issuance submission.

**Cost:** If the third-party submitter includes less than three items (e.g., publications) in a first pre-issuance submission, there is no USPTO fee. Otherwise the fee for every 10 items is $180 (or fraction thereof) for a large entity. Small entity discounts apply, but micro-entity discounts do not apply.

**Anonymity:** Pre-issuance submissions may be made either electronically or on paper, and they may be submitted anonymously such that the real party in interest is not identified. The third party also has no requirement to serve the applicant with its pre-issuance submission. The USPTO will provide direct notification to the applicant if the applicant participates in the USPTO’s e-Office Action program. Of course, the third party submitter should keep in mind that such a submission will heighten the awareness of the applicant that another party is challenging the patentability of their claims.

**Statement of Relevance:** Pre-issuance submissions must include a listing of the publication(s) being submitted, as well as “a concise statement of relevance” for each submitted publication. In fact, much of the effectiveness of the pre-issuance submission comes with the ability to submit the concise description regarding the reference’s disclosure. This is the third-party submitter’s best way of helping the USPTO examiner reject or at least limit the claims since the third-party submitter will have no other say on the matter beyond the concise statement of relevance. The concise statement of relevance should set forth facts explaining how the particular printed publication is of potential relevance to the examination of the application in which the submission has been filed. Often this is done most effectively by including claim charts of the currently pending claims in the application at issue and mapping the claim language to specific paragraphs and figures in the cited references. However, the concise description of relevance does not permit third parties to submit direct arguments against patentability or set forth conclusions regarding whether one or more claims are patentable. Thus, the concise description of relevance is not an invitation for a third party to propose actual rejections of the claims or set forth arguments relating to an Office Action in the application to or to an applicant’s reply to an Office Action in the application. Finally, merely annotating or highlighting the copy of a particular printed publication will not be deemed a proper concise description of relevance.

**Estoppel:** There is technically no estoppel associated with the third-party submitted publication submitted using the pre-issuance procedure. For example, the publication can already be of record and can be cumulative of information already presented to the Examiner. However, the fear of submitting information via pre-issuance submission is that the concise description of relevance, possibly combined with the arguments during prosecution if the Examiner relies on the reference in an Office Action, will render the submitted reference(s) unusable for post-grant proceedings via an estoppel-like effect. In other words, the general concern is that the more a reference of record is discussed/argued during prosecution, the more difficult it will be to meet the standard for instituting the post-grant proceeding.

As a practical matter, the success of a third-party petitioner at post-grant proceedings will largely depend on the specific facts of the case, namely on the context of how the cited art was utilized during prosecution and how it is being utilized in the petition for post-grant proceeding. The Patent Trial and Appeal Board ("PTAB") is given much discretion in making the determination as to whether the arguments set forth by the petitioner are sufficient to institute the post-grant proceeding. And decisions to grant or deny petitions based on previously cited art have gone both ways. For example, in *Microsoft Corp. v. Parallel Networks Licensing, LLC*, IPR2015-00483 (Jul. 15, 2015), the PTAB instituted an *inter partes* review even though institution was primarily based on a prior art reference that had been previously presented to the USPTO. In this case, however, the previously-cited reference was cited by applicant in an information disclosure statement and initiated by the Examiner, but was not used in a rejection and there was no evidence that the Examiner considered the specific disclosure relied on by the petitioner. A more difficult scenario will be where the cited art was relied upon in a rejection. For example, in *Microboards Technology LLC v. Stratasys Inc.*, IPR2015-00287 (May 28, 2015), the petitioner challenged claims of a U.S. patent as anticipated by a U.S. patent reference to Crump. During prosecution, the notice of allowability stated that Crump did not disclose a particular feature, and the petitioner asserted that the comments of the Examiner were directed to a specific figure not relied on by the petitioner. The PTAB declined to institute the inter partes review, and referred to 35 U.S.C. § 325(d), noting that “[b]ecause Crump, and specifically the question of whether Crump discloses or suggests [this feature], was previously considered by the Patent Office, the PTAB exercises its discretion under 35 U.S.C. § 325(d) *as an additional basis* to decline to institute inter partes review on this ground.” That is not to say that the same result will be reached in every such situation, but if a reference that was relied on in the Office Action is used as a basis for instituting a post-grant proceeding, there should be a very clear indication and a strong position for why the argument raised

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in the petition was not considered during prosecution, instead of merely suggesting that the Examiner misunderstood the reference or that a different aspect of that reference should be considered.

