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IP Strategies

Summary of the America Invents Act

On September 16, 2011, the Leahy-Smith America Invents Act (AIA), also called the Patent Reform Act of 2011, was enacted into law. President Obama stated that this "long overdue reform is vital to our ongoing efforts to modernize America's patent laws." The changes mostly harmonize US patent law with the rest of the world.

A major change is the shift from a first-to-invent system to a first-to-file system. The first-to-file system, which goes into effect on March 16, 2013, reveals a few twists relevant to patent protection in the United States. First, the inventor who files a later application is permitted to contest inventorship on a previously filed application only if it is shown that the subject matter disclosed in the previous application was derived from the inventor who files the later application. This occurs through a derivation proceeding, which replaces interference proceedings. Second, inventors still have a one-year grace period during which the inventor's own disclosures or disclosures of others who derived their invention from the inventor may not be used as prior art if they occurred within 12 months prior to the effective filing date of the invention.

Foreign public use and offers for sale are considered prior art under the AIA, whereas previously, use and sale of the invention by third parties abroad were not bars to patent protection in the United States. Though the one-year grace period still allows an inventor to avoid the prior-art effects of his or her own foreign use or sale of the invention within that time period, any of his or her foreign use or sale prior to one year before the effective filing date of the application will bar the inventor from obtaining a patent in the United States.

Previously, a defense to infringement based on prior commercial use was limited to business method patents, but under the AIA, it has been expanded to all inventions. If an inventor owns the invention as a trade secret and subsequently a patent application is filed on the same invention by another entity and issues as a patent, then the trade secret owner is provided with the "prior user defense" against a patent infringement claim.

For successful use of a prior user defense, it must be demonstrated that there was internal commercial use or sale of the subject matter by the trade secret owner, in good faith, at least one year prior to the effective filing date of the claimed invention. The person asserting a prior user defense under this section must establish the defense under the "clear and convincing" evidentiary standard for proving invalidity.

Ex Parte Reexamination procedures remain mainly unchanged. *Inter Partes* Reexamination proceedings will, however, be replaced by a new type of proceeding called "*Inter Partes* Review," which will become available on September 16, 2012. *Inter Partes* Reexamination requests may still be filed in the interim, but the request must now establish that there is a reasonable likelihood that the requester would prevail with respect to at least one claim of the patent being challenged in contrast to the previous standard that required only that a Substantial New Question be established. The new "likelihood of success" standard already applies to the *Inter Partes* Review proceedings.

In this issue...

Summary of the America Invents Act 1

Draft Biosimilars Approval Guideline Released by FDA: More Questions than Answers? 2

Doing Business on the Internet 2011 Seminar Recap 3

Recent Changes in Gray Market Rules 4

Case Law Review 6

WARNING: Non-USPTO Solicitations That May Resemble Official USPTO Communications 8

Another novel way in which a granted patent can be challenged under the AIA is by Post-Grant Review (PGR) proceedings. Under PGR, a person who is not the patent owner may petition the USPTO to review the validity of an issued patent within nine months of its grant or issuance of a reissue patent. PGR rules go into effect September 16, 2012 and are applicable to business method patents under the transitional program, but the PGR process goes into effect only as to "first-to-file" patents, which are patents that are filed on or after March 16, 2013.

Assertions of invalidity may be made on any grounds of patentability that one can raise as a defense in patent infringement litigation before the courts, including failure of the claims to define subject matter eligible for patenting, lack of novelty, obviousness and to provide a written description or enablement. A petitioner initiating a PGR proceeding need bear the burden of proving invalidity only by the lower standard of "by a preponderance of the evidence" in contrast to the higher "clear and convincing" evidentiary standard.

PGR is available only if the challenger has not already initiated a civil action in District Court. PGR proceedings are to be conducted by the Patent Trial and Appeal Board, which will replace the Board of Patent Appeals and Interferences on September 16, 2012 for proceedings that commence on or after that date. PGR proceedings may be terminated either by settlement or by decision of the Board. There is also estoppel associated with the challenger at the USPTO, the District Courts and the International Trade Commission (ITC) in asserting invalidity on any ground that could have been reasonably raised during PGR.

