



PATENT HAPPENINGS

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on judicial, legislative, and administrative developments in patent law.

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JUDICIAL HAPPENINGS

Obviousness – Analogous Prior Art

Showing a prior art reference is “reasonably pertinent” to the claimed invention, so it qualifies as analogous art, “goes a long way” in showing there is a

motivation to combine the reference with other references in the same field of endeavor as the claimed invention so instructed the Federal Circuit in *In re Icon Health & Fitness Inc.*, No. 2006-1573, 2007 WL 2189161 (Fed. Cir. Aug. 1, 2007). Addressing claims directed to a folding treadmill having a gas spring “to assist in stably retaining” the base in a second (folded) position, the Federal Circuit affirmed the PTO’s § 103 rejection of the claim over a combination of two prior art references. The first reference, an advertisement for a folding treadmill, showed all of the claimed limitations except the gas spring. The second reference, a patent claiming a folding bed with dual springs, disclosed the use of a single spring to assist in stably retaining a bed frame and further disclosed that a gas spring was interchangeable with the single spring.

As an initial matter, the applicant urged that the prior art reference directed to the folding bed was non-analogous art, and therefore could not support an obviousness rejection. This argument failed. The Federal Circuit found the spring in the second reference was used to solve the same problem for which the inventor used the gas spring in the claimed folding treadmill — to provide lift assistance. Quoting *KSR*, the court noted that “familiar items may have obvious uses beyond their primary purposes.” *Id.* at *4. Accordingly, the court held that when considering the folding mechanism and gas spring of the claimed invention, which were not described in the application as being unique to treadmills, analogous art could come from any area describing hinges, springs, latches, counterweights, or other similar mechanisms—such as the folding bed in the second reference.¹ *Id.*

The court further found a motivation to combine the first and second references since the second reference was directed to the same problem solved by

¹ For more cases on analogous art see Robert A. Matthews, Jr., 2 ANNOTATED PATENT DIGEST §§ 18:27 thru 18:31 [*hereinafter* APD].

the claimed invention's gas spring. Thus, the Federal Circuit noted that "[o]ne skilled in the art would naturally look to prior art addressing the same problem as the invention at hand." *Id.* at *4. Further, the court stated that "while perhaps not dispositive of the issue, the finding that [the second reference], by addressing a similar problem, provides analogous art to Icon's application goes a long way towards demonstrating a reason to combine the two references." *Id.* Finally, the Federal Circuit noted that the similarity of the problem addressed in the second reference and the claimed invention and the similarity of solutions to that problem further showed that one skilled in the art would combine the two references.

Seeking to avoid the rejection, the applicant argued that the second reference taught away from the claimed invention because if the spring of the second reference was used in the applicant's claimed invention, the spring force would be so great it would render the invention inoperable. The Federal Circuit dismissed this argument by concluding that one of skill in the art, when adapting the teachings of the second reference to the claimed invention, would have known to use a weaker spring. *Id.* at *5. The applicant also attempted to argue that the second reference failed to disclose a gas spring that maintained a certain force on the frame after the assembly was closed as the inventor disclosed in the specification. Noting that the applicant had broadly claimed the invention as only requiring "assisting" the movement of the frame, this argument failed since it was directed to an unclaimed feature. The Federal Circuit stated "Icon's argument may have carried some weight with more narrow claims, which it could have obtained by amendment. But faced with broad claims encompassing anything that assists in stably retaining the tread base, we reject Icon's argument." *Id.*

