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VEPACHEDU EDUCATIONAL FOUNDATION

The Andhra Journal of Industrial News

IP and Industry News

Issue 135

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CONTENTS

Novelty

Novelty is the quality of being new[2]. However, this simple and clear definition is the tip of the iceberg of a complexity that confuses all. For example, a "novelty item" is a novel object sold for its uniqueness and fancy qualities, rather than for its use. An article of trade whose value is chiefly decorative, comic, or the like and whose appeal is often transitory[3]. If a novel object has a practical use, i.e., it is novel and useful, it is not a "novelty item," but a "novel item." The Supreme Court of United States (SCOTUS)[4] adds more complexity for the good of economy[5].

In the world of patents, novelty is a requirement for patentability. A "novel item" may be a "patentable invention," if it is not only useful and novel, but also non-obvious. In other words, if an article has 1) utility[6], 2) novelty[7] and 3) non-obviousness[8] or inventive step[9], it is a patentable invention.

Accordingly, novelty under the patent law seeks to ensure that a patent will not issue if the public already possesses the invention. Although it is usually straightforward, it can be difficult for alleged inventions in complex fields like biotechnology, chemistry, and pharmaceuticals, for various reasons including, but not limited to, from incompetent and confused examiners to conniving and dishonest inventors who rewrite ancient technology in modern terminology using a major loophole in the system, i.e., inventor is lexicographer, which is supported by the case law to confuse and to destroy the clarity of even the most well defined technical terms. An applicant is given the opportunity to be a lexicographer and to rebut the presumption that claim terms are to be given their ordinary and customary meaning by clearly setting

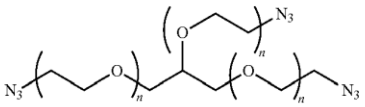
forth a definition of the term that is completely different from its ordinary and customary meaning and could misrepresent the whole technology. For example, if an applicant defines, the term “rose” as defined herein represents any flower that has a pungent odor; and then claims, “I claim a rose.” What is an examiner to do?

> "*What's in a name? That which we call a rose by any other name would smell as sweet.*" Romeo and Juliet (II, ii, 1-2)

There are a ton of real examples in the patent literature, such as in US 20150183988 A1 (Becker et al.), wherein the applicant University of Akron claims:

1. A covalently crosslinked hydrogel comprising the strain-promoted reaction product of an 8-member cycloalkyne functionalized polyalkylene glycol and a multi-arm glycerol exytholate triazide.

27. The covalently crosslinked hydrogel of claim **7** wherein said multi-arm glycerol exytholate triazide comprises a 3-arm glycerol exytholate triazide having the formula:



wherein n is an integer from about 8 to about 30.

What is an “exytholate?” Is it a typo? Of course, it is not, because the applicant uses this new word in publications (Zheng et al., Strain-Promoted Crosslinking of PEG-based Hydrogels via Copper-Free Cycloaddition, ACS Macro Lett. 2012 Aug 21; 1(8): 1071–1073) and patent applications uniformly, without ever defining it verbally. It is “ethoxylate” but intentionally written as “exytholate,” with a specific purpose. However, it is a legitimate exercise of the rights of applicant to be a lexicographer to create new words, upheld and reinforced by the American courts. Fortunately, the structures provided and the glycerol ethoxylate triazide shown in NMR Fig 10, para [0049], produced from glycerol ethoxylate at [0106], gives away the secret of the enigmatic new word “exytholate.”

Issue 135	5117 Kali Era, MANMADHA Year, ASHADHA Month 2073 Vikramarka Era, MANMADHA Year, ASHADHA Month 1937 Salivahana Era, MANMADHA Year, ASHADHA Month 2015 AD, JULY (Published online AUGUST 1, 2015)

Unfortunately, there is no procedure to make "glycerol exytholate triazide." What is the purpose of this new "chemically incorrect, improper and dyslexic" word "exytholate," when there is a chemically correct "ethoxylate" word derived from "ethoxy"? Why did the University of Akron create this improper dyslexic word? How does one "*exit-hole-ate*" "glycerol ethoxylate triazide" to make "glycerol exytholate triazide?"

Thanks to such lexicographers, interpretation of statements in a written description of a patent is a difficult task, due to an inherent tension between the two possibilities, a clear lexicographic definition and a description connived by the lexicographer inventor. The difficulty is in the interpretation of claims 'in view of the specification' without importing limitations from the specification into the claims. This tension is further complicated by a patent system with ambiguous statutes, confusing case law, conniving inventors and trolls, incompetent and deceptive patent preparers and examiners[(10)], and "jury and judges[(11)]."

As the USPTO tries to improve the quality of the patents granted, the examiners are playing it safe by taking the easy route of obviousness rejections. As a result, an inventor lexicographer can obtain a patent for an ancient technology rewritten in modern terminology. Because the claimed invention is not identically disclosed (using different terminology) and patentability shall not be negated by the manner in which the invention was made, the examiner considers that the alleged invention is "novel" under 35 USC section 102. This is a win for the conniving inventor or troll, because 1) the anticipatory reference is considered by the USPTO, 2) it has been declared "not anticipatory," by finding the alleged invention to be novel over the (anticipatory) reference, and 3) as a result, during later litigation the reference may lose its value because it was already considered by the USPTO during patent prosecution.

