

Developments in U.S. Patent Law



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Developments in U.S. Patent Law



What's New?

- Patent Office Initiatives
- Legislative Proposals
- Judicial Developments

Patent Office Initiatives

The Patent Office has several, popular on-going initiatives

- **Track One – Prioritized Examination**

- Prioritized examination is available for a fee at the time of filing an original utility application.
- Thousands of applicants have obtained patents within six months of filing.

- **Patent Prosecution Highway**

- When an applicant receives a ruling from its national patent office that at least one claim is allowable, the applicant may request accelerated examination of the corresponding claim(s) in the counterpart U.S. application.
- This allows applicants to reach final disposition of a patent application more quickly and efficiently than standard examination processing. More than 70,000 applications have used this program.

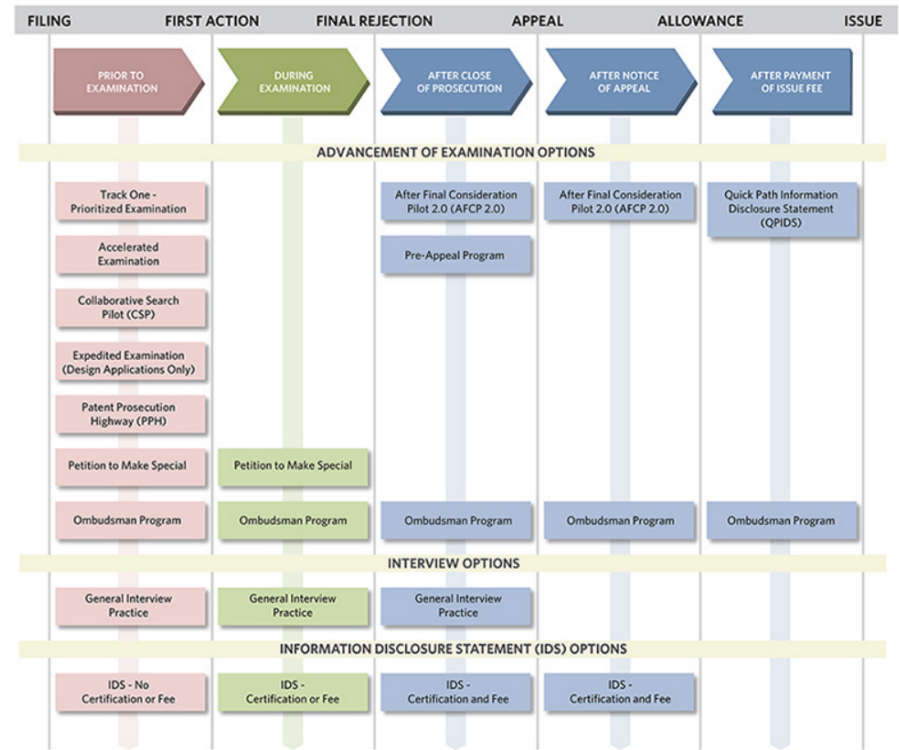
- **After Final (Action) Consideration**

- Applicants having received a final rejection of claims may request further consideration in connection with a further amendment to at least one independent claim that the applicant believes will lead to allowance with only limited further searching and/or consideration by the examiner.

Patent Office Initiatives

The Patent Office has **many more on-going initiatives**, each designed to help applicants more efficiently obtain patents

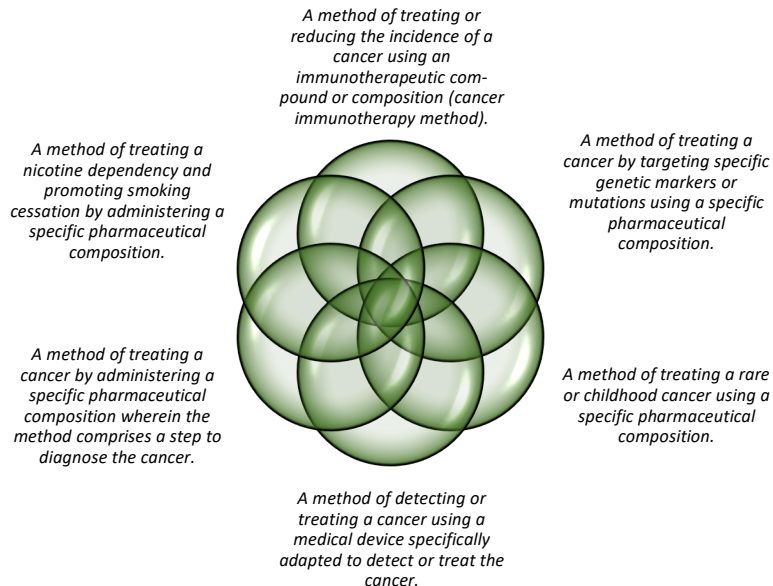
All are explained at the Patent Office's dedicated website [link](#)



Patent Office Initiatives

Cancer Moonshot Expedited Examination Pilot Program

- Qualifying applications involving cancer-related technologies are advanced out of turn for examination.
- Program is open until the earlier of January 31, 2025, or until 1000 petitions are granted.
- The application must be in the field of oncology or smoking cessation and must contain at least one **eligible method claim**.
- Details at this Patent Office website [link](#).



