

Wegner Transitions: January 31, 2017, The Past Two Years

January 31, 2017, marked the second anniversary since my retirement from the Foley firm, and the end of my non-compete clause. This two year period has been a “sabbatical” from daily practice during which time I’ve completed a treatise on the *Leahy Smith America Invents Act* of 2011, to be published by Thomson Reuters and also electronically on Westlaw.

Proposed Rules Changes: Attached is the first of a series of publications based upon research for the treatise, *First-to-File Inspired Changes to the PTO Rules: Lessons from “First to File Patent Drafting”*.

Regards,

Hal

FIRST-TO-FILE INSPIRED CHANGES TO THE PTO RULES: LESSONS FROM *FIRST TO FILE PATENT DRAFTING**

Harold C. Wegner**

DETAILED TABLE OF CONTENTS	2
ORIGINS OF THE CHANGES PROPOSED IN THIS PAPER	3
DIRECTOR LEE’S RESPONSE TO THE PROPOSED RULES	3
THE PROPOSED RULES	4
37 CFR § 1.56 Duty to disclose information material to patentability.	4
37 CFR § 1.71 Detailed description and specification of the invention.	5
37 CFR § 1.72 Title and abstract.	5
37 CFR § 1.73 Summary of the invention.	6
37 CFR § 1.75 Claim(s).	7
37 CFR § 1.77 Arrangement of application elements.	8
37 CFR § 1.97 Filing of information disclosure statement.	8
37 CFR § 1.99. Background of the Invention	9
APPENDIX: REFORMULATED RULE 73	10

*This paper is an outgrowth of research for the writer’s treatise, *FIRST TO FILE PATENT DRAFTING: A PRACTITIONER’S GUIDE* (Thomson Reuters forthcoming 2017), which will also be available on Westlaw.

** President, The Naples Roundtable, Inc., 8805 Tamiami Trail North PMB-150, Naples, Florida 34108. hwegner@gmail.com. The views of the author are personal and do not represent the views of The Naples Roundtable or any other organization or person.

February 4, 2017

DETAILED TABLE OF CONTENTS

ORIGINS OF THE CHANGES PROPOSED IN THIS PAPER	3
DIRECTOR LEE’S RESPONSE TO THE PROPOSED RULES	3
THE PROPOSED RULES	4
37 CFR § 1.56 Duty to disclose information material to patentability.	4
37 CFR § 1.71 Detailed description and specification of the invention.	5
37 CFR § 1.72 Title and abstract.	5
37 CFR § 1.73 Summary of the invention.	6
37 CFR § 1.75 Claim(s).	7
37 CFR § 1.77 Arrangement of application elements.	8
37 CFR § 1.97 Filing of information disclosure statement.	8
37 CFR § 1.99. Background of the Invention	9
APPENDIX: REFORMULATED RULE 73	10
I. INTRODUCTION	10
II. UPDATED RULES: A . FIRST TO FILE IMPERATIVE	11
III. NEW RULE 73(a): TRUMPING <i>CUOZZO SPEED</i>	14
IV. NEW RULE 73(b): GENERIC COVERAGE FOR AN ELEMENT	14
V. NEW RULE 73(c): “INVENTIVE CONCEPT”	15
VI. NEW RULE 73(d): GENERIC UTILITY	18
VII. NEW RULE 73(e): RIGHT TO EXPERIMENTAL USE	18
A. A Split within the Judiciary	
B. Compelling a Federal Circuit <i>En Banc</i> Review	
C. The Theoretical Nature of “Too Much” Patent Protection	
VIII. ELIMINATION OF OUTDATED PROVISIONS	22
A. Rule 73 -- Proper Statutory Basis Until 65 Years Ago	
B. The <i>Manual</i> is also Outdated	
IX. CONCLUSION	24

ORIGINS OF THE CHANGES PROPOSED IN THIS PAPER

The pressure to file patent applications as early as possible under the new first-to-file regime of the *Leahy Smith America Invents Act* of 2011 requires a rethinking by the Government of its published procedures in the *Rules of Practice in Patent Cases*. To the extent that the regulations delay the first filing of a United States patent application any such delay may be fatal versus a junior inventor who wins the race to the Patent Office; this is particularly the case where an Asian or European applicant has a priority date keyed to a “home country” application with fewer formalities that delay a first filing, where the “home country” priority date trumps a domestic competitor’s delayed first filing date in the United States.

