

M

Protective Intellectual Property Services, LLC

106 Woodstone Drive
Buffalo Grove, IL 60089-6754
Phone: 224-406-4268
E-Mail: Lanny@protectiveIPservices.com
URL: www.protectiveIPservices.com

CREATING YOUR SUSTAINED COMPETITIVE ADVANTAGE BY STRATEGIC INTELLECTUAL PROPERTY MANAGEMENTSM

May 2007

Clients and Friends,

This newsletter contains current news about US patents and the US Patent and Trademark Office, current intellectual property (IP) court cases, domestic and international IP news and IP information of general interest to management of technology companies, inventors, entrepreneurs and attorneys.

Because of the potential impact of the Supreme Court's KSR International Co. vs. Teleflex, Inc. decision on the patent office's application of the obviousness criteria [35 C.F.R. § 103], I have attached at the end of the newsletter a two-page USPTO memo that states the patent office's preliminary implementation of the decision. The complete Supreme Court decision is available from PIPS upon request.

PIPS provides strategic intellectual property services; pre-legal intellectual property protection assistance and negotiation services; and in-licensing of needed technologies and out-licensing of excess technologies. Please visit [our web site](#) for more information about PIPS, its services and capabilities.

Please contact PIPS to discuss your situation in a free 45 minute consultation.

We appreciate your feedback at suggestions@protectiveIPservices.com.

USPTO

Government Nixes Stem Cell Patents

New York Law Journal - New York, NY, USA
In a decision that could widen the field for embryonic stem cell research in the US, the government's patent office has overturned 10-year-old patents held ...

US Patent Office Invalidates Three WARF Patents On Human Embryonic ...

Medical News Today (press release) - UK
The US Patent and Trademark Office on Monday released on its Web site a preliminary

ruling that invalidates three "broad" patents on human embryonic stem ...

USPTO Releases New Five-Year Strategic Plan

<http://www.uspto.gov/web/offices/com/strat2007/>
Plan builds on record breaking progress in 2006

Under Secretary Dudas speaks at the Global Forum Intellectual Property Protection and Innovation in Beijing, China

<http://www.uspto.gov/web/menu/testspeech.html>

If you no longer want to receive communication from PIPS, please send an e-mail to info@protectiveIPservices.com with "Remove" in the subject line.

Protective Intellectual Property Services, LLC

S
U
S
T
A
I
N
E
D

C
O
M
P
E
T
I
T
I
V
E

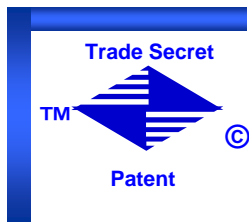
A
D
V
A
N
T
A
G
E

S
T
R
A
T
E
G
I
C

I
N
T
E
L
L
E
C
T
U
A
L

P
R
O
P
E
R
T
Y

M
A
N
A
G
E
M
E
N
T



Protective Intellectual Property Services, LLC

CREATING YOUR SUSTAINED COMPETITIVE ADVANTAGE BY STRATEGIC
INTELLECTUAL PROPERTY MANAGEMENT SM

Dudas spoke of the importance of intellectual property to the global economy and global IP trends, opportunities, and challenges.

[Congress Introduces Patent Reform Act of 2007](#)

Circuits Assembly - Atlanta,GA,USA
WASHINGTON – Congress this week introduced into legislation The Patent Reform Act of 2007, a bill aimed at helping the filing process and to ease the ...

[COURTS](#)

[Bank of America Sued for Patent Infringement](#)

New York Law Journal - New York,NY,USA
A Florida company has filed a lawsuit against Bank of America Corp., saying the bank's "Keep the Change" savings program infringes on a patent. ...

[Rulings Weaken Patents' Power](#) [High Court Decides On Two Key Cases](#)

Washington Post Staff Writers Robert Barnes and Alan Sipress
The Supreme Court concluded a series of cases yesterday that weaken the protection given to patent holders, making it more difficult to get a patent and easier to challenge existing ones.

[Patent licensing: For enforcing companies, the rules have changed](#)

WTN News - Madison,WI,USA
Many patent owners enforce their patent rights against potential infringers by licensing the patent rather than going to court to stop the infringing ...