However, Under 35 USC 103 patent for a claimed invention may not be obtained, notwithstanding that it being novel, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. The US patent examiner would reject the claim as being obvious over the ancient technology, intentionally or incompetently

failing to recognize the "inherent anticipation." The inventor lexicographer can easily overcome the obviousness rejection during the prosecution, by providing evidence of comparative data, even if it were not presented in the application submitted on the effective filing date. In addition, patent examiners look only to the problem the patentee was trying to solve, assuming that a person having ordinary skill in the art (PHOSITA) attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem, and conclude that a patent claim cannot be proved obvious merely by showing that the combination of elements was 'obvious to try' because they are worried about falling prey to hindsight bias, thereby losing the (precious and uncommon commodity) commonsense[(11)], if any. The SCOTUS's admonition to the CAFC for failure to preserve the commonsense together with the familiar framework for determining obviousness (as set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966)) is on deaf ears, so far.

Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment[(12)]. However, the USPTO examiners fail to recognize the pertinent prior art that claims read on when a broader interpretation was given or inherency was considered, forced by the blinder-guidelines provided to them by the USPTO, requiring exact terminology. As a result, instead of taking the ordinary and customary meaning of a claim term, which is the meaning that the term would have to a PHOSITA in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application[(13)]; the examiners find very narrow and exacting language in prior art to reject claims under the easy-to-overcome obviousness paradigm, instead of explicit or inherent anticipation, allowing illegal monopolies over the matter available in the public domain, depriving the public from availing the free knowledge in the public domain; contrary to the Constitutional mandate and the purpose of patent regimes across the world.

Issue 135	5117 Kali Era, MANMADHA Year, ASHADHA Month 2073 Vikramarka Era, MANMADHA Year, ASHADHA Month 1937 Salivahana Era, MANMADHA Year, ASHADHA Month 2015 AD, JULY (Published online AUGUST 1, 2015)

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VEPACHEDU EDUCATIONAL FOUNDATION

The Andhra Journal of Industrial News

IP and Industry News

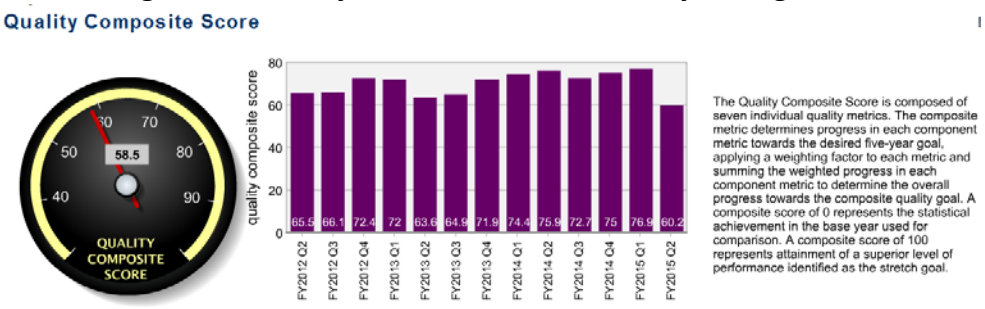
The combination of such blinders and lack of commonsense is the recipe for disastrous results, in general; and in patent prosecution, in particular. As a result, the patents granted by the USPTO are inferior in many aspects and invalid, yet with the presumption of validity attached, resulting in litigation.

To address some of the problems associated with the American patent system, president Obama signed the America Invents Act in 2011 that came into force incrementally, resulting in the partial integration of the US patent law with the rest of the world on March 16, 2013. For the first time in the history of U.S. patent law, to improve the patent quality, the AIA now allows third parties to submit pre-grant submissions and post-grant review[(14)]. However, so long as the examiners at the USPTO are confused about anticipation and obviousness, and fail to use anticipation for the fear that they might commit the crime of "stretching[(15)]" the prior art to fit the claim, no matter how many 3rd party submissions pertinent and anticipatory are submitted, the quality of the patent grant will remain poor and encroaches upon the free public domain.

Examples of such failure of the USPTO in recognizing anticipation can be seen in the obviousness rejections in an umpteen number of PCT applications[(16)].

Quantity over Quality at the USPTO

Intellectual property (IP) protection affects the economy by providing incentives to invent novel products and technologies that create jobs and boost the economy through the short-term monopolies to the inventors protecting from unauthorized copying. Patents are IP that may need to be appraised for accounting, tax, litigation and transactional purposes. IP intensive industries support at least



Issue 135	5117 Kali Era, MANMADHA Year, ASHADHA Month 2073 Vikramarka Era, MANMADHA Year, ASHADHA Month 1937 Salivahana Era, MANMADHA Year, ASHADHA Month 2015 AD, JULY (Published online AUGUST 1, 2015)

శ్రీ వేపచేదు విద్యా పీఠము

VEPACHEDU EDUCATIONAL FOUNDATION

The Andhra Journal of Industrial News

IP and Industry News

40 million jobs in the US and contribute more than $5 trillion, nearly 35 percent of the gross domestic product[2], making the US a world leader and a super power.

A strong patent system, supported by quality patents, also boosts American competitiveness. Thus, a strong patent system effectively promoting innovation is a key driver of economic growth and job creation. Such innovation requires an expedient examination process resulting in issued patents that comply with all statutory requirements and stand the scrutiny of litigation in the courts of law. Errors in patent grant and administration procedures can cause legal uncertainty and increase costs for all users of the patent system: rights-holders, competitors, users of patent information and the patent offices. The United States of America must set the standard for patent quality to ensure other countries both respect US patents and seek to raise quality themselves. Maintaining high quality patents also helps US companies to invest in innovation, enabling them to compete in the world marketplace.

Last year, the Washington Post reported that some of the 8,300 patent examiners repeatedly lied about the hours they were putting in, and many were receiving bonuses for work they didn't do, and the top agency officials ensured that cheaters were protected[3].

Therefore, the USPTO has established enhanced patent quality initiative[4] to:

- Build more confidence in the US patent system by enhancing patent quality;
- Make the system understandable and usable by all inventors; and
- Ensure each of our customers is treated fairly and professionally throughout the patent application process.

