DESIGN PATENT PERSPECTIVE: The Design Patent Application PART 3

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In parts 1 and 2 we discussed the title and figure description portions of a design patent application and introduced the drawings and claim. This month we continue discussing drawing requirements and common drawing errors and explain further why multiple claims in a design patent should be considered.

DRAWINGS

Drawings in a design patent application are extremely important because they constitute the entire visual disclosure of a claim.[1] The drawings must satisfy the substantive disclosure requirements of enablement and definiteness under paragraphs one and two of 35 U.S.C. § 112 and the technical requirements of 37 CFR §§ 1.84 and 1.152. When drawings fail to adequately disclose the claimed design, an examiner will issue a rejection under section 112, first and second paragraphs, as nonenabling and indefinite. When drawings fail to satisfy the technical requirements of sections 1.84 and 1.152, an examiner will issue an objection to the drawings. Both rejections and objections must be overcome with properly submitted drawings before a design patent will issue.

Section 1.84 sets forth the general drawing standards for both design patents and utility patents. It contains twenty-five separate requirement sections labeled (a) through (y). Section 1.152 is directed specifically at design drawings. It addresses these six points: (1) drawings must comply with section 1.84; (2) there must be a sufficient number of views to completely disclose the design; (3) surface shading should be used to show the character and contour of surfaces; (4) solid black surface shading is not permitted except to show the color black and color contrast; (5) broken lines are appropriate to show environmental structure, but not to show hidden planes and surfaces or alternate positions; and (6) photographs and drawings may not be combined in one application and photographs must not disclose environmental structure.

Section 112 paragraph one requires that a description of the invention be "in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same." Paragraph two requires that the claim "particularly point[] out and distinctly claim[] the subject matter which the applicant regards as his invention."

An applicant should take great care in properly preparing drawings for a design patent application. If the drawing disclosure does not satisfy the enablement and definiteness requirements of section 112 and cannot be cured without introducing prohibited new matter, (35 USC 132, 37 CFR 1.121), then the application will be considered fatally defective. Although a continuation in part or new application may be filed, the original filing date may be lost and intervening prior art may become a problem. Drawing problems may require converting objectionable portions to broken lines. This technique disclaims portions of the original design and as a result it may be harder to prove infringement. Further, the process of curing drawing problems adds expense and delays the issue date, which in turn delays the ability to stop infringers and collect damages. Finally, clear and accurate drawings may make the enforcement process easier by eliminating potentially distracting side issues concerning validity and infringement under the ordinary observer test.

The following are some examples of common drawing errors resulting in objections and rejections, all of which ultimately were overcome by either correction or broken line conversion. Error examples are taken from design patent prosecution histories.

INDEFINITENESS AND LACK OF ENABLEMENT

The single most common drawing error is the failure to properly illustrate the exact appearance of all claimed design features. If any portion of the design is left to conjecture or multiple interpretations, then the claim will be considered indefinite and not enabled. The precise shape, depth, contour, and spatial relationships of all design elements and details, no matter how small, must be shown clearly and consistently. Common design features that typically cause definiteness and enablement problems are holes,[2] depressions and indentations,[3] raised areas, open and hollow areas,[4] transparent surfaces,[5] complex curves and bends, small design elements, and internal structures that can be viewed.[6]

Indefiniteness and nonenablement often are caused by the failure to use proper shading and sufficient corroborating views. For example, typically the nature of every bend and change in depth and contour cannot be determined from simple plan or elevational views that lack shading.[7] If such details cannot be determined from a perspective or other view, then the drawings will not enable the entire design. This can cause significant problems because new views and shading cannot be added without some antecedent basis due to the prohibition against adding new matter to a claim. Unlike defective utility patent drawings that may be corrected based on a detailed written description of the invention, design patent applications usually are filed without detailed written descriptions. Often the only way to cure the problem is to convert the indefinite structure to broken lines, which may adversely affect enforcement efforts.

The failure to properly illustrate all design features may result from an applicant or their representative becoming so familiar with the design that certain details of depths and contours are mentally assumed and the lack of proper illustration is overlooked. A practical way to combat this common phenomenon is to ask a person unfamiliar with the design to view and describe each design feature in detail, including shape, depth, contour, and whether the feature represents an open or closed element. If they are unable to do so completely and accurately, then additional lines, views, and/or shading should be added to the drawings.