Substituting Multiplexer for Bus was Obvious

Highlighting what appears to be *KSR*' primary impact — patentees now have a *de facto* evidentiary burden to demonstrate some form of unexpectedness of their claimed invention to survive an obviousness challenge where all elements of the claimed invention are shown somewhere in the prior art — the district court in *Asyst Technologies, Inc. v. Empak, Inc.*, 2007 WL 2255220, *5 (N.D. Cal. Aug. 3, 2007), overturned a jury verdict finding the asserted claims valid and infringed. The court granted the accused infringer JMOL that the claims directed to a method for tracking articles in a manufacturing facility using several

connected computers were invalid for obviousness. The prior art systems used a bus to connect the various computers. The claimed invention allegedly improved on the prior art by substituting a multiplexer for the bus. The district court held that this was an obvious substitution in view of the patentee's failure to show unexpectedness or unpredictability in using the multiplexer for the bus. Hence, the court noted that "[t]he evidence at trial showed the use of a multiplexer did not yield unpredictable results but rather was a substitution of one known element for another." The court further found significant that the patentee did "not offer a convincing explanation as to how the multiplexer in the '421 patent is performing in an unusual or unexpected manner." Consequently, the district court concluded that "[t]he use of a multiplexer in the '421 patent appears a product not of innovation but of ordinary skill and common sense. It illustrates well the type of combination of known elements that the Supreme Court determined to be obvious in *KSR*." In reaching its holding, the district court further rejected the patentee's argument that the use of the multiplexer provided an added benefit over the use of a bus since it helped to extend the life of the system's battery. The court found that benefit resulted from a "predictable use of prior art elements according to their established functions," and therefore did not establish nonobviousness.

Internet-Based Patent Survives § 103 Attack

The district court in *Muniauction, Inc. v. Thomson Corp.*, 2007 WL 2225847, *11 (W.D. Pa. July 31, 2007), denied an infringer's motion for a new trial on the issue of obviousness and ruled that substantial evidence supported the jury's verdict finding that a claimed internet auction invention was not invalid for obviousness. The infringer had argued that under *KSR* the jury's validity verdict could not stand. The district court disagreed. It found that *KSR* was not applicable since there was no dispute about the existence of a motivation to combine prior art. Instead, the evidence showed that one of the claimed features, an ability to confirm bid parameters, was not shown in any of the prior art. Nor did the infringer contend that the feature was an obvious modification of the prior art. The court, therefore, held that "[w]ithout such evidence, the jury could only reasonably have found that Old Parity did not contain all of the elements found in the asserted claims of the '099 Patent. As such, the obviousness analysis ends there." Additionally, the court upheld a lost profits award of 34 million dollars, enhanced the

damage award to 78 million dollars for willful infringement, awarded prejudgment interest at prime plus one percent, and entered a permanent injunction barring future infringement.

Disavowal of Claim Scope

Finding a “disavowal” of claim scope, the Federal Circuit in *SafeTCare Mfg., Inc. v. Tele-Made, Inc.*, No. 2006-1535, 2007 WL 2215718, *5-*7 (Fed. Cir. Aug. 3, 2007), affirmed a summary judgment of no infringement of claims directed to an adjustable hospital bed. The disputed issue focused on the proper construction of the term “pushing force” as used in a claim limitation reciting that the bed have a plurality of motors that exert a “pushing force” on components of the bed to cause a portion of the bed to adjust upwardly. The accused product had a motor that “pulled” a frame component towards the motor, rather than pushing the component away, to achieve its upward adjustment. In the specification, the inventor had stated that “as an important feature of the present invention” the motor applies “pushing forces” to the frame components in contrast to conventional beds that had motors exerting a pulling force against the frame components. Applying *Phillips*, the Federal Circuit found that this point of distinction, which was repeated in several sections of the specification, showed a disavowal of coverage for motors that “pulled” components, and therefore “the patentee’s disavowal of such motors in the specification is dispositive.” *Id.* at *7. Consequently, the motor in the accused product that applied a “pulling” force to move the frame components did not meet the claim limitation literally or under the doctrine of equivalents. *Id.*²