Issue 135	5117 Kali Era, MANMADHA Year, ASHADHA Month 2073 Vikramarka Era, MANMADHA Year, ASHADHA Month 1937 Salivahana Era, MANMADHA Year, ASHADHA Month 2015 AD, JULY (Published online AUGUST 1, 2015)

శ్రీ వేపచేదు విద్యా పీఠము

VEPACHEDU EDUCATIONAL FOUNDATION

The Andhra Journal of Industrial News

IP and Industry News

As part of this initiative and commitment to issuing patents that clearly define the scope of the rights therein, that are within the bounds of the patent statutes as interpreted by the judiciary, and that provide certainty as to their validity to encourage investment in research, development, and commercialization; the USPTO has released new training for examiners in the area of functional claiming, guidance on subject matter eligibility of claims, an improved classification system for searching prior art and targeted three aspects of patent quality, so-called the "patent quality pillars"[(5)]: (1) Excellence in work products, in the form of issued patents and Office actions; (2) excellence in measuring patent quality, including appropriate quality metrics; and (3) excellence in customer service. The USPTO recognizes that examiners are the fundamental resource essential to building and strengthening the first pillar[(5)].

Table 6. **Rate the quality of the patents issued by the following agencies (operating company)**

	Excellent	Very good	Good	Adequate	Poor	N/A
European Patent Office	19%	41%	21%	7%	3%	8%
Japan Patent Office	10%	25%	26%	13%	1%	27%
Korean Intellectual Property Office	5%	11%	25%	15%	4%	40%
State Intellectual Property Office (China)	2%	10%	23%	21%	16%	29%
US Patent and Trademark Office	9%	23%	35%	19%	9%	5%

Table 7. **Rate the quality of the patents issued by the following agencies (NPE)**

	Excellent	Very good	Good	Adequate	Poor	N/A
European Patent Office	19%	37%	18%	10%	1%	15%
Japan Patent Office	13%	22%	27%	9%	5%	25%
Korean Intellectual Property Office	3%	6%	31%	16%	5%	39%
State Intellectual Property Office (China)	2%	3%	19%	24%	11%	40%
US Patent and Trademark Office	15%	10%	30%	25%	10%	11%

Table 8. **Rate the quality of the patents issued by the following agencies (private practice)**

	Excellent	Very good	Good	Adequate	Poor	N/A
European Patent Office	15%	47%	25%	3%	0%	10%
Japan Patent Office	8%	25%	37%	8%	2%	21%
Korean Intellectual Property Office	2%	18%	29%	18%	3%	31%
State Intellectual Property Office (China)	2%	12%	26%	25%	6%	30%
US Patent and Trademark Office	7%	23%	39%	18%	6%	8%

Despite these alleged efforts to improve, the quality of US patents has been deteriorating. A new independent review[(6)] by the National Academy of Public Administration found that the U.S. Patent and Trademark Office's award-winning telework program to be a patent system that stresses "quantitative production over quality" and questions whether

examiners are working hard enough; while patents are being issued at a rate of more than one million a decade. Oversight of examiners based at the Alexandria headquarters was “completely ineffective.”

Patent quality is based on meeting the legal requirements of subject matter, utility, disclosure, enablement, novelty and nonobviousness; and may include components such as value of invention, specification, patent prosecution, and commercialization. Bad patents drive up costs for innovative companies by forcing them to pay undeserved license fees or incur litigation costs. The USPTO policies have resulted in the grant of thousands of low quality patents to trolls bringing the majority of cases, hitting companies of every size in industries from high-tech to main street.

While the EPO has once again been rated number one for patent quality among the world's largest patent offices, according to a recent survey of patent professionals by Intellectual Asset Management (IAM) magazine. The latest IAM benchmarking survey is based on responses received earlier this year from more than 650 corporate IP managers, non-practising entity (NPE) executives, and private practice lawyers and attorneys worldwide. Corporate respondents rated EPO grants as either excellent or very good and the EPO also ranked first in the level of service provided by the IP5 offices. The EPO has received top marks for patent quality in all of the most recent editions of the IAM survey (2012, 2011 and 2010). The other offices included in the survey are the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the State Intellectual Property Office of the People's Republic of China (SIPO), and the United States Patent and Trademark Office (USPTO). Things had got worse over the last year for the USPTO, according to 12% of operating company respondents and 14% of those from private practice.

Turkey Baster Technology Appeal

Issue 135	5117 Kali Era, MANMADHA Year, ASHADHA Month 2073 Vikramarka Era, MANMADHA Year, ASHADHA Month 1937 Salivahana Era, MANMADHA Year, ASHADHA Month 2015 AD, JULY (Published online AUGUST 1, 2015)

Under the Virginia Family Law, Sections 20-156[7], "assisted conception" means a pregnancy resulting from any intervening medical technology, whether in vivo or in vitro, which completely or partially replaces sexual intercourse as the means of conception. Such intervening medical technology includes, but is not limited to, conventional medical and surgical treatment as well as noncoital reproductive technology such as artificial insemination by donor, cryopreservation of gametes and embryos, in vitro fertilization, uterine embryo lavage, embryo transfer, gamete intrafallopian tube transfer, and low tubal ovum transfer. Therefore, it would make sense to think that such intervening medical technology includes, but is not limited to, the listed methods.

In *Boardwine v Bruce*, the issue was if the “turkey baster” constituted medical technology for assisted pregnancy[8] as defined under the Virginia Family Law. A circuit court ruled that turkey baster method of insemination didn't come from medical technology. "The plain meaning of the term 'medical technology' does not encompass a kitchen implement such as a turkey baster," the appeals court wrote in its decision. That may be true for the plain meaning of the term 'medical technology', but the Code of Virginia[7] expressly leaves the door open for any method not listed under the Code. Further, a turkey baster is defined as a siphoning device or manual (i.e. hand-operated) positive displacement pump used in medical, scientific and industrial applications[9].