The AIA provides patent owners the option to request supplemental examination (SE) of a patent to "consider, reconsider, or correct information believed to be relevant to the patent." SE is also an additional avenue that patent owners may utilize to satisfy their duty of disclosure after a patent has issued. Therefore, patent owners may utilize SE to eliminate defenses based on inequitable conduct that may likely be raised against the patent during litigation.

Along with the aspects of patent reform discussed above, the AIA has brought about several more changes that also touch on the fee structure of the USPTO (nearly all fees were increased by 15 percent ten days after enactment), disclosure of best mode (failure to disclose best mode has been eliminated as an invalidity defense), studies (for example, a study on genetic testing is ongoing and may affect gene patents), patent marking law (only the US government may bring about qui tam actions), creation of a micro entity (these entities are eligible for a 75 percent fee discount) and establishing a satellite office in Detroit (to hire more examiners and staff to work through the current backlog of more than 700,000 patent applications).

The AIA has been the recipient of abundant praise and great censure since its enactment, but one may only gain a better understanding of all its ramifications once it goes into effect in its entirety. It holds the promise of creating a more efficient, objective, predictable and transparent patent system and enhancing the quality of patents in the United States.

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Draft Biosimilars Approval Guideline Released by FDA: More Questions than Answers?

On February 9, 2012, the Federal Drug Administration (FDA) released draft guidance regarding how the FDA will review biosimilars, which are generic versions of FDA-approved biological products. The February 9 guidance relates to quality and scientific considerations in demonstrating biosimilarity as well as questions and answers regarding implementation of the Biologics Price Competition and Innovation Act of 2009 (BPCI Act).

The BPCI Act was enacted as part of the Affordable Care Act on March 23, 2010. Similar to the Hatch-Waxman Act, which established abbreviated pathways for the approval of generic drug products, the BPCI Act creates an abbreviated licensure pathway for biological products shown to be biosimilar to, or interchangeable with, an FDA-licensed biological reference product. The BPCI Act also addresses exclusivity periods, including an exclusivity period for the first biological product determined to be interchangeable with the reference product. There is also an exclusivity period for certain biological products for which pediatric studies are conducted. Similar to the Hatch-Waxman Act, the BPCI Act also provides procedures for identifying and resolving patent disputes involving applications for biosimilar products.

The Public Health Service (PHS) Act defines biosimilarity as occurring where "the biological product is highly similar to the reference product notwithstanding minor differences in clinically inactive components" and

that "there are no clinically meaningful differences between the biological product and the reference product in terms of the safety, purity, and potency of the product." An application for a biosimilar product must contain data demonstrating biosimilarity from analytical studies, animal studies or possibly clinical studies. The FDA recommends that sponsors of proposed biosimilar products request an initial meeting with the FDA to provide a proposed plan for developing the biosimilar product and to present preliminary comparative data with a reference biological product.

To meet the higher standard of "interchangeability," the applicant must provide information sufficient to demonstrate biosimilarity, and also to demonstrate that the biological product can be expected to produce the same clinical result as the reference product in any given patient. As indicated previously, the applicant must demonstrate that there are no clinical meaningful differences between the proposed product and the reference product in terms of safety, purity and potency. Specific analytical factors to determine biosimilarity between a proposed product and a reference product include functional activities, expression systems, cell types, manufacturing processes, physicochemical and immunochemical properties, quality and quantity of impurities, stability, and drug-specific reference standards based on the scientific literature. These factors need not be identical in the biosimilar and reference products.

Unlike generic drug products, an abbreviated pathway for biological products presents challenges because of scientific and technical complexities. For example, biological products are larger and more complex than the smallest molecular drugs. Also, most biological products are produced in living organisms, such as a microorganisms or cells, whereas small molecule drugs are usually synthesized. Because of the variability that exists in biological systems, it is difficult to guarantee uniformity among similar biological products.

