



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 —

USPTO Delays Implementation of 3-Track Examination

The USPTO was scheduled to implement a 3-track patent examination program at the beginning of May 2011. Track 1 was to include a priority examination. Due to budget constraints, the 3-track program has been put on hold for an indefinite period of time.

More information can be obtained at info@shimokaji.com



Good News for Patent Owners - Federal Circuit Makes it Harder to Prove Inequitable Conduct

In *Therasense v. Becton*, the patent involved disposable blood glucose test strips. Prosecution of the patent occurred over thirteen years. During prosecution, an affidavit argued the meaning of a prior art reference - whether it taught the absence of a protective membrane. The Federal Circuit explained they have now "[tightened] the standards for finding both intent and materiality in order to redirect a doctrine that has been overused to the detriment of the public."

"A district court should not use a 'sliding scale,' where a weak showing of intent may be found sufficient based on a strong showing of materiality, and vice versa. Moreover, a district court may not infer intent solely from materiality. Instead, a court must weigh the evidence of intent to deceive independent of its analysis of materiality." Even though "direct evidence of deceptive intent is rare," "the specific intent to deceive must be 'the single most reasonable inference able to be drawn from the evidence.'"

Further, "the materiality required to establish inequitable conduct is but-for materiality. When an applicant fails to disclose prior art to the PTO, that prior art is but-for material if the PTO would not have allowed a claim had it been aware of the undisclosed prior art." An exception to this requirement is where the conduct is "egregious."

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