The Court of Appeals, *In Breit v. Mason*[10], has “harmonized” Code §§ 20-49.1(B)(2) and 20-158(A)(3) to be consistent with “the intent of the legislature to ensure that all children born in the Commonwealth have a known legal mother and legal father.” The Court of Appeals concluded that it would create a “manifest absurdity” to interpret Code § 20-158(A)(3) to foreclose any legal means for an intended, unmarried, biological father to establish legal parentage of a child born as a result of assisted conception, merely by virtue of his status as a “donor.” And the Supreme Court of Virginia[10] affirmed the judgment of the Court of Appeals in a manner that avoids constitutional conflict, by rejecting the notion that children have a purported right or interest in not having a father; although disagreed with reasoning that it

was purely legal question of statutory and constitutional interpretation and that at common law, there was no recognized duty on the part of an unmarried father to support his biological child.

Turkey Baster Vaginal Insemination is a popular term for insemination in which still liquified ejaculate is drawn into a simple device—turkey basters were used in a distant past, now disposable dedicated devices are preferred—which provide gentle suction. The semen is then expressed (squeezed) into the vagina, or directly into the cervical os or opening, ideally at the time of ovulation[(11)].

A better method, in light of some courts confusion regarding "technology," comprising a similar device working exactly the same way, but has different name, without any questions regarding medical technology, such as "the needleless syringe" to perform the "Turkey Baster Vaginal Insemination[(12)]" may be advised for artificial insemination.

References:

1. Dr. Rao Vepachedu is the Managing Director at Cardinal Risk Management and registered patent attorney with extensive experience in the management of intellectual property and extensive experience in research and teaching. He currently works for Cardinal Intellectual Property (CIP), Cardinal Risk Management (CRM), and Cardinal Law Group (CLG). In addition, he is the president of Vepachedu Educational Foundation Inc. (www.vepachedu.org), a 501(c) (3) educational foundation. For more information visit: www.linkedin.com/in/vepachedu; http://www.avvo.com/attorneys/60201-il-sreenivasarao-vepachedu-764535.html, and http://www.crm-ip.com/vepachedu.html. Contact: svepachedu@yahoo.com or rao.vepachedu@cardinal-ip.com: www.linkedin.com/in/vepachedu and http://www.crm-ip.com/vepachedu.html;

http://www.avvo.com/profile/dashboard.

Novelty: References and Notes:

(2) See also novelty definition at Merriam-Webster: http://www.merriam-webster.com/dictionary/novelty

Issue 135	5117 Kali Era, MANMADHA Year, ASHADHA Month 2073 Vikramarka Era, MANMADHA Year, ASHADHA Month 1937 Salivahana Era, MANMADHA Year, ASHADHA Month 2015 AD, JULY (Published online AUGUST 1, 2015)

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[3] See for more on Novelty Items: https://en.wikipedia.org/wiki/Novelty_item; Definition 3: http://dictionary.reference.com/browse/novelty?s=t

[4] The Supreme Court is the highest tribunal in the nation for all cases and controversies arising under the Constitution or the laws of the United States. The Court stands as the final arbiter of the law and guardian of constitutional liberties. This includes defining words like "novelty," for example. See also: http://www.supremecourt.gov/about/about_us.aspx

[5] An invention cannot be patented if it is known, published, or patented. 35 U.S.C. § 102(a). The Supreme Court of the United States opined that it is "to find a balance between promoting innovation and allowing the public to use and perfect the invention for the good of the economy." *Bilski v. Kappos, 130 S. Ct. 3218, 3252-53 (2010).*

[6] *Utility:*
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.
As interpreted by the Federal courts, 35 U.S.C. 101 has three purposes. First, 35 U.S.C. 101 limits an inventor to ONE patent for a claimed invention. If more than one patent is sought, a patent applicant will receive a statutory double patenting rejection for claims included in more than one application that are directed to the same invention. See MPEP § 804. Second, 35 U.S.C. 101 defines which categories of inventions are eligible for patent protection. An invention that is not a machine, an article of manufacture, a composition or a process cannot be patented. See Diamondv.Chakrabarty, 447 U.S. 303, 206 USPQ 193 (1980); Diamondv.Diehr, 450 U.S. 175, 209 USPQ 1 (1981); In re Nuijten, 500 F.3d 1346, 1354, 84 USPQ2d 1495, 1500 (Fed. Cir. 2007). Third 35 U.S.C. 101 serves to ensure that patents are granted on only those inventions that are "useful." This second purpose has a Constitutional footing — Article I, Section 8 of the Constitution authorizes Congress to provide exclusive rights to inventors to promote the "useful arts." See Carl Zeiss Stiftungv.Renishaw PLC, 945 F.2d 1173, 20 USPQ2d 1094 (Fed. Cir. 1991). Thus, to satisfy the requirements of 35 U.S.C. 101, an applicant must claim an invention that is statutory subject matter and must show that the claimed invention is "useful" for some purpose either explicitly or implicitly. Application of this latter element of 35 U.S.C. 101 is the focus of these guidelines.

Under PCT Article 33(4), a claimed invention shall be considered industrially applicable if, according to its nature, it can be made or used (in the technological sense) in any kind of industry. "Industry" shall be understood in its broadest sense, as in the Paris Convention for the Protection of Industrial Property.