Another technique is to draft a detailed written description of the design. Although detailed written descriptions typically are not filed with design patent applications, they can be.[8] The exercise of describing each design feature in detail may reveal portions of the design that need additional illustration. Further, if the written description is filed, it may potentially serve as antecedent basis for any needed drawing corrections (much like a utility patent written description).

INCONSISTENCIES BETWEEN VIEWS

Another common drawing error is lack of consistency between different views of the design. Examples of such inconsistencies are solid lines existing in some views and not in others,[9] structures and gaps that differ between views,[10] solid lines in one view and broken lines in another,[11] and edges that are straight in one view and curved or zigzagged in another.[12] If the inconsistencies are minor and it is clear from the initial drawings that the applicant had possession of the design, then the drawings can be corrected without adding new matter.[13] However, if the inconsistencies "are of such a magnitude that the overall appearance of the design is unclear,"[14] the claim likely will be rejected as nonenabling and indefinite under 35 USC 112, paragraphs one and two.

One way to minimize or avoid inconsistencies is to focus on each individual design feature separately and then methodically proceed through each view to make sure the feature is illustrated consistently in each view. Checklists can be helpful for this exercise.

LINE QUALITY

Lines in design drawings must be "durable, clean, black (except for color drawings), sufficiently dense and dark, and uniformly thick and well-defined."[15] Further, "[t]he weight of all lines ... must be heavy enough to permit adequate reproduction."[16]

Common objections are that solid lines are too close together,[17] contain small breaks inconsistent with other views,[18] are jagged,[19] pixaleted,[20] rough,[21] blurry,[22] imprecise,[23] fuzzy,[24] bleeding,[25] and that solid and broken lines cannot be distinguished.[26] Often using a higher resolution can cure line problems,[27] and when multiple solid lines must be closely spaced, it is helpful to use carefully executed fine lines.[28] Remember that drawings are reproduced to two-thirds in size and that lines distinct in the original may impermissibly merge when reproduced.[29]

Lines defects usually can be corrected without adverse effect, but if lines are so blurry and unclear that intricate details cannot be understood, then the only solution may be correct the ambiguous area to broken lines.[30] The broken lines must appear distinctly separate from the solid lines.

SHADING PROBLEMS

Shading is one of the primary ways to illustrate surface contours in drawings. Officially, shading is not required, but CFR § 1.152 states "[a]ppropriate and adequate surface shading *should* be used to show the character or contour of the surfaces represented" (emphasis added) and CFR § 1.84(m) states "[t]he use of shading in views is encouraged if it aids in understanding the invention ....". The preferred shading technique is spaced lines that are thin, as few in number as practicable, and that contrast with the rest of the drawings,[31] although stippled shading also may be used.[32] The view should be shaded as if light comes from the upper left corner at an angle of 45°.[33]

When drawings are not adequately shaded, examiners typically encourage shading with statements such as "[s]urface shading is of particular importance in the showing of three (3) dimensional articles where it is necessary to delineate plane, concave, convex, raised, and/or depressed surfaces of the subject matter, and to distinguish between open and closed areas."[34] Shading suggestions usually are accompanied by a warning against adding new matter, a reminder that any additional surface shading must find antecedent basis in the original disclosure.[35]

All drawing figures must be consistently shaded and all shading must be consistent with contours evident from various profile views.[36] A common mistake is including shade lines or stippling in areas that have been disclaimed with broken lines.[37] That is improper and the shading in disclaimed areas must be removed. Other common problems are using surface shading that is poor and inaccurate,[38] too dark,[39] random and confusing,[40] or that blends into and cannot be distinguished from solid lines used to claim the design. Finally, shade lines must be readily distinguishable from oblique lines that represent translucent or transparent surfaces in a design drawing.

