



SHIMOKAJI & ASSOCIATES, P.C.

Intellectual Property Lawyers
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NEWSLETTER

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We specialize in the litigation and registration of patent, trademark, and copyright matters. The clients we serve range from start-ups to Fortune 500 companies, government entities, and universities. Though located in the US, our expertise and representation has an emphasis in Asia.

— LATEST NEWS & EVENTS —

Federal Circuit Makes it Harder to Overcome Obviousness

In *Tokai v. Easton*, the patented invention was a utility lighter. The Federal Circuit noted that courts "may find a motivation to combine prior art references in the nature of the problem to be solved," and that "[t]his form of motivation to combine evidence is particularly relevant with simpler mechanical technologies." The court concluded that "the simplicity and availability of the components making up the claimed invention, and an explicit need in the prior art for safer utility lighters—compel a conclusion of obviousness as to the subject matter of each of the asserted claims."

More information can be obtained at info@shimokaji.com



New USPTO Guidelines for Definite Claims

The USPTO has just issued new guidelines to help examiners ensure that patent claims "particularly point out and distinctly claim" the invention. In other words, claims must be definite. The guidelines apply to already filed applications.

Step One - the examiner is to "fully understand the subject matter of the invention."
A claim must be given its broadest reasonable interpretation. Words must be given their "plain meaning." If the claim can be read with more than one reasonable interpretation, then the claim is indefinite.

Step Two - the examiner must determine whether those skilled in the art would understand what is claimed.

Examples of possible indefinite terms:

- functional language
- terms of degrees
- subjective terms
- Markush groups

The text of the guidelines can be found at <http://edocket.access.gpo.gov/2011/2011-2841.htm>.