FIRST TO FILE PATENT DRAFTING

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§ 1[a][7][D] Differences between American and Foreign Laws

In connection with the scope of the state of the art based upon a prior use or commercialization, care must be exercised to make sure that one understands that the comparable definitions under United States law in some cases have a wider meaning than in Europe or Japan. For example, an invention may be in "public use" even though secret. *See, e.g.,* § 2[b][1][E] , *Differences between American and Overseas Laws.*

§ 1[a][8] The "*Dynamic Drinkware* Phenomenon", Beware!

The "*Dynamic Drinkware* Phenomenon" is shorthand for the increasing uncertainties in the patent case law that are forthcoming in the wake of major statutory changes. These changes before and continuing through the *Leahy Smith America Invents Act* have created a web of complexities and the promise of patent decisions difficult to fathom.

Dynamic Drinkware, LLC v. Nat'l Graphics, Inc., 800 F.3d 1375 (Fed. Cir. 2015), is a good case study. It shows that even the most experienced patent jurists with fifty or more years in the field are having great difficulties interpreting the new patent laws. (The case is considered in more detail at §4[h], *Patentability as a Condition for Patent-Defeating Effect.*

Dynamic Drinkware does not even involve the *Leahy Smith America Invents Act*: "Because we refer to the pre-[*Leahy Smith America Invents Act*] version of [35 USC] § 102, we do not interpret here [its] impact on [*In re Wertheim*, 646 F.2d 527, 537 (CCPA 1981),] in newly designated [35 USC] § 102(d)." *Dynamic Drinkware*, 800 F.3d at 1381 n.2.

Dynamic Drinkware, itself, remarkably interprets the pre-*Leahy Smith America Invents Act* patent law. The panel denies a patent-defeating effect to disclosure as of a provisional application filing date. The court made this denial even though the relevant disclosure is found in the provisional application.

That *Dynamic Drinkware* is keyed to case law superseded by statutory enactment as explained in *Ex parte Yamaguchi*, 88 U.S.P.Q.2d 1606 (B.P.A.I. 2008). Astonishingly, the opinion cites but does not otherwise comment on the *Yamaguchi* case; it is simply judicially ignored as to its highly relevant content.

Why the *Dynamic Drinkware* opinion is so very wrong has already been explained by two of the leading appellate patent commentators, Courtenay C.

Brinckerhoff and Professor Dennis Crouch. *See* Courtenay C. Brinckerhoff, *Wertheim, Dynamic Drinkware and the AIA*, PharmaPatentsBlog (Nov. 3, 2015); Professor Dennis Crouch, *Federal Circuit Backtracks (A bit) on Prior Art Status of Provisional Applications and Gives us a Disturbing Result (Dynamic Drinkware v. National Graphics* (Fed. Cir. 2015)), Patently O Blog (September 8, 2015).

§ 1[b] Technology-Specific Patent-Eligibility Challenges

An outline of how to draft a patent application "today" for inventions involving issues under Section 101 relating to patent-eligibility is contained in the immediately following §§ 1[b][1] – 1[b][3]. A far more detailed exposition of the legal issues is found in Chapter 15, *Claiming Patent-Eligible Subject Matter.*

An even more detailed exposition of the issues is found in a parallel monograph by this author, PATENT-ELIGIBILITY, which is designed for in depth study of the issues for the purpose of a test case at either the Patent Trial and Appeal Board or the Federal Circuit.

"Inventive" applications of software and biotechnology innovations as well as diagnostic methods have come under special scrutiny under 35 USC § 101 through a series of cases denying patent-eligibility starting with *Bilski* v. *Kappos*, 561 U.S. 593 (2010)(software), and continuing with *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (2012)(diagnostic method); the *Myriad* case, *Ass'n for Molecular Pathology v. Myriad Genetics., Inc.*, 133 S. Ct. 2107, 2116 (2013)(DNA); and *Alice Corp. v. CLS Bank International*, 134 S. Ct. 2347 (2014)(software). The current section deals with the pragmatic realities of dealing with the Patent Office interpretation of these cases where the goal is to gain a patent of any kind without an appeal.

For a first filing "today", however, there may be some hope that when a new President in 2017 names a new Under Secretary of Commerce to head the Patent Office that the new Administration will take a more favorable view to patent-eligibility more in line with the historic case law as outlined in § 15, *"Inventive" Patent-Eligible Subject Matter*. *See* § 1[b][8], *New Approach in a New Administration in 2017* (discussing options open under a more patent-friendly Under Secretary of Commerce). There is, at this writing, no expectation that a particular candidate or party will prevail in the November 2016 election, much less who the new Under Secretary will be nor what policies may be taken. In any event, for a first filing "today", the application will be *examined* under a new