[DOMESTIC](#)

[Researchers Applaud Federal Rejection of Stem Cell Patent Claims](#)

KPBS - San Diego,CA,USA
Researchers in California are hailing a decision by federal regulators that rejected key patent claims on human embryonic stem cells. ...

[Stem cell patent dispute: Wisc. fights back](#)

Scientist - UK
In the fallout from a major decision by the US patent agency to reject key stem cell patents for

embryonic stem cell research held by the Wisconsin Alumni ...

[Vonage win reprieve in patent case](#)

Pocket-lint.co.uk - UK
Following a patent dispute with Verizon in America, Vonage has managed to stave off closure even though a judge in a lower court had said the company could ...

[Apple patent points to iPhone as remote](#)

MacNN - Santa Clara,CA,USA
Apple has filed for a patent titled "Techniques for pairing remote controllers with host devices" that mentions using a "mobile phone" to serve as a remote ...

[Google Tips Its Hand On Voice Search With Speech Interface Patent](#)

InformationWeek - Manhasset,NY,USA
A Google watcher says a patent on a voice interface for a search engine is a roadmap to the company's future in voice search applications. ...

[Integrated IP management technologies: the means to more ends](#)

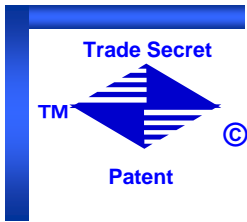
Innovation Asset Group
"Arizona Technology Enterprises (AzTE), a technology transfer organization, understands that research organizations must emulate successful enterprises to capitalize on the commercial value of technology that universities and research labs are creating.

[Sears bolsters it's balance sheet with IP...\\$1.8 Billion worth!](#)

Innovation Asset Group "Sears is on the cutting edge of a financial innovation so important that it could unlock trillions of dollars in capital across Corporate America and change the way managers of a wide range of businesses think about their balance sheets. "

[IP Value in the Life Sciences Industry](#)

Innovation Asset Group
The life sciences industries provide some of the best examples of the risk/reward continuum inherent in the creation and commercialization of ideas. See the recent IAM article highlighting the necessity of a strong IP asset management program. More whitepapers available for download [here](#).



Protective Intellectual Property Services, LLC

CREATING YOUR SUSTAINED COMPETITIVE ADVANTAGE BY STRATEGIC
INTELLECTUAL PROPERTY MANAGEMENT SM

[Embryonic stem cell pioneer chose to publish, not patent](#)

San Diego Union Tribune - San Diego, CA, USA
On April 2, the US Patent and Trademark Office issued a ruling that may invalidate the Wisconsin patents. Bongso's work was identified as proof that what ...

[Antitrust Enforcement and Intellectual Property Rights: FTC/DOJ ...](#)

Patently-O - Chicago, IL, USA
The FTC and DOJ have jointly issued a monumental report on the relationship between patent rights and antitrust policy. Gems from the report: ...

[Avoiding Costs of Intellectual Property Litigation: Think "Mediation"](#)

Inside Indiana Business (press release) - Indianapolis, IN, USA
Protection of intellectual property is becoming more of a priority for American businesses. In 2006, over 440,000 patent applications were filed with the ...

[Dems, Republicans Unite on Patent Reform](#)

InternetNews.com - USA
The Patent Reform Act of 2007 would make it more difficult to prove that a patent was willfully infringed, which would reduce the possibility of treble ...

[House Panel Urges Patent Bill Compromise](#)

New York Law Journal - New York, NY, USA
Lawmakers are urging the pharmaceutical and high-technology industries to forge a compromise on a proposed patent reform bill. ...

[Patent Reform Questioned](#)

PC World - USA
Patent reform legislation introduced last week would create uncertainty about the validity of many US patents, critics said Thursday. ...

[2007 Patent Reform: Proposed Amendments on Damages](#)

Patently-O - Chicago, IL, USA
The proposed 2007 Patent Reform Act (the "Leahy-Berman bill") details modifications to 35 USC § 284 that will most certainly reduce many patent ...

[INTERNATIONAL](#)

[Law Firms Rush to Hire ITians](#)

Economic Times - India
With the shortage of required talent being a major hurdle for niche outsourced works like patent drafting, the law firms are even rushing to India ...

