

IP Bulletin, November 2012

Nutter's periodic IP news update and practical tips

November 15, 2012

Legal Update

Drafting Patent Applications to Avoid Claim Scope Disavowal Issues

Now more than ever, care should be taken when drafting patent applications to avoid unintentionally narrowing the claims under the doctrine of claim scope disavowal. While the case law surrounding this doctrine is constantly evolving, there are a number of “best practices” that can be followed at the application drafting stage to minimize the risk of an adverse claim construction ruling down the road. Some of these best practices include drafting carefully any characterization of the “invention” and any critique of the prior art in the specification, and disclosing multiple embodiments of any key claim features whenever possible.

To read more about case law and practical application drafting tips regarding claim disavowal, [click here](#).

USPTO Expands Ability to Request Additional Specimens and Other Information from Trademark Applicants and Registrants

On May 22, 2012, the U.S. Patent and Trademark Office (USPTO) published final rules that: (1) expand the ability of the USPTO to obtain specimens or other information reasonably necessary for proper examination, (2) allow the USPTO to conduct a post-registration pilot program to assess the accuracy of the register, and (3) facilitate the USPTO with verifying the accuracy of identifications of goods/services on the register. The rules took effect on June 21, 2012, and allow the USPTO to request additional information from trademark applicants and owners. Trademark applicants should more closely consider the intended use of the goods/services at the time of filing and focus the description of the goods/services listed in the application accordingly. Those who already have registered trademarks should consider the *current* use of goods/services in commerce at the time of filing the affidavit, and consult their attorney to ensure that the description of the goods/services is consistent with the use.

For a discussion of the final rules and how they could affect trademark practice, [click here](#).

Court Identifies USPTO Error in Patent Term Adjustment Calculations

The Eastern District of Virginia recently determined in *Exelixis, Inc. v. Kappos* that the USPTO has been miscalculating Patent Term Adjustment (PTA) in cases where a Request for Continued Examination (RCE) was filed after three or more years of pendency. The USPTO has for many years interpreted the statute governing PTA as immediately tolling the three year statutory period for the calculation of PTA upon the filing of an RCE, regardless of whether the RCE is filed before or after the three year mark. But, in *Exelixis*, the USPTO was ordered to calculate the PTA on a day-for-day basis when an RCE is filed *after* three years from filing regardless of what else occurs during the continued prosecution, *i.e.*, the filing of an RCE after the three year mark has “no impact on PTA.” It is unclear at this time whether the USPTO will adjust their PTA calculation rules to adhere to the order generally, whether the USPTO will appeal to the Federal Circuit, or whether the USPTO will simply maintain the current practice. But, patent owners should consider auditing their portfolio with eyes for cases where an RCE was filed three or more years after the filing date. If the patent is within two months of issuance, the PTA can be challenged within the USPTO by filing a request for reconsideration under 37 C.F.R. 1.705(d). If the patent issued within the past 180 days, the owner can choose to challenge the ruling in the Eastern District of Virginia, under the precedent of *Exelixis*.

To read the court’s decision, [click here](#).

Best Practices for Conducting Examiner Interviews

A patent applicant can request an examiner interview during most stages of U.S. patent prosecution, which allows the applicant to have patentability discussions with the USPTO examiner reviewing the applicant's pending application. Examiner interviews can be an effective tool to advance patent prosecution, and can have the added benefit of minimizing written remarks on the record, which can help limit prosecution history estoppel. Interview strategies and techniques vary among different practitioners and for different applications, but some general tips and techniques can help applicants get the most out of examiner interviews.

For tips and techniques in conducting Examiner interviews, [click here](#).

USPTO and EPO to Launch Cooperative Patent Classification

The USPTO and the European Patent Office (EPO) will launch the Cooperative Patent Classification (CPC) scheme on January 1, 2013. The CPC effort has been years in the making and aims to harmonize U.S. and European classification of documents, namely patents. The CPC incorporates best practices of existing USPTO and EPO classification systems and is based on the European Classification (ECLA) system. The harmonization should improve searching at the USPTO and EPO by facilitating work sharing, yielding more consistent search results across patent offices, and facilitating the retrieval of documents by examiners at the USPTO and EPO. Patent applicants should correspondingly benefit from Examiners spending less time on searching and more time on substantive examination of applications, all while receiving more consistent search results across patent offices.

For more information about the CPC, visit the [official CPC website](#).

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 Christina Sperry. Assistance in the preparation of this issue was provided by Lauren Ingegneri, Kevin C. McGrath, Christopher A. Potts and Michael P. Visconti. For further information, please contact your Nutter attorney at 617-439-2000.

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Life Sciences: Biotechnology, Pharmaceuticals & Medical Devices

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