[7] *Novelty:*
35 U.S.C. 102 Conditions for patentability; novelty and loss of right to patent.
(a) NOVELTY; PRIOR ART.--A person shall be entitled to a patent unless--
(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or
(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.
(b) EXCEPTIONS.--
(1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.--A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if--
(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.
(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.--A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if--
(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;
(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or
(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.
(c) COMMON OWNERSHIP UNDER JOINT RESEARCH AGREEMENTS.--Subject matter disclosed and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person in applying the provisions of subsection (b)(2)(C) if--
(1) the subject matter disclosed was developed and the claimed invention was made by, or on behalf of, 1 or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention;
(2) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and
(3) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.
(d) PATENTS AND PUBLISHED APPLICATIONS EFFECTIVE AS PRIOR ART.--For purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), such patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application--
(1) if paragraph (2) does not apply, as of the actual filing date of the patent or the application for patent; or
(2) if the patent or application for patent is entitled to claim a right of priority under section 119, 365(a), or 365(b), or to claim the benefit of an earlier filing date under section 120, 121, or 365(c), based upon 1 or more prior filed applications for patent, as of the filing date of the earliest such application that describes the subject matter.

Under PCT Article 33(2), a claimed invention shall be considered novel if it is not anticipated by the prior art as defined in the Regulations.

Under EPO Article 54, (1) An invention shall be considered to be new if it does not form part of the state of the art.
(2) The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application.
(3) Additionally, the content of European patent applications as filed, the dates of filing of which are prior to the date referred to in paragraph 2 and which were published on or after that date, shall be considered as comprised in the state of the art.
(4) Paragraphs 2 and 3 shall not exclude the patentability of any substance or composition, comprised in the state of the art, for use in a method referred to in Article 53(c), provided that its use for any such method is not comprised in the state of the art.
(5) Paragraphs 2 and 3 shall also not exclude the patentability of any substance or composition referred to in paragraph 4 for any specific use in a method referred to in Article 53(c), provided that such use is not comprised in the state of the art.

[(8)] Non-Obviousness
35 U.S.C. 103 Conditions for patentability; non-obvious subject matter.

Issue 135	5117 Kali Era, MANMADHA Year, ASHADHA Month 2073 Vikramarka Era, MANMADHA Year, ASHADHA Month 1937 Salivahana Era, MANMADHA Year, ASHADHA Month 2015 AD, JULY (Published online AUGUST 1, 2015)

శ్రీ వేపచేదు విద్యా పీఠము

VEPACHEDU EDUCATIONAL FOUNDATION

The Andhra Journal of Industrial News

IP and Industry News

[Editor Note: Applicable to any patent application subject to the first inventor to file provisions of the AIA (see 35 U.S.C. 100 (note)). See 35 U.S.C. 103 (pre-AIA) for the law otherwise applicable.]
A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102 , if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.
(Amended Nov. 8, 1984, Public Law 98-622, sec. 103, 98 Stat. 3384; Nov. 1, 1995, Public Law 104-41, sec.1, 109 Stat. 3511; subsection (c) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-591 (S. 1948 sec. 4807); subsection (c) amended Dec. 10, 2004, Public Law 108-453, sec. 2, 118 Stat. 3596; amended Sept. 16, 2011, Public Law 112-29, secs. 20(j) (effective Sept. 16, 2012) and 3(c) (effective March 16, 2013), 125 Stat. 284.)
(Public Law 112-29, sec. 14, 125 Stat. 284 (Sept. 16, 2011) provided that tax strategies are deemed to be within the prior art (see AIA § 14).)

[(9)] Inventive step:
Under PCT Article 33(3), a claimed invention shall be considered to involve an inventive step if, having regard to the prior art as defined in the Regulations, it is not, at the prescribed relevant date, obvious to a person skilled in the art.

Under EPO Chapter VII – Inventive step:
1. An invention is considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the Art. Novelty (see G-IV, 5) and inventive step are different criteria. The question – "is there inventive step?" – only arises if the invention is novel.
2. The "state of the art" for the purposes of considering inventive step is as defined in Art. 54(2) (see G-IV, 1). It is to be understood as concerning such kind of information as is relevant to some field of technology (see T 172/03). It does not include later published European applications referred to in Art. 54(3). As mentioned in G-IV, 3, "date of filing" in Art. 54(2), means date of priority where appropriate (see F-VI). The state of the art may reside in the relevant common general knowledge, which need not necessarily be in writing and needs substantiation only if challenged (see T 939/92).
3. The "person skilled in the art" should be presumed to be a skilled practitioner in the relevant field of technology, who is possessed of average knowledge and ability and is aware of what was common general knowledge in the art at the relevant date (see T 4/98, T 143/94 and T 426/88). He should also be presumed to have had access to everything in the "state of the art", in particular the documents cited in the search report, and to have had at his disposal the means and capacity for routine work and experimentation which are normal for the field of technology in question. If the problem prompts the person skilled in the art to seek its solution in another technical field, the specialist in that field is the person qualified to solve the problem. The skilled person is involved in constant development in his technical field (see T 774/89 and T 817/95). He may be expected to look for suggestions in neighbouring and general technical fields (see T 176/84 and T 195/84) or even in remote technical fields, if prompted to do so (see T 560/89). Assessment of whether the solution involves an inventive step must therefore be based on that specialist's knowledge and ability (see T 32/81). There may be instances where it is more appropriate to think in terms of a group of persons, e.g. a research or production team, rather than a single person (see T 164/92 and T 986/96). It should be borne in mind that the skilled person has the same level of skill for assessing inventive step and sufficient disclosure (see T 60/89, T 694/92 and T 373/94).
4. Thus the question to consider, in relation to any claim defining the invention, is whether before the filing or priority date valid for that claim, having regard to the art known at the time, it would have been obvious to the person skilled in the art to arrive at something falling within the terms of the claim. If so, the claim is not allowable for lack of inventive step. The term "obvious" means that which does not go beyond the normal progress of technology but merely follows plainly or logically from the prior art, i.e. something which does not involve the exercise of any skill or ability beyond that to be expected of the person skilled in the art. In considering inventive step, as distinct from novelty (see G-VI, 3), it is fair to construe any published document in the light of knowledge up to and including the day before the filing or priority date valid for the claimed invention and to have regard to all the knowledge generally available to the person skilled in the art up to and including that day.
In order to assess inventive step in an objective and predictable manner, the so-called "problem-and-solution approach" should be applied. Thus deviation from this approach should be exceptional.
5. In the problem-and-solution approach, there are three main stages:
(i)determining the "closest prior art",