Many of the changes in this paper deal with the time pressure of the new first-to-file regime while others were developed as part of a comprehensive study of the *Rules of Practice in Patent Cases*. The proposed rules in this paper are a byproduct of a two year effort to produce a new treatise, **FIRST TO FILE PATENT DRAFTING: A PRACTITIONER’S GUIDE**, now under publication by Thomson Reuters which will also appear electronically on Westlaw.

DIRECTOR LEE’S RESPONSE TO THE PROPOSED RULES

The question may be fairly asked: Why weren’t proposed changes directed to the then Director, the Hon. Michelle K. Lee? The answer: The original proposal was presented to her in August 2016. Neither Ms. Lee nor anyone in her Office acknowledged the proposals. (The proposals were shunted to the Office of the Assistant Commissioner who, like Ms. Lee, never substantively responded, but that office did acknowledge receipt of the proposals.)

THE PROPOSED RULES

37 CFR § 1.56 Duty to disclose information material to patentability.¹

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98 **or made available to the Office by its inclusion in the Global Dossier Initiative**. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

- (1) Prior art cited in search reports of a foreign patent office in a counterpart application **unless included in the Global Dossier Initiative**, and
- (2) The closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office **or included in the Global Dossier Initiative**. * * *

¹ The Global Dossier Initiative is now up and running. It provides the American (or other counterpart) Examiner with the full prior art citations from parallel prosecution files. Given that the U.S. Examiner should study the parallel prior art citations, now is the time to modify 37 CFR § 1.56(a) to **exclude** from the applicant's duty to disclose any prior art that is included in the Global Dossier Initiative. The complete Rule 56(a) would read as shown here, with additions shown in **bold underlined**.

37 CFR § 1.71 Detailed description and specification of the invention.

* * *

(c) [**deleted**] *[In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.]*

* * *

37 CFR § 1.72 Title and abstract.

* * *

(b) A brief abstract of the technical disclosure in the specification must commence on a separate sheet, preferably following the claims, under the heading “Abstract” or “Abstract of the Disclosure.” The sheet or sheets presenting the abstract may not include other parts of the application or other material. The abstract must be as concise as the disclosure permits, preferably not exceeding 150 words in length. The purpose of the abstract is to enable the Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure.

(c) In lieu of the requirements of a brief abstract under the previous subsection, it shall be sufficient to recite verbatim the elements of the broadest claim and, in the case of an invention of a chemical or biotechnology product, a specific utility for such product.

37 CFR § 1.73 Summary of the invention.³

“A brief summary of the invention may include the following features:

“(a) A specific definition of an element of the claimed invention may be provided in which case that specific definition shall trump any otherwise broader reasonable interpretation of that element.

“(b) A generic element in a claim shall be given an interpretation to cover the full scope of the meaning of that generic element; to emphasize the breadth of such generic element alternative exemplifications of such element maybe provided beyond any shown in the Detailed Description of the Invention.

“(c) a patentable element or patentable combination of elements under sections 102 and 103 of this title, where such patentable element or patentable combination is identified as an “inventive concept” shall negate any otherwise case law exclusion from patent-eligibility under section 101 of the statute.

(d) in the case of a an element which is a generic composition of matter, a recitation of a specific utility for such generic composition shall satisfy the requirement that such invention is useful under section 101 of the statute.

(e) an express disclaimer of the applicant’s right under any patent against a third party that “experiments on” a patented invention.

³ The rule, *here*, is entirely new in content. The appendix includes the proposed rule with changes from the current rule, together with an explanation for each of the five subsections.