**Conclusion**: In summary, some of the advantages of the pre-issuance submission procedure include the following: (1) ability to comment on the submitted publication(s) with a concise statement of relevance, often by way of claim charts; (2) ability to determine risks involved due to arguments/amendments made by the applicant during prosecution; (3) relatively low cost; (4) anonymity, and (5) no estoppel. The potential downsides to the pre-issuance submission procedure include: (1) a heightened awareness of the applicant that a third party is challenging their claims; (2) a fairly narrow window of opportunity for submitting the art with uncertainty when a first Office action will issue; (3) no active participation or argumentation about patentability with the Examiner; and (4) the submission must be a printed publication, which may limit the ability to submit information about public use, prior sales, or inequitable conduct that is not in printed form.

**Endnotes**

Richard is an associate at Renner Otto. Richard’s practice focuses on patent preparation, prosecution, and counseling, mainly in the mechanical and materials-related arts. Richard has handled patent matters in a wide range of technologies, including aerospace systems, hydraulics, heat exchangers, electrochemical devices, lighting, flooring, composites, and consumer products. Richard’s practice also includes pursuing and defending trademark rights and copyright protection.

Luis represents clients in patent and trademark application preparation, prosecution, licensing and litigation. Among other technologies, Luis has handled patent matters in the fields of telecommunication systems, uninterruptible (data center and telco) power supplies, fluorescent lighting and ballasts, digital signal processing, audio signal processing, welding equipment, computer programs, software-based control systems, electrical circuits, optical devices, computer hardware, remote monitoring, and mechanical assemblies.

1 This presumption of validity is not applicable during post-grant proceedings at the USPTO. In post-grant proceedings, such as Inter Partes Review (IPR) or Post-Grant Review (PGR), petitioners need only establish unpatentability by a preponderance of the evidence—i.e., that the claims are more likely than not unpatentable. This is a significantly reduced burden of proof compared to litigation. However, these post-grant procedures are often expensive, and it may be beneficial to take a more proactive approach to having the Examiner consider relevant references submitted via pre-issuance submission or the like.

2 Pre-issuance submissions are made pursuant to 37 CFR § 1.290, 35 U.S.C. § 122(e) and MPEP § 1134.01.

3 Where a pre-issuance submission is filed in a reissue, the Office will process the submission as a protest under 37 CFR § 1.291 because protests are permitted in a reissue. If the submission is compliant under pre-issuance submission procedure according to 37 CFR § 1.290, then it should also comply with § 1.291.

4 The real party in interest must not have a duty of disclosure pursuant to 37 CFR § 1.56.

5 The standard for instituting an inter partes review is a reasonable likelihood that the petitioner will prevail on at least one claim. For post-grant review, the standard for institution is that at least one challenged claim is more likely than not to be deemed unpatentable.
I’m Exhausted: Patent Rights Extinguished After A Sale

By Kyle B. Fleming

In *Impression Prosds., Inc. v. Lexmark Int’l, Inc.* 1 the Supreme Court rejected the Federal Circuit’s restrictive view of patent exhaustion and held that a product’s sale exhausts the patentee’s patent rights vis-à-vis that product. This means that a patentee cannot control post-sales activity under threat of patent infringement. But the Supreme Court did leave open the possibility that contract terms (and remedies for breach) might be available to control such activities.

**Background**

Lexmark makes and sells printers and toner cartridges throughout the world. Lexmark offered two options for purchasing toner. One option was at a discount but subject to an express single-use/no-resale restriction that precluded transferring the used cartridge to anyone other than Lexmark in what it called a “Return Program Cartridge.” Lexmark also sold “Regular Cartridges” at full price and without the use/resale restrictions.

Impression’s business was to acquire used Lexmark cartridges—both Return Program Cartridges and Regular Cartridges—refill them, and resell them in the U.S. Of course, Impression’s refilled cartridges were much cheaper than Lexmark’s. And that is where the trouble started.

