



# Patent Scope

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# Statutory Provisions

## United States: 35 U.S.C 271(a)

“... Whoever, without authority makes, uses, offers to sell, or sells any **patented invention**, within the United States or imports into the United States any **patented invention** during the term of the patent therefor, infringes the patent.”

## Patent Act of Korea, Art. 94

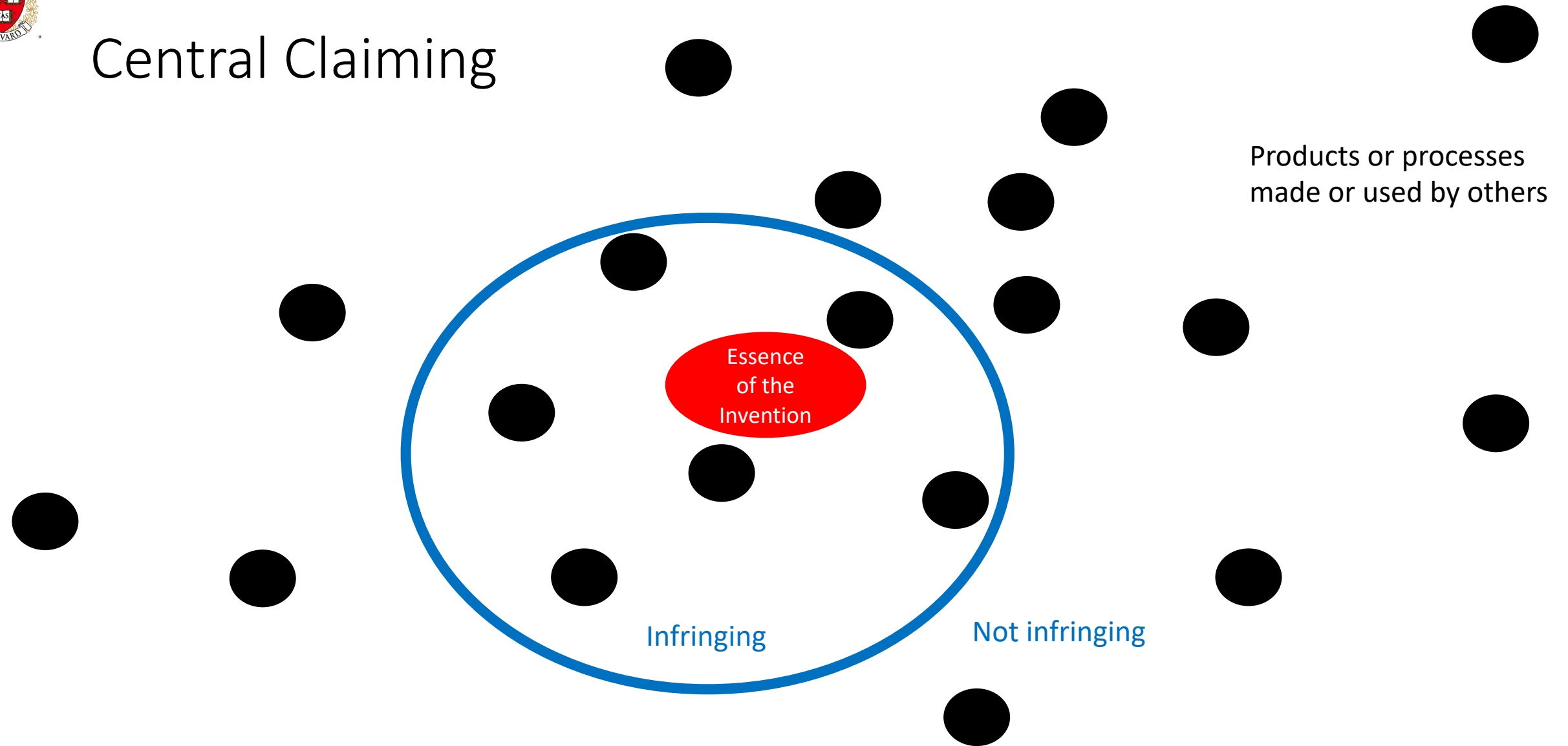
“A patentee shall have the exclusive right to commercially and industrially execute his/her **patented invention**.”

## Patent Act of Japan, Art. 68

“A patentee shall have the exclusive right to work the **patented invention** as a business.”



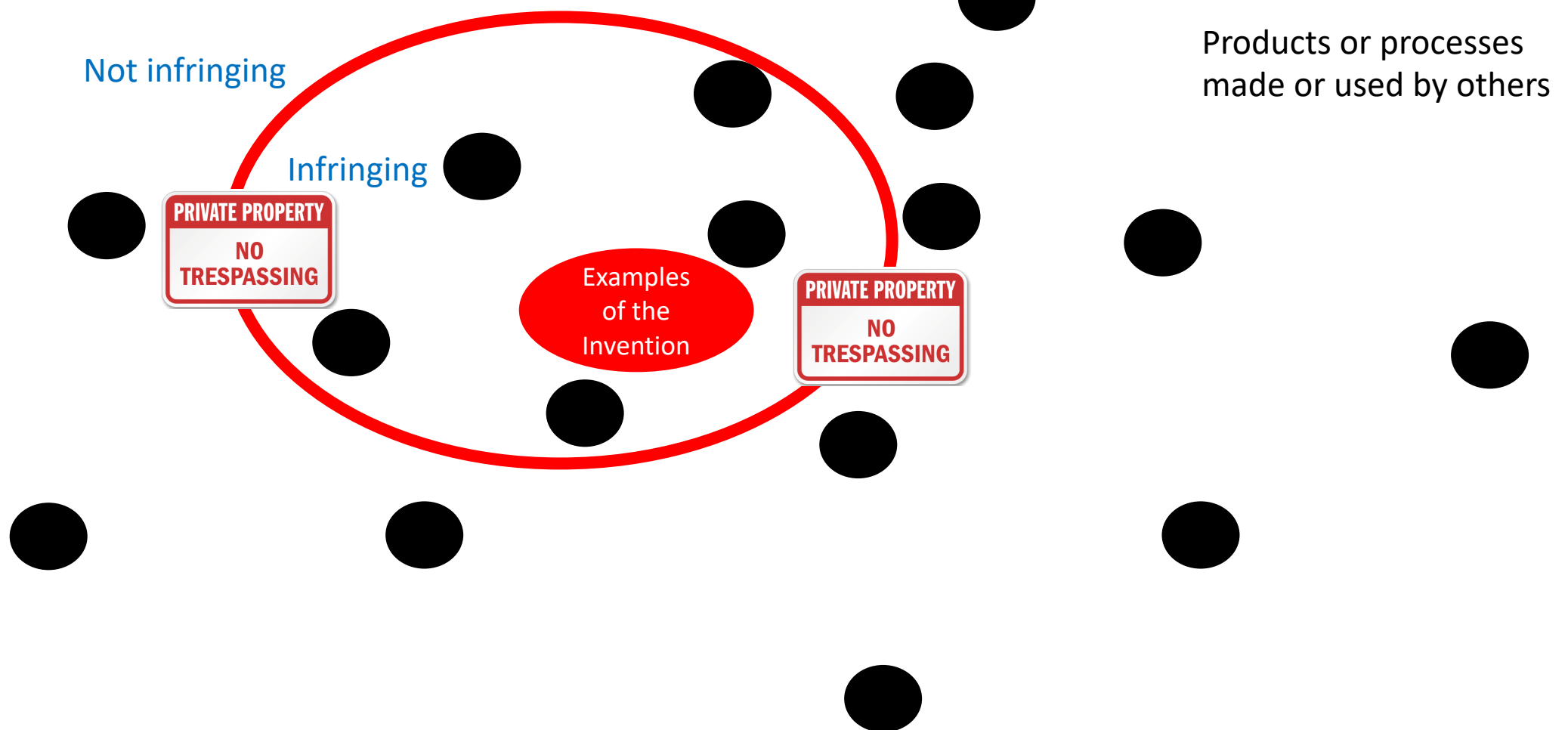
# Central Claiming



Patentee defines red zone; government official (typically a judge) defines blue zone



# Peripheral Claiming



Patentee defines red zone; government official (typically a judge) defines blue zone



# Statutory Provisions

## Patent Act of Korea, Art. 97

“The scope of protection of a patented invention shall be determined by the descriptions of the claims.”

## Patent Act of Japan, Art. 70

“The technical scope of a patented invention shall be determined based upon the statements in the scope of claims attached to the application.”

## Patent Act of China, Art. 59

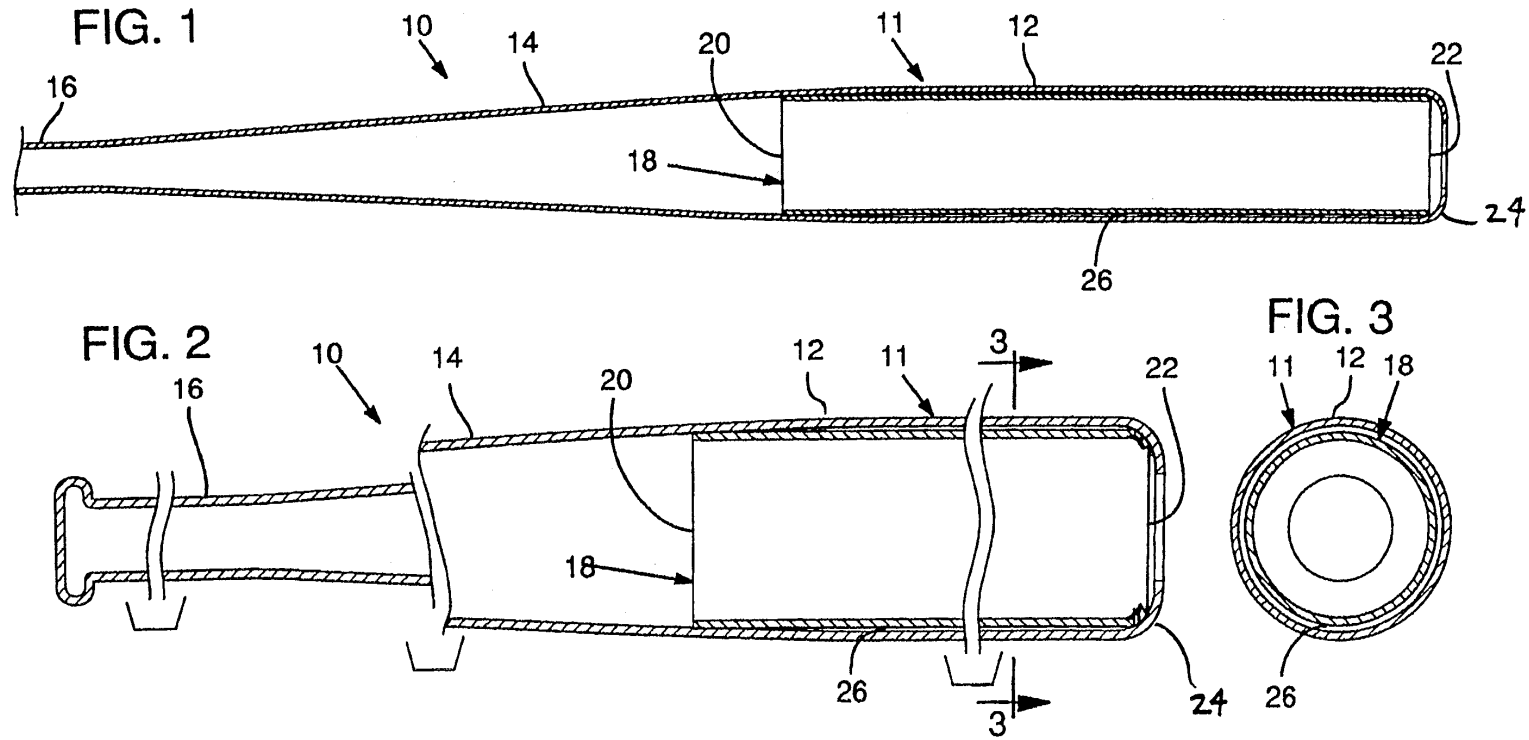
“For the patent right of an invention or a utility model, the scope of protection shall be confined to what is claimed, and the written description and the pictures attached may be used to explain what is claimed.”

## United States, 35 USC 112(b)

“The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.”