The FDA definition of biosimilars remains vague. While in theory, biosimilarity may refer to "no clinical meaningful differences" between a proposed product and a reference drug, it is difficult to elucidate the meaning in practice. While numerous comparative experiments and clinical trials may be performed to demonstrate biosimilarity and interchangeability, it seems that there are no set guidelines for the approval process. In other words, a biosimilar applicant may not know how many experiments and/or clinical trials are necessary for demonstrating biosimilarity. While the FDA recommends working with sponsors of proposed biosimilar products, it seems that the FDA is reluctant to fully develop guidelines and prefers to work with sponsors on a case-by-case basis.

An example of the complexity of the technology involved in biosimilars is how proteins and peptides are defined. The February 9 guidance defines "protein" as an amino acid polymer with a specific sequence that is greater than 40 amino acids long and excludes a chemically synthesized polypeptide. On the other hand, a "chemically synthesized polypeptide" is defined as an amino acid polymer that is made entirely by chemical synthesis and fewer than 100 amino acids long. A chemically synthesized polypeptide is not a "biological product" and will be regulated as a drug unless the polypeptide otherwise meets the statutory definition of a "biological product" (e.g., a vaccine). The FDA also defines an amino acid polymer that is fewer than 40 amino acids long as a peptide, not a protein, which will be regulated as a drug unless the polypeptide otherwise meets the statutory definition of a "biological product" (e.g., a vaccine).

The FDA's definitions of proteins, peptides and polypeptides are indicative of the questions raised by the February 9 guidance. The FDA classifies proteins, peptides and polypeptides based upon size, use and the method in which they are produced. Small proteins that meet the FDA definition of "peptide" (neuropeptides, for example) are routinely produced by biological organisms. However, under the proposed classification system, neuropeptides would be classified as a drug or a biological product, depending on how they were made (e.g., chemically synthesized or isolated from a cell) or how they are to be used (e.g., on their own or as part of a vaccine). Such a classification raises more questions than answers.

While the February 9 guidance is welcomed by applicants seeking to develop biosimilars, many questions remain. Undoubtedly there will be many comments and suggestions submitted in response to the February 9 guidance.

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Doing Business on the Internet 2011 Seminar Recap

Social media and/or social networking websites have enjoyed increased recognition of late as valuable tools for enhancing business. For example, increasingly companies are developing a presence on sites such as Facebook, MySpace, Twitter, and YouTube. While a

forward-thinking approach to the use of social media sites is to be commended, it is important to recognize the inherent intellectual property risks that these sites uniquely create.

Social media sites represent the "new frontier" for IP infringement due to their ubiquitous nature and their architecture, which allows users to post (possibly without authorization) digital content with relative ease. The two main areas on social media sites in which IP infringement is likely to be most prevalent are (1) in user-generated content and graphics and (2) in user names/Twitter handles. Fortunately, there are strategies that savvy parties can take to protect their valuable IP assets in the face of the social media revolution.

One measure that should be taken as soon as practicable is registering all trademarks as user names/page names/group names with all applicable social media sites. For example, in 2009 Facebook changed its policy to allow users to register URLs for their accounts that follow the format www.facebook.com/username. Parties that are concerned about protecting their IP should register each trademark for a brand as a separate user name. For example, it is now possible to customize a Facebook account such that any time anyone enters a URL with the user name of *any of a company's trademarks*, they are automatically redirected to a landing page of that company's choosing. Furthermore, policies should be implemented to ensure that social media sites are monitored to detect instances of infringement. This monitoring may be performed internally, through third-party monitoring service providers or through law firms, such as Vedder Price.

It is also important to understand the different Terms of Use/Terms of Service governing the use of the different social media sites. For example, the trademark policies of Twitter, Facebook and LinkedIn vary considerably with regard to the scope of protection afforded to trademark owners. Presently, Facebook appears to have a more "pro-trademark owner" policy than other social media sites.