Lexmark sued Impression for infringing U.S. patents covering the cartridges. Specifically, Lexmark alleged infringement based on (1) resale/reuse of Return Program Cartridges that Lexmark originally sold in the U.S. (but not the Regular Cartridges) and (2) resale/reuse and import of both Return Program Cartridges and Regular Cartridges that Lexmark originally sold outside the U.S.

**Federal Circuit’s Analysis**

Sitting en banc, the Federal Circuit 2 ruled that patent exhaustion did not apply to either of the accused activities.

With respect to cartridges first sold by Lexmark within the U.S., the Federal Circuit relied on its 1992 *Mallincrodt* 3 decision, holding that a patentee may sell an item and retain the right to enforce, through patent infringement lawsuits, “clearly communicated, . . . lawful restriction[s] as to post-sale use or resale.” The exhaustion doctrine, the Federal Circuit reasoned, derives from the prohibition on making, using, selling, or importing items “without authority.” Because lawful post-sales restrictions withhold some authority from the buyer, violations of post-sales restrictions are “without authority” and therefore subject to patent enforcement.

As for cartridges that Lexmark first sold outside the U.S., the Federal Circuit followed *Jazz Photo* 4 (2001), in which it held that a patentee’s sale abroad did not terminate its ability to bring an infringement suit against a buyer that later imported the article and sold the product in the United States. According to the Federal Circuit, exhaustion of U.S. patent rights is only justified when a patentee receives “the reward available from [selling in] American markets.” Because U.S. patents offer no protection outside the U.S., the patentee cannot receive the “reward” for its U.S. patent rights from such sales, and therefore exhaustion cannot apply.

**Supreme Court Decision**

The Supreme Court was mostly unimpressed and unpersuaded by the Federal Circuit’s reasoning. According to the Court, the Federal Circuit’s fundamental mistake is not understanding the genesis of the exhaustion doctrine:

> The Federal Circuit reached a different result largely because it got off on the wrong foot. The “exhaustion doctrine,” the court believed, “must be understood as an interpretation of the infringement statute, which prohibits anyone from using or selling a patented article ‘with-out authority’ from the patentee... If the patentee expressly withholds a stick from the bundle [of patent rights]—perhaps by restricting the purchaser’s resale rights—the buyer never acquires that withheld authority, and the patentee may continue to enforce its right to exclude that practice under the patent laws.

The misstep in this logic is that the exhaustion doctrine is not a presumption about the authority that comes along with a sale; it is instead a limit on the scope of the patentee’s rights. United States v. General Elec. Co., 272 U. S. 476, 489 (1926) (emphasis added). The right to use, sell, or import an item exists independently of the Patent Act. What a patent adds—and grants exclusively to the patentee—is a limited right to prevent others from engaging in those practices. See *Crown Die & Tool Co. v. Nye Tool & Machine Works*, 261 U. S. 24, 35 (1923). Exhaustion extinguishes that exclusionary power. See *Bloomer*, 14 How., at 549 (the purchaser ‘exercises no rights created by the act of Congress, nor does he derive title to [the item] by virtue of the ... exclusive privilege granted to the patentee’). As a result, the sale transfers the right to use, sell, or import because those are the rights that come along with ownership, and the buyer is free and clear of an infringement lawsuit because there is no exclusionary right left to enforce.

In addition to exploring the historical pedigree of exhaustion, the Supreme Court focused on the practical impact of allowing potentially hidden restraints on alienation of goods. “Patent exhaustion reflects the principle that, when an item passes into commerce, it should not be shaded by a legal cloud on title as it moves through the marketplace,” and exhaustion is “the point where patent rights yield to the common law principle against restraints on alienation.”

The Supreme Court had little trouble applying exhaustion to all sales, regardless of where made, and brushed off attempts to treat non-U.S. sales differently. Relying in part

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on its recent decision in *Kirtsaeng* applying copyright’s “first sale” doctrine (analogous to patent exhaustion) to non-U.S. sales, the Court wrote:

What helped tip the scales for global exhaustion was the fact that the first sale doctrine originated in “the common law’s refusal to permit restraints on the alienation of chattels.” *Id.*, at 538. That “common-law doctrine makes no geographical distinctions.” *Id.*, at 539. The lack of any textual basis for distinguishing between domestic and international sales meant that “a straightforward application” of the first sale doctrine required the conclusion that it applies overseas. *Id.*, at 540 (internal quotation marks omitted).