# Patent No. 5,415,398



U.S. Patent

May 16, 1995

5,415,398



# Patent No. 5,415,398

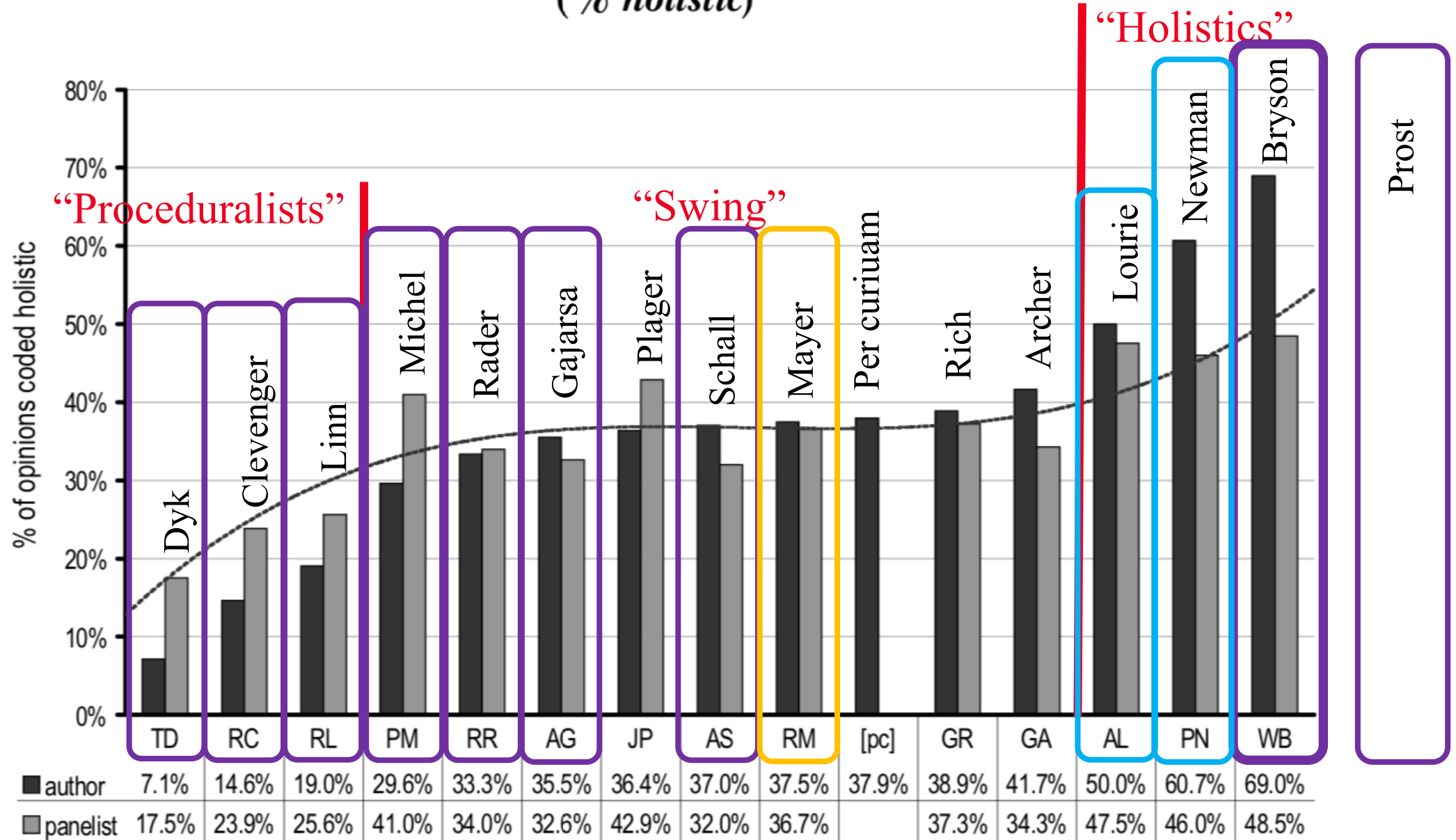
I claim:

1. A bat, comprising: a hollow tubular bat frame having a circular cross-section; and an insert positioned within the frame, the insert having a circular cross-section, the insert having first and second ends adjoining the tubular frame, the insert being separated from the tubular frame by a gap forming at least part of an annular shape along a central portion between said first and second ends, the frame elastically deflectable across the gap to operably engage the insert along a portion of the insert between the insert first and second ends.





**Figure 7: The Methodology of Federal Circuit Judges**  
 (% holistic)



Source: Wagner & Petherbridge, "Is the Federal Circuit Succeeding?," 152 U. Penn. L. Rev. 1105, 1158 (2004)



FIGURE 4: USAGE OF INTRINSIC EVIDENCE  
(100 TERM ROLLING AVERAGE)

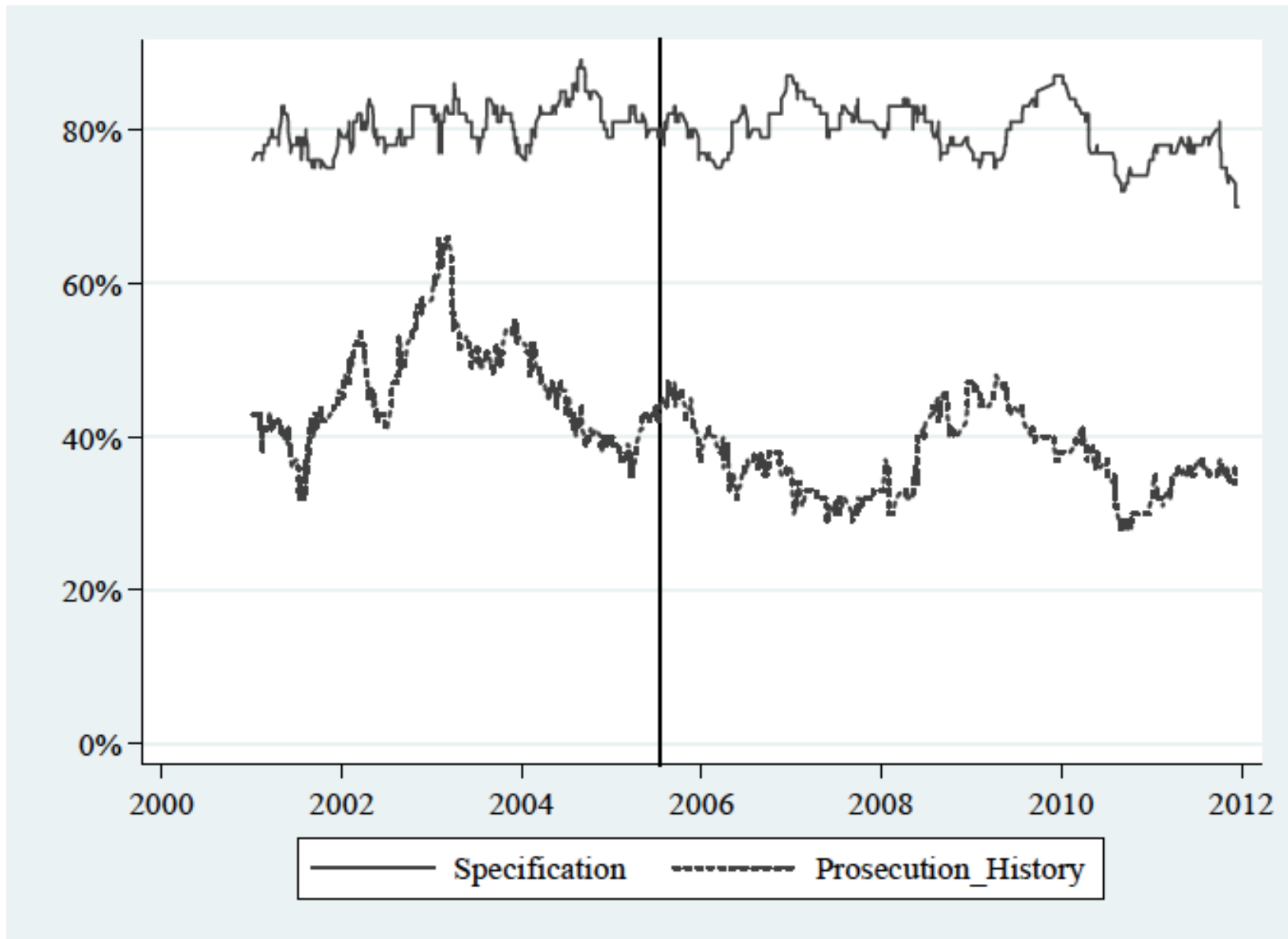




FIGURE 5: USE OF EXTRINSIC EVIDENCE  
(100 TERM ROLLING AVERAGE)

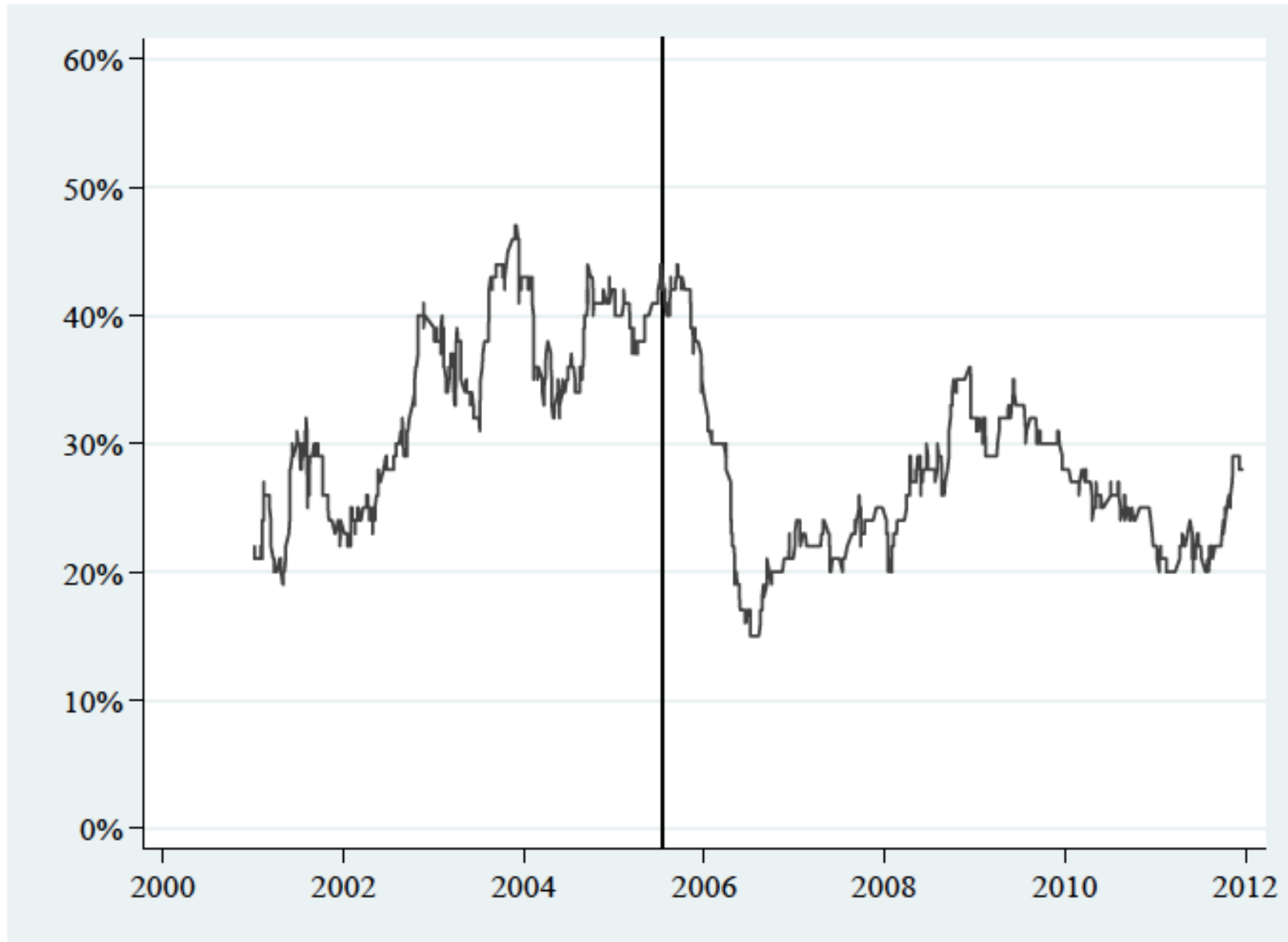




FIGURE 6: USE OF DICTIONARIES  
(100 TERM ROLLING AVERAGE)