Given the risk that social media sites may be used as tools for infringing valuable IP assets, it is also important to understand what remedies are available. There are two main ways to enforce IP rights that have been violated on a social media site: (1) via a social media site's internal dispute resolution mechanism or (2) via a traditional dispute resolution mechanism. With regard to the internal dispute resolution mechanism, it is important to be aware that many social media sites offer reporting tools allowing aggrieved parties to lodge complaints of IP infringement. The social media site operators will then attend to such complaints as they see fit. However, it may be the case that the internal dispute resolution mechanism is inadequate for addressing an aggrieved party's needs. In this situation, it is important to bear in mind the availability of traditional dispute mechanisms. For example, certain situations may call for the preparation and delivery of a cease and desist letter, or in the majority of instances, litigation. Vedder Price attorneys are always available to advise on any social media issues that may arise.

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Recent Changes in Gray Market Rules

The recent explosion of the international trade of goods over the Internet is undeniable. Trade that was once hindered by customs, distances and language is now greatly facilitated by a "single click" interface. A small "Ma & Pa" store with a website, a PayPal account, a product, a client in a foreign country, and access to a FedEx International account is now engaged in international trade.

New problems are born from this important shift. The first is an increase in the flow of gray market goods sold directly to clients on small scales. Large retailers or wholesalers like Amazon, eBay or Costco struggle with the control of the origin of goods they sell.

Gray market goods are generally defined as the trade of a commodity through distribution channels that, while legal, are unofficial, unauthorized or unintended by the original manufacturer. In the context of an Internet retailer, wholesale prices given to a foreign retailer even with a promise of a minimum sale price can resurface on the Internet at lower sales prices, for example, when promotional codes, or other rebates are provided. A foreign distributor can anonymously open a boutique on Amazon and sell goods in violation of any distributorship agreement. Furthermore, because online shoppers are so price sensitive and tools exist to compare prices of similar items, website purchases are especially easy to divert with a small net rebate.

US Law defines gray market goods, or "parallel imports," as genuine products possessing a brand name protected by a trademark or copyright. They are typically manufactured abroad, and purchased and imported into the US by third parties, thereby bypassing the authorized US distribution channels.

Most goods are protected through the Copyright Act or the Trademark Act. Protection under trademark law includes branding of specific goods (e.g., the Vortex™ wetsuit), the use of house marks (e.g., Tyr® as a producer of wetsuits generally) and/or the use of trade dresses on the product itself or its packaging (e.g., color codes on Tyr's wetsuits). The Lanham Act establishes that US Customs may prevent the entry of gray market goods as long as certain conditions are met. Section 526 of the Tariff Act prohibits the importation of trademarked goods without the explicit written consent of the owner, but this barrier applies only to goods that are physically and "materially different" from the domestic product likely to cause consumer confusion. If the identical good finds its way back to the United States, retailers cannot use trademark law to bar imports. If the good is "materially different" in any way, imports can be blocked. For example, if Amazon sells in the United States a "materially different" foreign version of a Tyr® wetsuit, an action for trademark infringement is appropriate.

Courts had helped define what constitutes a "material difference." For example, if the goods sent are imported with altered or obliterated serial numbers, imported with non-English language instructions, manuals or labels, the goods are offered at significantly discounted prices without a warranty, or if minor differences in composition or appearances can be found, these imports may be blocked. In the case of the Tyr wetsuits, if the rubber type differs, or if the color coding or sizing differs between countries, trademark law can be used to control imports.

Copyright law can now also be used to control gray market sales. Copyrights in trade goods can be embedded in the good (e.g., the aesthetic design of color stripes printed on a wetsuit), an instruction booklet or even the wording on a package. Under US Law, the importation, without the authority of the owner of the copyright, of a work that has been acquired outside the United States is an infringement of the exclusive right to distribute copies.

Copyright protections differ greatly from trademark protections. The creator of a copyrighted good is entitled to regulate the distribution of that good unless one of the very limited exceptions apply. The first sale doctrine is one of these exceptions. Once a copyright owner consents to the sale of particular copies of his work, he "loses control" over subsequent sales, and may not thereafter exercise the distribution right with respect to that work.

Gray market goods are by definition legally sold to a foreign party and subsequently the scope of consent is exceeded. In *Omega S.A. v. Costco Wholesale Corp.*, the wholesaler Costco legally purchased Omega watches through a New York importer who purchased the watches abroad. Omega took issue with its watches being sold at a large-box wholesaler and argued the first sale doctrine would not apply as these goods were produced abroad and sold to a foreign distributor for sale.