Applying patent exhaustion to foreign sales is just as straightforward. Patent exhaustion, too, has its roots in the antipathy toward restraints on alienation. 

The Supreme Court dismissed Lexmark’s complaint that exhaustion should not attach when it did not receive a “U.S. patent premium” on sales outside the U.S.

Exhaustion is a separate limit on the patent grant, and does not depend on the patentee receiving some undefined premium for selling the right to access the American market. A purchaser buys an item, not patent rights. And exhaustion is triggered by the patentee’s decision to give that item up and receive whatever fee it decides is appropriate “for the article and the invention which it embodies.” *Univis*, 316 U. S., at 251. The patentee may not be able to command the same amount for its products abroad as it does in the United States. But the Patent Act does not guarantee a particular price, much less the price from selling to American consumers. Instead, the right to exclude just depends on the patentee receiving a premium for the patent grant, and does not depend on whether the patentee decides to sell—whether on its own or through a licensee—that sale exhausts its patent rights, regardless of any post-sale restrictions the patentee purports to impose, either directly or through a licence.

Although rejecting patent law as a basis for imposing post-sale restrictions on goods sold, the Supreme Court did suggest that other regimes, such as contract law, might be used, at least to control the actions of the direct purchaser from the patentee. Practically, while post-sales restrictions in sales contracts might be enforceable against a commercial/sophisticated purchaser, attempts to impose such restrictions on subsequent purchasers or on ordinary consumers might run afoul of contract formation rules relating to contracts of adhesion and general judicial antipathy for restraints on alienation. But careful sales arrangements, processes, and agreements will increase the chances of success for patentee’s still hoping to restrict post-sales activities.

The Court concluded:

More is at stake when it comes to patents than simply the dealings between the parties, which can be addressed through contract law. Instead, exhaustion occurs because, in a sale, the patentee elects to give up title to an item in exchange for payment. Allowing patent rights to stick remora-like to that item as it flows through the market would violate the principle against restraints on alienation. Exhaustion does not depend on whether the patentee receives a premium for selling in the United States, or the type of rights that buyers expect to receive. As a result, restrictions and location are irrelevant; what matters is the patentee’s decision to make a sale.

And:

In sum, patent exhaustion is uniform and automatic. Once a patentee decides to sell—whether on its own or through a licensee—that sale exhausts its patent rights, regardless of any post-sale restrictions the patentee purports to impose, either directly or through a licence.

Although rejecting patent law as a basis for imposing post-sale restrictions on goods sold, the Supreme Court did suggest that other regimes, such as contract law, might be used, at least to control the actions of the direct purchaser from the patentee. Practically, while post-sales restrictions in sales contracts might be enforceable against a commercial/sophisticated purchaser, attempts to impose such restrictions on subsequent purchasers or on ordinary consumers might run afoul of contract formation rules relating to contracts of adhesion and general judicial antipathy for restraints on alienation. But careful sales arrangements, processes, and agreements will increase the chances of success for patentee’s still hoping to restrict post-sales activities.

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**Endnotes**

Kyle is a partner in Renner Otto’s Litigation Practice Group. Kyle is a versatile and veteran trial lawyer and counselor that has been solving problems and achieving clients’ goals for more than 20 years. Kyle has successfully handled numerous and varied appeals and cases involving, for example, patent and intellectual property infringement, importation and trade disputes, complex commercial disputes and breach of contract, securities and anti-trust violations, shareholder/partner disputes, and Constitutional or common law violations.

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iv. *Id.* at 734 (quoting 35 U. S. C. §271(a)).


vi. *All Eight participating Justices found patent exhaustion based on the original sales in the U.S., and seven (except Justice Ginsberg) did with respect to the non-U.S. sales.*


viii. *Id.* at p. 16.


x. *Impression*, p. 19.

xi. *Id.* at pp. 20-21.

xii. *Id.* at p. 23.

xiii. *Id.* at p. 18.
“Not-So-Secret” Sales Under the “On Sale Bar” of AIA 35 U.S.C. § 102(b)

By Brian M. Baker

In the United States, disclosure of an invention prior to the filing of an application for patent is never good. If the disclosure is made by the inventor, a joint inventor, or another who obtained the subject matter from the inventor or joint inventor, then the inventor has a one year window in which to make the filing. If the disclosure is made by someone else, then it is a complete and immediate bar to filing. These two possibilities are embodied in 35 U.S.C. §§ 102(a)(1) and (b) and are known as statutory bars.