37 CFR § 1.75 Claim(s).

* * *

(b) More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied. **Where more than twenty claims are presented in an application and there is apparent duplication amongst two or more claims, the Examiner may require the applicant to explain why all claims are necessary and require provisional election of no more than twenty claims for further prosecution.**

* * *

(d)(1) The claim or claims must conform to the invention as set forth in the **Summary of the Invention** [*remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a))*].

* * *

(e) **reserved** [*Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order:*

(1) *A preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known,*

(2) *A phrase such as “wherein the improvement comprises,” and*

(3) *Those elements, steps, and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.]*

* * *

37 CFR § 1.77 Arrangement of application elements.

(a) The elements of the application, if applicable, should appear in the following order:

* * *

(7) Background of the invention, **if present**.

* * *

37 CFR § 1.97 Filing of information disclosure statement.

Unless the applicant files a *Background of the Invention* under § 1.99, the applicant shall file an Information Disclosure Statement under this section and § 1.98:

(a) In order for an applicant for a patent or for a reissue of a patent to have an information disclosure statement in compliance with § 1.98 considered by the Office during the pendency of the application, the information disclosure statement must satisfy one of paragraphs (b), (c), or (d) of this section.

(b) An information disclosure statement shall be considered by the Office if filed by the applicant within any one of the following time periods:

(1) Within **fifteen** [*three*] months of the **later of the** filing date of a national application **or claimed priority date of such national application** other than a continued prosecution application under § 1.53(d) ;

* * *

(b) An information disclosure statement shall be considered by the Office if filed by the applicant within any one of the following time periods:

(1) Within **fifteen** [*three*] months of the **later of the** filing date of a national application **or claimed priority date of such national application** other than a continued prosecution application under § 1.53(d) ;

* * *

37 CFR § 1.99. Background of the Invention⁴

(a) An applicant may file a section captioned *Background of the Invention* as part of the patent application which shall consist of a list identifying the most pertinent prior art known to the applicant; a copy of each cited reference shall accompany the citation.

(b) The *Background of the Invention* may be filed either as part of the original application or by amendment at any time up to fourteen months from the earliest claimed priority date, accompanied by a copy of each cited reference.

(c) If the *Background of the Invention* contains more than five prior art citations, the applicant shall certify the reason that more than five prior art references are needed when the applicant shall only cite the most pertinent prior art.

(d) A *Background of the Invention* meeting the requirements of this section shall be considered to meet the duty of disclosure under 37 CFR §§ 1.97, 1.98.

⁴ There is neither a statutory nor rules basis for a *Background of the Invention*. Instead the requirement for a *Background of the Invention* is found in MPEP § 608.01(c), *Background of the Invention*:

“The Background of the Invention may include the following parts:

“(1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions. The statement should be directed to the subject matter of the claimed invention.

“(2) Description of the related art including information disclosed under 37 C.F.R. 1.97 and 37 C.F.R. 1.98: A paragraph(s) describing to the extent practical the state of the prior art or other information disclosed known to the applicant, including references to specific prior art or other information where appropriate. Where applicable, the problems involved in the prior art or other information disclosed which are solved by the applicant’s invention should be indicated. See also MPEP § 608.01(a), § 608.01(p) and § 707.05(b).”

APPENDIX: REFORMULATED RULE 73

I. INTRODUCTION

This paper proposes the streamlining of American patent filing procedures, spurred by the need to be “first to file” under the *Leahy Smith American Invents Act* of 2011. Americans up to the present time have been disadvantaged by having more complex and arcane filing requirements than overseas applicants in their home countries. Under “first to file” it is imperative that red tape and formalities be cut for the original American application to put the American applicant on a par with overseas applicants in the race to the *first* (home) “courthouse.”

