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PATENT AND TRADEMARK OFFICE**

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**January 2018 update to the MPEP**

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# January 2018 update to the MPEP

- Substantive revision to Chapters 200, 700-1000, 1200, 1400, 1500, 1800, 2000-2300, 2500 and 2700.
- A 52 page summary of changes accompanied the update.
- Topics include: 1) Subject Matter Eligibility (DC Bahr will discuss), 2) Markush practice, 3) Applying prior art under pre-AIA 102(e), 4) Double Patenting and 5) Written Description (exemplary cases).

# Markush Practice

- Update provides guidance on Markush practice in line with *Supplementary Examination Guidelines for Determining Compliance with 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications*, 76 Fed. Reg. 7162 (Feb. 9, 2011).
- New section 2117 includes an overview of what a Markush claim is.
- New section 706.03(y) addresses the rejection of improper "Markush" claims. A Markush claim contains an "improper Markush grouping" if
  - (1) the members do not share a "single structural similarity" or (2) the members do not share a common use.
  - The term "single structural similarity" means that the members of the Markush grouping belong to the same recognized physical or chemical class or to the same art-recognized class.

# Markush Practice

- Section 803.02 provides revised guidance on making a provisional election of species. Examiners are instructed not to include a rejection for improper Markush grouping with a written election of species requirement.
- Sections 2111.03 and 2173.05(h) provides guidance on determining whether a claim that includes a Markush grouping is definite under U.S.C. 112(b).

# Applying prior art under pre-AIA 35 U.S.C. 102(e)

- A new requirement to apply a US patent as prior art under pre-AIA 35 U.S.C. 102(e) as of the filing date of a US provisional application for which benefit is claimed was added to MPEP 706.02(f) and 2136.03 in the January publication of the MPEP.
  - In order to apply the US patent reference as of the provisional application's filing date, at least one claim in the US patent must be supported by the written description of the prior provisional application.
  - There is no requirement that the supported claim be the same disclosure or related to the subject matter relied upon in making the rejection.
  - This requirement is based upon a 2015 decision by the U.S. Court of Appeals for the Federal Circuit (Federal Circuit) in *Dynamic Drinkware, LLC, v. National Graphics, Inc.*, 800 F.3d 1375 (Fed. Cir. 2015) (*Dynamic Drinkware*).
- The requirements that the subject matter relied upon in making the rejection be described in the patent and provisional application, that benefit of the provisional application be timely claimed, and that at least one inventor be in common between the patent and provisional application continue to exist.
- No change in applying a reference under current 35 U.S.C. 102(a)(2).

# Applying prior art under pre-AIA 35 U.S.C. 102(e)

- The courts recently expanded the holding of *Dynamic Drinkware* to the application of US published applications and international applications published by WIPO (deemed US published applications) that claim the benefit of provisional applications as prior art under pre-AIA 35 U.S.C. 102(e).
- The court decisions making this expansion were published after the August 2017 revision date of the January publication of the MPEP, but the memo of April 5, 2018 provides guidance on this expansion.
- The new requirement continues to only apply to prior art under pre-AIA 35 U.S.C. 102(e).

# Double patenting

- MPEP 1214.06 and 804, subsection I.B.1.b)(iv) were revised to provide instruction where a provisional NSDP rejection is appealed to the PTAB, but it is not reached in the Board's decision. If the rejection is still provisional when the application is again before the examiner, the provisional rejection should be withdrawn where it is the only remaining rejection of record of a claim.
  - Where the reference has matured into a patent and the claims still conflict with the appealed application, a double patenting rejection (non-provisional) should be made.
  - If a rejection of record was affirmed as to each claim subject to the provisional NSDP rejection that wasn't reached, then the failure to reach the NSDP rejection does not preserve the claims for further examination.

# Written Description (exemplary cases)

- 2163 added discussion of *Cubist Pharm., Inc. v. Hospira, Inc.*, 805 F.3d 1112, 1118, 117 USPQ2d1054, 1059 (Fed. Cir. 2015) (The fact that the inventors were mistaken as to one aspect of the structure of daptomycin at the time the application [ ] was filed does not render the specification inadequate to satisfy the written description requirement. It was enough that the specification disclosed relevant identifying characteristics that distinguished daptomycin from other compounds and thus showed that the inventors had possession of daptomycin, even though they may not have had an accurate picture of the entire chemical structure of that compound.)

## Written Description (exemplary cases)

- 2163 added discussion of *Yeda Research and Dev. Co. v. Abbott GMBH & Co.*, 837 F.3d 1341, 120 USPQ2d 1299 (Fed. Cir.2016) (Under the doctrine of inherent disclosure, when a specification describes an invention that has certain undisclosed yet inherent properties, that specification serves as adequate written description to support a subsequent patent application that explicitly recites the invention's inherent properties.)

# Questions and Comments

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