Until recently, it was not clear whether or not the post-AIA interpretation of these statutory bars included private or so-called secret sales as invalidating disclosures. Pre-AIA 35 U.S.C. § 102(b) reads that a person shall be entitled to a patent unless:

the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

The new wording of 35 U.S.C. § 102(b) states that a person shall be entitled to a patent unless:

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.

Prior to the AIA, it was understood that secret sales and offers for sale were encompassed by the statutory bars and could bar patentability. But the new language was open for interpretation.

On the one hand, this language could be read like pre-AIA 35 U.S.C. § 102(b)—secret sales/offers are still included in the prior art and can bar patentability. On the other hand, it could be read to mean that sales must be “available to the public” in order to bar patentability. Under this interpretation, one could avoid triggering the bar by maintaining the secrecy of sales/offers and communications via non-disclosure agreements or confidentiality agreements (NDAs and CDAs). The bar would only be triggered by an actual commercial and public sale/offer, or public use.

At the outset, the United States Patent and Trademark Office (USPTO) adopted the position that the new AIA 35 U.S.C. § 102(b) does not cover secret sales or offers for sale. The USPTO further clarified that a sale or offer for sale is secret “if it is among individuals having an obligation of confidentiality to the inventor,” and that a sale or offer for sale “must make the invention available to the public” to be considered prior art.

USPTO Manual of Patent Examining Procedure (MPEP) 2152.02. But the USPTO’s position is not binding on the courts, and it remained to be seen which interpretation would win out.

This question was answered, at least in part, earlier this year when the Federal Circuit issued its decision in the case of Helsinn Healthcare, S.A. v. Teva Pharmaceuticals USA (Fed Cir. May 1, 2017). In Helsinn Healthcare, the Federal Circuit addressed “whether the AIA changed the meaning of the on-sale bar under 35 U.S.C. § 102 so that there was no qualifying sale” where the public was aware of a sale, but not aware of the details of that sale related to Helsinn’s post-AIA patent at issue in the case. Id. at 7.

Helsinn’s patent is directed to intravenous formulations of the drug palonosetron, which is an antiemetic used to treat chemotherapy-induced nausea and vomiting, for example. The issue raised in the case was whether Helsinn’s patent was invalid in view of the AIA “on sale bar.” More particularly, the issue was whether a license agreement and a supply and purchase agreement between Helsinn and a third party, MGI Pharma, Inc., that occurred more than one year prior to the priority date of the patent at issue, were invalidating sales/offers that should be considered prior art under AIA 35 U.S.C. § 102(b).

Helsinn entered into the agreements with MGI, and then the agreement was announced in a joint press release of the two corporations and also in MGI’s Form 8-K filing with the Securities and Exchange Commission (SEC), which included partially-redacted copies of the agreements. The non-redacted portions included the palonosetron products covered, method of payment, and method of delivery. On the other hand, the publicly-released non-redacted portions did not include the price terms or sufficient details of the claimed invention to enable one to practice the invention, such as the specific dosage formulations and method(s) of formulation of the drugs.

At the first instance, the District Court found that the agreements constituted a sale but held that they were not prior art. The District Court holding included an interpretation of AIA 35 U.S.C. § 102(b) in line with that of the USPTO, stating that the agreements “did not make Helsinn’s claimed invention available to the public.” Helsinn Healthcare S.A. v. Dr. Reddy’s Laboratories Ltd., 2016 WL 832089, at *52 (D.N.J. Mar. 3, 2016).

Thus, according to the District Court, sales of a product made by a secret process may not bar patentability of that process so long as the process itself remains secret.

On appeal to the Federal Circuit, this decision was overturned. While the Federal Circuit agreed that the Helsinn and MGI agreements constituted a sale of the palonosetron drug, the Federal Circuit found that the patent at issue was invalid because the sale fell under the AIA “on sale bar.” In particular, the Federal Circuit gave no deference to the

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USPTO interpretation of AIA 35 U.S.C. § 102(b) and overturned the District Court’s interpretation of the statute. The Federal Circuit held that “if the existence of the sale is public, the details of the invention need not be publicly disclosed in the terms of the sale.” *Helsinn*, Fed. Cir. at 27. The court reasoned that to hold otherwise “would materially retard the progress of science and the useful arts, and give a premium to those who should be least prompt to communicate their discoveries.” *Id.* at 23.