While there are a variety of rules and practices that should be changed, for the purpose of the present paper, the focus is on just one rule, Rule 73, 37 CFR § 1.73, which is proposed to be reformulated to take into account contemporary issues that face applicants today. Proposed new Rule 73 is split into four units, each representing an area where an improved practice is necessary. First, the proposed rule is stated. The changes from the current Rule 73 are shown next.

II. UPDATED RULES: A FIRST TO FILE IMPERATIVE

The creation of the first-to-file system in the United States has created a global competition amongst inventors to win the race to the “home” Patent Office. While in theory an inventor can file first in any Paris Convention country, as a practical matter of language and convenience, the first filing in 99+ percent of all cases is in the inventor’s home country.

This means that if the Japanese patent law facilitates early filing due to simpler filing requirements than under American patent law, and if the added formalities and requirements of American patent law mean that an American first filing is slowed down by two weeks or so vis a vis the speedier first filing in Japan, then if American and a Japanese inventors are contemporaneous working on the same subject matter, the Japanese inventor even if second to invent will be first to file in his home country even if the American inventor is two weeks senior in terms of when he made his invention.

Thus, it is imperative that the United States modify its filing practices to facilitate the earliest filing dates for the American inventor in his home patent office. (Of course, the Japanese or other overseas patent applicant will also have to meet American formal requirements when entering the United States, but that applicant will have one year to meet such requirements, given that he has the security of his Japanese priority date.)

Rule 73 is entirely redrafted under the current proposal:

Proposed 37 CFR § 1.73, *Summary of the Invention.*

“A brief summary of the invention may include the following features:

“(a) A specific definition of an element of the claimed invention may be provided in which case that specific definition shall trump any otherwise broader reasonable interpretation of that element.

“(b) A generic element in a claim shall be given an interpretation to cover the full scope of the meaning of that generic element; to emphasize the breadth of such generic element alternative exemplifications of such element maybe provided beyond any shown in the Detailed Description of the Invention.

“(c) a patentable element or patentable combination of elements under sections 102 and 103 of this title, where such patentable element or patentable combination is identified as an “inventive concept” shall negate any otherwise case law exclusion from patent-eligibility under section 101 of the statute.

(d) in the case of a an element which is a generic composition of matter, a recitation of a specific utility for such generic composition shall satisfy the requirement that such invention is useful under section 101 of the statute.

(e) an express disclaimer of the applicant’s right under any patent against a third party that “experiments on” a patented invention.

The rule is repeated, here, showing the new language in **bold underlined** and the old text in *italics*:

“A brief summary of the invention **may involve the following features** [*indicating its nature and substance, which may include a statement of the object of the invention, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.*:]

“(a) A specific definition of an element of the claimed invention may be provided in which case that specific definition shall trump any otherwise broader reasonable interpretation of that element.

“(b) A generic element in a claim shall be given an interpretation to cover the full scope of the meaning of that generic element; to emphasize the breadth of such generic element alternative exemplifications of such element maybe provided beyond any shown in the Detailed Description of the Invention.

“(c) a patentable element or patentable combination of elements under sections 102 and 103 of this title, where such patentable element or patentable combination is identified as an “inventive concept” shall negate any otherwise case law exclusion from patent-eligibility under section 101 of the statute.

(d) in the case of a an element which is a generic composition of matter, a recitation of a specific utility for such generic composition shall satisfy the requirement that such invention is useful under section 101 of the statute.

(e) an express disclaimer of the applicant’s right under any patent against a third party that “experiments on” a patented invention.

III. NEW RULE 73(a): TRUMPING *CUOZZO SPEED*

“A brief summary of the invention may involve the following features:

“(a) A specific definition of an element of the claimed invention may be provided in which case that specific definition shall trump any otherwise broader reasonable interpretation of that element.”

Under *Cuozzo Speed Technologies, LLC v. Lee*, 136 S.Ct. 2131 (2016), the claimed invention for purposes of validity is given its “broadest reasonable interpretation”. There may be, say, five elements in a claim, one of which is close to the prior art where the patentee would like to cabin the interpretation of that element to its literal wording or otherwise limit its scope. *Here*, the applicant is encouraged to *define* the element in a way to cabin a broader interpretation that would read on subject matter unpatentable over the prior art.