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IP and Industry News

(ii)establishing the "objective technical problem" to be solved, and
(iii)considering whether or not the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person.
5.1 Determination of the closest prior art
5.2 Formulation of the objective technical problem
5.3 Could‑would approach
5.4 Claims comprising technical and non‑technical aspects
6. In the context of the problem-solution approach, it is permissible to combine the disclosure of one or more documents, parts of documents or other pieces of prior art (e.g. a public prior use or unwritten general technical knowledge) with the closest prior art. However, the fact that more than one disclosure must be combined with the closest prior art in order to arrive at a combination of features may be an indication of the presence of an inventive step, e.g. if the claimed invention is not a mere aggregation of features (see G‑VII, 7). See for more information: http://www.epo.org/law-practice/legal-texts/html/guidelines/e/g_vii.htm

[10] Last year, the Washington Post reported that some of the 8,300 patent examiners repeatedly lied about the hours they were putting in, and many were receiving bonuses for work they didn't do, and the top agency officials ensured that cheaters were protected. See, Quantity over Quality at the USPTO, The Andhra Journal of Industrial News, Issue 135, August 1, 2015: http://www.vepachedu.org/AJIN/AIJN-135.pdf

[11] In *In re Zletz*, the examiner and the Board had interpreted claims reading "normally solid polypropylene" and "normally solid polypropylenehaving a crystalline polypropylene content" as being limited to "normally solid linear high homopolymers of propylene which have a crystalline polypropylene content." The court ruled that limitations, not present in the claims, were improperly imported from the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

[11] The Supreme Court in *KSR, 550 U.S. at 404, 82 USPQ2d*, reaffirmed the familiar framework for determining obviousness as set forth in *Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966)*. However, the Supreme Court particularly emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art."

The Supreme Court stated that the Federal Circuit had applied the teaching-suggestion-motivation (TSM) test in an overly rigid and formalistic way (KSR, 550 U.S. at 404, 82 USPQ2d at 1391) and erred in four ways: (1) "by holding that courts and patent examiners should look only to the problem the patentee was trying to solve " (Id. at 420, 82 USPQ2d at 1397); (2) by assuming "that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem" (Id.); (3) by concluding "that a patent claim cannot be proved obvious merely by showing that the combination of elements was 'obvious to try'" (Id. at 421, USPQ2d at 1397); and (4) by overemphasizing "the risk of courts and patent examiners falling prey to hindsight bias" and as a result applying "[r]igid preventative rules that deny fact finders recourse to common sense."

[12] Superguide Corp. v. DirecTV Enterprises, Inc., 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004).

[13] Phillips v. AWH Corp.,415 F.3d 1303, 1313, 75 USPQ2d 1321, 1326 (Fed. Cir. 2005) (en banc); Sunrace Roots Enter. Co. v. SRAM Corp., 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc., 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003); Ferguson Beauregard/Logic Controls v. Mega Systems, 350 F.3d 1327, 1338, 69 USPQ2d 1001, 1009 (Fed. Cir. 2003); ACTV, Inc. v. The Walt Disney

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IP and Industry News

Company, 346 F.3d 1082, 1092, 68 USPQ2d 1516, 1524 (Fed. Cir. 2003); E-Pass Technologies, Inc. v. 3Com Corporation, 343 F.3d 1364, 1368, 67 USPQ2d 1947, 1949 (Fed. Cir. 2003)

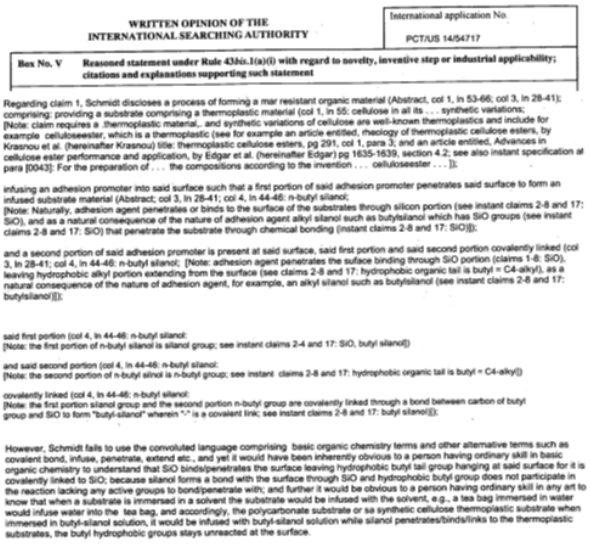
The ordinary and customary meaning of a term may be evidenced by a variety of sources, including "the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art." Phillips v. AWH Corp., 415 F.3d at 1314, 75 USPQ2d at 1327. If extrinsic reference sources, such as dictionaries, evidence more than one definition for the term, the intrinsic record must be consulted to identify which of the different possible definitions is most consistent with applicant's use of the terms. Brookhill-Wilk 1, 334 F.3d at 1300, 67 USPQ2d at 1137; see also Renishaw PLC v. Marposs Societa' per Azioni, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998) ("Where there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings.") and Vitronics Corp. v. Conceptronic Inc., 90 F.3d 1576, 1583, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996) (construing the term "solder reflow temperature" to mean "peak reflow temperature" of solder rather than the "liquidus temperature" of solder in order to remain consistent with the specification.). If more than one extrinsic definition is consistent with the use of the words in the intrinsic record, the claim terms may be construed to encompass all consistent meanings. See e.g., Rexnord Corp. v. Laitram Corp., 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) (explaining the court's analytical process for determining the meaning of disputed claim terms); Toro Co. v. White Consol. Indus., Inc., 199 F.3d 1295, 1299, 53 USPQ2d 1065, 1067 (Fed. Cir. 1999) ("[W]ords in patent claims are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that a word was used with a special meaning."). Compare MSM Investments Co. v. Carolwood Corp., 259 F.3d 1335, 1339-40, 59 USPQ2d 1856, 1859-60 (Fed. Cir. 2001) (Claims directed to a method of feeding an animal a beneficial amount of methylsulfonylmethane (MSM) to enhance the animal's diet were held anticipated by prior oral administration of MSM to human patients to relieve pain. Although the ordinary meaning of "feeding" is limited to provision of food or nourishment, the broad definition of "food" in the written description warranted finding that the claimed method encompasses the use of MSM for both nutritional and pharmacological purposes.); and Rapoport v. Dement, 254 F.3d 1053, 1059-60, 59 USPQ2d 1215, 1219-20 (Fed. Cir. 2001) (Both intrinsic evidence and the plain meaning of the term "method for treatment of sleep apneas" supported construction of the term as being limited to treatment of the underlying sleep apnea disorder itself, and not encompassing treatment of anxiety and other secondary symptoms related to sleep apnea.).