Notably, however, the Federal Circuit did not directly address the broader question of whether the AIA “on sale bar” encompasses non-publicly released, secret sales or offers for sales, as is the case in pre-AIA 35 U.S.C. § 102(b). The court also did not directly address what date is the trigger for the “on sale bar”—the date of the public disclosure of the sale/offer or the date of the sale/offer itself.

In view of this first major decision on the AIA “on sale bar,” inventors and corporations should be aware that a publicly known sale of an invention will trigger the one-year window for filing a patent application related to that invention, even where the details of the invention are not disclosed. Moreover, they should understand that even a completely secret sale or offer for sale may be enough to trigger the “on sale bar.” If an agreement, communication or interaction could be considered a sale or an offer for sale of an invention, the prudent course would be to file a patent application directed to that invention within one year of the sale or offer for sale, regardless of whether the sale or offer for sale was made public.

**Endnotes**

Brian is an associate at Renner Otto. Brian prosecutes domestic and international utility and design patents primarily in the mechanical and biomedical arts, and further handles matters in the chemical/biotech, business method, software and trademark arts. Brian has a wide array of experience prosecuting technology matters including, but not limited to, hydraulic, pneumatic, piezoelectric, and electromagnetic pumps, motors, manifolds, valving systems and braking systems, fluid containment and delivery systems, aerospace and projectile systems, imaging and radar systems, packaging and packaging systems, consumer and personal care products, surgical and general medical devices, and medical packaging.
IP5 Updates

By TaeRa Franklin

USPTO: Amendments to Rules Regarding Reviving an Abandoned Trademark Application
On July 8, 2017, an amendment to the USPTO’s rules went into effect regarding petitions to revive an abandoned trademark application and petitions to the Director of the USPTO regarding other trademark matters. The amendment allows the USPTO to provide more detailed procedures regarding the deadlines and requirements for requesting revival, reinstatement, or other actions by the Director. The amendment is intended to provide the public with notice of the deadlines and requirements for making the aforementioned requests, facilitate the efficient and consistent processing of such requests, and promote the integrity of application/registration information in the trademark electronic records system as an accurate reflection of the status of applications and registrations. The amendments can be found in 37 C.F.R. §§2.64, 2.66, and 2.146.

The first edition of the Unitary Patent Guide was published in August 2017. The Guide seeks to provide companies, inventors, and their representatives with an outline of the procedure for obtaining a unitary patent from the EPO once the companies, inventors, and their representatives have been granted a European patent based on the provisions of the European Patent Convention.

SIPO: New Administrative Measures for Prioritized Patent Examination in Effect
On August 1, 2017, SIPO’s revised administrative measures for prioritized patent examination became effective. The new measures allow applicants to request prioritized application not only for invention patent applications, but also for utility and design applications. Also, the new measures permit expediting re-examination and invalidation procedures under certain conditions. Further, the new measures reduce the number of documents required to request prioritized application.

China’s Ministry of Commerce intends to draft a document on protecting the intellectual property rights of foreign companies in China. The document is expected to describe a plan to intensify China’s crack-down on malicious trademark registration, online intellectual property right infringement and business secret theft.

KIPO: Changes in KIPRIS for User Friendlier Search
KIPO has expanded the information on citation data in KIPRIS. KIPRIS now includes not only “cited documents,” but also “citing documents.” Cited documents are references in a search report of patent X to earlier published patents or patent application. Citing documents are either patents or patent applications which are published later than patent X and include a reference to patent X in their search reports. Now, users can access both cited and cited documents in KIPRIS by clicking on the Details button.

A new feature showing a graphical overview of all patent family members has been introduced in KIPRIS. This new feature permits users to view at a glance all corresponding applications and filing dates of those applications.

Endnotes
TaeRa is an associate at Renner Otto and focuses her practice on patent preparation and prosecution, particularly in the electrical, electronics and telecommunications fields.