LACK OF VIEWS

CFR § 1.152 states that a design drawing "must contain a sufficient number of views to constitute a complete disclosure of the appearance of a design." However, this does not mean that the entire article always must be disclosed, because it is permissible to claim just a portion of an article.[41] But if certain views of an article are omitted, a statement should be included that the views not shown form no part of the claimed design. If the applicant does not include such a statement, the examiner likely will.[42]

IMPROPER SCALE AND SIZE

CFR § 1.84(k) states "[t]he scale to which a drawing is made must be large enough to show the mechanism without crowding when the drawing is reduced in size to two-thirds in reproduction." An examiner may suggest that a drawing be enlarged in scale to provide more space for fine line definition.[43] Further, it usually is improper to include drawing figures of different sizes because it can be unclear whether multiple embodiments are being claimed or that some figures are shown enlarged for ease of illustration.[44]

IMPROPER WORDS AND MARKINGS

Occasionally a design patent drawing will contain extraneous words, arrows, lead lines, or numbers. Although these markings may be appropriate in utility patent drawings, they are improper in design patent drawings. Examiners have explained that "[i]t is longstanding [PTO] Office practice that [design] patent drawings must be free from instructional indicia, text labels, reference characters, arrows, dimension lines and other markings unrelated to the claim"[45]

INCORRECT NUMBERING

Drawing sheet numbers and view numbers "must be plain and legible, and must

not be used in association with brackets or inverted commas, or enclosed within outlines, e.g., encircled."[46] Both drawing sheets and figure views must be numbered in consecutive Arabic numerals starting with 1.[47] Views are numbered independently of sheets "and, if possible, in the order in which they appear on the drawing sheet(s)."[48] Errors include failing to number sheets or views,[49] or failing to number views consecutively and in Arabic numerals.[50] Further, suffixes such as 1A, 1B, etc. are improper.[51] An examiner may object if numbers are drawn free hand and not in a simple, clear, mechanical fashion.[52]

MISCELLANEOUS DRAWING ISSUES

Exploded views and indeterminate break lines must be joined with a bracket.[53] When a design feature claimed in solid lines meets an area disclaimed with broken lines, the entire boundary should be defined with a break line for clarity. For an example, *see* D666,465 (Breakout tool). Drawing figures should appear in an upright position unless there is a substantial reason for the figure to appear at an angle.[54] Exploded views, partial views, and sectional views are not often used in design patent drawings, but they can be helpful or even necessary, and their detailed requirements are set forth in 37 CFR § 1.84(h), subsections (1), (2), and (3). Color drawings and photographs also are rare, and their requirements are set forth in 37 CFR § 1.84(a)(2) (color) and (b) (photographs).[55] When drawings are amended, the figure or figure number should not be labeled as "amended." Rather, sheets containing amended drawings should be prepared according to the procedure explained in 37 CFR § 1.121(d) and labeled as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as appropriate.

THE CLAIM

Last month's column introduced the design patent claim. A claim typically is written in the form "[t]he ornamental design for an [article of manufacture] as shown."[56] If in addition to the figure descriptions, a special description is included in the specification, then the typical form is "[t]he ornamental design for an [article of manufacture] as shown *and described*."[57] (emphasis added).

Since the form of a claim is simple, errors are rare. The most common error is failing to describe the article of manufacture with the same words that are used in the title.[58] Another error occasionally made is using the term "illustrated" instead of "shown."[59]

As discussed in last month's column, the USPTO currently follows the rule set forth in 37 CFR 1.153 that "[m]ore than one claim is neither required nor permitted."[60] This rule is not mandated by statute. 35 U.S.C. § 112 provides in relevant part "[t]he specification shall conclude with one *or more* claims …." (emphasis added).

The Court of Customs and Patent Appeals (CCPA) addressed the apparent conflict between the statute and the rule in *In re Rubinfield*[61] in 1959. The court stated it was "unable to find any clear conflict between Rule 153 and the applicable statutes"[62] reasoning that "[w]hile 35 U.S.C. § 112 states that 'The specification shall conclude with one or more claims,' that provision does not necessarily mean that every applicant shall, as a matter of right, be entitled to present a plurality of claims regardless of the nature of the invention involved."[63]

Following *Rubinfield*, USPTO practice consistently has allowed only one claim in a design patent. However, as discussed in last month's column, in 1980 the CCPA held in *In re Zahn*[64] that a design patent applicant could claim just a *portion* of the article of manufacture and that portion claiming does not violate either 35 U.S.C. § 171 or 35 U.S.C. § 112 (description and enablement). The ability to claim just a portion of an article of manufacture appears to have severely undercut the rationale used to limit design patents to only one claim.