(14) IP and National Competitiveness: http://www.cardinal-ip.com/ip-news-strategy/ip-and-national-competitiveness/

(15) "Stretching" is a crime committed by a patent examiner while reviewing the prior art in rejecting a claim in question. The dictionary meaning of stretch is "to draw out or extend to the full length or extent" (The meaning at: http://dictionary.reference.com/browse/stretch). One might wonder why such extension of a piece of prior art to its fullest extent is crime. However, there is another meaning of stretch, "to extend, force, or make serve beyond the normal or proper limits" (the last meaning at: http://dictionary.reference.com/browse/stretch). This is the stretch that examiners are afraid of, for all the reasons and fears such as "hindsight" and looking through the "blinders" put on. The question remains to be answered, despite the SCOTUS'es clear dictate to use commonsense and not to limit for fear of hindsight.

Examples of such "full extent stretching" confused with "beyond proper limits stretching" are too many, because it is subjective and requires case-by-case analysis in view of conniving lexicographer invention.

(16) PCT/US2014/054717 (WO2015035361)



WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY

International application No. PCT/US 14/54717

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

Regarding claim 1, Schmidt discloses a process of forming a mar resistant organic material (Abstract, col 1, ln 53-66; col 3, ln 28-41); comprising: providing a substrate comprising a thermoplastic material (col 1, ln 55: cellulose in all its . . . synthetic variations; [Note: claim requires a .thermoplastic material,. and synthetic variations of cellulose are well-known thermoplastics and include for example cellulooseester, which is a thermoplastic (see for example an article entitled, rheology of thermoplastic cellulose esters, by Krasnou et al. (hereinafter Krasnou) title: thermoplastic cellulose esters, pg 291, col 1, para 3; and an article entitled, Advances in cellulose ester performance and application, by Edgar et al. (hereinafter Edgar) pg 1635-1639, section 4.2; see also instant specification at para [0043]: For the preparation of . . . the compositions according to the invention . . . celluloseester . . .]);

infusing an adhesion promoter into said surface such that a first portion of said adhesion promoter penetrates said surface to form an infused substrate material (Abstract; col 3, ln 28-41; col 4, ln 44-46: n-butyl silanol; [Note: Naturally, adhesion agent penetrates or binds to the surface of the substrates through silicon portion (see instant claims 2-8 and 17: SiO), and as a natural consequence of the nature of adhesion agent alkyl silanol such as butylsilanol which has SiO groups (see instant claims 2-8 and 17: SiO) that penetrate the substrate through chemical bonding (instant claims 2-8 and 17: SiO)]);

and a second portion of said adhesion promoter is present at said surface, said first portion and said second portion covalently linked (col 3, ln 28-41; col 4, ln 44-46: n-butyl silanol; [Note: adhesion agent penetrates the suface binding through SiO portion (claims 1-8: SiO), leaving hydrophobic alkyl portion extending from the surface (see claims 2-8 and 17: hydrophobic organic tail is butyl = C4-alkyl), as a natural consequence of the nature of adhesion agent, for example, an alkyl silanol such as butylsilanol (see instant claims 2-8 and 17: butylsilanol)]);

said first portion (col 4, ln 44-46: n-butyl silanol: [Note: the first portion of n-butyl silanol is silanol group; see instant claims 2-4 and 17: SiO, butyl silanol])

and said second portion (col 4, ln 44-46: n-butyl silanol: [Note: the second portion of n-butyl silnol is n-butyl group; see instant claims 2-8 and 17: hydrophobic organic tail is butyl = C4-alkyl])

covalently linked (col 4, ln 44-46: n-butyl silanol: [Note: the first portion silanol group and the second portion n-butyl group are covalently linked through a bond between carbon of butyl group and SiO to form "butyl-silanol" wherein "-" is a covalent link; see instant claims 2-8 and 17: butyl silanol]);

However, Schmidt fails to use the convoluted language comprising basic organic chemistry terms and other alternative terms such as covalent bond, infuse, penetrate, extend etc., and yet it would have been inherently obvious to a person having ordinary skill in basic organic chemistry to understand that SiO binds/penetrates the surface leaving hydrophobic butyl tail group hanging at said surface for it is covalently linked to SiO; because silanol forms a bond with the surface through SiO and hydrophobic butyl group does not participate in the reaction lacking any active groups to bond/penetrate with; and further it would be obvious to a person having ordinary skill in any art to know that when a substrate is immersed in a solvent the substrate would be infused with the solvent, e.g., a tea bag immersed in water would infuse water into the tea bag, and accordingly, the polycarbonate substrate or sa synthetic cellulose thermoplastic substrate when immersed in butyl-silanol solution, it would be infused with butyl-silanol solution while silanol penetrates/binds/links to the thermoplastic substrates, the butyl hydrophobic groups stays unreacted at the surface.

