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Allergan Cannot Avoid Patent Invalidation By Patent Transfer to American Indian Tribe

Mylan sought to invalidate Allergan patents for dry eye treatment, via inter partes review (IPR) in the patent office.

In response, Allergan transferred title to the patents to the Saint Regis Mohawk Tribe, who then asserted sovereign immunity in an effort to terminate the IPR.

The Federal Circuit explained that Indian tribes have "inherent sovereign immunity" which extends to actions by the federal government.

However, immunity does not apply where the federal government acts through an agency in an "investigative action" or an "adjudicatory agency action".

The Federal Circuit concluded that tribal sovereign immunity cannot be asserted in an IPR, as an IPR is neither a judicial proceeding by a private party or an enforcement action by the federal government. It is a "hybrid proceeding".

An IPR is instituted according to a decision of the patent office. The patent office may choose to continue the proceeding, even if the party who sought review chooses to discontinue.

Further, the patent office's role in an IPR is to protect the public by keeping patent monopolies "within their legitimate scope".

COMMENTS:

This decision does not mean that the Allergan patents are invalid. It only means that the patent transfer to the tribe cannot prevent a challenge to the validity of the patents.

Wal-Mart Expands Its Reach Into Electronic Health Records

Wal-Mart is no longer just your neighborhood retail store.

The patent office recently awarded Wal-Mart a patent for "Obtaining a Medical Record Stored on a Blockchain From a Wearable Device."

A "private key" and a "public key" are typically needed to access data in a blockchain. The user holds the private key.

If the user is a patient who is incapacitated, the user cannot provide the private key. Thus, a first responder cannot access the patient's medical records in the blockchain.

The patented invention provides an RFID scanner that can read a wearable device of the patient. The wearable device can then transmit health data to a computer.

A biometric scanner may also scan a bodily feature of the patient and transmit the data to the computer. The scanner could be a fingerprint sensor, a facial recognition sensor, an iris scanner and the like.

COMMENTS:

The interesting question is how will Wal-Mart incorporate this patent into, or leverage this patent with, Wal-Mart's retail operations and database of customer information.

What is a "Body" of a Spinal Instrument?

Spineology's patent covered an instrument to cut "hollow chambers within bone." The patent claims described the instrument as including "an elongated body having a proximal end and a distal end . . . configured to engage bone."

The patent drawings depicted a "main shaft" having one end that extended into a "barrel".

The Federal Circuit began by pointing out that the patent specification did not include the term "body".

Some of the claims explained that the "body" included a "view port" which, according to the drawings, was in the "barrel".

Other claims explained that the "body" constrains a control knob "within the proximal end of the body" which, according to the drawings, was not in the "main shaft".

Given these claim descriptions of the "body", the Federal Circuit concluded that the "body" includes the "barrel" but not the "main shaft".

COMMENTS:

This case reminds the patent applicant of the importance of ensuring that claim terms are defined in the patent specification to minimize potential problems of claim construction when the patent becomes the subject of a dispute.

USPTO Guidelines to Its Examiners on Patentable Treatment Methods

In *Vanda v. West-Ward*, the Federal Circuit found valid a patent for treating schizophrenia with a drug.

The USPTO responded by issuing Guidelines to its patent examiners to ensure examination consistent with *Vanda*.

The "primary steps" of the *Vanda* patent claim, according to the Guidelines, included the steps of obtaining a patient sample, performing an assay on the sample, and administering a drug.

The Guidelines emphasize that the *Vanda* claim included a step of a doctor administering a drug. In other words, the *Vanda* patent claim included applying natural relationships and was not simply "directed to" natural relationships.

COMMENTS:

The Guidelines emphasize the importance of administering a drug for treatment, as opposed to simply pointing out a relationship between the drug and the disease. Thus, a step of administering "something" should be considered for inclusion in your patent claim.

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