

The Latest Intellectual Property News



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Hello from everyone in Lowe Hauptman & Ham, LLP, and welcome to The Latest Intellectual Property News, a newsletter for updating you with recent information about Intellectual Property.

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INDEFINITENESS STANDARD IN USPTO DIFFERS FROM THAT IN COURT

By Sean A. Passino, Ph.D., Esq./Partner (spassino@ipfirm.com)

A panel of the Federal Circuit redefined the standard for indefiniteness in the United States Patent and Trademark Office. *In re Packard*, slip op. 13-1204 (Fed. Cir. May 6, 2014). According to the *per curiam* decision, when the USPTO initially issues a well-grounded rejection that identifies ways in which language in a claim is ambiguous, vague, incoherent, opaque, or otherwise unclear in describing and defining the claimed invention, and thereafter the applicant fails to provide a satisfactory response, the USPTO can properly reject the claim as failing to meet the statutory requirements of §112, ¶2. The satisfactory response can take the form of a modification of the language identified as unclear, a separate definition of the unclear language, or, in an appropriate case, a persuasive explanation for the record of why the language at issue is not actually unclear. Without a remand, the panel found that “[o]n the facts before us, this holding suffices to uphold the rejection that occurred here.”

According to the USPTO, among other things, the claim recites a *flat, plane ... card ... with a front top side of the card comprising ... a raised side edge A card cannot be a flat plane and have a raised side edge: and who even knows what a front top side of a card is. The examiner alleged that claim terms lacked an antecedent basis or were otherwise unclear. Packard did not respond in detail: “he did not focus on the claim language difficulties, nor did he propose clarifying changes or show why, on close scrutiny, the existing claim language really was as reasonably precise as the circumstances permitted.” The Board relied on the failure to respond as a basis to affirming the rejection. Circuit Judge Pleger wrote a concurring opinion explaining the balancing of competing policies, namely, the presumption that the USPTO issues valid claims and the notice function of claims. Too much weight to the presumption means that claims are uncertain – i.e., the right construction is unknown – until a final court decision. More weight to both the presumption and notice functions means that claims have a meaning that best accords with what one of “reasonable skill” would understand to be intended. Too much weight to the notice function means that a patent would be invalid if the public would have to “guess” at the claim terms.*

The opinion seems to ignore the inherent imperfections of language. In any case, this month

should see a decision on this issue from the United States Supreme Court in *Nautilus v. Biosig Instr.*, No. 13-369.

CLONES PER SE ARE NOT ELIGIBLE FOR PATENTING

By Sean A. Passino, Ph.D., Esq./Partner (spassino@ipfirm.com)

In re Roslin Institute, slip op. 2013-1407 (Fed. Cir. May 8, 2014) held that the Board correctly found that all of Roslin's pending claims are unpatentable subject matter under 35 U.S.C. § 101. The Federal Circuit affirmed.

The case concerns technology relevant to the first mammal ever cloned from an adult somatic cell: Dolly the Sheep. A clone is an identical genetic copy of a cell, cell part, or organism. The relevant application contains a claim directed to a *live-born clone of a pre-existing, nonembryonic, donor mammal, wherein the mammal is selected from cattle, sheep, pigs, and goats*. The Federal Circuit, in affirming the Board, noted that, on one hand, in *Funk Bros. Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127 (1948), a combination of natural organisms itself—the mixture of bacteria—was unpatentable, because its “qualities are the work of nature” unaltered by the hand of man, but, on the other hand, in *Diamond v. Chakrabarty*, 447 U.S. 303 (1980), the GMO was patentee's discovery, not nature's handiwork. According to the panel, discoveries that possess “markedly different characteristics from any found in nature” are eligible for patent protection. Existing organisms are not.

No one disputed that the donor sheep whose genetic material was used to create Dolly could not be patented. Roslin argued that copies (clones) are eligible for protection, because they are “the product of human ingenuity” and “not nature's handiwork, but [their] own.” However, the panel found that Dolly herself is an exact genetic replica of another sheep and does not possess markedly different characteristics from any sheep found in nature. Dolly's genetic identity to her donor parent renders her unpatentable. Along the way, the Federal Circuit rejected phenotypical differences, mitochondrial DNA differences, and temporal differences as being “markedly different characteristics from any found in nature” and therefore sufficient to make a clone eligible for patent protection.

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