Declaratory Judgment

In its fifth post-*MedImmune* published opinion addressing the actual controversy requirement for an accused infringer’s declaratory judgment claim,³ the Federal Circuit in *Sony Elec., Inc. v. Guardian Media Technologies, Ltd.*, No. 2006-1363, 2007 WL 2215762 (Fed. Cir. Aug. 3, 2007), reversed the dismissal of declaratory judgment claims brought by several

accused infringers against the patentee. The district court had dismissed the claims, under the now discredited “reasonable apprehension of immediate suit” standard, because the patentee had never threatened litigation against any of the accused infringers and expressed a willingness to continue licensing negotiations. Reiterating that this standard is no longer the law, the Federal Circuit stated “our post-*MedImmune* decisions, while not attempting to define the outer boundaries of declaratory judgment jurisdiction, have made clear that a declaratory judgment plaintiff does not need to establish a reasonable apprehension of a lawsuit in order to establish that there is an actual controversy between the parties.” *Id.* at *11. Applying the new “all circumstances” standard, the Federal Circuit held that where the patentee had presented to the accused infringers claim charts identifying specific products and product lines as infringing, had responded to the accused infringers’ arguments that certain prior art references invalidated the claims, and maintained its position that the accused infringers required a license and owed back royalties, and the accused infringers informed the patentee they disagreed, an actual controversy existed. Under these facts, the parties did not seek an advisory opinion, but a resolution to a concrete and definite dispute. *Id.* at *12-*13.

In reaching its conclusion, the Federal Circuit rejected the patentee’s argument that since it was willing to continue negotiating with the accused infringers to find a “business resolution” to the dispute, the controversy was not sufficient to sustain jurisdiction. The Federal Circuit stated that “a patentee’s apparent continued willingness to engage in licensing negotiations does not prevent a plaintiff from maintaining a declaratory judgment suit. Accordingly, even if the parties’ interactions in this case could be characterized as ‘negotiations,’ Sony was within its rights to terminate them when it determined that further negotiations would be unproductive. Although Guardian may have wanted to negotiate with Sony, Sony was not required to negotiate with Guardian.” *Id.* at *13.

Prosecuting Attorney Had No Right to Appeal

In *Nisus Corp. v. Perma-Chink Sys., Inc.*, No. 2006-1592, 2007 WL 2296504, *2-*4 (Fed. Cir. 2007), the Federal Circuit held that negative comments in a judicial opinion about the conduct of a nonparty, for example comments to the effect that the nonparty committed inequitable conduct during the prosecution

² For further cases on disclaimers of claim scope arising from statements in the specification see APD §§ 5:54 thru 5:60.

³ The four previous cases are *Benitec Australia Ltd. v. Nucleonics, Inc.*, 2007 WL 2069646 (Fed. Cir. July 20, 2007); *Honeywell Int’l, Inc. v. Universal Avionics Sys. Corp.*, 488 F.3d 982 (Fed. Cir. 2007); *Teva Pharm. USA, Inc. v. Novartis Pharm. Corp.*, 482 F.3d 1330 (Fed. Cir. 2007); *SanDisk Corp. v. ST Microelectronics, Inc.*, 480 F.3d 1372 (Fed. Cir. 2007).

of a patent application, do not give that nonparty a right to appeal the judgment if the district court does not also sanction the nonparty. Applying this standard, the court dismissed for lack of jurisdiction an appeal by a patent attorney of a judgment finding that the patent attorney had participated with others in committing inequitable conduct during the prosecution of a patent application. The Federal Circuit held that while the district court's opinion finding inequitable conduct may have included statements that could harm the reputation of the prosecuting attorney, the attorney, as a nonparty, had no right to appeal that judgment since the district court had not imposed any sanctions against the patent attorney. The Federal Circuit held that "[w]ithout the exercise of the sanctioning power, a finding of inequitable conduct is insufficient to confer appellate jurisdiction over an appeal by the aggrieved attorney." *Id.* at *4. Instead, the prosecuting attorney was left to seek a writ of mandamus to expunge its name from the record. *Id.* Mindful of the potential for collateral use of the district court opinion against the attorney in the future, the Federal Circuit also noted that the prosecuting attorney was not a full participant in the underlying case and, therefore, he did not have a full and fair opportunity to respond to the district court's characterization of his conduct. *Id.*

