This is your Release #7 (May 2020)

Patent Law
A Practitioner's Guide
Fourth Edition

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This new release for *Patent Law* updates and expands the text, discussing the following topics, among others:

Patent-eligible subject matter: The Patent Office has issued new guidance regarding patent eligibility, as reflected in Flow Chart 1-1A. The guidance provides an additional pathway to patent eligibility, using what the Patent Office calls a "streamlined analysis." But it is not yet clear whether this change will result in a significant increase in the type and number of claims held to be patent-eligible subject matter. It is too soon to determine how the Patent Trial and Appeal Board, much less the Federal Circuit, will respond to this change in specific cases. See § 1:7.1, at note 48.17.

Methods of treatment: In *Vanda Pharmaceuticals Inc. v. West-Ward Pharmaceuticals International Ltd.*, the Federal Circuit considered claims to a method of treating schizophrenia. The court found that the claims were "directed to a specific method of treatment for specific patients using a specific compound at specific doses to achieve a specific outcome. They are different from *Mayo*. They recite more than the natural relationship between CYP2D6 metabolizer genotype and the risk of QTc prolongation. Instead, they recite a method of treating patients based on this relationship that makes iloperidone safer by lowering the risk of QTc prolongation. Accordingly, the claims are patent eligible." See § 1:7.1, at note 57.1.

Statutory bars: In *Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc.*, the Supreme Court analyzed the effect of the America Invents Act on the on-sale bar of section 102 and refused to change the long-settled case law interpreting the words "on sale." "Because we determine that Congress did not alter the meaning of 'on sale' when it enacted the AIA, we hold that an inventor's sale of an invention to a third party who is obligated to keep the invention confidential can qualify as prior art

(continued on reverse)

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under § 102(a). We therefore affirm the judgment of the Federal Circuit." See § 5:3.4, at note 19.16.

Divided infringement and articles made abroad by a process claimed in U.S. patent: In a case of first impression, the Federal Circuit, in S*yngenta Crop Protection, LLC v. Willowood, LLC*, considered the elements of infringement under 35 U.S.C. § 271(g), which prohibits unauthorized importation of a product made in accordance with the method claims of a U.S. patent. Specifically, does such infringement require that all steps in a claim be performed abroad by, or at the direction or control of, a single entity? The court's answer was negative: "Nothing in this statutory language suggests that liability arises from *practicing* the patented process abroad. Rather, the focus is only on acts with respect to *products* resulting from the patented process. Thus, because the statutory language as a whole is clear that practicing a patented process abroad cannot create liability under § 271(g), whether that process is practiced by a single entity is immaterial to the infringement analysis under that section." See new § 9:9.

Opinion letter: The release includes a revised version of the sample opinion letter that might be sent to a client or other person requesting a written opinion with respect to validity and infringement. See § 14:5.

In addition, **Appendix B** (the statute), **Appendix C** (PTO rules of practice), the **Table of Authorities**, and the **Index** have been updated.

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FILING INSTRUCTIONS

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