

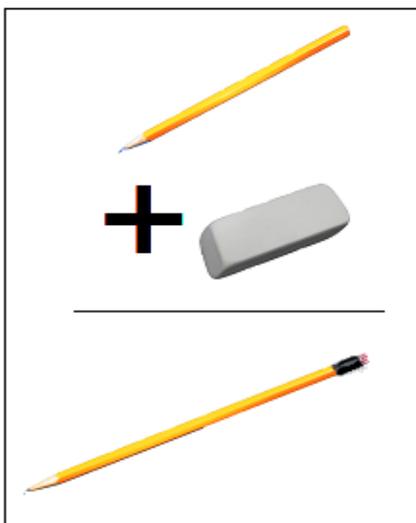
IS IT OBVIOUS? PTO UPDATES KSR OBVIOUSNESS GUIDELINES

In the United States, an invention that is obvious is not eligible for patent protection. Three years ago, the U.S. Supreme Court addressed legal standards to determine whether an invention is obvious in *KSR Int'l Co. v. Teleflex Inc.* ("KSR"). In response, the Patent Office published guidelines to assist patent examiners on determining obviousness based on KSR. Last August, the Patent Office issued an updated set of KSR Guidelines ("Updated Guidelines") for patent examiners and practitioners. The updated Guidelines address recent and relevant Federal Circuit caselaw that dealt with obviousness since the KSR Supreme Court decision.

The KSR decision provided various rationale that may be used to reject patent claims on the grounds of being obvious. Those include whether a claimed combination of prior art elements was known and within the level of skill of an ordinary artisan, or whether the claimed invention would have been obvious to try an providing a finite number of predictable solutions.

Recognizing that these and other rationale provided by the Supreme Court have the potential of resulting in off-hand rejections, the Updated Guidelines provides particular "teaching points" of recent

court rulings that patent examiners and practitioners can use when analyzing whether an invention may be obvious and unpatentable.



Below are some of the key teaching points set forth in the Federal Register:

- Even where a general method that could have been applied to make the claimed product was known and within the level of skill of the ordinary artisan, the claim may nevertheless be nonobvious if the problem which had suggested use of the method had been previously unknown. *In re Omeprazole Patent Litigation*, 536 F.3d 1361 (Fed. Cir. 2008).
- A claimed combination of prior art elements may be nonobvious where the prior art teaches away from the claimed combination and the combination yields more than predictable results. *Crocs, Inc. v. U.S. International Trade Commission*, 598 F.3d 1294 (Fed. Cir. 2010).
- A claimed invention is likely to be obvious if it is a combination of known prior art elements that would reasonably have been expected to maintain their respective properties or functions after they have been combined. *Sundance, Inc. v. DeMonte Fabricating Ltd.*, 550 F.3d 1356 (Fed. Cir. 2008).
- A combination of known elements would have been prima facie obvious if an ordinarily skilled artisan would have recognized an apparent reason to combine those elements and would have known how to do so. *Ecolab, Inc. v. FMC Corp.*, 569 F.3d 1335 (Fed. Cir. 2009).
- The scope of analogous art is to be construed broadly and includes references that are reasonably pertinent to the problem that the inventor was trying to solve. Common sense may be used to support a legal conclusion of obviousness so long as it is explained with sufficient reasoning. *Wyers v. Master Lock Co.*, No. 2009-1412, -F.3d-, 2010 WL 2901839 (Fed. Cir. July 22, 2010).
- An inference that a claimed combination would

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not have been obvious is especially strong where the prior art's teachings undermine the very reason being proffered as to why a person of ordinary skill would have combined the known elements. *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314 (Fed. Cir. 2009).

- When determining whether a reference in a different field of endeavor may be used to support a case of obviousness (i.e., is analogous), it is necessary to consider the problem to be solved. *In re ICON Health & Fitness, Inc.*, 496 F.3d 1374 (Fed. Cir. 2007).

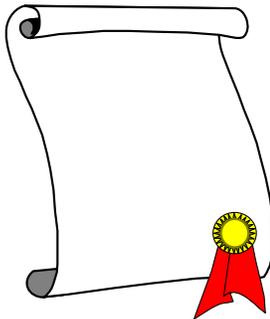
- Analogous art is not limited to references in the field of endeavor of the invention, but also includes references that would have been recognized by those of ordinary skill in the art as useful for applicant's purpose. *Agrizap, Inc. v. Woodstream Corp.*, 520 F.3d 1337 (Fed. Cir. 2008).

- Because Internet and Web browser technologies had become commonplace for communicating and displaying information, it would have been obvious to adapt existing processes to incorporate them for those functions. *Muniauction, Inc. v. Thomson Corp.*, 532 F.3d 1318 (Fed. Cir. 2008).

- A chemical compound would have been obvious

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New Bill Alert!