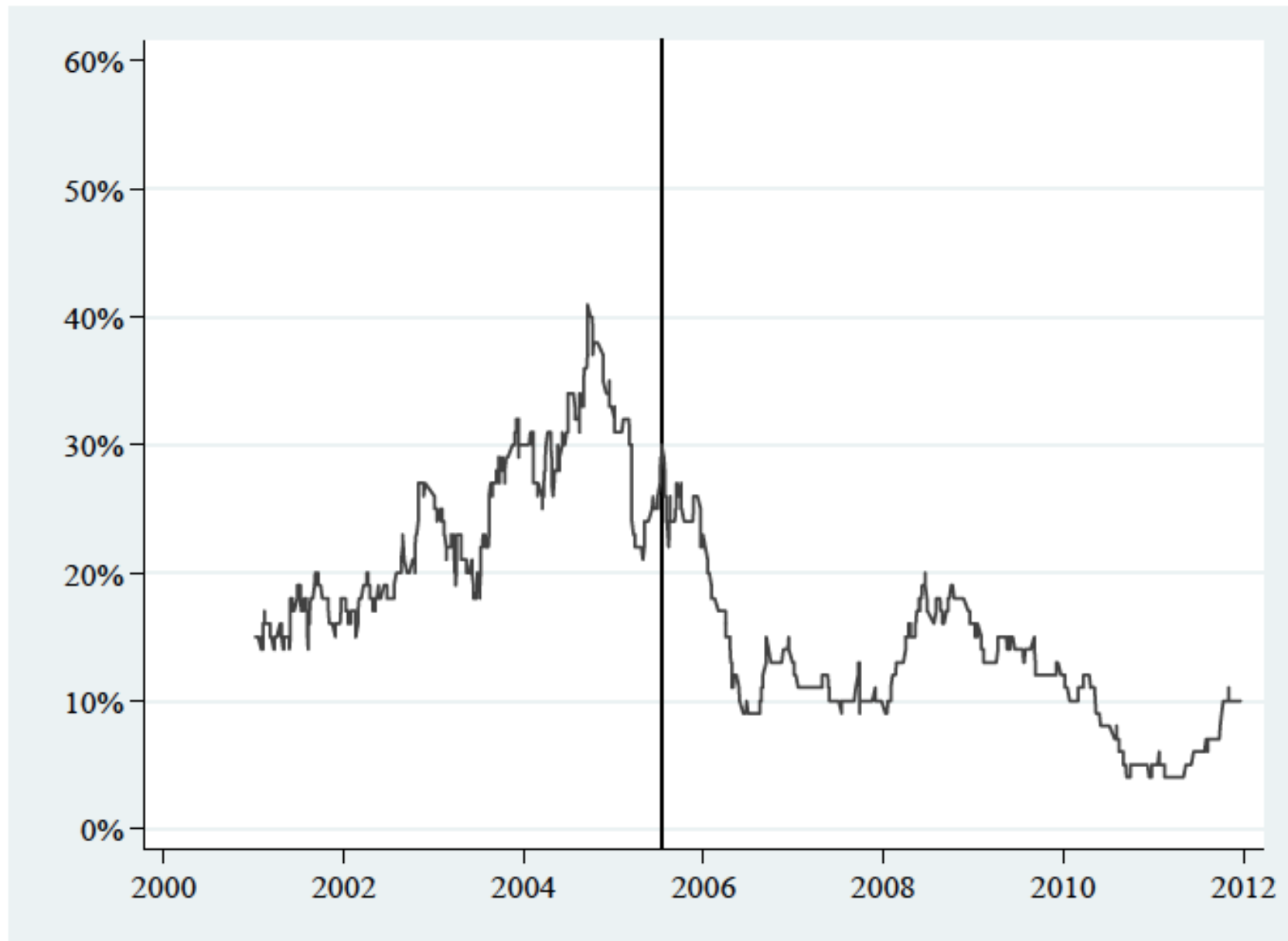




FIGURE 7: USE OF EXPERT EVIDENCE  
(100 TERM ROLLING AVERAGE)

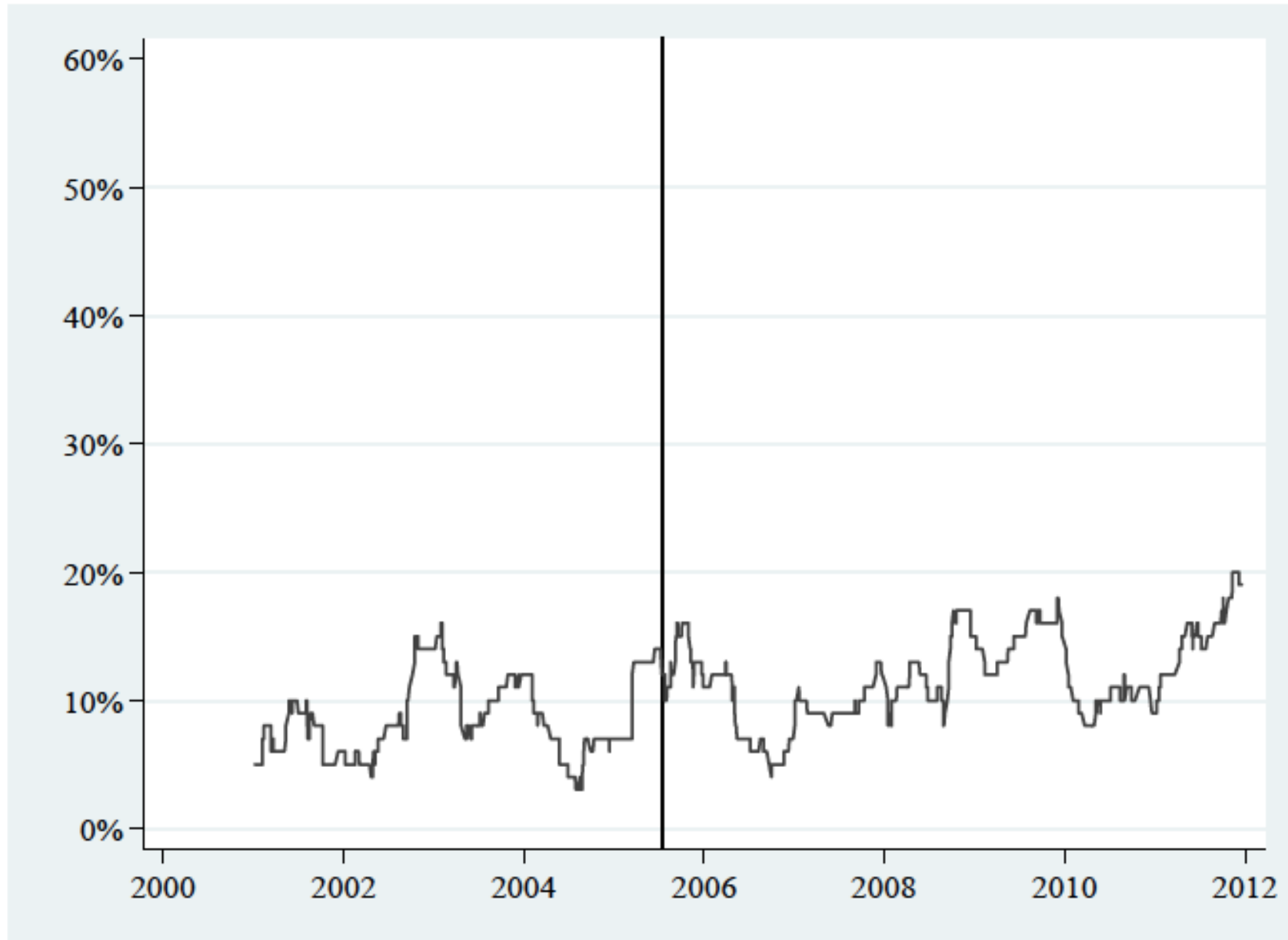




FIGURE 2: REVERSAL RATE—PER-CLAIM-TERM BASIS  
(100 TERM ROLLING AVERAGE)