In three precedential cases, the first sale doctrine had been found to apply and the copyright owner was barred from regulated trade of gray market goods once the goods reentered the United States. For example, the doctrine applies when a product is manufactured and sold in the United States, when the good is produced abroad and first sold in the United States, and when the good is manufactured in the United States, sold abroad, and ultimately returned to the United States in a "round" trip .

In *Omega*, the goods were manufactured abroad, first sold to a foreign distributor and imported into the United States for sale. The distinction is very small, but was sufficient for the courts. These goods were found to not have been "lawfully made under the USA copyright law" and were thus unworthy of protection under the first sale doctrine.

If you have any questions about this article, please contact **Alain Villeneuve** at +1 (312) 609 7745. ■

Practice Tips:

1. We strongly recommend securing US Trademark protection for relevant marks to be asserted. The ownership of a registered mark is always helpful in establishing a presumption of ownership in association with Section 526 US Custom actions.
2. Customize the foreign version of your goods, for example, use foreign labels, tags or instructions. Use promises of services like warrantees or guarantees to distinguish your goods.
3. When small volumes are involved, take action directly with the international shipper or the ultimate sale outlet instead of with US Customs. Shipper contact information is always disclosed on the infringing website. Report Section 526 violations to these shippers in addition to US Customs.
4. The consequence of *Omega* is that goods sold to foreign distributors should always be manufactured abroad. Printing of a user's handbook in the UK (instead of the USA) sold with a product manufactured and sold abroad blocks resale in the USA.
5. We recommend to file for US Copyright protection with the Copyright Office. The ownership of a registration grants several advantages during the enforcement including recovery of attorney's fees.

Case Law Review

Federal Circuit Continues to Hone in on What Constitutes Patentable Subject Matter Post-*Bilski*

Dealertrack, Inc. v. Huber
(Fed. Cir. 2012)

The mere recitation in the preamble of a claim that a method is "computer aided" is likely insufficient to satisfy Section 101 of the Patent Act, which defines patentable subject matter.

In *Dealertrack, Inc. v. Huber*,[1] the US Court of Appeals for the Federal Circuit issued an opinion clarifying what constitutes patentable subject matter in light of the Supreme Court's ruling in *Bilski v. Kappos*.[2] Patentee Dealertrack, Inc. (Dealertrack) sued David L. Huber, Finance Express, LLC and RoutOne, LLC (Alleged Infringers) in the US District Court for the Central District of California for infringing two of its patents directed to computer-aided methods and systems for processing credit applications over electronic networks. The Alleged Infringers defended on grounds, *inter alia*, that the claims in one of the asserted patents (i.e., `427 Patent) were invalid for failure to claim patent-eligible subject matter under 35 U.S.C. § 101.[3] The District Court agreed with the Alleged Infringers' position and granted summary judgment due to invalidity of all claims of the `427 Patent for failure to claim patent-eligible subject matter under § 101. Dealertrack appealed to the US Court of Appeals for the Federal Circuit (Federal Circuit).

In determining whether the claims of the `427 Patent were indeed invalid under § 101, the Federal Circuit analyzed claim 1 of the `427 Patent, which reads as follows:

1. A **computer aided method** of managing a credit application, the method comprising the steps of:

[A] receiving credit application data from a remote application entry and display device;

[B] selectively forwarding the credit application data to remote funding source terminal devices;

[C] forwarding funding decision data from at least one of the remote funding source terminal devices to the remote application entry and display device;

[D] wherein the selectively forwarding the credit application data step further comprises:

[D1] sending at least a portion of a credit application to more than one of said remote funding sources substantially at the same time;

[D2] sending at least a portion of a credit application to more than one of said remote funding sources sequentially until a finding [sic, funding] source returns a positive funding decision;

[D3] sending at least a portion of a credit application to a first one of said remote funding sources, and then, after a predetermined time, sending to at least one other remote funding source, until one of the finding [sic, funding] sources returns a positive funding decision or until all funding sources have been exhausted; or,

[D4] sending the credit application from a first remote funding source to a second remote finding [sic, funding] source if the first funding source declines to approve the credit application.