A bill introduced by Sen. Charles E. Schumer last month could create a limited three-year term of protection for new and original fashion designs. Copyright protection for the designs of useful articles, such as fashion designs, is extremely limited.

Presently, fashion designs are only protectable under copyright "if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article," 17 U.S.C. §101.

The Copyright Act defines "useful article" as "an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally part of a useful article is considered a 'useful article'."

Under current legislation, in order to register a copyright claim in a fashion design the Copyright

Office requires pictorial, graphic or sculptural features that are either physically separable or "while physically inseparable by ordinary means from the utilitarian item, are nevertheless clearly recognizable as a pictorial, graphic or sculptural work which can be visualized on paper, for example, or as a free-standing sculpture, as another example, independent of the shape of the useful article"

Courts have applied the separability test in a way that excludes most designs from copyright protection and the U.S. Copyright Office is also restrictive in registering most designs. The Schumer bill, titled *The Innovative Design Protection and Piracy Prevention Act*, if enacted, would provide limited intellectual property protection for a three-year period for new and unique fashion designs. Under the proposed legislation, a designer who claims that his or her work has been copied will have to demonstrate that his or her design represents "a unique, distinguishable, non-trivial and non-utilitarian variation over prior designs" and demonstrate that a copy is "substantially identical" to the original protected design. Consumers would not be held legally responsible for accidental purchases of illegal copies. In addition, the proposed legislation also includes an exception for home sewers, who would be permitted to copy a protected design for personal use or the use of a family member.

If enacted, the legislation would, for the first time, allow for designers to benefit from legal protections that, up to now, have not been available to them. We will continue to monitor the status of the Senator Schumer's bill and report further developments in future editions of the Ostrolenk Newsletter.

Sean P. McMahon, Associate

Protect Your Intellectual Property

Part 1 in a Series

Ostrolenk Faber introduces a first part in a continuing series of articles to address steps for protecting valuable intellectual property. This series is designed to inform the reader of options for protecting intellectual property, steps associated with intellectual property protection, and ways to assist members of Ostrolenk Faber LLP to work efficiently and keep costs down. Future Ostrolenk Newsletters may continue where a previous issue left off, or may introduce a new subject designed to educate the reader in protecting intellectual property.

This Fall 2010 Ostrolenk Newsletter series

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35 U.S.C. §112, ¶6 ???

It All Depends On What the Word “Means” Means

Applicants commonly take advantage of so called "means-plus-function" (MPF) language in patent claims to describe claim elements that perform a particular function. Indeed, 35 U.S.C. §112 explicitly authorizes the use of such language. While MPF claim elements appear to offer a straightforward way to express a desired functional element of a claim, interpretation of these types of claim elements has been rather erratic in the courts. The Federal Circuit sought to reduce related confusion in its recent decision in *Gregory Baran v. Medical Device Technologies* (Fed. Cir. 2010).

Gregory Baran is a doctor and the owner of two related patents covering automated biopsy instruments. In the district court, Judge O'Malley interpreted the recitation, "release means for retaining the guide in the charged position" to require a structure that exhibited both a releasing function and a retaining function. Dr. Baran, on the other hand, argued that this element only required the recited retaining function.

35 USC 112, paragraph 6, explicitly authorizes claim elements to be recited as "as a means or step for performing a specified function." The language at issue, therefore, would appear to fall under Section 112, paragraph 6. Section 112 goes on to specify how such claim terms should be construed. Specifically, Section 112 requires such terms to be "construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." In light of this clear authorization to present claim limitations in the form of a means "for" performing a specific function and the clear guidance provided in the statute as to interpretation, the erratic nature of claim construction when it comes to MPF limitations is somewhat puzzling.

For example, in the present case, the Federal Circuit agreed with Judge O'Malley noting, in part that:

"[T]he claim language recites both a release function and a retention function. Dr. Baran's argument regarding the placement of the term 'release' is unavailing. The relevant inquiry is whether the term at issue is purely functional. See *Signtech USA, Ltd. v. Vutek, Inc.*, 174 F.3d 1352, 1356 (Fed. Cir. 1999) (construing "ink delivery means" to be equivalent to "means for ink delivery" because "ink delivery" was purely functional language); *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308,

1318 (Fed. Cir. 1999) ("[W]hen it is apparent that the element invokes purely functional terms . . . the claim element may be a means-plus-function element despite the lack of express means-plus-function language."). In the context of the '797 patent, the term 'release' is not an idle description but a vital function to be performed by the means-plus-function element. The patent does not recite a biopsy instrument that retains indefinitely without release; rather, the contemplated function is to retain for the express purpose of producing a spring-loaded release on demand. The claim language ties both functions to the same means-plus-function element, so it is appropriate that the element be construed accordingly."