IV. NEW RULE 73(b): GENERIC COVERAGE FOR AN ELEMENT

“A brief summary of the invention may involve the following features:

* * *

“(b) A generic element in a claim shall be given an interpretation to cover the full scope of the meaning of that generic element; to emphasize the breadth of such generic element alternative exemplifications of such element maybe provided beyond any shown in the Detailed Description of the Invention.”

Where an applicant has multiple examples of a claimed invention but a particular element is identical in each example, here, recitation in the *Summary of the Invention* may include alternate embodiments to exemplify the element and lead to a broader interpretation of that element beyond the exemplified element.

V. NEW RULE 73(c) “INVENTIVE CONCEPT”

“A brief summary of the invention may involve the following features:

* * *

“(c) a patentable element or patentable combination of elements under sections 102 and 103 of this title, where such patentable element or patentable combination is identified as an “inventive concept” shall negate any otherwise case law exclusion from patent-eligibility under section 101 of the statute.”

Recent Supreme Court case law has excluded from patent-eligibility inventions within the literal wording of Section 101 (e.g., “process”) but which are nevertheless excluded on the basis of case law exceptions to patent-eligibility, namely, “laws of nature, natural phenomena, and abstract ideas.”. However, such recent case law has said that if there is an “inventive concept” as to the claimed subject matter, then the claimed invention is patent-eligible despite the case law exceptions.

Supreme Court case law has been difficult to understand in this area as at least on case has found that the invention with all its claim elements *is* patent-eligible, *Diamond v. Diehr*, 450 U.S. 175 (1981), while more recent cases have dissected claims into their constituent elements to reach a conclusion that the claimed invention lacks an “inventive concept”.

Under the proposed rule, an applicant can *identify* a combination or subcombination of elements within the generic claim as the “inventive concept”.

An “inventive concept” to distinguish the claimed invention from the prior art may take several forms. Most common is the absence of a *motivation* to combine several prior art references, as explained by Circuit Judge Linn in *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006):

“A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as

“the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references.... The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.’

“*In re Kotzab*, 217 F.3d 1365, 1370 (Fed.Cir.2000) (internal citations omitted). However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *See [In re Lee*, 277 F.3d 1338, 1343–46 (Fed.Cir.2002)]; [*In re Rouffet*, 149 F.3d 1350, 1355-59 (Fed.Cir.1998)]. This requirement is as much rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decisionmaking, as it is in § 103. *See id.* at 1344–45.

“In considering motivation in the obviousness analysis, the problem examined is not the specific problem solved by the invention but the general problem that confronted the inventor before the invention was made. *See, e.g., Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1323 (Fed.Cir.2005) (‘One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings.’); *Ecolochem, Inc. v. S. Cal. Edison Co.*, 227 F.3d 1361, 1372 (Fed.Cir.2000)

(‘Although the suggestion to combine references may flow from the nature of the problem, ‘[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness.’ ‘ (internal citation omitted) (quoting *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881 (Fed.Cir.1998)); *In re Beattie*, 974 F.2d 1309, 1312 (Fed.Cir.1992) (‘[T]he law does not require that the references be combined for the reasons contemplated by the inventor.’); *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed.Cir.2005) (characterizing the relevant inquiry as ‘[would] an artisan of ordinary skill in the art at the time of the invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, [] have selected the various elements from the prior art and combined them in the manner claimed’); see also *Graham*[v. *John Deere & Co.*, 383 U.S. 1, 35 (1966)] (characterizing the problem as involving mechanical closures rather than in terms more specific to the patent in the context of determining the pertinent prior art). Therefore, the ‘motivation-suggestion-teaching’ test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims. See *Cross Med. Prods.*, 424 F.3d at 1321–24. From this it may be determined whether the overall disclosures, teachings, and suggestions of the prior art, and the level of skill in the art—*i.e.*, the understandings and knowledge of persons having ordinary skill in the art at the time of the invention—support the legal conclusion of obviousness. See *Princeton Biochemicals*, 411 F.3d at 1338 (pointing to evidence supplying detailed analysis of the prior art and the reasons one of ordinary skill would have possessed the knowledge and motivation to combine).”⁵

⁵ *Kahn*, 441 F.3d at 987-88.

