

IP Bulletin, May 2013

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Legal Update

The Nutter IP Bulletin provides periodic IP news updates and practical tips

After the AIA - Strategies for Expediting Patent Filings

While the America Invents Act (AIA) brought many significant changes to the U.S. patent laws, there is arguably no more impactful change than the shift from a “first to invent” system to a “first inventor to file” system. Now the U.S. Patent and Trademark Office (USPTO) will award a patent to an applicant with the “earliest effective filing date.” This shift in the law increases the stakes for large companies, small companies, and individual inventors seeking patent protection, as patent applicants will now find themselves racing to the U.S. patent office. It is now more paramount than ever that patent applicants evaluate and modify internal procedures to ensure that innovative ideas are identified and applications are filed as timely as practical.

To learn about strategies for filing more quickly, [click here](#).

Federal Circuit Shows Divide Over Computer Method Patent Claims

On May 10, 2013, the Federal Circuit issued a decision in its en banc rehearing of *CLS Bank International v. Alice Corp.* In a 5-5 split, the Federal Circuit affirmed a district court decision that Alice Corp's. computer method patent claims, as well as similar claims directed to systems and computer-readable media, are not directed to eligible subject matter under 35 U.S.C. § 101. A total of six opinions were written, showing a deep divide among the judges over the patentability of computer method claims. Certain judges called for Supreme Court guidance, and Chief Judge Randall Rader even included “additional reflections” on the Court's struggle with this issue. The divided decision once more throws computer method patent claims into uncertainty, but the multitude of opinions from the various judges does provide insight into their thinking that may be valuable to litigants and applicants dealing with computer method patent claims. At this time, however, any consideration of computer method patent claims should occur on a case-by-case basis with the assistance of a patent attorney, as the various analyses from this decision will have to be compared with prior precedent and the particular claims at issue to determine subject matter eligibility.

To read the Federal Circuit's opinion, [click here](#).

A Retrospective on Trademarks in 2012

If you are a Marxist, you view the world in terms of class struggle; if you are an artist, you see the world as colors and forms; and if you are a trademark lawyer, you see the world in terms of, well, trademarks (and service marks). So, what do trademarks reveal about 2012? Some un-surprising things (but at least they confirm what we suspected), and some very interesting things.

To read more about the year in trademarks, [click here](#).

USPTO Announces Second Iteration of After Final Consideration Pilot Program

On May 19, 2013, the USPTO launched the After Final Consideration Pilot 2.0 (AFCP), thereby extending and revising the original After Final Consideration Pilot that was implemented in March, 2012. Designed to further the goal of compact prosecution, the AFCP 2.0 provides examiners with additional time to consider applicant responses after a final rejection. Under the new version of the program, examiners will utilize the additional time to interview and discuss their thinking with applicants even if a response does not place an application in condition for allowance. Applicants and practitioners can use this program to avoid filing a Request for Continued Examination to have amendments considered and allowed. To do so, applicants must submit a response under 37 C.F.R. § 1.116 that includes a non-broadening amendment to at least one independent claim, along with a request under the pilot program. The AFCP 2.0 will run until September 30, 2013, and further details are available at the links below.

To read the USPTO's announcement, [click here](#).

To read the Notice in the Federal Register, [click here](#).

To read the USPTO's guidelines for consideration under the pilot, [click here](#).

Supreme Court Establishes International Copyright Exhaustion

In *Kirtsaeng v. John Wiley & Sons*, the U.S. Supreme Court held that the first sale of a copyrighted article manufactured abroad "exhausts" the copyright owner's rights to that article. The case concerned a college student's resale of textbooks in the U.S. that were bought in Thailand at low cost. Even though the textbooks were manufactured abroad, the Court held that the resale was permissible under the first sale doctrine of the Copyright Act. This ruling has far-reaching implications for media companies, as it establishes that the Copyright Act does not grant copyright owners the right to divide foreign markets from domestic markets. Despite speculation otherwise, however, the decision is unlikely to affect patented articles, at least in the near future.

For a further discussion of the *Kirtsaeng* decision, [click here](#).

What Does Reasonable and Non-Discriminatory Mean, Anyway?

U.S. District Court Judge James Robart recently decided *Microsoft Corp. v. Motorola, Inc.*, a suit concerning a so-called standard essential patent (SEP) owner's obligation to license the patent under reasonable, and non-discriminatory (RAND) terms. Judge Robart's opinion provides a rare detailed roadmap for determining whether a RAND obligation was followed. As a result, the decision is likely to be closely reviewed and addressed in future decisions concerning RAND licensing terms. More broadly, the decision can be relevant to companies considering whether to join a standard setting organization (SSO) or patent licensing pool.

For a further discussion of RAND licenses, [click here](#).

The USPTO Updates Patent Term Adjustment Rules

On April 1, 2013, the USPTO published interim final rules that implemented changes to patent term adjustment (PTA) provisions mandated by the AIA Technical Corrections Act of January 14, 2013. In addition to streamlining USPTO administrative procedures and procedures by which patentees can challenge PTA calculations, the rules also level the PTA "playing field" for filers of U.S. national stage applications. The new rules apply retroactively to any patent granted on or after January 14, 2013. While the rules became effective as of their publication, the USPTO will accept

public comments until May 31, 2013, after which a final rule will be published.

For a further discussion of the new PTA rules, [click here](#).

Nutter's IP Bulletin is a bi-monthly publication of the Intellectual Property Practice at Nutter McClennen & Fish LLP in Boston. This edition of the bulletin was edited by Derek P. Roller. Assistance in the preparation of this issue was provided by Peter Nils Baylor, Padma Choudry, William C. Geary III, Lauren Ingegneri, Megan E. Jeans, and Lydia G. Olson. For further information, please contact your Nutter attorney at 617-439-2000.

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Practice Areas

Intellectual Property

- Patent Prosecution and Portfolio Management

- Trademarks, Copyrights and Trade Secrets

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Related Professionals

Lisa Adams

Peter Nils Baylor

Ronald E. Cahill

Padma Choudry

William C. Geary III

Lauren Ingegneri

Megan E. Jeans

Konstantin M. Linnik, Ph.D.

Lydia G. Olson, Ph.D.

John J. Penny, V

David J. Powsner