A detailed explanation of the "one claim" rationale is contained in *Ex parte Wiessner*,[65] a case involving three claims – one to an entire bed, one to the bed's headboard, and one to the bed's footboard. *Wiessner* cites and quotes many cases, but basically three reasons are provided for the one claim restriction. First, the concept of claim dependency or combination/sub-combination (also referred to as genus-species) existing in utility patent practice allegedly should *not* apply to design patents.[66] That is, an applicant should not be able to claim the entire design and then just a portion of the same design in the same patent. The primary basis for this reasoning, according to *Wiessner*, is language from the Supreme Court in *Gorham v. White*[67] including the statement "[a] patent for a product is a distinct thing from a patent for the elements entering into it, or for the ingredients of which it is composed, or for the combination which causes it."[68]

Second, according to *Wiessner*, the only purpose for allowing claims on distinctive and separate parts is "to point out those predominant and controlling features in a design the use of which alone would be regarded as preserving the identity of a design, even when other parts are omitted."[69] Under *Wiessner*, if an ordinary observer would not be likely to recognize the sameness or resemblance between the segregated parts and the whole design, the separate claims should not be allowed. In short, since the ordinary observer looks to just one overall design to determine infringement[70] "[t]o permit claims for parts that belong to details which possess no distinct and visible resemblance to and create in the mind no impression of the whole design would be to set traps for the unskilled and unwary."[71]

Third, according to *Wiessner*, "[t]he only apparent reason for allowing [multiple claims] in one case instead of requiring separate applications is to save the applicant the additional expense and trouble."[72] The *Wiessner* court concluded this was not reason enough, particularly in light of the other stated reasons for not permitting more than one claim.

None of *Wiessner's* reasons for restricting a design patent to only one claim holds up under careful scrutiny. First, regarding the asserted prohibition against multiple and "dependent" claims in design patents based on language from *Gorham v. White*, this reasoning never was correct. As succinctly stated by William Simonds in his treatise *The Law of Design Patents* published in 1874, "[u]pon examining the decision of the court below it will be seen that this language [above quoted from *Gorham v. White*] has no relation whatever to the question of whether a design patent may have one or more claims, but is used solely for the purpose of negativing the idea advanced by the judge below to the effect that a patent for a design is in effect a patent for the agencies used to cause an appearance and not for the appearance itself."[73]

Second, regarding the confusion an ordinary observer allegedly may suffer if combination and subcombination (portion) claiming is allowed in a single design patent, this reasoning breaks down for at least two reasons. First, portion claiming now is expressly allowed on less than the entire article of manufacture and portion claiming has not created unreasonable confusion. Second, in design patent law, an ordinary observer is not a real person, but rather an artificial construction that both usually knows more (about prior art) and sometimes sees less (by factoring out functional features) than a real person does.[74] To suggest that such a complex artificial construction would be "confused" by a full claim and a portion claim in the same design patent seems untenable.

Third, good reason exists to allow multiple claims in design patents beyond saving an applicant time and expense. As stated by Mr. Simonds over one hundred and thirty-five years ago: "[w]here a design contains features which are separate and distinct from the other features, there seems to be no good reason why a claim may not be made to each of such features. Suppose a design for the ornamentation of the surface of a circular plate to consist of three features, radial rays at the centre, a wreath of flowers outside of this, and ornamental serrations at the periphery. It would seem absurd to compel the producer to take a patent for the design as a whole, thus permitting any one so disposed to use any two of these features with impunity."[75]

An option to file multiple design patents does not effectively solve the problem mentioned in Mr. Simonds' treatise. Beyond the considerable additional expense of multiple drawings and administrative filings, a significant number of design patent applicants are not aware of the need for separate protection on portions of their designs. Unlike utility patent practice where multiple independent and dependent claims are typical, portion claiming in multiple patents is far from the standard in design patent practice. And it is unlikely to become standardized until multiple claims are allowed in a single design patent. Unfortunately, the first time many design patentees become aware of the potential need for separate portion claims is when their legal advisor informs them they have no case for infringement because a competitor has successfully designed around their patent by omitting portions of the design. The "traps for the unskilled and unwary" mentioned in *Wiessner* now are not due to the *presence* of multiple portion claims in one design patent, but rather the prohibition against them.