VI. NEW RULE 73(d): GENERIC UTILITY

“A brief summary of the invention may involve the following features:

* * *

(d) in the case of a an element which is a generic composition of matter, a recitation of a specific utility for such generic composition shall satisfy the requirement that such invention is useful under section 101 of the statute.”

The proposed rule is to encourage the practice in the case of an invention to a generic family of new chemical compounds that the applicant recite a *specific* utility shared by all members of the family, absent which it is possible that the generic claim could be denied on the basis that not all of the claimed compounds are stated to possess a statutory utility

VII. NEW RULE 73(e): RIGHT TO EXPERIMENTAL USE

“A brief summary of the invention may include the following features:

* * *

(e) an express disclaimer of the applicant’s right under any patent against a third party that “experiments on” a patented invention.”

A. A Split within the Judiciary

“[T]he making of a patented machine to be an [act of infringement] must be the making with an intent to use for profit, and not for the mere purpose of philosophical experiment, or to ascertain the verity and exactness of the specification.”

Hon. Joseph Story⁶

“[T]oo much patent protection can impede rather than ‘promote the Progress of Science and useful Arts.’ ”

Hon. Stephen Breyer⁷

“‘Philosophical’ or verification experiments *** do not constitute infringement; patents are awarded to facilitate the inventor's downstream commercialization of the invention, whereas the public's upstream research activities are believed not to interfere with that end-use.”

Andrew S. Baluch⁸

⁶ *Sawin v. Guild*, 21 F.Cas. 554 (C.C.D. Mass. 1818) (No. 12,391) (Story, J.)(citing *Whittemore v. Cutter*, 29 F. Cas. 1120 (C.C.D.Mass.1813) (No. 17,600)(Story, J.)); *see also See also Byam v. Bullard*, 4 F.Cas. 934 (C.C.D. Mass. 1852) (No. 2,262) (Curtis, J.)(“Mr. Justice Story, in *Whittemore v. Cutter* [Case No. 17,600], [] held that making a machine for a philosophical experiment, or to test the sufficiency of the specification, would not be an infringement; and in *Sawin v. Guild* [Id. 12,391], where he says the act must be with intent to deprive the patentees of some lawful profit; and also by Mr. Justice Patteson, in *Jones v. Pearce*, Webst. Pat. Cas. 125, where he excepts the making of a patented article for mere amusement, and not for profit. In these cases, inasmuch as there was supposed to be no damage, there was thought to be no action. * * * [N]o sale was [an infringement] except one which would be within the terms of the grant contained in the letters-patent, which is a grant of an exclusive right to make, use, and vend to others to be used.”); *Oxley v. Holden*, 141 E.R. 1327, 1340 (Common Bench 1860)(“In *Jones v. Pearce*, 1 Webster's P.C. 121, the defendant had made a pair of wheels upon the principle of the plaintiff's patent: and in answer to a question from the jury, Patteson, J., said: “If he did actually make these wheels, his making them would be a sufficient infringement of the patent, *unless he merely made them for his own amusement, or as a model.*”) (emphasis added; footnote deleted).

⁷ *Lab. Corp. of Am. Holdings v. Metabolite Labs., Inc.*, 548 U.S. 124, 126 (2006) (Breyer, J., dissenting from dismissal of writ as improvidently granted).