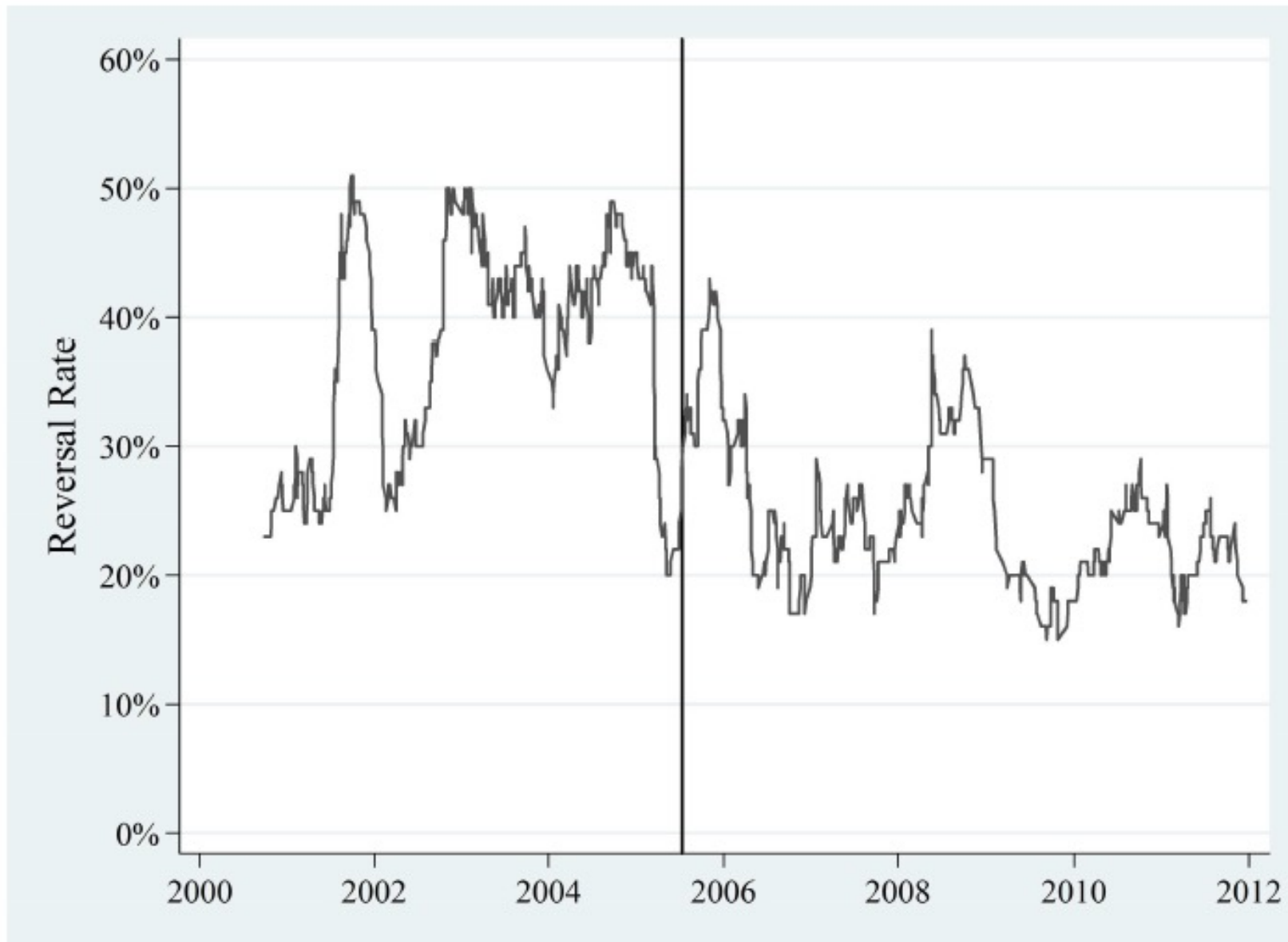




CHART 1: PERCENTAGE OF REVERSAL VOTES BY JUDGE

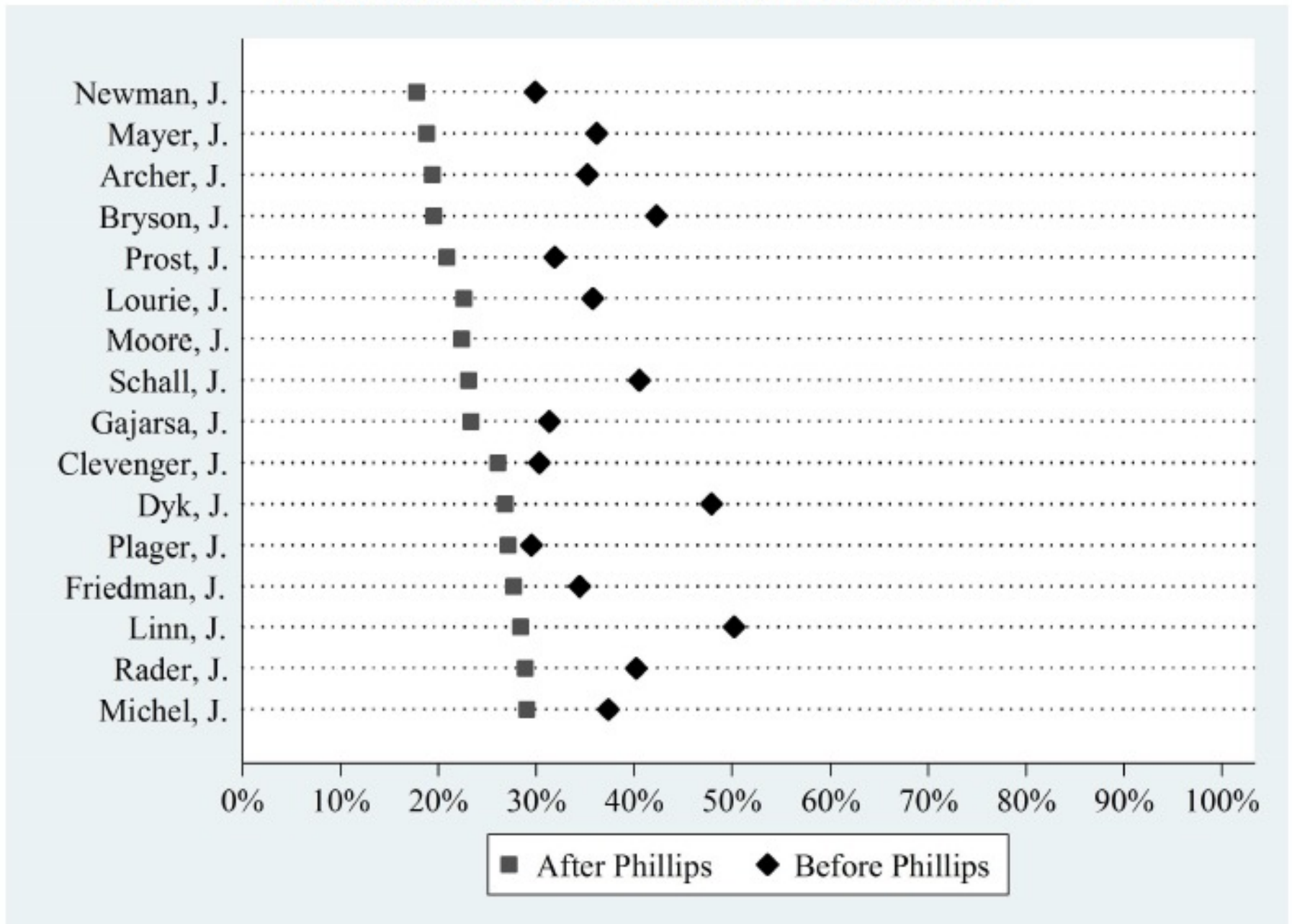
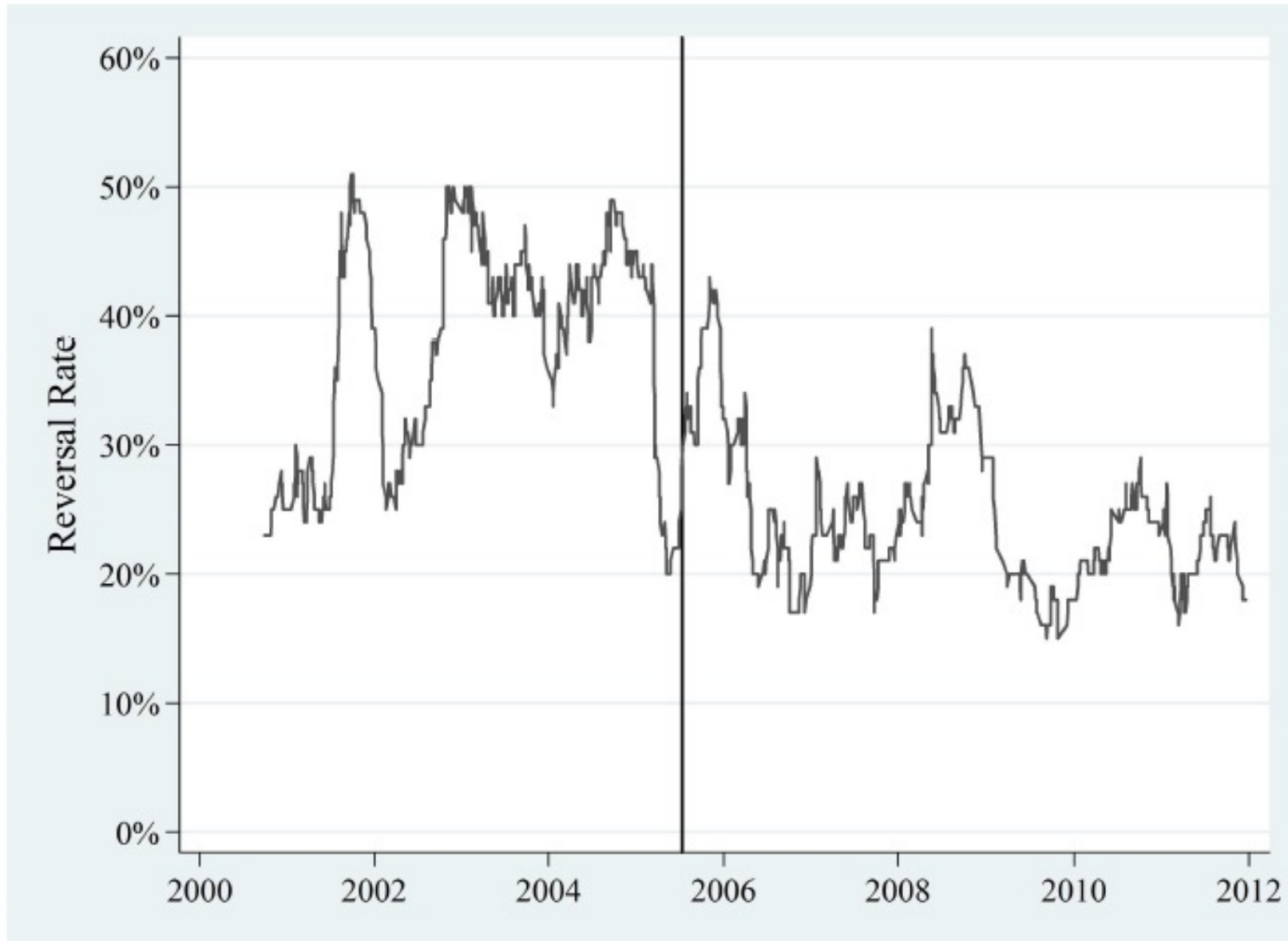




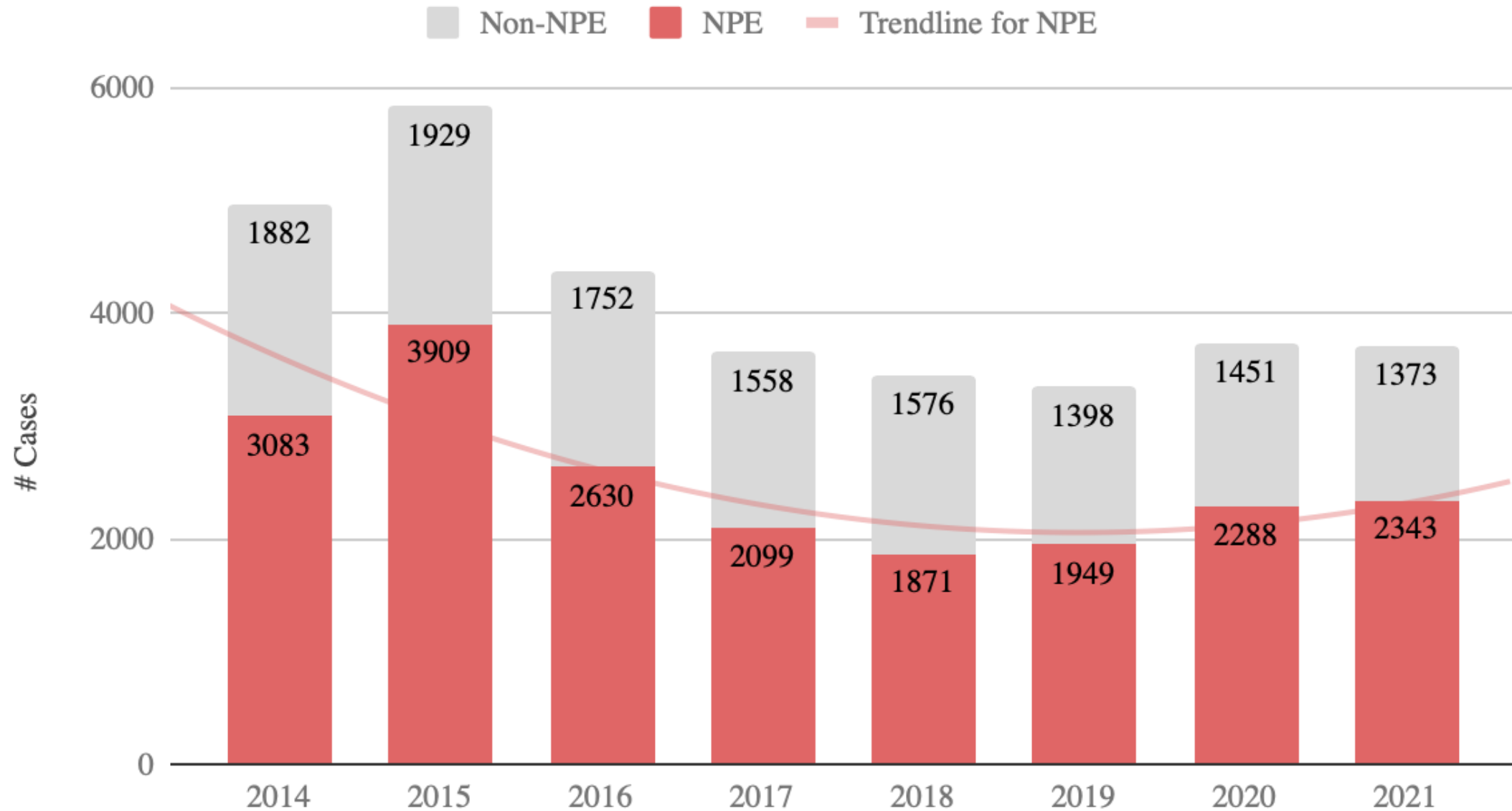
FIGURE 2: REVERSAL RATE—PER-CLAIM-TERM BASIS  
(100 TERM ROLLING AVERAGE)







# District Court Litigation: Year-by-Year

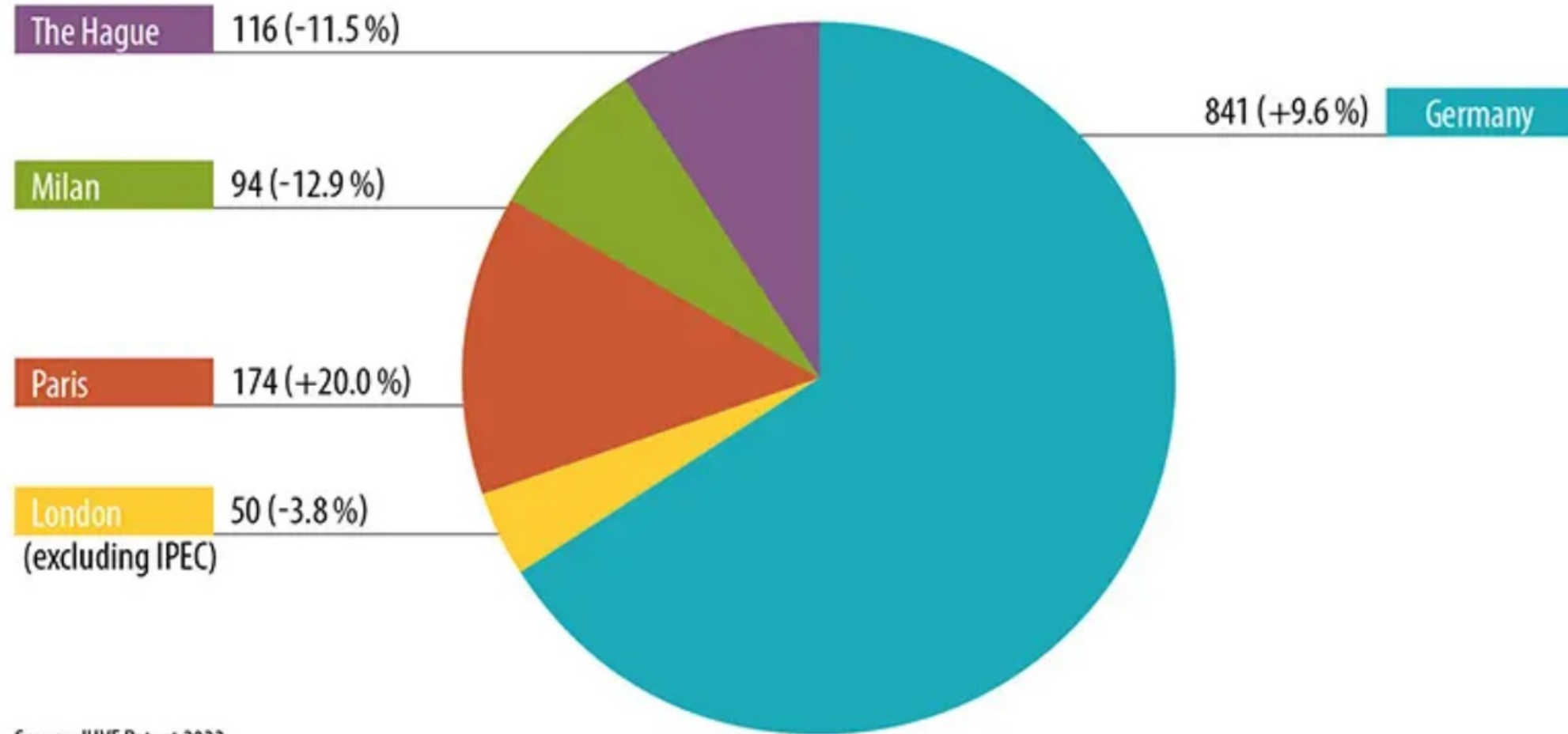


Source: <https://www.unifiedpatents.com/insights/2022/1/3/2021-patent-dispute-report-year-in-review>



# Germany and France buck the trend

Among the important patent locations in Europe only Germany and France recorded an overall increase in the number of new patent lawsuits.