Patent Office Initiatives

Climate Change Mitigation Program

- Qualifying applications involving greenhouse gas reduction technologies are advanced out of turn for examination.
- Program is open until the earlier of June 7, 2027, or until 4000 petitions are granted.
- Applications **must contain one or more claims to a product or process that mitigates climate change by reducing, removing, or assessing greenhouse gas emissions.**
- Details at this Patent Office website [link](#).



Patent Office Initiatives: Proposed Fee Increases

5% Increases

- An across-the-board 5% fee increase to most patent-related fees.
- Additionally increasing by 5% application filing, search, and examination fees.

Information Disclosure Statement

- Three surcharges (\$200, \$300, \$300) due upon the first filing of any information disclosure statement (IDS) that results in a cumulative number of applicant-provided citations exceeding 50, 100, or 200 references, respectively.

Tiered fees for Continuation Applications

- New tiered fee for filing continuing applications more than 3 or 7 years after the earliest benefit date (\$1500 and \$3000, respectively).
- Intended to encourage more efficient filing and prosecution behavior and offset future lost maintenance fee collections that eventually recover the examination costs incurred.

Patent Office Initiatives: Proposed Fee Increases

Tiered Request for Continued Examination (RCE) fees

- The Office proposes to pass more of the costs associated with RCEs to applicants.
- Increasing fee amounts for first and second RCEs (\$1500 and \$2500, respectively), and adding an additional tier with a higher fee (\$3600) for third and subsequent RCEs.

Tiered Terminal Disclaimer Fees

- The Office proposes to change the flat fee for filing a terminal disclaimer.
- A sliding fee scale where fees increase after certain milestones, e.g., a final action or appeal.
- Proposed fees (ranging from \$200 to \$1400) encourage applicants to file terminal disclaimers as early as possible during the examination process, enabling more efficient examination.

Details at this Patent Office website [link](#).



Protecting American Intellectual Property Act of 2022

- Impose sanctions on foreign entities/persons involved in “significant” theft of U.S.-owned trade secrets.
- Annual Presidential report to Congress, identifying “foreign persons” who have “knowingly engaged in, or benefited from, significant theft” of trade secrets, if the activity is “likely to result in . . . a significant threat to the national security, foreign policy, or economic health” of the U.S.
- Applies to foreign persons who provide “significant” financial or technical support to, or act on behalf of, the direct offender, including an entity’s CEO or board members.

Judicial Developments: Supreme Court Addressed Enablement



Amgen v. Sanofi

- **Court held invalid as non-enabled claims reciting a genus of antibodies by their function:** binding particular amino acid residues on a protein and, thus, blocking that protein from interfering with the body's ability to remove cholesterol.
- Patents "claim[ing] an entire class" of inventions "**must enable a [skilled person] to make and use the entire class.**"
- The patent need not always describe "how to make and use every single embodiment within a claimed class."
- A roadmap to each embodiment may be sufficient, but not when it requires "painstaking experimentation."

Court's decision is available at this [link](#).

Judicial Developments: Supreme Court Will Not Address



Teva Pharms. USA v. GlaxoSmithKline

- If a generic drug's FDA-approved label carves out all language that the brand manufacturer has identified as covering its patented uses, can the generic manufacturer be held liable on a theory that its label still intentionally encourages infringement of those carved-out uses?
- The Federal Circuit effectively answered "yes."
- Despite the government's recommendation for the Supreme Court's review ...
- Court issued an order in mid-May declining to address this issue.

Judicial Developments: Supreme Court Will Not Address



U.S. Government Recommended Review

- *Interactive Wearables, LLC v. Polar Electro Oy*
- *Tropp v. Travel Sentry, Inc.*

- **What is the appropriate standard for determining whether a patent claim recites a patent-ineligible concept, e.g., abstract idea, under 35 U.S.C. § 101?**
- In both cases, the Federal Circuit summarily affirmed district court decisions that concluded the patents claimed abstract ideas without inventive concept and without technical improvement over prior art.
- The Federal Circuit has explicitly invited Supreme Court review and, despite the government's repeated recommendations—including here—for such review ...
- Court issued an order in mid-May, declining to address this issue.

Judicial Developments: Supreme Court Will Not Address



Thaler v. Vidal (PTO)

- Patenting of artificial intelligence.
- **Does the Patent Act categorically restrict the statutory term “inventor” to human beings alone?**
- Federal Circuit effectively answered “yes.”
- The government recommended no Supreme Court review and ...
- Court issued an order in late April, declining to address this issue.

Thank you

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