⁸ Andrew S. Baluch, *Relating the Two Experimental Uses in Patent Law: Inventor's Negation and Infringer's Defense*, 87 B.U. L. Rev. 213, 232 (2007). A footnote at the end of this passage states that “[t]his is not the case with ‘research tools’ (such as a microscope) whose end-use is intended to facilitate experimentation on something else. *See Integra [Lifesciences I, Ltd. v.*

There is a fundamental misunderstanding of the historic right to *experiment on* a patented invention which surely Promotes the Progress of the Useful Arts, e.g., the right to tinker with a patented microscope to see how that microscope operates and thus lead to improvements in that microscope. (This is distinguished from an infringing *experiment with* a patented invention, e.g., where a patented microscope is used to study a specimen with no thought to how the microscope operates or otherwise study the microscope itself.⁹)

B. Compelling a Federal Circuit *En Banc* Review

The proposed rule is designed to compel the Federal Circuit to take a case *en banc* to resolve the historical split between Joseph Story versus Stephen Breyer. If the Federal Circuit follows the law as set forth by the late Joseph Story in a well reasoned opinion, there is the possibility that the Supreme Court would not grant *certiorari* to consider a holding that follows Story. If the Court were to grant *certiorari* then at least the matter would be concluded one way or the other: Without such review, we have the continued anti-patentee attitude of Justice Breyer that is no worse than a bad outcome at the Court.

Merck KGaA, 331 F.3d 860 (Fed. Cir. 2003)] (Newman, J., concurring in part and dissenting in part) ('Use of any existing tool in one's research is quite different from study of the tool itself.');

[Rebecca S. Eisenberg, *Patents and the Progress of Science: Exclusive Rights and Experimental Use*, 56 U. Chi. L. Rev. 1017, 1078 (1989)] (excluding from exemption the use of a patented invention 'with a primary or significant market among research users');

Janice M. Mueller, *No "Dilettante Affair": Rethinking the Experimental Use Exception to Patent Infringement for Biomedical Research Tools*, 76 Wash. L. Rev. 1, 54-55 (2001) (proposing a 'reach-through' royalty approach to experimental uses with research tools)."

⁹ Perhaps the best explanation of the distinction between a noninfringing "experimentation on" a patented invention and an infringing "experimentation with" a patented invention has been provided by Professor Mueller, *supra*.

Anyone having any doubt about the need to clarify the right to experiment “on” a patented invention should read the important work of Professor Karshedt.¹⁰ He explains that Justice Breyer’s article, “*The Uneasy Case*[,] demonstrates [his] grave concerns with the effect of intellectual property rights on the dissemination of information. In addition, although this work was focused on copyright, it is clear that he saw patents as even more pernicious because they protect ‘ideas,’ as opposed to merely expression”.¹¹ The missing piece in the Breyer analysis is a recognition of Justice Story’s view that patent rights can coexist with the right to experiment “on” a patented invention.

C. The Theoretical Nature of “Too Much” Patent Protection

The Breyer warning about “too much” patent protection does not translate from his copyright-based jurisprudence even disregarding the Story line of experimental use case law: First, patent based research is most generally focused on innovation creation starting from the very *specific point* of a patented invention. Second, neither is the Breyer concern over “too much” protection realistic insofar as major industry is concerned: An American based multinational can avoid U.S. patent rights altogether by conducting research in, e.g., Germany, Japan or China outside the scope of the U.S. patent – and in any event where national patent laws

¹⁰ Dmitry Karshedt, *Photocopies, Patents, and Knowledge Transfer: “The Uneasy Case” of Justice Breyer’s Patentable Subject Matter Jurisprudence*, 69 Vand. L. Rev. 1739 (2016)(discussing Stephen Breyer, *The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs*, 84 Harv. L. Rev. 281, 316-18 (1970)).