Source: JUVE Patent 2022

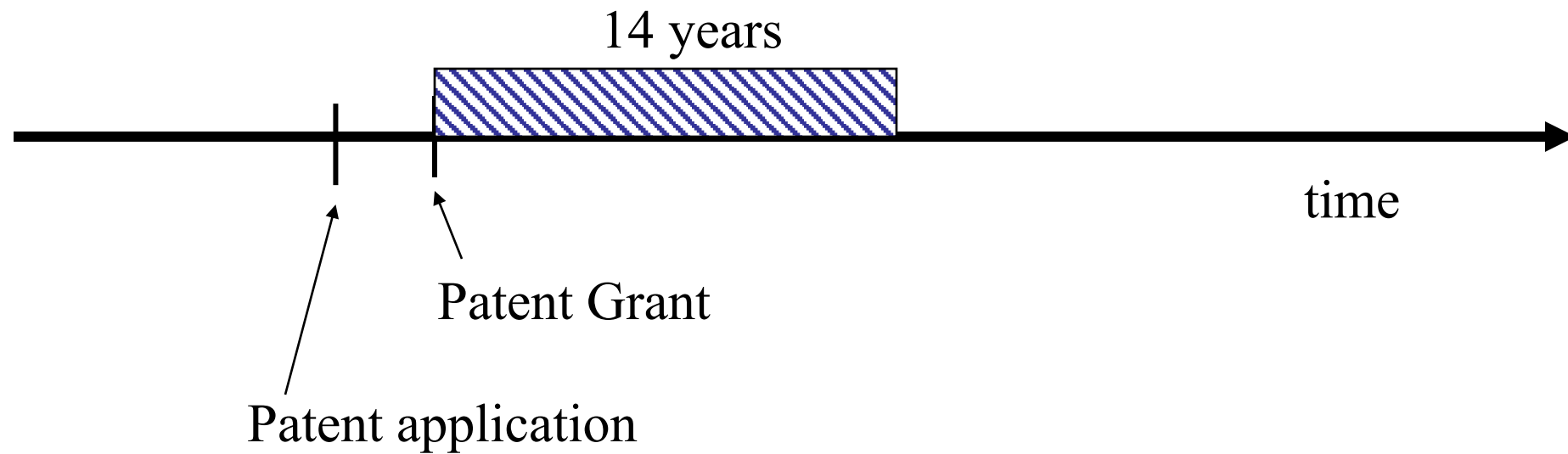


## European Patent Convention Art. 69 (original form)

“The extent of the protection conferred by a European patent or a European patent application shall be determined by the terms of the claims. Nevertheless, the description and drawings shall be used to interpret the claims.”

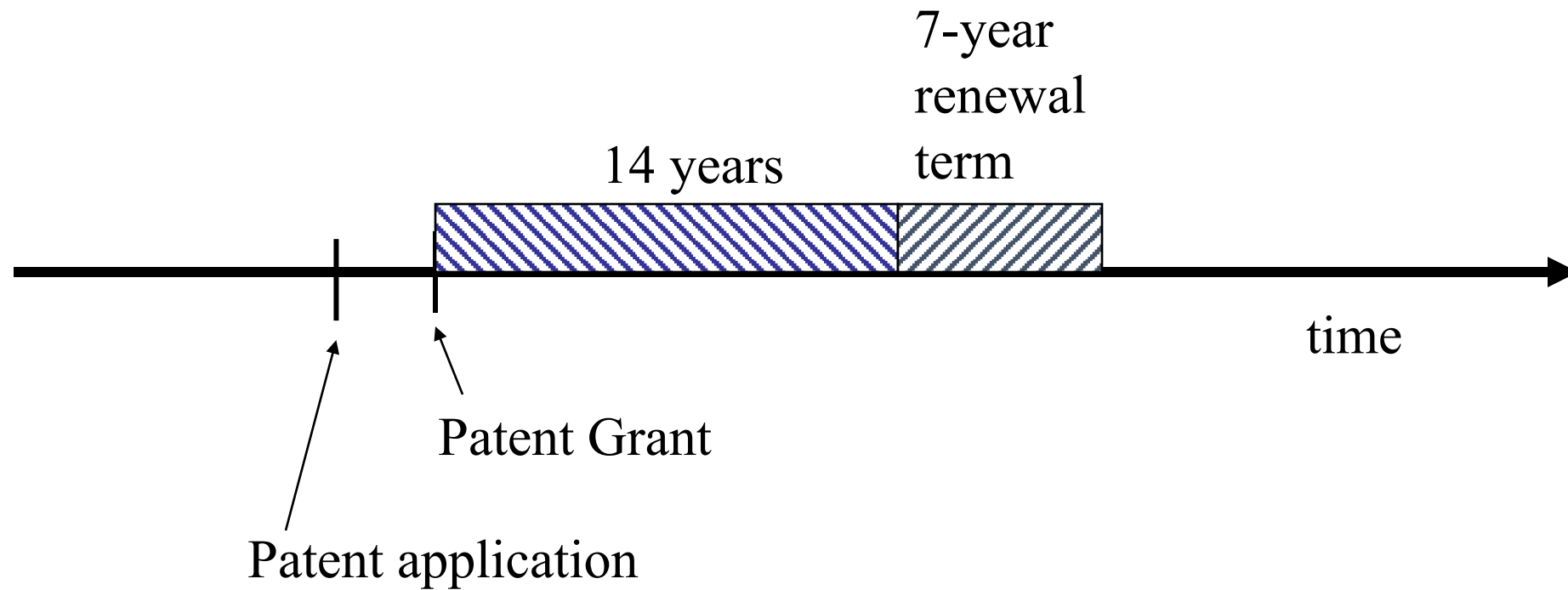


# Duration of Utility Patents, 1791-1836



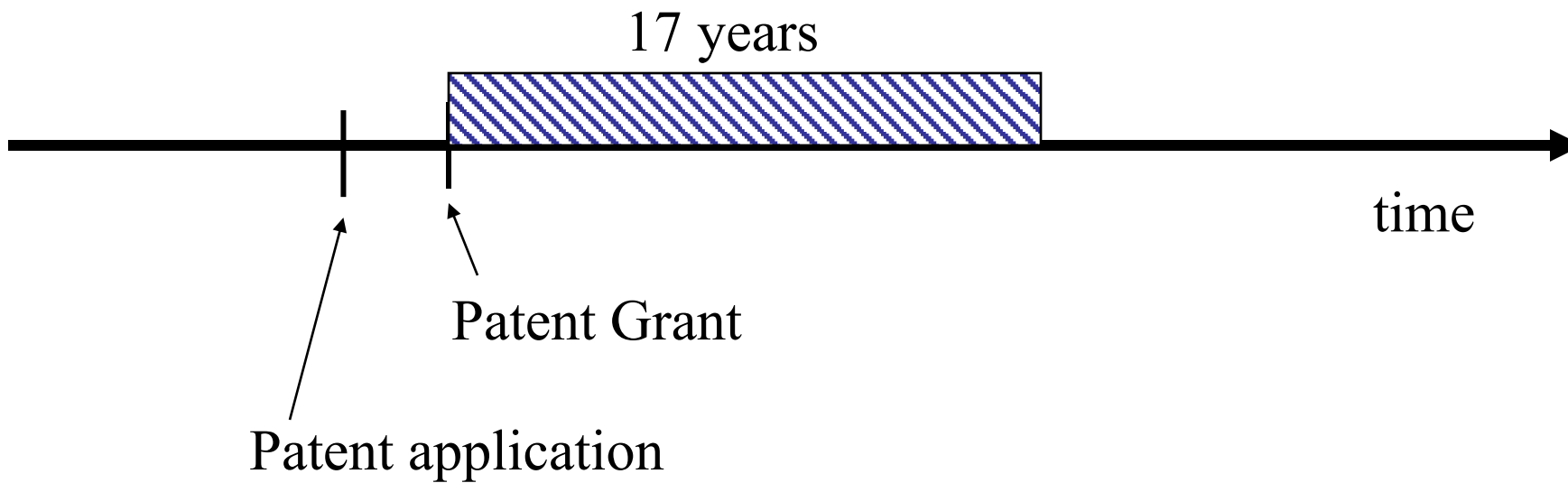


# Duration of Utility Patents, 1836-1861



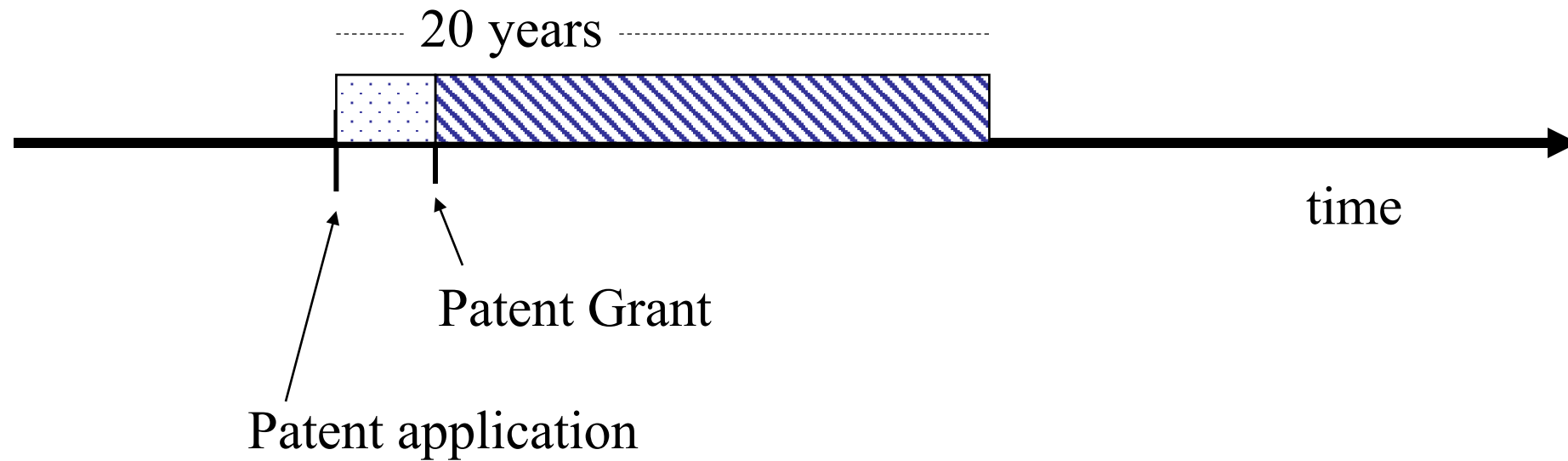


# Duration of Utility Patents, 1861-1995





# Duration of Utility Patents, 1995-present





# Duration of Utility Patents, 1995-present

Referenced continuation application ( § 120)

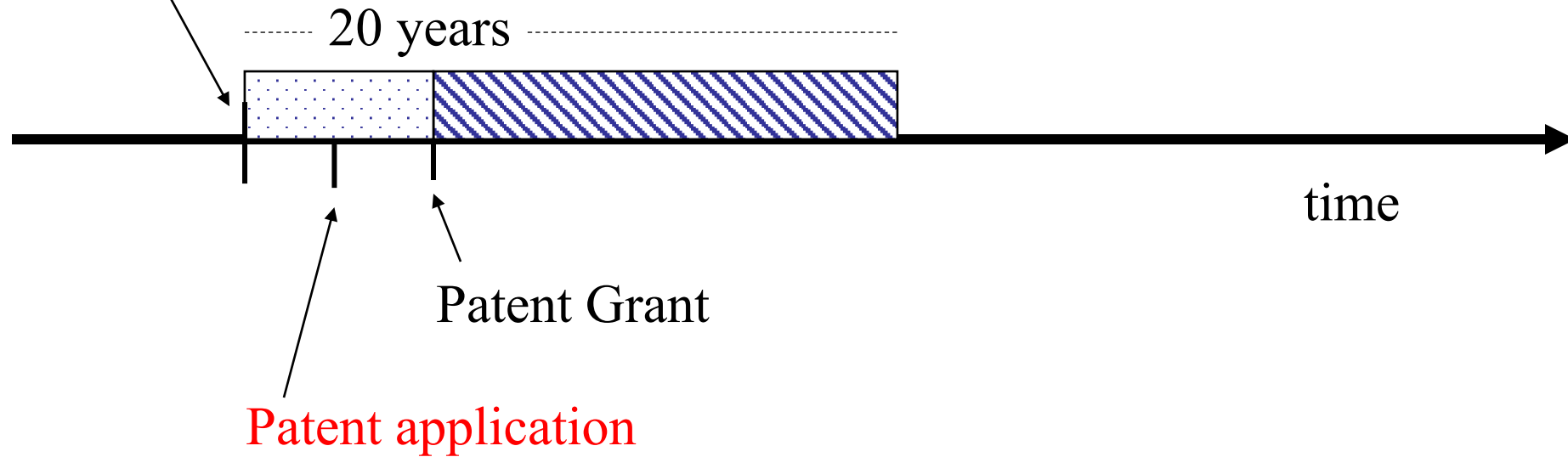






# Duration of Utility Patents, 1995-present

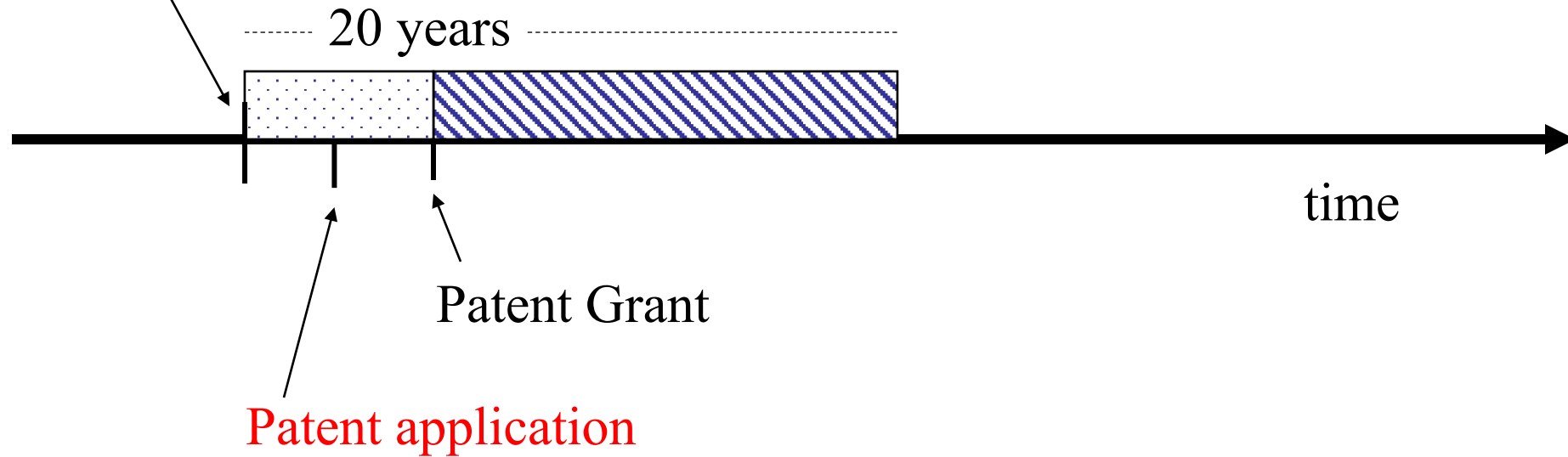
Referenced divisional application ( § 121)