The Federal Circuit also affirmed the district court's denial of the prosecuting attorney's motion to intervene in the underlying lawsuit. Noting that permission to intervene does not necessarily confer standing to appeal, the Federal Circuit ruled that even had the district court granted the prosecuting attorney's motion, the attorney still would have lacked standing to appeal the inequitable-conduct judgment since the court had not sanctioned the attorney as part of its judgment, and therefore the attorney lacked "a substantial legal interest in the underlying litigation" to justify intervention. *Id.* at *5.

Patent Law Preempts Price-Control Statute

Precluding enforcement of the controversial statute enacted by the District of Columbia back in 2005 that made it illegal for drug manufacturers to sell a patented drug in the District at an excessive price or impose minimum resale requirements that constituted an "excessive price," the Federal Circuit held in *Biotechnology Industry Org. v. Distr. of Columbia*, No. 2006-1593, 2007 WL 2189156 (Fed. Cir. Aug. 1, 2007), that the D.C. statute frustrated the purposes of the federal patent law, and therefore the patent law preempted the statute under the Supremacy Clause.

Although not a typical patent matter, the Federal Circuit held that the plaintiff's challenge to the D.C. statute arose under the patent laws because the plaintiff's claim necessarily required the resolution of a patent issue, i.e., whether federal patent law preempted the statute, and the plaintiff sought injunctive relief against the enforcement of a state regulation. *Id.* at *3-*5. Addressing the merits of the preemption challenge, the Federal Circuit noted that providing financial incentives to inventors to invest the time and capital in research needed to develop new products in return for the inventors enjoying a limited period of time where they may charge above-market profits for the patented technology is one of the purposes of the federal patent laws. *Id.* at *8-*9. The Federal Circuit found that the D.C. statute specifically targeted patented drugs products only, and in doing so shifted the benefits of a patented drug invention from the inventors to consumers. According to the court, "[b]y penalizing high prices—and thus limiting the full exercise of the exclusionary power that derives from a patent—the District has chosen to re-balance the statutory framework of rewards and incentives insofar as it relates to inventive new drugs." *Id.* at *10. But, "[t]he underlying determination about the proper balance between innovators' profit and consumer access to medication, though, is exclusively one for Congress to make." *Id.* Consequently, the Federal Circuit ruled that the D.C. statute presented an "obstacle to the federal patent law's balance of objectives as established by Congress," and therefore was preempted by the federal patent law. *Id.*⁴

Foreign Priority

Section 119(a) of the Patent Act allows an inventor to claim the benefit of the filing date of a foreign patent application for its U.S. patent application under certain circumstances. In *Boston Scientific Scimed, Inc. v. Medtronic Vascular, Inc.*, No. 2006-1434, 2007 WL 2255222 (Fed. Cir. Aug. 8, 2007), the Federal Circuit held that to invoke the benefit of § 119(a), the foreign patent application must have been filed by the inventor named in the U.S. application or by an entity who, at the time the foreign patent application was filed, was acting on behalf of the named inventor. Accordingly, where an entity had filed a foreign patent application that allegedly disclosed an invention later claimed by a named inventor in a U.S. patent application, but the foreign entity had filed its patent application *before* it

⁴ For additional material regarding preemption see APD § 2:27.

had any legal relationship with the named inventor and was not filing the foreign application on behalf of the named inventor, the named inventor could not claim foreign priority to that application. *Id.* at *3. The case left open the possibility that had the entity filing the foreign application been legally required to assign the foreign application to the named inventor at the time it filed the foreign application, the application could be treated as having been filed “on behalf” of the named inventor. While the party who was denied its claim of foreign priority raised this issue by arguing that theories of constructive trust and equitable assignment should have applied to the foreign application, the party had failed to raise those legal issues to the Board, and therefore the Federal Circuit held that they could not be considered in the § 146 action before the district court. *Id.* at *4.