In addressing whether the foregoing claim was directed to patent-eligible subject matter, the Federal Circuit began by citing to its 2010 decision in *Research Corp. v. Microsoft Corp.*[4] for the proposition that § 101 is generally an inclusive statute that favors a finding of patent-eligible subject matter[5] over a finding of patent-ineligible subject matter. Additionally, the Federal Circuit noted a "clear congressional mandate that a very broad swath of inventions be eligible for patent protection." Despite recognizing that § 101 presents a relatively low hurdle for purposes of patentability, the Federal Circuit concluded that the claims of the `427 Patent were "invalid as being directed to an abstract idea preemptive of a fundamental concept or idea that would foreclose innovation in this area."

In support of its conclusion of invalidity, the Federal Circuit characterized claim 1 of the `427 Patent as explaining "the basic concept of processing information through a clearinghouse." As such, the Federal Circuit found that the steps of the method did not "impose meaningful limits on the claim's scope," borrowing a

1 Nos. 2009-1566, 2009-1588 (Fed. Cir. Jan. 20, 2012).
2 130 S. Ct. 3218 (2010).
3 35 U.S.C. § 101 ("[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.").
4 627 F.3d 859 (Fed. Cir. 2010).
5 *See Id.* at 868 (noting that for abstractness to invalidate a claim, it must "exhibit itself so manifestly as to override the broad statutory categories of eligible subject matter and the statutory context that directs primary attention on the patentability criteria of the rest of the Patent Act.").

phrase from the holding in *In re Bilski*.[6] The Federal Circuit stated that "[n]either Dealertrack nor any other entity is entitled to wholly preempt the clearinghouse concept."

The Federal Circuit then turned its attention to the issue of whether the limitation "computer aided," as used in claim 1, demonstrated that the claim was not, in fact, directed to an unpatentable, abstract idea. Unfortunately for Dealertrack, the Federal Circuit found that "[t]he undefined phrase 'computer aided' is no less abstract than the idea of a clearinghouse itself." To this point, the Federal Circuit noted, "[s]imply adding a 'computer aided' limitation to a claim covering an abstract concept, without more, is insufficient to render the claim patent eligible." In particular, the Federal Circuit found that "the claims here recite only that the method is 'computer aided' without specifying any level of involvement or detail." Based on this logic, the Federal Circuit affirmed the determination of the District Court that the claims of the `427 patent were patent-ineligible abstract ideas under § 101. ■

6 545 F.3d 943, 961–62 (Fed. Cir. 2008) (*en banc*).

Practice Tip:

Method claims should recite one or more specific components for carrying out the steps of the method *within the body of the claim* in order to avoid pitfalls such as those encountered by Dealertrack in the above case. Method claims that fail to recite adequate structure in the body are susceptible to challenges under 35 U.S.C. § 101. Vedder Price patent attorneys are skilled at preparing method claims capable of withstanding scrutiny under Section 101 of the Patent Act.

HTC Corp. v. IPCom GmbH & Co.

(Fed. Cir. 2012)

The Federal Circuit has again attempted to clarify its jurisprudence surrounding means-plus-function claims in its recent decision in *HTC Corp. v. IPCom GmbH & Co.*[1] On appeal from the District Court for the District of Columbia, HTC argued that IPCom's asserted patent, US Patent No. 6,879,830 (the '830 Patent), was invalid, *inter alia*, for failing to distinctly claim the subject matter which the applicant regards as his invention as required by 35 U.S.C. § 112, second paragraph. While upholding the District Court's finding that the patent was not invalid for indefiniteness because HTC had waived the argument, the Federal Circuit reiterated its earlier holding that means-plus-function claims can be invalid for indefiniteness in situations where a claim recites structure amounting to a general purpose computer only and does not sufficiently describe an algorithm for accomplishing the claimed functionality.