The court thus essentially read a second "release" function into the claim element despite the fact that the intended function was rather clearly laid out in conventional MPF language as a "means for retaining the guide." The Court's reliance on *Al-Site Corp. v. VSI Int's, Inc.* is puzzling since the present case would appear to be distinguishable in that the limitation in question expressly includes MPF language. Similarly, *Signtech USA, Ltd. v. Vutek, Inc.* also appears misapplied since the claim also clearly defines the required function of "retaining the guide," and thus, there would appear to be little reason to look for equivalence.

While MPF claim limitations still serve a very useful purpose, recent caselaw may give pause to applicants. In this case, the desired functionality of the claim element was explicitly recited by the applicant in the statutorily authorized format, and yet the district court and the Federal Circuit decisions construed the language in a manner that appears contrary to the plain language of the statute. On the small scale, the lesson to be learned would be to take care that no other word or phrase is linked to the recited "means" in an MPF claim element. Unfortunately, in the end, no matter how clearly an applicant appears to be, the meaning of any particular "means" may be subject to debate.

Keith J. Barkaus, Associate



Is It Obvious? (Continued from page 2)

over a mixture containing that compound as well as other compounds where it was known or the skilled artisan had reason to believe that some desirable property of the mixture was derived in whole or in part from the claimed compound, and separating the claimed compound from the mixture was routine in the art. *Aventis Pharma Deutschland v. Lupin Ltd.*, 499 F.3d 1293 (Fed. Cir. 2007).

· An obvious to try rationale may be proper when the possible options for solving a problem were known and finite. However, if the possible options were not either known or finite, then an obvious to try rationale cannot be used to support a conclusion of obviousness. *Rolls-Royce, PLC v. United Technologies Corp.*, 603 F.3d 1325 (Fed. Cir. 2010).

· Where there were a finite number of identified, predictable solutions and there is no evidence of unexpected results, an obvious to try inquiry may properly lead to a legal conclusion of obviousness. *Perfect Web Technologies, Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1328-29 (Fed. Cir. 2009).

· Even though all evidence must be considered in an obviousness analysis, evidence of nonobviousness may be outweighed by contradictory evidence in the record or by what is in the specification. *PharmaStem Therapeutics, Inc. v. Viacell, Inc.*, 491 F.3d 1342 (Fed. Cir. 2007).

· Evidence that has been properly presented in a timely manner must be considered on the record. Evidence of commercial success is pertinent where a nexus between the success of the product and the claimed invention has been demonstrated. *Hearing Components, Inc. v. Shure Inc.*, 600 F.3d 1357 (Fed. Cir. 2010).

· Evidence of secondary considerations of obviousness such as commercial success and long-felt need may be insufficient to overcome a prima facie case of obviousness if the prima facie case is strong. An argument for nonobviousness based on commercial success or long-felt need is undermined when there is a failure to link the commercial success or long-felt need to a claimed feature that distinguishes over the prior art. *Asyst Techs., Inc. v. Emtrak, Inc.*, 544 F.3d 1310 (Fed. Cir. 2008).

As will be appreciated, the "learning points" in the Updated Guidelines offer some assistance for patent examiners and practitioners to determine whether a claimed invention is obvious. Whether they do, in fact, serve to clarify the issue remains to be seen.

Joel J. Felber, Associate

Protect Your Intellectual Property (Continued from page 2)

features steps associated with trademark protection.

The most reliable means of determining whether a proposed mark is available for use and whether it can be registered in the U.S. Patent and Trademark Office ("PTO") is to conduct a trademark search. This generally follows a two step approach:

1. A "**knock-out**" search of the PTO records by an attorney in our firm. This looks only for registrations and applications of identical or virtually identical marks which may directly conflict with your proposed mark. If such a conflict does exist, you may decide to choose a different mark and the cost of a full search can be avoided.

2. If the knock-out search does not locate any obvious conflicts, a **full search**, prepared by an outside specialist, can be obtained. A full search covers a wider range of the PTO records, as well as state trademark registrations, business name and product directories, trade and consumer publications, other "common law" sources, Internet web sites and domain names. A full search looks not only for identical marks, but also similar marks identifying goods and services related to those covered by the proposed mark. We review the search report and prepare a legal analysis of the availability of the proposed mark for use and registration.

Searching can reduce the risk of a potentially costly surprise. No matter how well you think you know your industry, profession, or field, it is virtually impossible to be aware of every trademark or business name in use. This is especially true of marks that have been filed in the PTO on an intent to use basis. These applications, which establish rights in the mark as of the application filing date, can remain pending for up to four years before the applicant is required to actually begin commercial use of the mark.

Stephen J. Quigley, Of Counsel

(Check back in the Winter Ostrolenk Newsletter for the remainder of this and other articles in this Series).

FIRM NEWS:

Ostrolenk Faber LLP is proud to announce the addition of Steven M. Hoffberg as a partner of the firm. Mr. Hoffberg is a member of the Bars of New York and Connecticut, and is registred to practice before both federal and state courts. For more information on Mr. Hoffberg and to view his full bio, visit www.ostrolenk.com or visit us on Facebook.