[EU-Wide Patent Scheme Back on Agenda](#)

BusinessWeek - USA
The European Commission has kicked off a fresh round of talks on an EU-wide patent system, trying to break a 20-year deadlock which harms the 27-nation ...

[Another sign Chinese IP practices are maturing](#)

Innovation Asset Group
"Sohu.com Tuesday threatened to sue Google for violating its intellectual property rights, and renewed a demand for the company to stop downloads of a Chinese software tool based, in part, on one of its own databases."

[Trade Analyst Raises Concerns Ahead of EU- US Summit](#)

Crosswalk.com - Chesterfield, VA, USA
"Private US intellectual property rights are under international assault by foreign governments that are intent upon securing transfer of US scientific and ...

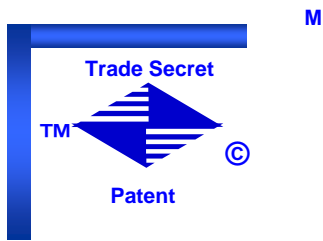
[EU debates criminal sanctions for intellectual property violations](#)

ComputerworldUK - UK
The European Parliament is to vote on a proposed law criminalising intellectual property infringements later today, after a fierce debate on its scope. ...

[Businesses risk missing income due to intellectual property rights ...](#)

PublicTechnology.net - UK
Small businesses risk missing out on valuable income from new technology or ideas because they're not certain about their intellectual property rights, ...

[UK Intellectual Property Office offers IP guide for China.](#)



Protective Intellectual Property Services, LLC

CREATING YOUR SUSTAINED COMPETITIVE ADVANTAGE BY STRATEGIC
INTELLECTUAL PROPERTY MANAGEMENT SM

ThomasNet Industrial News Room (press release) - New York, NY, USA
The new UK Intellectual Property Office (UK-IPO) guide 'China, an Enforcement Roadmap', offers guidance to the Chinese Intellectual Property protection and ...

OTHER

[TAEUS Offers Free Patent Analysis Reports for the Ocean Tomo ...](#)

PR-Inside.com (Pressemitteilung) - Wien, Austria
The TIPSheet is a single report that contains the TIPScores (TAEUS Intellectual Property Scores) for the patents reviewed in the auction. ...

[Ignorance over patent reforms could make your nano tech fortune a flash in the pan](#)

www.smalltimes.com

typical nanotechnology pioneers will need to pay close attention to cultivate their intellectual properties in view of these changes. Otherwise, the impact will hardly be nano.



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

MEMORANDUM

DATE: May 3, 2007

TO: Technology Center Directors

FROM: *Margaret A. Focarino*
Margaret A. Focarino
Deputy Commissioner
for Patent Operations

SUBJECT: Supreme Court decision on *KSR Int'l. Co., v. Teleflex, Inc.*

The Supreme Court has issued its opinion in *KSR*, regarding the issue of obviousness under 35 U.S.C. § 103(a) when the claim recites a combination of elements of the prior art. *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007). A copy of the decision is available at <http://www.supremecourtus.gov/opinions/06pdf/04-1350.pdf>. The Office is studying the opinion and will issue guidance to the patent examining corps in view of the *KSR* decision in the near future. Until the guidance is issued, the following points should be noted:

- (1) The Court reaffirmed the *Graham* factors in the determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under *Graham* are:
 - (a) determining the scope and contents of the prior art;
 - (b) ascertaining the differences between the prior art and the claims in issue;
 - (c) resolving the level of ordinary skill in the pertinent art; and
 - (d) evaluating evidence of secondary consideration.

Graham v. John Deere, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

- (2) The Court did not totally reject the use of “teaching, suggestion, or motivation” as a factor in the obviousness analysis. Rather, the Court recognized that a showing of “teaching, suggestion, or motivation” to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

- (3) The Court rejected a rigid application of the “teaching, suggestion, or motivation” (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject matter to be obvious.

(4) The Court noted that the analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit, and that it was “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. The Court specifically stated:

Often, it will be necessary . . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit**.

KSR, slip op. at 14 (emphasis added).

Therefore, in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.