VENABLE LLP

IP news & comment

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Wyeth v. Kappos: The USPTO may be Shortchanging the Term of Your Patent

In *Wyeth v. Kappos*, the Federal Circuit ruled that the U.S. Patent and Trademark Office was miscalculating the term of certain patents entitled to term extension known as "Patent Term Adjustment." The U.S. Patent and Trademark Office had been affording patent applicants additional term corresponding to the *greater of* two types of delays during examination, known as "A" delays and "B" delays. However, the Federal Circuit ruled that applicants are entitled to *both* the "A" delays and "B" delays.

Recent Federal Circuit Decisions Help Patent Owners Defend Against Validity Challenges

The U.S. Supreme Court roiled patent owners when it decided *KSR International Co. v. Teleflex Inc.* in May 2007. The decision resulted in greater scrutiny of patent claims, a lower allowance rate for U.S. patent applications, and a greater number of court decisions invalidating patents. Recent decisions of the Federal Circuit have reigned in *KSR's* impact in the courts, especially for patents in unpredictable fields of invention.

Venable Continues to Outpace Average Patent Allowance Rate

The recent *KSR* and *Bilski* decisions, discussed in previous editions of this newsletter, present new challenges for patent applicants. In the wake of these decisions, the allowance rate for patent applications at the U. S. Patent and Trademark office has reached its lowest level in years. Venable's patent team employs strategies that address these changes in case law and continue to achieve an above-average allowance rate.

Patentable Subject Matter—Software Included?

Although Chief Justice Warren E. Burger wrote that patentable subject matter includes “anything under the sun that is made by man," as technology advances, the definition of patentable subject matter is always revisited (*Diamond v. Chakrabarty*, 447 U.S. 303 (1980)). The patent statute defines a patentable invention as "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement " (35 U.S.C. §101). Recently, the Board of Patent Appeals and Interferences added its own two cents with regard to a machine or article of manufacture.

Maximizing Protection for Software Innovations

Software innovators can better protect their intellectual property by drafting patent claims with an eye toward how those claims may actually be interpreted in litigation. Many inventors view the issuance of a patent by the U.S. Patent and Trademark Office as an assurance of intellectual property protection. Yet, the courts are often unforgiving toward poorly drafted patent claims.

"New Media" Provisions of Revised FTC Endorsement and Testimonial Guides

The Federal Trade Commission recently announced that it has approved final revisions to its Guides Concerning the Use of Endorsements and Testimonials in Advertising (16 C.F.R. Part 255), which address endorsements and testimonials by consumers, experts, organizations, and celebrities in advertising.

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