Innovative Markman Procedures

Perhaps pioneering future procedures for conducting *Markman* hearings, the United States District Court for the Northern District of Iowa in *Ideal Instruments, Inc. v. Rivard Instruments, Inc.*, 2007 WL 2296407 (N.D. Iowa Aug. 10, 2007), invoked for a second time a procedure whereby the court provided the parties with a written draft of its tentative claim construction rulings *before* the *Markman* hearing.⁵ Finding the procedure highly effective for limiting and focusing the issues at the hearing, the court stated that

Once again, the court and the parties found that use of a tentative draft dramatically narrowed the number of issues that the parties felt compelled to argue during the *Markman* hearing. Specifically, the plaintiff requested that the court “revisit” its construction of only one claim term [of the sixteen disputed claim terms], while the defendant took issue with the court’s construction of only four claim terms. Moreover, both parties recommended that the court continue to use such a procedure for *Markman* decisions in patent cases in the future and expressed their hope that other federal district court judges would become aware of and use such a procedure in patent cases.

Id. at *1.

Additionally, the court allowed the parties to conduct the hearing telephonically with “webcasts” of Power Point presentations and found this procedure useful and cost effective. *Id.* at *2.

⁵ *Maytag Corp. v. Electrolux Home Prods., Inc.*, 411 F.Supp.2d 1008, 1015-16 (N.D. Iowa 2006), was the first case.

The Northern District of California has also experimented with providing parties with draft claim construction rulings, but has done so after the *Markman* hearing. Under this procedure, the court, after conducting a *Markman* hearing, issues an initial claim construction ruling and invites the parties to submit supplemental briefs addressing disputes with the initial ruling before the court finalizes its claim construction rulings.⁶

Withholding Patent from Standards Setting Body

In another highly publicized battle between chip manufacturers Qualcomm and Broadcom, the district court in *Qualcomm Inc. v. Broadcom Corp.*, 2007 WL 2296441 (S.D. Cal. Aug. 6, 2007), held that Qualcomm waived its right to enforce its asserted patents by carrying out a deliberate scheme to withhold information about its patent rights from an industry standard-setting body to which it belonged. Relying on *Rambus Inc. v. Infineon Tech. AG*, 318 F.3d 1081 (Fed. Cir. 2003), and examining the legal obligations of the body’s members, the district court found that Qualcomm owed the standard-setting body a duty to disclose information about its patent rights and deliberately violated that duty. In view of what it found to be intentionally egregious tactics by Qualcomm, the court ruled that the circumstances warranted a total unenforceability of the asserted patents and all family related patents. The court opted to impose the unenforceability sanction over a lesser sanction of finding an implied license. Additionally, due to the intentional nature of Qualcomm’s misconduct before the standards-setting body and its litigation misconduct, which consisted of willful discovery violations and a pattern of making misrepresentations to Broadcom and the court as to Qualcomm’s involvement in the standard-setting body, the court further held that the case was exceptional and that Broadcom was entitled to a full recovery of all its attorney’s fees. 2007 WL 2261799, *2 (S.D. Cal. Aug. 6, 2007). The court’s ruling supplemented its prior ruling, set forth at 2007 WL 1031373, *7-22 (S.D. Cal. Mar. 21, 2007), which found in favor of Broadcom on the issue of waiver, but withheld ruling on the scope of remedy. In the August opinion, the court found that Qualcomm’s post-trial production of

⁶ *Netflix, Inc. v. Blockbuster, Inc.*, 2007 WL 549903, *1 (N.D. Cal. Feb. 20, 2007); see also *Space Systems/Loral, Inc. v. Lockheed Martin Corp.*, 2006 WL 2684272, *1. n.1 (N.D. Cal. Sept. 19, 2006). See generally APD § 3:14.

over two hundred thousand pages of highly relevant e-mails and other documents showing its involvement in the standard-setting body during the relevant time period provided further evidence of the extent of Qualcomm's misconduct to support the unenforceability sanction.

