



SHIMOKAJI & ASSOCIATES, P.C.

NEWSLETTER

Intellectual Property Lawyers
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We specialize in the litigation, registration, and monetization of patent, trademark, and copyright matters. The clients we serve range from start-ups to Fortune 500 companies, government entities, and universities. Though located in the US, our expertise and representation has an emphasis in Asia.

— LATEST NEWS & EVENTS —

California District Court Prevents Injunction on Standard Essential Patents When No Prior Offer to License

In *Realtek v. LSI*, the district court for the Northern District of California found that a holder of standard essential patents could not seek injunctive relief at the ITC before offering a license on RAND terms.

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Federal Circuit Says No Affidavit to Rebut Enablement

In re Morsa, the patent application was for the furnishing of benefits information and benefits. The examiner rejected the claims as being anticipated over a publication

On appeal to the Federal Circuit, the PTO argued that the publication was presumed enabling and the applicant failed to show any evidence to the contrary such as by affidavits or expert declarations.

The Federal Circuit held that affidavits or declarations are not necessary to challenge the enablement of a prior art reference. The Court explained that the presumption of enablement is only procedural. The initial burden of persuasion is on the applicant to show that the cited reference is not enabling. Then, the burden then shifts to the PTO to show that the cited reference is indeed enabling.

The Federal Circuit further explained that a non-frivolous argument of non-enablement does not require affidavits or declarations, although they may be helpful. The Court explained that “[w]hen a reference appears to not be enabling on its face, a challenge may be lodged without resort to expert assistance.”