¹¹ *Id.*, 69 Vand. L. Rev. at 1751 (footnote omitted)(discussing Stephen Breyer, *The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs*, 84 Harv. L. Rev. 281 (1970)).

permit experimental use of a patented invention: The results of such research can then be imported back to the United States without patent infringement.¹²

VIII. ELIMINATION OF OUTDATED PROVISIONS

A. Rule 73 -- Proper Statutory Basis Until 65 Years Ago

“Rule 73” is a new home for dealing principally with features of a generic invention. The current content of Rule 73 has roots to principles derived from English law, which is seen from a case nearly 200 years ago when Justice Joseph Story explained that the origins of the requirement for the “nature of the invention.” *Earle v. Sawyer*, 8 F.Cas. 254, 257 (C.C.Mass. 1825) (No. 4,247) (Story, J.) (“[T]he law of patents in England * * * required [] a proviso in every grant * * * particularly to describe and ascertain the nature of the invention * * *.”).

Rule 73 until now has been directed to a disclosure of the “nature and substance” of an invention, an historic statutory requirement that has not been a part of the patent law for sixty-five (65) years. Thus, the Rule 73 requirements in the existing statute have been entirely eliminated in the proposed new rule.

As explained in *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 350 n.5 (1961), , the 1952 Patent Act provided an express statutory definition

¹² *Bayer AG v. Housey Pharmaceuticals, Inc.*, 340 F.3d 1367, 1378 (Fed. Cir. 2003)(Dyk, J.)(interpreting 35 USC § 271(g)) (“[To constitute patent infringement, t]he process [used offshore] must be used directly in the manufacture of the product, and not merely as a predicate process to identify the product to be manufactured. A drug product, the characteristics of which were studied using the claimed research processes, therefore, is not a product ‘made by’ those claimed processes.”)

of infringement as 35 U.S.C.A. § 271(a). Regarding prior law, the Court in *Aro* explained that:

“Although there was no statutory provision defining infringement prior to [the 1952 Patent Act], the definition [of infringement] adopted is consonant with the long-standing statutory prescription of the terms of the patent grant, which was contained in § 4884 of the Revised Statutes as follows:

“Every patent shall contain a short title or description of the invention or discovery, *correctly indicating its nature and design*, and a grant to the patentee * * * of the exclusive right to make, use, and vend the invention or discovery throughout the United States * * *” (Emphasis supplied [by the Court].)

This provision is now contained without substantial change in 35 U.S.C. § 154, 35 U.S.C.A. § 154.

Aro, 365 U.S. at 350 n.5 (emphasis supplied in part by the Court and by this writer). Quoting the words of the late Pasquale J. Federico, up through the eve of the effective date of the 1952 Patent Act, the statute required “a ... description of the invention ... correctly stating its nature and design.” P. J. Federico, *Commentary on the New Patent Act* [1954], reproduced at 75 J. Pat. And Trademark Off. Soc’y 161, 201-02 (1993). But, the statutory basis for the “nature” and “design” disclosure requirement ceased with the effective date of the 1952 Patent Act: “The old statute [before the 1952 Patent Act] required ‘a short title or description of the invention or discovery, correctly stating its nature and design’; this has been shortened to ‘a short title of the invention’ since the title is of no legal significance.” *Id.*

B. The *Manual* is also Outdated

The *Manual of Patent Examining Procedure*, is out of date. MPEP § 608.01(d), *Brief Summary of Invention* [R-07.2015], after quoting current 37 CFR § 1.73, states as follows:

“Since the purpose of the brief summary of invention is to apprise the public, and more especially those interested in the particular art to which the invention relates, of the nature of the invention, the summary should be directed to the specific invention being claimed, in contradistinction to mere generalities which would be equally applicable to numerous preceding patents. That is, the subject matter of the invention should be described in one or more clear, concise sentences or paragraphs.

“The brief summary, if properly written to set out the exact nature, operation, and purpose of the invention, will be of material assistance in aiding ready understanding of the patent in future searches. The brief summary should be more than a mere statement of the objects of the invention, which statement is also permissible under 37 CFR 1.73.”

IX. CONCLUSION

The Director of the Office has a responsibility to modernize the rules of the Office to better accommodate American innovation under the *Leahy Smith America Invents Act* of 2011.