The subject matter of the '830 Patent includes a handover in a cellular telephone network. A handover occurs when a cellular telephone, called a "mobile station" in the patent, switches from one base station to another. The language of IPCom's asserted claim recites "an arrangement for reactivating the link with the first base station if the handover is unsuccessful." The parties agreed that the language "an arrangement for reactivating the link" invoked treatment as a means-plus-function claim limitation. HTC argued that the claim was rendered indefinite because the specification did not sufficiently describe a structure that accomplished the function as recited. More specifically, HTC argued that the specification did not discuss any hardware or specific circuitry or schematics that accomplished the reactivation of the link.

The Federal Circuit revisited its holding in *Aristocrat Techs. Austl. PTY Ltd. v. Int'l Game Tech.*,[2] and stated that the disclosure of a general purpose computer (a processor and transceiver in this case), without more, is insufficient to overcome an indefiniteness challenge to a means-plus-function claim. The disclosure, the Federal Circuit opined, must identify an algorithm that the general purpose computer executes in order for the claim not to be in violation of the requirements of 35 U.S.C. § 112, paragraph 6.

1 *HTC Corp. v. IPCom GmbH & Co.*, No. 2011-1004 (Fed. Cir. Jan. 30, 2012), available at http://www.cafc.uscourts.gov/images/stories/opinions-orders/11-1004.pdf, last viewed Feb. 6, 2012.

2 *Aristocrat Techs. Austl. PTY Ltd. v. Int'l Game Tech.*, 521 F.3d 1328 (Fed. Cir. 2008).

The Federal Circuit stated that the District Court was incorrect in its decision that a processor and transceiver, by themselves, are sufficient structure under an indefiniteness attack. The denial of HTC's motion for summary judgment on the ground of indefiniteness was not overturned, however, because HTC, even when given the opportunity, failed to raise the lack-of-algorithm argument in the District Court and therefore had constructively waived the argument on appeal.

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Practice Tips:

When claiming software or business method inventions, where the use of a general purpose computer is common, be mindful of the implications of using means-plus-function claim language by:

- **including (in the specification) at least one algorithm for reaching the desired result.**
- **thinking about alternate algorithms and disclosing the alternatives in order to increase claim breadth.**

WARNING: Non-USPTO Solicitations That May Resemble Official USPTO Communications[1]

Be aware that private companies **not** associated with the United States Patent and Trademark Office (USPTO) often use trademark application and registration information from the USPTO's databases to mail or e-mail trademark-related solicitations. Trademark applicants and registrants continue to submit a significant number of inquiries and complaints to the USPTO about such solicitations, which may include offers: (1) for legal services; (2) for trademark monitoring services; (3) to record trademarks with US Customs and Border Protection; and (4) to "register" trademarks in the company's own private registry.

These companies may use names that resemble the USPTO name, including, for example, the terms "United States" or "US." Increasingly, some of the more unscrupulous companies attempt to make their solicitations mimic the look of official government documents rather than the look of a typical commercial or legal solicitation by emphasizing official government data like the USPTO application serial number, the registration number, the International Class(es), filing dates, and other information that is publicly available from USPTO records. Many refer to other government agencies and sections of the US Code. Most require "fees" to be paid.

Some applicants and registrants have reported paying fees to these private companies, mistakenly thinking that they were paying required fees to the USPTO. So, be sure to read trademark-related communications carefully before making a decision about whether to respond. **All official correspondence will be from the "United States Patent and Trademark Office" in Alexandria, VA, and if by e-mail, specifically from the domain "@uspto.gov."**

If you receive a trademark-related solicitation that you believe is deceptive, you may file an on-line consumer complaint with the Federal Trade Commission (FTC), at www.FTC.gov. Although the FTC does not resolve individual consumer complaints, it may institute, as the nation's consumer protection agency, investigations and prosecutions based on widespread complaints about particular companies or business practices. If you wish to contact the USPTO regarding such solicitations, please e-mail TMFeedback@uspto.gov. When notifying us about or forwarding a misleading communication, please also specify whether the recipient thought it was an official USPTO communication and whether fees were mistakenly paid. ■

1 *WARNING: Non-USPTO Solicitations That May Resemble Official USPTO Communications*, USPTO.GOV, http://www.uspto.gov/trademarks/solication_warnings.jsp (last visited Mar. 9, 2012).

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