

The IP Beacon, March 2017

By Andrew B. Cohn, Brian C. Kwok, Brittany Parks, Kelvin L. Varghese | March 30, 2017

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Subject Matter Eligibility Guidance from the Federal Circuit: *Thales Visionix v. United States*

By [Kelvin Varghese](#)

Both the courts and the Patent and Trademark Office (PTO) have struggled to define the metes and bounds of the subject matter eligibility analysis under 35 U.S.C. § 101. The Court of Appeals for the Federal Circuit's recent decision on March 8, 2017 in *Thales Visionix Inc. v. United States* further clarifies the first step of the eligibility analysis, while confirming the significance of that step.

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No Respite On The Horizon For CBM Patents

By [Andrew Cohn](#)

The Patent Trials and Appeals Board and the Federal Circuit have continued their hostility to payment and financial technology patents, recently invalidating three patents and reversing a large damage award in *Smartflash LLC v. Apple Inc.*, see *Smartflash LLC v. Apple Inc.*, Case No. 2016-1059 (Fed. Cir. March 1, 2017 (*Smartflash*)). Given this stance, it seems as though the Covered Business Method patent review under the America Invents Act (AIA), along with the decision in *Alice Corp. v. CLS Bank Int'l*, have become the death knell for many such patents moving forward.

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Secure Access Denied Access in Third CBM Eligibility Decision by Federal Circuit

By Aaron Taggart

As a result of the Federal Circuit's decision in *Secure Access, LLC v. PNC Bank National Association* in late February, it is not likely that a flood of Covered Business Method (CBM) reviews will be coming any time soon. By statute, Covered Business Method reviews are reserved for patents relating to "a financial product or service," and under the Federal Circuit's narrow reading of that statute, the number of CBM reviews will likely remain quite small relative to the number of *Inter Partes* Reviews.

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What to Know About Post-Grant Review and the Biotech Industry

By [Brian Kwok](#), Nicole Johnson, and Nick Martini

The AIA made several significant changes to United States patent law, including the establishment of post-grant proceedings before the Patent Trials and Appeals Board where patents have the potential of being invalidated in a much more efficient and expedient manner. In the five years since the AIA was enacted, two types of post-grant proceedings, *Inter Partes* Review and Post-Grant Review, have become increasingly popular tools for biotechnology companies to resolve patent

disputes.

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How Patent Enforcement Laws May Be Getting Some New Ink

By Kenneth Parker and [Brittany Parks](#)

On December 2, 2016, the Supreme Court of the United States (SCOTUS) decided to review the U.S. Court of Appeals for the Federal Circuit's decision in *Impression Products v Lexmark Intl*. The case presents two significant questions regarding the theory of "patent exhaustion":

- Whether patent law can restrict the use or resale of a patented item after the first authorized sale of that item in the U.S.; and
- Whether the authorized sale of a patented item outside the U.S. exhausts the U.S. patent rights in that item.

The answers to these questions will have an important impact on patent enforcement in the U.S. and internationally. Due to the complexity of the case, this article summarizes the relevant background issues and procedural history, and then discuss the significant repercussions that SCOTUS' decision may have on the technology industry.

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Federal Circuit Holds a Business Method Claim Directed to a GUI to be Patent-Eligible – will the PTO Agree?

By Christian Hines

It's no secret the Federal Circuit and the United States Patent and Trademark Office have been inconsistent when it comes to determining the patent eligibility of claims directed to software, leaving patent practitioners guessing as to whether their software-based inventions are patentable. As it stands today, some district court judges and Federal Circuit panels have been very willing to find software-related inventions patent ineligible. Recently, in the *Trading Techs. Int'l, Inc. v. CQG, Inc.* decision, the Federal Circuit dealt, yet again, with the question of whether software claims were patent-eligible.

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