Product Specific Case or Controversy

As a cautionary warning to parties who find themselves unable to agree on how to limit the scope of an infringement controversy on their own, one district court applied a pro-active use of the "case or controversy" requirement to whittle down the scope of possible accused products that it would consider part of the suit in *QRG, Ltd. v. Nartron Corp.*, 2007 WL 2234511, *3-*4 (M.D. Pa. Aug. 1, 2007). In that case, the plaintiff filed a non-infringement and invalidity declaratory judgment action challenging the validity and scope of several of the patentee's patents. Instead of identifying all of the specific products for which it was seeking a declaration of noninfringement, the plaintiff identified its product lines, which contained many different models of products. The patentee counterclaimed on only one of its patents, but did so against several of the plaintiff's products lines. It too did not identify the specific products it accused of infringement. Despite a request from the court to limit the scope of the dispute to specific products, the parties were unable to agree how to limit the scope of discovery within the various product lines. To resolve this impasse, the district court *sua sponte* revisited the issue of subject matter jurisdiction and ruled that the plaintiff's mere identification of its product lines, without identifying specific products, was too broad and vague under the particular circumstances to show an actual case or controversy sufficient to support jurisdiction for the declaratory judgment claims for many of the challenged patents. Accordingly, the court dismissed the declaratory judgment claims for products lines that did not appear to the court to be within the scope of the dispute in view of some prelitigation letters that identified specific accused products. The court also limited the scope of the patentee's infringement counterclaim in the same way. The district court, however, based its analysis in part on the now discredited "reasonable apprehension" standard, and hence its opinion may be open to some attack on this basis.

Settlement Agreements

Providing a vivid example of the importance of

putting all material terms of an orally agreed to settlement on the record, a district court sustained a party's objections to a magistrate's ruling regarding the scope of a patent license given as part of settling an infringement action in *Medinol Ltd. v. Guidant Corp.*, 2007 WL 2265568, *5 & *7 (S.D.N.Y. Aug. 7, 2007). To settle the dispute, the parties had orally outlined the major terms of the settlement agreement in open court and then agreed to thereafter prepare written documents memorializing and implementing the agreement. The agreement included the patentee granting the accused infringer a fully paid-up license in exchange for a lump sum payment. During the course of preparing the documents, a dispute arose as to whether the agreed upon paid-up license was for any and all products produced by the accused infringer or limited to a field-of-use license only applicable to the two accused products and any improvements thereof. Notably, the patentee's counsel when outlining the terms of the settlement in open court never mentioned the "field-of-use" restriction. After conducting an evidentiary hearing as to the parties' intent as to the scope of the license, the magistrate judge ruled in favor of the patentee and found that there was an intent to limit the paid-up license to a field of use. Sustaining the accused infringer's objections to the magistrate's ruling, the district court held that because the terms of the settlement agreement outlined by the parties in open court were clear and unambiguous, the magistrate judge erred in conducting an evidentiary hearing. Further, because the patentee never identified on the record that the paid-up license was a limited "field-of-use" license, the district court "decline[d] to add a material term to an agreement that was never expressed on the record." Emphasizing the importance to litigants to place all material terms of a settlement agreement on the record, the judge noted that the "case demonstrates the validity of an old legal truism: 'God may know but the record must show.'"

ADMINISTRATIVE HAPPENINGS

The USPTO published proposed rules that, if promulgated, will affect any claim reciting alternative language, including but not limited to *Markush*-type claiming. 72 Fed. Reg. 44,992 (Aug. 10, 2007). The window for public comment expires October 9, 2007. According to the USPTO, to ensure "a more thorough and more reliable examination" of claims using alternative language to claim one or more species, the Office seeks to establish a mechanism to limit a single claim to a single invention. Further, the proposed rules

will impose additional written description identification requirements for applicants claiming priority to prior-filed applications.