# Duration of Utility Patents, 1995-present

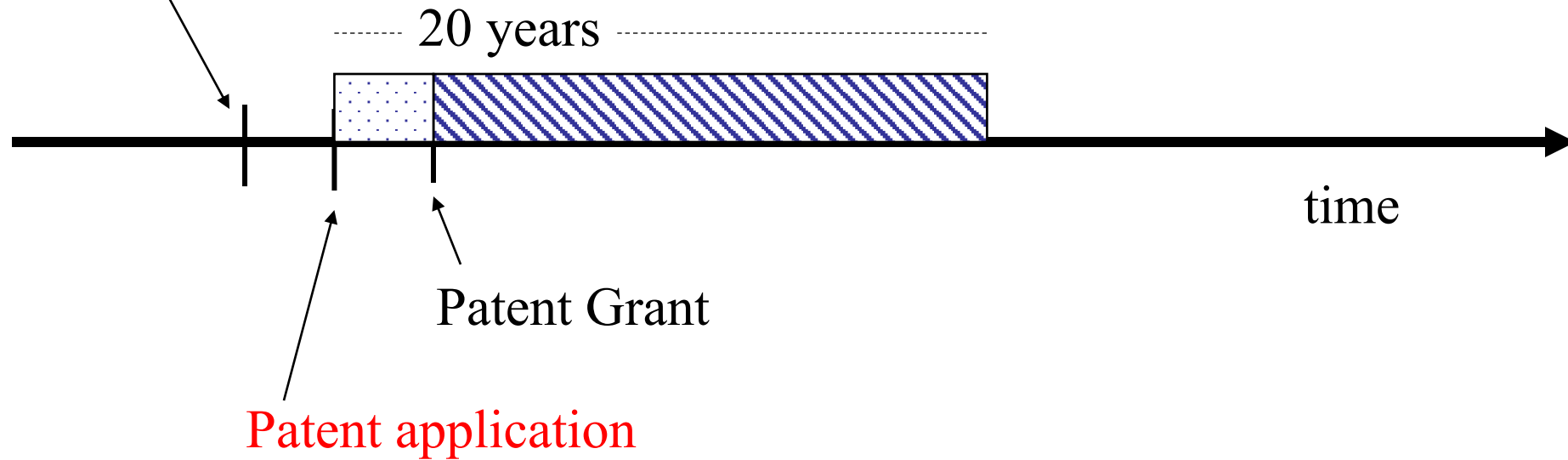
Referenced PCT application naming U.S. ( § 365(c))





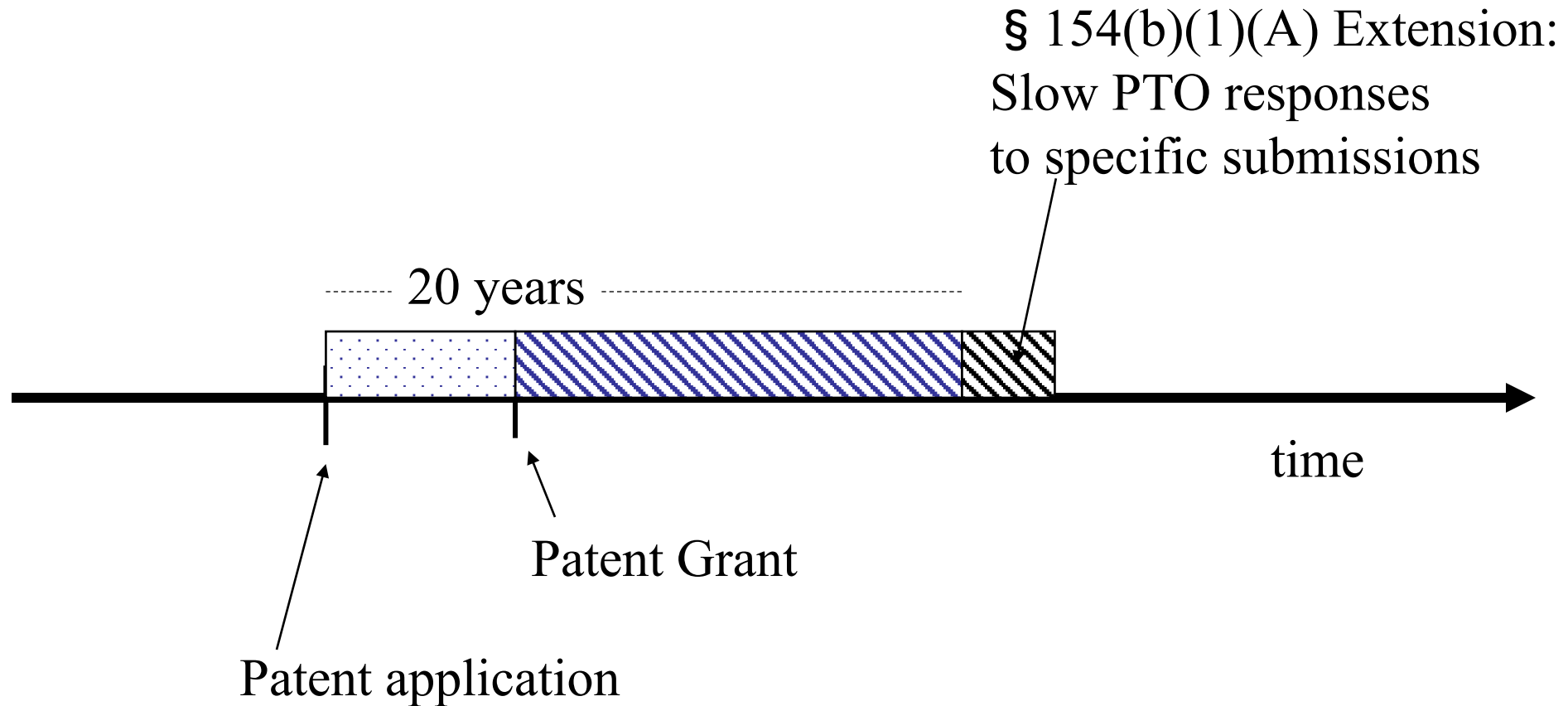
# Duration of Utility Patents, 1995-present

Referenced Paris-Convention application ( § 119)



