AMERICAN CONTINENTAL GROUP

1800 M Street NW | 5th Floor | Washington D.C. 20036
Tel: (202) 327-8100 | Fax: (202) 327-8101

PATENT & TRADEMARK POLICY REPORT
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I. Congressional Update:

- On Tuesday, Senator Mitt Romney (R-UT), along with HELP Ranking Member Bill Cassidy, M.D. (R-LA), and 15 Republican colleagues penned a letter to National Institutes of Health (NIH) Director Monica Bertagnolli, M.D., opposing the Biden Administration's proposal to permit agencies to seize drug patents from companies under the Bayh-Dole Act if the Administration deems the drug prices too high. The senators expressed grave concerns that such actions could stifle healthcare innovation and impede access to life-saving treatments for millions of Americans. They emphasized that utilizing march-in rights to regulate drug prices would undermine public-private partnerships crucial for biomedical research and development, ultimately hindering the advancement of new cures and treatments. The letter underscores bipartisan opposition to the Biden proposal, highlighting concerns about potential negative consequences on healthcare innovation and public-private partnerships. The full text of the letter can be found here.

II. USPTO Updates:

- On Friday, the USPTO extended its successful First-Time Filer Expedited Examination Pilot Program, allowing eligible first-time patent filers to have their applications advanced for earlier review. Under this initiative, known as "accorded special status," applicants will receive expedited initial feedback from patent examiners. Kathi Vidal, Under Secretary of Commerce for Intellectual Property and Director of the USPTO, emphasized the program's role in supporting emerging

Headlines and Highlights:

- Republican Senators Write Letter in Opposition to Biden's Proposal on Drug Patent Seizures
- USPTO Extends First-Time Filer Expedited Examination Program
- IPOPHL Becomes ISA and IPEA for U.S. Applicants
- USPTO Proposes Rules for MTA Practice in Post-Grant Proceedings
- USPTO to Host AI and Intellectual Property Symposium
- Federal Circuit Upholds Ineligibility of IBM Patents
- Federal Circuit Affirms USPTO's Decision in Pfizer v. Sanofi Case

innovators and facilitating faster market entry for their products. In its initial year, the pilot saw over 350 petitions filed, with 142 accepted and 15 patents granted. The extended program will continue until March 11, 2025, or upon the approval of 1,000 petitions, whichever comes first. Read more here

- On Wednesday, the Intellectual Property Office of the Philippines (IPOPHL) became an International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA) for U.S. applicants under the Patent Cooperation Treaty (PCT). USPTO Director Kathi Vidal and IPOPHL Director General Rowel S. Barba signed the arrangement, expanding options for patent applicants seeking international protection. The IPOPHL's designation as an ISA and IPEA offers U.S. applicants an additional choice, alongside other renowned patent offices. This addition aims to streamline the global patent application process, enhancing convenience and accessibility for innovators seeking protection worldwide. The agreement is effective immediately and will last for eight years, marking a significant step in international patent cooperation. Read more here.

- On Monday, the US Patent and Trademark Office (USPTO) introduced a Federal Register notice unveiling proposed rules aimed at formalizing its pilot program for motion to amend (MTA) practice and associated procedures for post-grant proceedings before the Patent Trial and Appeal Board (PTAB). The pilot program enables patent owners to seek guidance from the PTAB regarding a proposed MTA and subsequently submit a revised MTA based on the provided guidance. This initiative signifies a step toward streamlining the MTA process and enhancing transparency in post-grant proceedings, potentially impacting the efficiency and fairness of patent dispute resolution at the USPTO.

- On March 27, the USPTO will host a public symposium on AI and intellectual property, in line with directives from the president's Executive Order 14110, "Safe, Secure, and Trustworthy Development and Use of Artificial Intelligence." The symposium will take place both virtually and in person at Loyola Marymount University Law School in Los Angeles at 10 a.m. PT. Limited seating is available for in-person attendance, and registration is required by March 22 for both virtual and in-person participation. The event will feature panel discussions led by experts in patent, trademark, and copyright law, focusing on various topics such as comparing copyright and patent law approaches, ongoing copyright litigation involving generative AI, and policy considerations surrounding name, image, and likeness (NIL) issues. Kathi Vidal, Under Secretary of Commerce for Intellectual Property and Director of the USPTO, emphasized the collaboration with the Department of Commerce and the U.S. Copyright Office in building a framework to address AI's intersection with intellectual property. Further information can be found here.

III. Judicial Update

- On Tuesday, in an opinion delivered by Chief Judge Moore, the Federal Circuit upheld a district court judgment deeming IBM's claims as patent ineligible under 35 U.S.C. § 101. The patent in question involved methods for targeting web-based advertisements based on search results. Despite IBM's argument that the claims represented a patent-eligible improvement in online advertising, the Federal Circuit disagreed, stating that the claims broadly recited a generic process of correlating advertisements with search results. The court

concluded that the claims lacked the inventive concept required for patent eligibility under the Alice test. This ruling marks a significant impact on patent and trademark law, signaling continued scrutiny of claims related to software and online technologies, potentially making it more challenging for such patents to be granted or upheld in court.

- On Tuesday, the Federal Circuit, in an opinion by Judge Lourie, affirmed USPTO's inter partes review decisions canceling Pfizer's claims in Pfizer Inc. v. Sanofi Pasteur Inc. The patent in question pertained to "conjugated Streptococcus pneumoniae capsular saccharide antigens" for use in pneumococcal vaccines. Pfizer contended that the USPTO erred in finding the claims obvious due to the absence of disclosure regarding the claimed range of glycoconjugate molecular weights in the prior art. However, the Federal Circuit disagreed, pointing out that the prior art did disclose weights for similar glycoconjugates that overlapped with the claimed range. This ruling underscores the significance of the "result-effective variable doctrine," indicating that optimizing variables to achieve improved results, even if not explicitly disclosed in the prior art, may render claims obvious. This decision will likely have a notable impact on patent law, particularly in cases where optimization of variables is crucial for innovation.