Since 35 USC 112 allows multiple claims, the patent office can remove the "one claim" restriction from design patents if they believe it is appropriate. Approximately ten years ago, officials from the patent office appeared open to allowing multiple claims in design patents and made inquiries to the design patent bar at AIPLA meetings if such a change was desired.[76] Apparently not enough organized positive response appeared from the bar to pursue the idea at the time. Perhaps both the patent office and the design patent bar should reconsider the proposal in light of the post-*Egyptian Goddess*[77] renaissance in design patent law and the current need for increased design patent protection.

In next month's column we will continue our discussion of other requirements for a design patent application. IPT

ENDNOTES

1. *See* MPEP § 1503.02.
2. *See* non-final rejection in prosecution history of U.S. D666,780.
3. *See* non-final rejections in prosecution histories of U.S. D666,661, U.S. D666,664.
4. *See* non-final rejections in prosecution histories of U.S. D666,437, U.S. D666,303.
5. *See* non-final rejection in prosecution history of U.S. D666,782.
6. *See* notice of allowance in prosecution history of U.S. D666,558.
7. *See* non-final rejection in prosecution history of U.S. D666,707.
8. *See* MPEP § 1502.01 II ("[W]hile not required, such a [written] description is not prohibited and may be incorporated, at applicant's option, into the specification or may be provided in a separate paper. *Ex parte Spiegel*, 1919 C.D. 112, 268 O.G. 741 (Comm'r Pat. 1919) …. In addition to the figure descriptions, the following types of statements are permissible in the specification: (A) Description of the appearance of portions of the claimed design which are not illustrated in the drawing disclosure.").
9. *See* non-final rejection in U.S. D666,415 and notice of allowance of U.S. D666,319 in their prosecution histories.
10. *See* non-final rejections in prosecution histories of U.S. D666,450, U.S. D666,707.
11. *See* non-final rejections in prosecution histories of U.S. D666,523, U.S. D666,779, and notice of allowance in prosecution history of U.S. D666,305.
12. *See* non-final rejection in prosecution history of U.S. D666,780.
13. *See* non-final rejection in prosecution history of U.S. D666,729.
14. See MPEP § 1502.02.
15. 37 CFR 1.84 (l).
16. *Id.*
17. *See* non-final rejection in prosecution history of U.S. D666,450.
18. *See* notice of allowance in prosecution history of U.S. D666,778.
19. *See* non-final rejection in prosecution history of U.S. D666,773.
20. *See* non-final rejection in prosecution history of U.S. D666,665.
21. *See* non-final rejection in prosecution history of U.S. D666,760.
22. *Id.*
23. *See* non-final rejection in prosecution history of U.S. D666,773.
24. *See* notice of allowance in prosecution history of U.S. D666,560.
25. *See* non-final rejection in prosecution history of U.S. D666,780.
26. *See* non-final rejection in prosecution history of U.S. D666,760.
27. *See* notices of allowance in prosecution histories of U.S. D666,558, U.S. D666,560.
28. *See* non-final rejection in prosecution history of U.S. D666,776.
29. *Id.*
30. *See* notice of allowance in prosecution history of U.S. D666,558.
31. *See* CFR § 1.84(m).
32. *See A Guide to Filing a Design Patent Application*, p. 13, available at www.uspto.gov.
33. *Id.*
34. *See* non-final rejection in prosecution history of U.S. D666,707.
35. *Id.*
36. *See* notices of allowance in prosecution histories of U.S. D666,330, U.S. D666,501, and non-final rejection in prosecution history of U.S. D666,776.
37. *See* notices of allowance in prosecution history of U.S. D666,305, U.S. D666,378.
38. *See* non-final rejection in prosecution history of U.S. D666,760.
39. *See* non-final rejection in prosecution history of U.S. D666,663.
40. *See* non-final rejection in prosecution history of U.S. D666,760.
41. *See In re Zahn*, 617 F.2d 261 (CCPA 1980).
42. *See* notice of allowance in prosecution history of U.S. D666,683.
43. *See* non-final rejection in prosecution history of U.S. D666,773.
44. *See* non-final rejection in prosecution history of U.S. D666,303.
45. *See* non-final rejection in prosecution history of U.S. D666,776.
46. 37 CFR § 1.84(p).
47. 37 CFR §§ 1.84(t) and (u).
48. 37 CFR § 1.84(u)
49. *See* non-final rejection in prosecution history of U.S. D666,784.