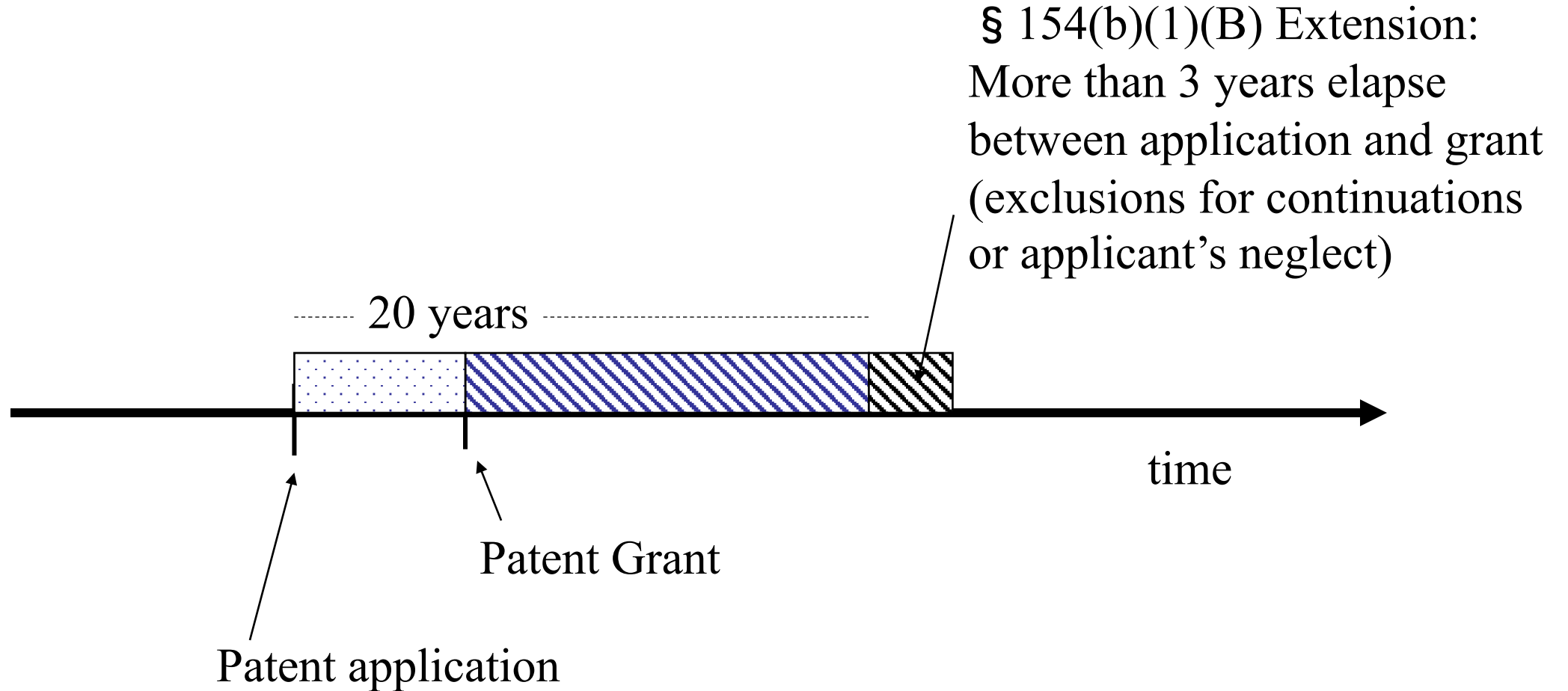


# Duration of Utility Patents, 1995-present



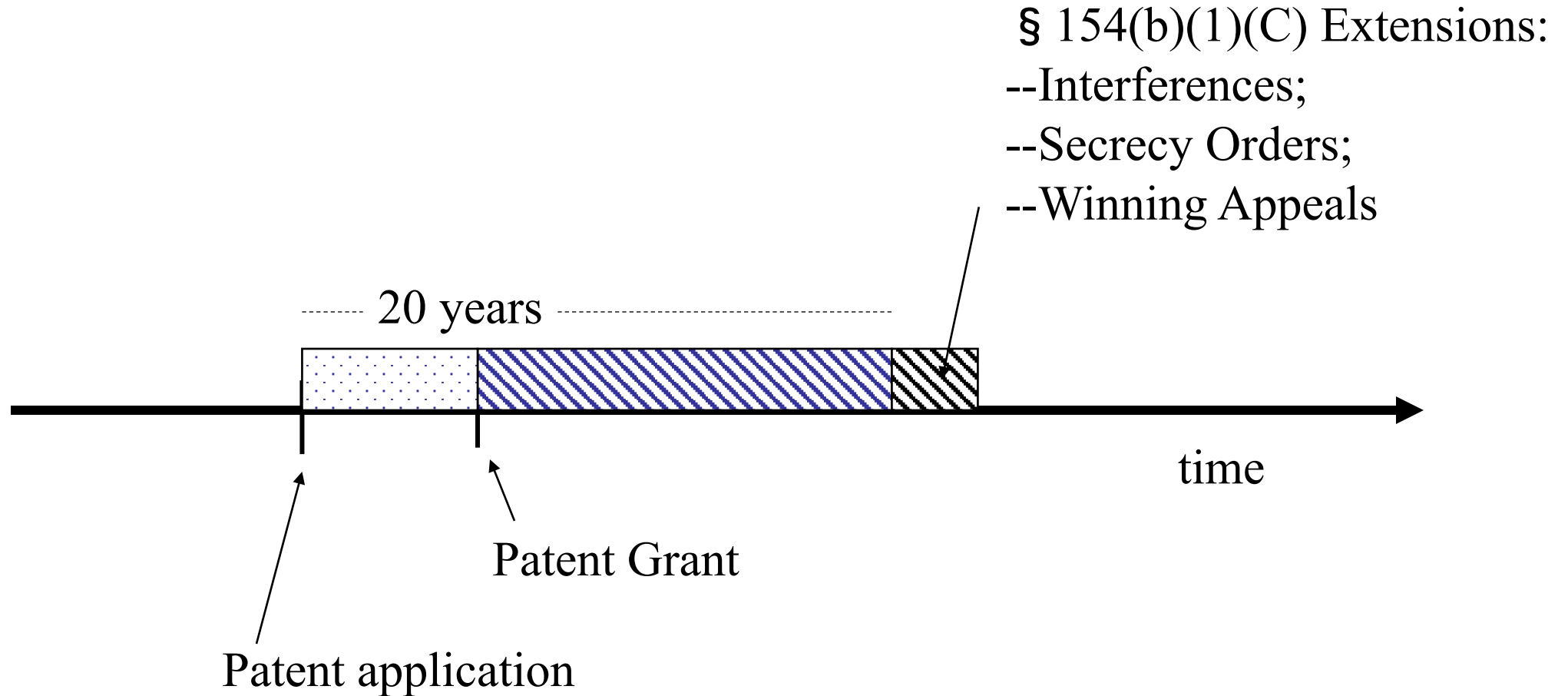


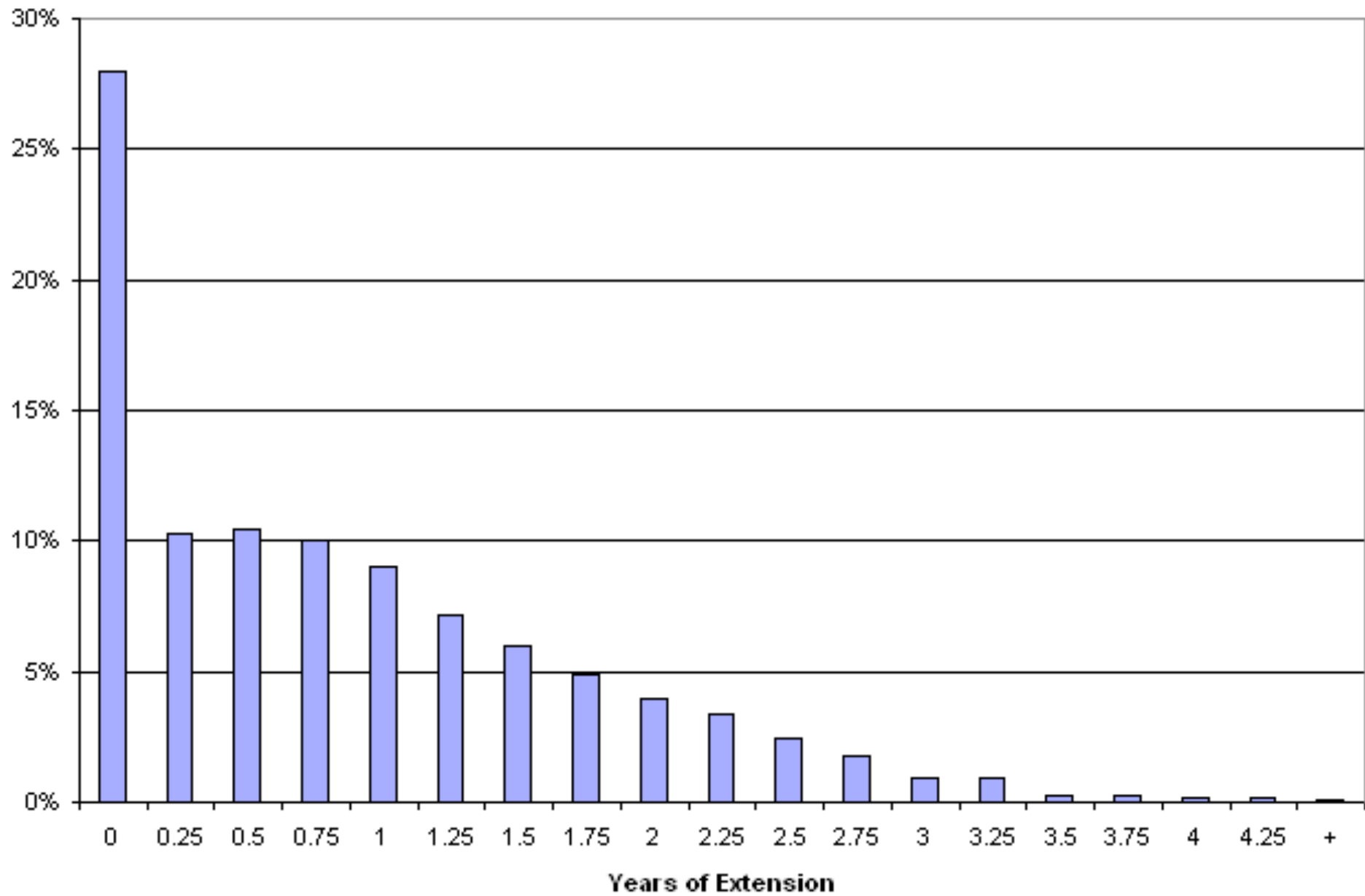
# Duration of Utility Patents, 1995-present