Current practice with respect to examination of claims reciting *Markush*-group language requires only that the alternatives be sufficiently few in number or so closely related that search and examination can be made without serious burden. See MPEP 803.02. All that is currently required is that the alternatives “share a common utility” and “share a substantial structural feature essential to that utility.” *Id.*

The proposed amendments to Rules 1.75 and 1.140, in particular, will provide a more exact standard by imposing a new “single invention test.” Proposed Rule 1.75 expressly requires that “[a] claim must be limited to a single invention.” In particular, Rule 1.75(j) will require that a claim using alternative terms must meet the following requirements: (1) the claim must not be difficult to construe, (2) no alternative can be defined by another set of alternatives, (3) no alternative can be encompassed by another alternative (unless no other practical way to define), and (4) each alternative must be substitutable one for another. Further, Rule 1.140 will require that all of the species encompassed by a claim reciting a list of alternatives must “share a substantial feature essential for a common utility” or must be “*prima facie* obvious over each other.” Under this Rule, applicants are further encouraged to submit a statement explaining that the claim is limited to a single invention, however, such a statement will be considered by the Office only if submitted at the same time as the presentation of such a claim or may be considered by the Office if submitted after the presentation of such a claim but before the mailing date of any restriction requirement or action on the merits.

Any claim using alternative language and reading on multiple species (whether *Markush*-type or other) will be subject to the proposed rules if “any portion of a claim requires selection from a list of alternatives.” A claim defining one generic invention, however, by using generic terminology to encompass more than one species would not be subject to proposed Rule 1.140. Claims to generic inventions, although not subject to a restriction requirement, may still be subject to an election of species requirement under Rule 1.146 for initial search and examination purposes.

On a matter not specifically related to alternative claiming, proposed Rule 1.75 is also amended to impose additional requirements on applicants with

respect to claiming priority to prior-filed applications. In particular, for applications claiming priority to and disclosing subject matter not disclosed in a prior-filed application, the Office will require an applicant to identify which claim or claims in the later-filed application have written description support in the prior-filed application that is sufficient to satisfy 35 U.S.C. § 112, ¶ 1.

The proposed rules, according to the USPTO, involve interpretive rules or rules of agency practice and procedure, and therefore are exempt from the Administrative Procedure Act’s notice and comment requirements. Nonetheless, the Office deemed it beneficial to voluntarily submit the proposed rules for public comment. The Office previously submitted the collection of information involved in this notice to the OMB and thus will not be resubmitting that information to OMB for its review and approval. Consequently, the USPTO may act quickly to enact the proposed rules after it evaluates the public comments.

FIRM HAPPENINGS

LMM-IP proudly announces that Timothy Donaldson, formerly a senior associate with Finnegan, Henderson, Farabow, Garrett & Dunner LLP, has joined the firm as a general partner. Tim will be based in the firm’s office in Herndon, VA. Tim focuses his practice in the procurement and enforcement of patents, particularly in the biotechnology, pharmaceutical, and chemical arts. He has extensive experience in drafting and prosecuting patent applications, including applications directed to novel DNA and protein sequences, antibodies, DNA expression vectors, transgenic plants, yeast expression systems, vaccines, drug screening, and diagnostic methods. Mr. Donaldson also brings with him years of experience in preparing patentability and freedom-to-operate opinions and counseling large and small clients in all aspects of domestic and foreign patent prosecution. Additionally, Tim possesses significant experience in all aspects of interference practice before the U.S. Patent and Trademark Office and related appeals before the Federal Circuit and § 146 actions in the district courts. Mr. Donaldson’s scientific background includes work in cellular and molecular immunology, parasitology, and viral-based gene expression in plants. He obtained a B.S. and M.S. in Biology from Wake Forest University and completed some doctoral work at Yale University before embarking on his legal career.

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