50. *See* non-final rejection in prosecution history of U.S. D666,314.
51. *See* notice of allowance in prosecution history of U.S. D666,558.
52. *See* non-final rejection in prosecution history of U.S. D666,450.
53. *See* 1.84(h)(1); *see also* notice of allowance in prosecution history of U.S. D666,485.
54. *See* non-final rejection in prosecution history of U.S. D666,524.
55. A discussion of the proper use of color drawings and photographs is beyond the scope of this article.
56. *See* MPEP § 1503.01, subsection III.
57. *Id.*
58. *Id.*
59. *See, e.g.,* notice of allowance in prosecution history of U.S. D666,747.
60. Although only one claim is allowed, multiple embodiments are permitted if they involve the same inventive concept and are not patentably distinct under the "obviousness-type" double patenting standard. *See* MPEP § 1504.05(II)(A). A discussion of multiple embodiments is beyond the scope of this article.
61. *In re Rubinfield* , 270 F.2d 391 (CCPA 1959).
62. *Id.* at 395.
63. *Id.*
64. 617 F.2d 261 (CCPA 1980).
65. 1898 C.D. 236, 85 O.G. 937.
66. The two potential types of multiple claims in a design patent are a combination-subcombination type claim (portion claiming), and multiple patentably distinct embodiments that are generally analogous to multiple independent claims in a utility patent. Only the combination-subcombination type potential claim is discussed in this article.
67. 81 U.S. 511 (1872).
68. *Id.* at 525, 526.
69. 1898 C.D. 236, 85 O.G. 937.
70. *See Ex Parte Wiessner*, 1898 C.D. 236, 85 O.G. 937.
71. *Ex Parte Gerard*, 43 O.G. 1235 (as quoted in *Ex Parte Wiessner*).
72. 1898 C.D. 236, 85 O.G. 937.
73. Simonds, *The Law of Design Patents*, p. 198 (1874).
74. For general background on these concepts, *see* Oake, *The Ordinary Observer Test - Part 3*, Intellectual Property Today (September, 2011).
75. *Id.* at 197.
76. Telephone interview with Jim Gandy, Design Patent Examiner, Supervisor and Practice Specialist, United States Patent and Trademark Office June 1972 - February 2005.
77. *Egyptian Goddess v. Swisa*, 543 F.3d 665 (Fed. Cir. 2008) (en banc).

CAFC Happenings

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– 1 –

Claim Construction: *In re Abbott Diabetes Care Inc.*, 2011-1516, -1517 vacates a Board construction of claims drawn to in vivo blood sugar monitors. The claims required an "electrochemical sensor" and the Board erroneously held that this could encompass wired connections between pads on the sensor and contacts on an exterior housing that receives signals from the sensor. The CAFC notes that the claim terms "contact" and "pad" suggest connectivity without wires or cables, a suggestion reinforced by disparaging remarks about cables and wires in the specification. Also, every embodiment showed connections without wires or cables. The CAFC notes that this is not an instance where a specific disavowal of wires is required since claim terms like "coupled" and "received" are consistent with and support the specification's exclusive depiction of a device without connecting wires or cables.

– 2 –

Declaratory Judgment Jurisdiction: *Matthews Int'l Corp. v. Biosafe Engineering, LLC*, 2012-1044 holds that declaratory judgment jurisdiction is lacking when, as here, the requisite "immediacy" of a substantial controversy is lacking. The subject patent was directed to method claims to cremation using certain equipment, and the declaratory judgment plaintiff simply made equipment, taking no steps toward direct infringement of the method claims. Nor was there evidence of direct infringement by the plaintiff's customers. None of the three vended units had yet been used by customers and in any case the plaintiff's equipment could be used in a non-infringing manner. The plaintiff had not alleged any facts that its customers planned to use the plaintiff's equipment in an infringing manner.

– 3 –

Inter Partes Reexam Jurisdiction: *Belkin Int'l, Inc. v. Kappos*, 2012-1090 affirms a Board determination that it lacked jurisdiction to consider three of four references proferred by the requester. The Director had determined, with respect to the initial request, that three references failed to raise a substantial new question of patentability, and that only the fourth reference, applied against only some of the claims, raised such a question. The requester never petitioned for review of this initial decision, then tried to back the three references into the examination by noting that the PTO is free to consider references that were not cited as the basis for the reexamination. The CAFC observed that the scope of reexamination is limited to those issues raised by the Director on his own initiative and those made by the requester in the original petition that the Director finds raise a substantial new question of patentability.

