

Kluwer Patent Blog

Fordham Conference 2015 - US Patent Potpourri

Daniel Byrne (Bristows) · Thursday, April 9th, 2015

John Richards (Ladas & Parry LLP, New York) identifies the problem that filing a patent involves a prior art search which is probably not as focussed as searched that occur in litigation and therefore the patent might require later amendment. The Patent Trial and Appeal Board (PTAB) takes a very strict approach to amendment in the USA. Most jurisdictions do not allow broadening of scope after grant except for the USA and Canada in specific circumstances and under strict time limit.

- Australia allows amendment and will advertise the amendment and stay any litigation.
- Canada allows for disclaimers.
- EPC as originally granted did not allow post grant amendments other than in opposition proceedings. EPC 2000 added provision for central limitation and also in court.
- UK allows amendment to amend voluntarily at any time or during litigation, it will be advertised and examined to ensure it complies with the requirements. The remedy is discretionary and delay can now no longer be taken into account.

He raises the question of what method should be adopted by the PTAB. The regulations for the America Invents Act are presently being amended. There is now an increased number of pages allowed to make the request for amendment (15 to 20).

Kenneth R Adamo (Kirkland & Ellis LLP, Chicago) points out that post-grant procedure can be run in parallel to court proceedings in the USA. This raises the question of whether the court proceedings can be stayed and who passes the post first. If the patent is revoked the patent rights end, but do not disappear retroactively. There is also estoppel in the US which is not present in the EPO or Japan. The USPTO will continue to make amendments even if the parties settle and the patentee no longer desires it. He notes that there is a new post grant amendment procedure in Japan.

How to construe patent claims? Is it a jury question? No, the Markman case held it was a question of law. **Robert J Goldman** (Ropes & Gray LLP) refers to the *de novo* standard of review of District Court claim constructions by the Federal Circuit and the controversy of this standard since it was introduced in 1998. Construction being a question to be revisited *de novo* on appeal.

The Supreme Court case of *Teva v Sandoz* (2015) ruled that the findings of fact which are subsidiary to claim construction should be reviewed under the 'clearly erroneous' standard, not a *de novo* review which only applies to the ultimate conclusion as to the meaning of the claims.

This does not solve the problem because, in the case of *Enzo Biochem v Applera Corp*, the District Court used expert testimony. The Federal Court reversed this on the basis of a *de novo* review of intrinsic evidence by ignoring the extrinsic evidence, which does not appear to be in the spirit of the *Teva* decision. The scope for arguing about extrinsic or intrinsic evidence is high, but it does not matter if the Court does not care about the distinction as long as there is intrinsic evidence available to enable it to undertake a *de novo* review.

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