03 Jan 1984 (03/01/1984) 23 Feb 1982 (23/02/1982)

Source of Abstract:	Accession number:	Publication Date of Abstract:	Retrieval Date of Abstract:

Most relevant passages or drawings: Abstract, col 1, ln 29-42 | Relevant to Claims: claims 1-9

Brief explanation of relevance:

US4,424,075A (Schmidt) anticipates a process of forming a mar resistant organic material (col 1, ln 29-42) comprising:

providing a substrate comprising a thermoplastic material (col 1, ln 29-38: cellulose containing materials [Note: cellulose esters are well-known thermoplastic materials, e.g., cellophane; see also an article entitled, Thermoplastic and biodegradable polymers of cellulose, by Simon; Polymer Degradation and Stobikry 59 (1998) 107-1115]), said substrate having a surface (Note: all substrates have surfaces including the cellulose-containing substrate, col 1, ln 29-42); infusing an adhesion promoter into said surface such that a first portion of said adhesion promoter penetrates said surface to form an infused substrate material, and a second portion of said adhesion promoter extends from said surface or is present at said surface, said first portion and said second portion covalently linked (col 1, ln 29-38: alkyl silanol [Note: see instant claims 2-8; especially claim 8 formula II, which reads on alkyl silanol; infusing is impregnating or immersing; see also instant specification, pg 22, ln 18-19: The polycarbonate substrate is immersed in the agent containing infusion solvent]; col 1, ln 39-41:To make the cellulose-containing material hydrophobic in accordance with the invention it can be immersed in the impregnating agent and then dried. [Note: see instant claims 6 and 8. "6. OT comprises a hydrophobic linear, branched, or cyclic organic chain covalently linked to said IC." Claim 8: IC = Si; OT= R).

([Note: optional language is ignored: [and optionally depositing a mar resistant coating or hardcoat on said surface, said mar resistant coating or hardcoat adhering to said infused substrate material absent an intermediate layer]).

2. 2)

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(2) Intellectual Property and the U.S. Economy, at**: http://www.uspto.gov/learning-and-resources/ip-motion/intellectual-property-and-us-economy**
(3. Patent office filters out abuses: http://www.washingtonpost.com/politics/patent-office-filters-out-worst-telework-abuses-in-report-to-watchdog/2014/08/10/cd5f442e-1e4d-11e4-82f9-2cd6fa8da5c4_story.html
(4) USPTO Launches Enhanced Patent Quality Initiative: http://www.uspto.gov/blog/director/entry/uspto_launches_enhanced_patent_quality
(5) New Quality Proposals: https://www.federalregister.gov/articles/2015/02/05/2015-02398/request-for-comments-on-enhancing-patent-quality
(6) Final Report on Fraud: http://apps.washingtonpost.com/g/page/politics/final-report-by-us-patent-and-trademark-office-on-telework-fraud-allegations/1245/
USPTO Quality: http://www.uspto.gov/corda/dashboards/patents/main.dashxml?CTNAVID=1000
EPO global benchmark for quality: http://www.epo.org/news-issues/news/2015/20150603.html

Turkey Baster Medical Technology

(7) Code of Virginia: http://law.lis.virginia.gov/vacode/20-156/; Mother loses appeal in turkey baster: http://www.cnn.com/2015/04/21/us/turkey-baster-pregnancy-legal-ruling/; 7a. § 20-158(A)(2)
(8) Brookside – Season 49, Episode 19, Turkey Baster [November 1997]: https://www.youtube.com/watch?v=wJkr-BvsTWY
Turkey Baster Method (Needleless Syringe): http://www.fertilityplus.com/faq/homeinsem.html#syringe
(9) See for example, US 2002/0020463 A1 (Porter et al.) para [0002], [0016]; US 2014/0309488 A1 (Fowler) para [0008]; US 2015/0198475 A1 (Vander Horst), para [0032]
(10) Breit v. Mason, 59 Va. App. 322, 337-38, 718 S.E.2d 482, 489 (2011): http://www.courts.state.va.us/opinions/opnscvwp/1120158.pdf
(11) The Free Dictionary: http://medical-dictionary.thefreedictionary.com/Turkey+Baster+Insemination; http://medical-dictionary.thefreedictionary.com/os
(12) Turkey Baster Method (Needleless Syringe): https://mondayschild1.wordpress.com/2010/06/27/so-you-bought-the-sperm-how-to-inseminate-yourself-without-the-high-costs-of-a-doctor/

Issue 135	5117 Kali Era, MANMADHA Year, ASHADHA Month 2073 Vikramarka Era, MANMADHA Year, ASHADHA Month 1937 Salivahana Era, MANMADHA Year, ASHADHA Month 2015 AD, JULY (Published online AUGUST 1, 2015)

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Om! Asatoma Sadgamaya, Tamasoma Jyotirgamaya, Mrityorma Amritamgamaya, Om Shantih, Shantih, Shantih!
(Aum! Lead the world from wrong path to the right path, from ignorance to knowledge, from mortality to immortality, and peace!)

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