– 4 –

Claim Construction: *Sandisk Corp. v. Kingston Technology Co., Inc.*, 2011-1346 returns to use of the singular indefinite article, reaffirming that despite the odd case to the contrary "a" or "an" can mean "one or more" and that this is "best described as a rule, rather than merely a presumption or even a convention." The subsequent use of the definite article ("the" or "said") refers back to the same claim term and does not change the general plural rule, but simply reinvokes the non-singular meaning, citing *Baldwin Graphics Systems, Inc. v. Siebert*, 512 F.3d 1338 (Fed. Cir. 2008).

– 5 –

Anticipation: *Energy Transport Group, Inc. v. William Demant Holding A/S*, 2011-1487, -1489 affirms a judgment of no anticipation of an acoustic feedback filter patent that required "substantially reducing" feedback between the microphone and speaker. The asserted reference admittedly taught every claim element and purportedly canceled the effect of feedback, but the CAFC stated that "even if cancelling…

acoustic feedback was enabled, however, the record does not show that "cancellation" or "reduction" of feedback, as disclosed by [the reference], is the same as the "substantial reduction" claimed." The jury's finding of the fact of no anticipation was supported by expert testimony that the reference calculates the wrong filter coefficients and for that reason would not achieve a substantial reduction in feedback.

– 6 –

Preliminary Injunction; Obviousness: *Hoffman-La Roche Inc. v. Apotex Inc.*, 2012-1270, -1271, -1272 affirms a denial of a preliminary injunction involving a method of treating post-menopausal women that required administering a single monthly dosage of a drug in an amount that was approximately 30 times stronger than the prior art daily use of the drug, with the prior art also suggesting monthly usage without supplying a dosage and teaching weekly usage at about seven times the daily dosage. The majority and the district court accordingly viewed the evidence as indicating that the patentee failed to show it would be likely to prevail on the merits.

The dissent accused the majority of mounting "a one-sided argument" and then referred to the years-long clinical trials and money the patentee had poured into its FDA clearance - "investment for which the defendants now seek the benefits, having borne neither the cost, nor the risk of failure." All of which is correct, except the dissent's quarrel appears to be more with an FDA that is so risk-averse it routinely requires years and millions of dollars to prove something that is legally considered to be obvious.

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Preliminary Injunction; Claim Construction: *Apple Inc. v. Samsung Electronics Co., Ltd.*, 2012-1507 reverses and remands the grant of a preliminary injunction involving a patent directed to multiple search modules in a consumer electronics device on two grounds. The first was that the requisite showing of irreparable harm failed to tie the harm to the alleged infringement with a sufficiently strong causal nexus. To do this, per the CAFC, the "patentee must rather show that the infringing feature drives consumer demand for the accused product". Here the patentee had produced only limited circumstantial evidence of the nexus, using the popularity of its own phone which incorporated the patented feature, a user guide for the accused device that explained the usefulness of the accused search feature but said nothing about what drives user demand, and two Internet articles extolling the accused product but published two years before the accused product entered the market. "The causal nexus requirement is not satisfied simply because removing an allegedly infringing component would leave a particular feature, application, or device less valued or inoperable."

The CAFC also addressed an erroneous claim construction that was related to the district court's holding that the patentee had established a likelihood of success on the merits. The claim at issue recited "a plurality of heuristic modules…wherein… each heuristic module corresponds to a respective area of search and employs a different, predetermined heuristic algorithm." The accused device had three search modules but two used the same algorithm. The patentee and district court reasoned that "plural" meant "at least two", so that all which was required to infringe was to have at least two modules employing different algorithms. The CAFC disagreed that "each" modified "plurality of heuristic modules" because "each" did not appear before "plurality of heuristic modules" but inside the "wherein" clause and before the phrase "heuristic modules", meaning the claim required at least two modules and that if more than two were present, each one would have to employ its own unique algorithm. The patentee had relied on *ResQNet.com, Inc., v. Lansa, Inc.*, 346 F.3d 1374 (Fed. Cir. 2003) but the CAFC opined that *ResQNet* actually supported the accused infringer since in *ResQNet* the term "each field" (analogous to the present case) was held to pertain to all fields while the different claim term "each of a plurality of fields" was held to mean "at least two, but not all". IPT