





## Panel

- ▶ **Dr. Ron D. Katznelson** (*Moderator, Co-Chair*), Bi-Level Technologies; Chairman, IEEE-USA IP Committee
- ▶ **Jonathan T. Kaplan** (*Co-Chair*), Kaplan IP Law, PLLC
- ▶ **Keith D. Grzelak**, Wells St. John PS; member and past Chairman, IEEE-USA IP Committee
- ▶ **Dr. Tom Tofigh**, Self
- ▶ **Mike Kappes**, IQ Analog



# Agenda

- ▶ Introduction of panelists and overview of the Agenda
- ▶ Protection of computer-implemented inventions after *Alice*; erosion of patent-eligible subject matter
- ▶ PTO's recent examination guidance on patent-eligible subject matter; patenting and claiming strategies
- ▶ Post-*eBay* commercialization and licensing strategies – beware of the adverse effects on injunctive relief
- ▶ Implications for startup IP owners given the push for “open source hardware.”
- ▶ *Helsinn*'s recent clarification of no grace period for “on sale” and “public use” activities before post-filing date



## Patent Eligibility

- ▶ The Statute (the 1952 Patent Act):  
35 U.S.C. § 101. Inventions Patentable

“Whoever invents or discovers **any** new and useful **process, machine, manufacture, or composition of matter**, or any new and useful improvement thereof, **may obtain a patent therefor**, subject to the conditions and requirements of this title.”



## Patent Eligibility (cont.)

- ▶ *Mayo v. Prometheus* (2012)
  - A method for measuring metabolites in the bloodstream to calibrate the appropriate dosage of thiopurine drugs
  - ***Not*** eligible for patenting
  - Set forth a new framework for evaluating patent eligibility
- ▶ *Alice v. CLS Bank* (2014)
  - Invention: a method for intermediated settlement
  - ***Not*** eligible for patenting
  - The problem: “we need not labor to delimit the precise contours of the ‘abstract ideas’ category”



# Patent Eligibility (cont.)

## ▶ The *Mayo/Alice* Framework:

- Does the claim recite a statutory category?
  - (“Process, Machine, Manufacture, Composition of Matter”)
  - If not, the claim is ***not*** patent eligible
- Is the claim “directed to” a judicial exception?
  - If not, the claim ***is patent eligible***
- Does the claim recites “significantly more” than the judicial exception?
  - If so, the claim ***is patent eligible***



# Commercialization and licensing considerations

- ▶ “Non practicing” patent owners have been unsuccessful in obtaining injunctions after *eBay* – their “harm” from infringement is ostensibly reparable by money damages
  - Removal of the prospect of injunction undermines fair compensation
  - Reconsider business models; use distribution licensing rather than licensing under the patent
- ▶ How do startups having IP address pressures for open source hardware licensing?



## AIA's zero grace period law in practice

- ▶ The America Invents Act (AIA) created a grace period exception that is more limited than the prior law under the new first inventor to file system.
- ▶ The general rule is that a patent application has to be filed before any disclosure in order to maintain novelty.
- ▶ However, the new AIA exception one-year grace period only provides protection for **enabling** disclosures made by the inventor or derived from the inventor.
- ▶ Even if a public disclosure is made at the time the invention was “on sale” or on “public use” prior to filing, that only prevents the use of that disclosure as invalidating prior art but cannot save the patent from forfeiture.





## Cautionary recommendations

- ▶ Protect trade secrets with NDA and development agreements, while concurrently filing early and often BEFORE bar activities (publication/public use/on-sale).
- ▶ Consider serial filing of provisional applications written with as complete a disclosure as possible, including diversity of species.
- ▶ Enumerate alternative species early and cover with early priority date filings; you do not know “your invention” even though you think that to be true. Prosecution has a way of refocusing “the invention” and AIA lost grace period creates more risk.
  - e.g., Fastener (genus) and bolt (species), but later screw, rivet, hook-and-loop, adhesive.
- ▶ Put any “likely” inventors as co-authors if you take the risk to publish before filing, ...but I wouldn't do it. It is a recipe for disaster.