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NEWSLETTER

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— LATEST NEWS & EVENTS —

Federal Circuit OK's Narrowing of Claims for Reissue

According to *In re Tanaka*, the reissue statute requires that the original patent must be "wholly or partly inoperative or invalid." The Federal Circuit stated that a patent is inoperative if it is ineffective to protect the disclosed invention. The omission of a narrower claim, such as a dependent claim, can render a patent partly inoperative, according to the Federal Circuit. Therefore, the addition of dependent claims through a reissue application is proper and can be a hedge against possible invalidity.

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What is Analogous Art for Obviousness?

In *Innovention v. MGA*, the patent disclosed a chess-like, light-reflecting board game. The district court found that certain laser chess references were non-analogous art for purposes of non-obviousness because they described electronic rather than real-world laser games.

The Federal Circuit explained that a reference qualifies as prior art when it is analogous to the claimed invention. According to the Federal Circuit, analogous art is tested by 1) "whether the art is from the same field of endeavor, regardless of the problem addressed" and 2) "if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved."

The Federal Circuit determined that the district court "failed to consider whether a reference disclosing an *electronic*, laser-based strategy game, even if not in the same field of endeavor, would nonetheless have been reasonably pertinent to the problem facing an inventor of a new, *physical*, laser-based strategy game." In particular, said the Federal Circuit, the Laser Chess references "relate to the same goal: designing a winnable yet entertaining strategy game."

Further, "inventors of numerous prior art patents contemplated the implementation of their strategy games in both physical and electronic formats."