



# SHIMOKAJI & ASSOCIATES, P.C.

Intellectual Property Lawyers  
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## NEWSLETTER

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We specialize in the litigation, registration, and monetization 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.

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### *Federal Circuit Finds Complex Computer Programming Goes Beyond Abstract Idea*

In *Ultramercial v. Hulu*, in deciding whether to dismiss a patent infringement lawsuit at its inception on the allegation of the patent covering an abstract idea, the Federal Circuit refused to dismiss because the claims required eleven complex computer programming steps.

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## *Federal Circuit Says Routine Experimentation Must Have Bounds*

In *Wyeth v. Abbott Labs*, the patents related to the use of rapamycin, a class of compounds used to treat and prevent restenosis. Although the specification described assays for screening potential compounds, the specification disclosed only one species of a compound and was silent about how to structurally modify that compound to yield compounds having the recited functional effects.

Wyeth argued that practicing the invention only required routine experimentation, and that the universe of potential compounds was inherently limited by the recited functional effects. Abbott argued that one of ordinary skill would need to engage in a laborious iterative process to determine what compounds would work.

The Federal Circuit agreed with Abbott, and found a lack of enablement. The court explained that routine experimentation is not without bounds. A considerable amount of experimentation can sometimes be permissible, but according to the court the specification must provide a reasonable amount of guidance. In this case, the Federal Circuit found that the specification disclosed only a starting point for further iterative research in an unpredictable and poorly understood field.