# Duration of Utility Patents, 1995-present

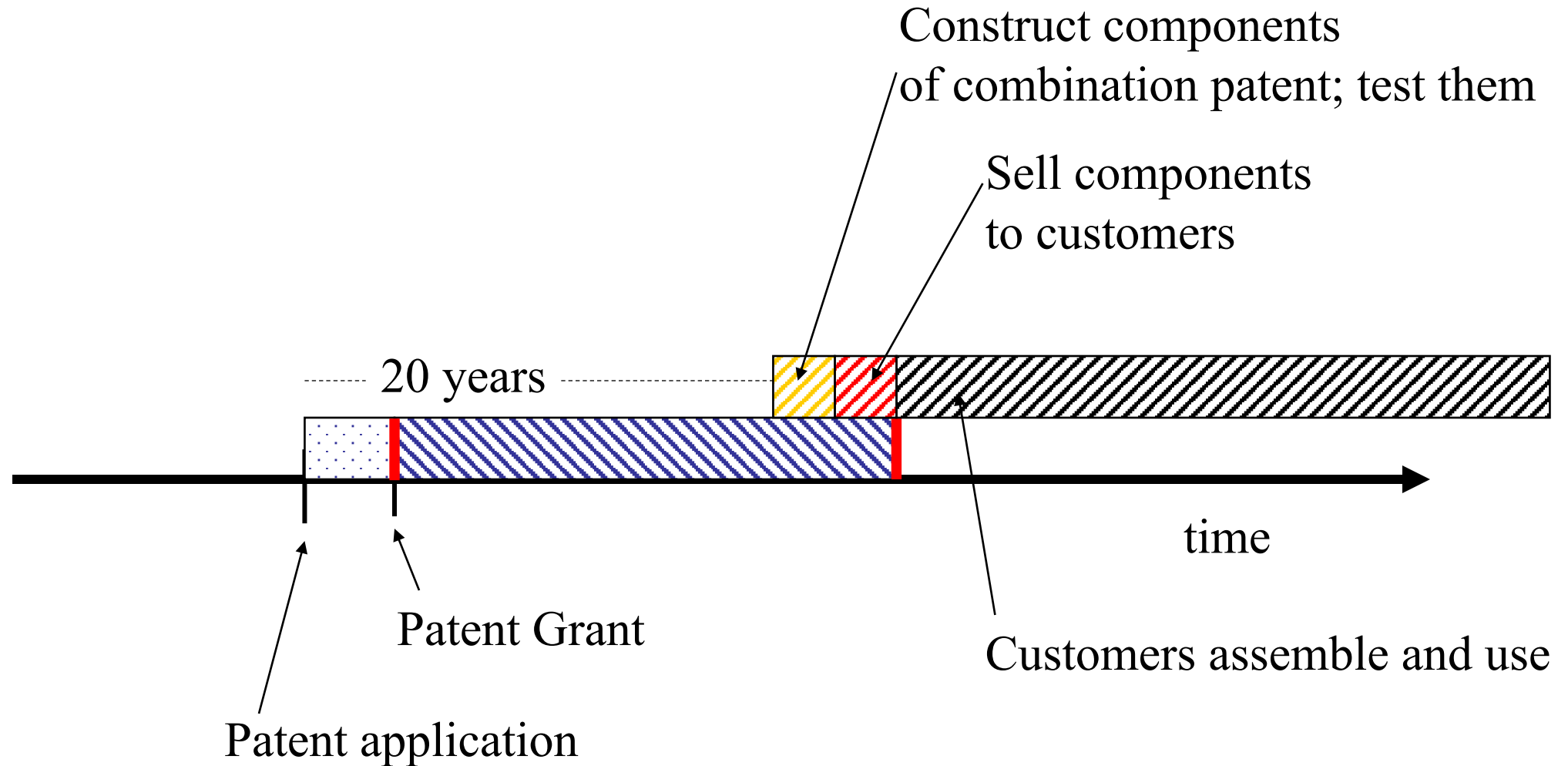




Source: Patently-O, 3/14/2008, <http://patentlaw.typepad.com/>



# Duration of Utility Patents



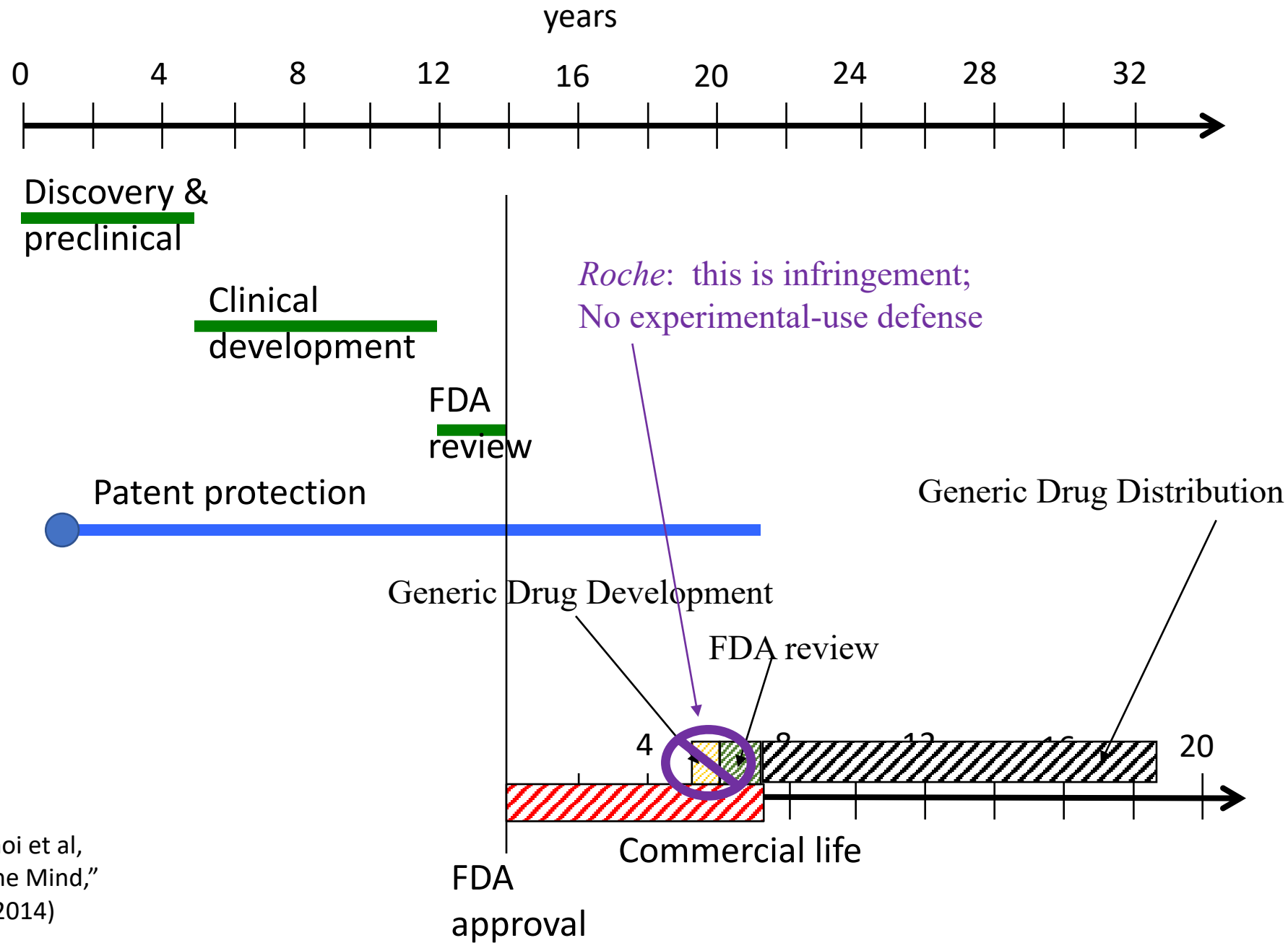




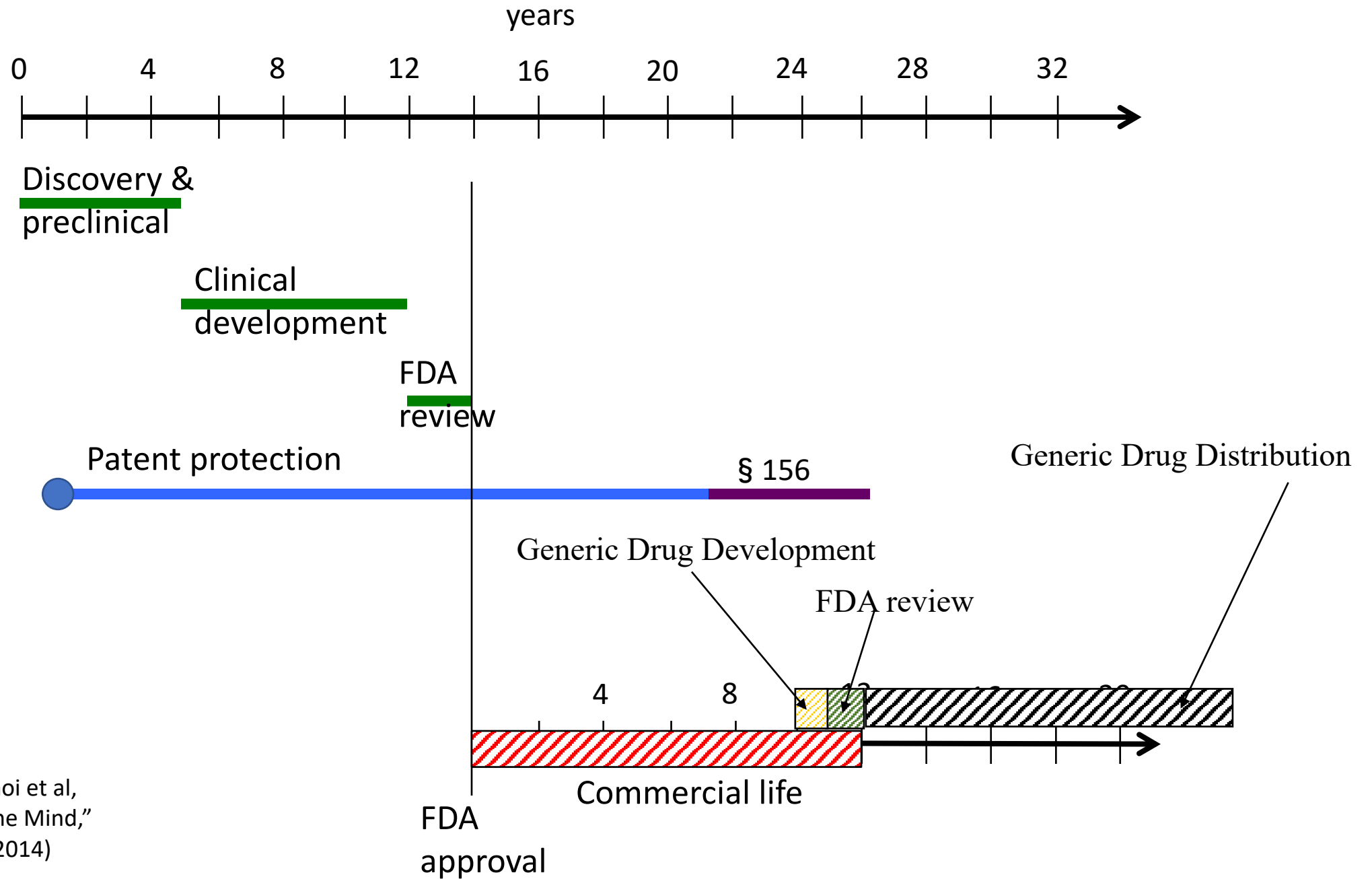
## Paper Converting Machine (CAFC 1984)

“It is undisputed that Magna-Graphics intended to finesse Paper Converting out of the sale of a machine on which Paper Converting held a valid patent during the life of that patent. Given the amount of testing performed here, coupled with the sale and delivery during the patent-term of a ‘completed’ machine (completed by being ready for assembly and with no useful noninfringing purpose), we are not persuaded that the district court committed clear error in finding that the Magna-Graphics' machine infringed the ... patent.

“To reach a contrary result would emasculate the congressional intent to prevent the making of a patented item during the patent's full term of 17 years. If without fear of liability a competitor can assemble a patented item past the point of testing, the last year of the patent becomes worthless whenever it deals with a long lead-time article. Nothing would prohibit the unscrupulous competitor from aggressively marketing its own product and constructing it to all but the final screws and bolts, as Magna-Graphics did here.”



Adapted from Choi et al,  
"Medicines for the Mind,"  
84 Neuron 554 (2014)

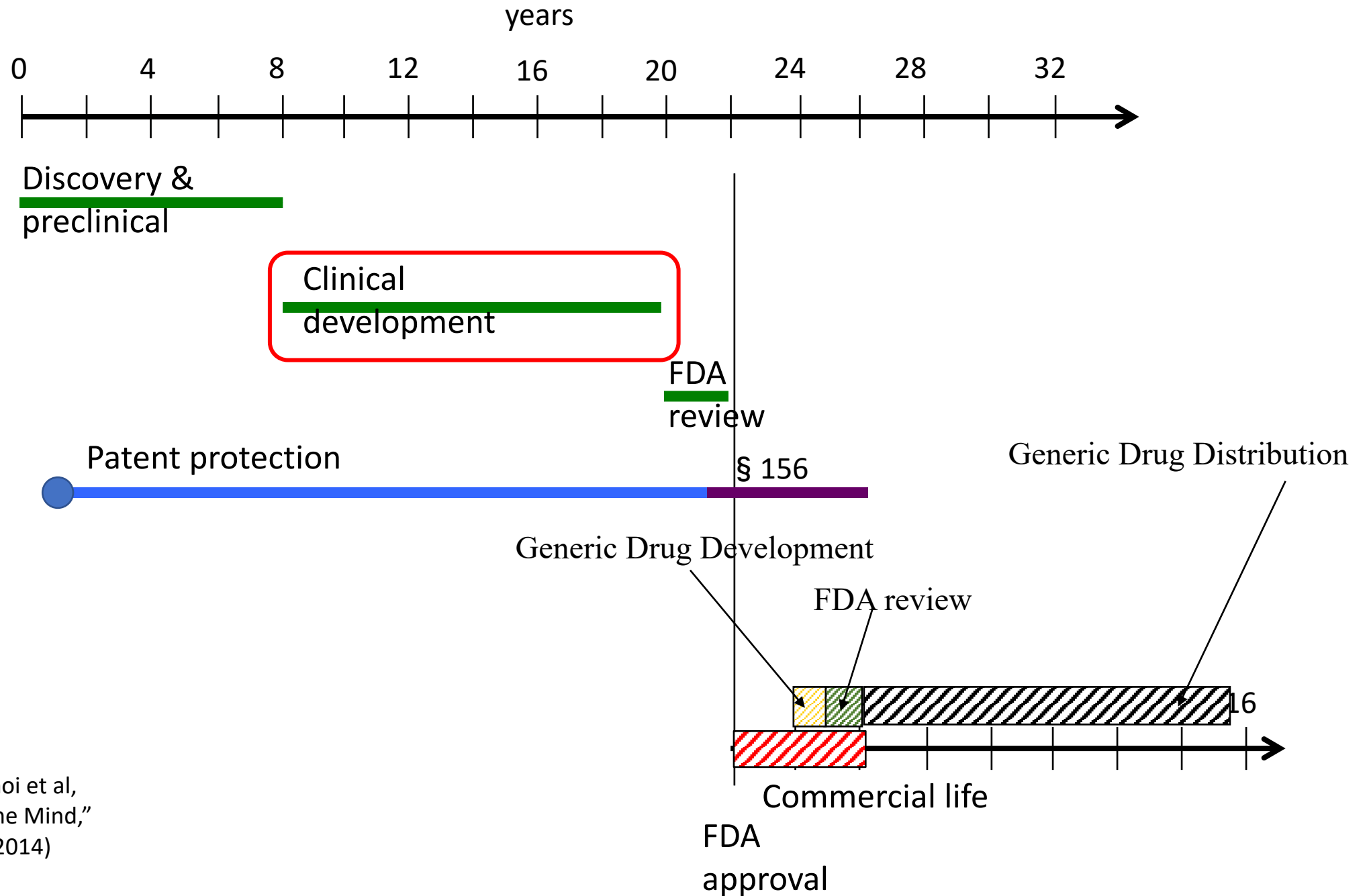


Adapted from Choi et al,  
"Medicines for the Mind,"  
84 Neuron 554 (2014)



# Key provisions of Hatch-Waxman Act (1984)

- Extension of patent term to offset FDA approval process – up to 5 years, but no further than 14 years from date of FDA approval ( § 156)
- No liability for making, using, or selling “a patented invention” “solely for uses reasonably related to the development and submission of information” to FDA ( § 271(e)(1))
- Abbreviated New Drug Application procedure (ANDA) for seeking FDA approval for generic equivalent of FDA-approved drug ( § 271(e)(2)).  
Applicant must show:
  - A. Bioequivalence of the generic and the pioneer drug
  - B. No patent impediment to commercial distribution of the generic version
    - 1) The drug at issue has not been patented
    - 2) The patent on the drug has expired
    - 3) Identify the date on which the patent will expire
    - 4) The patent on the drug is invalid or will not be infringed by the generic

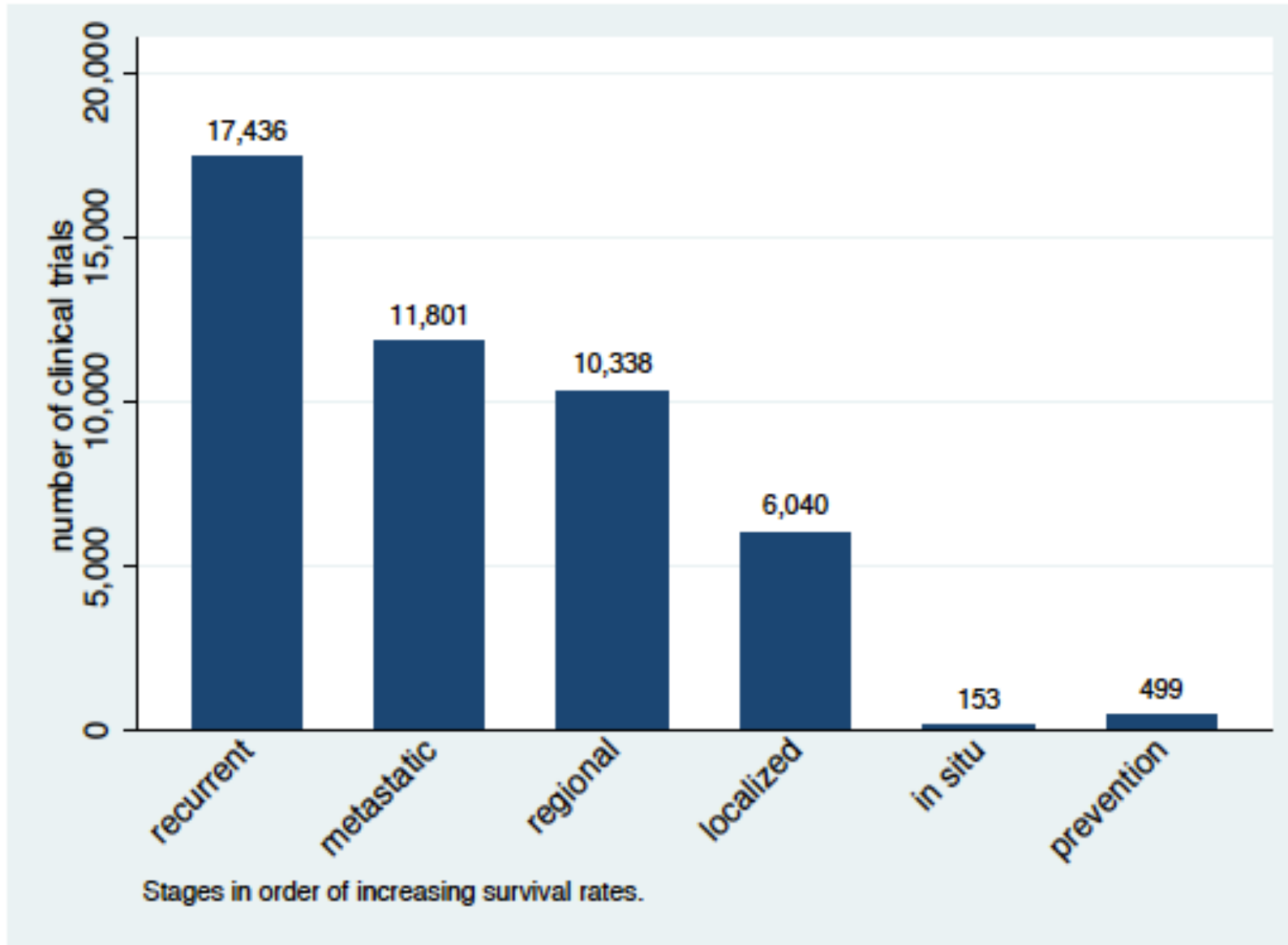


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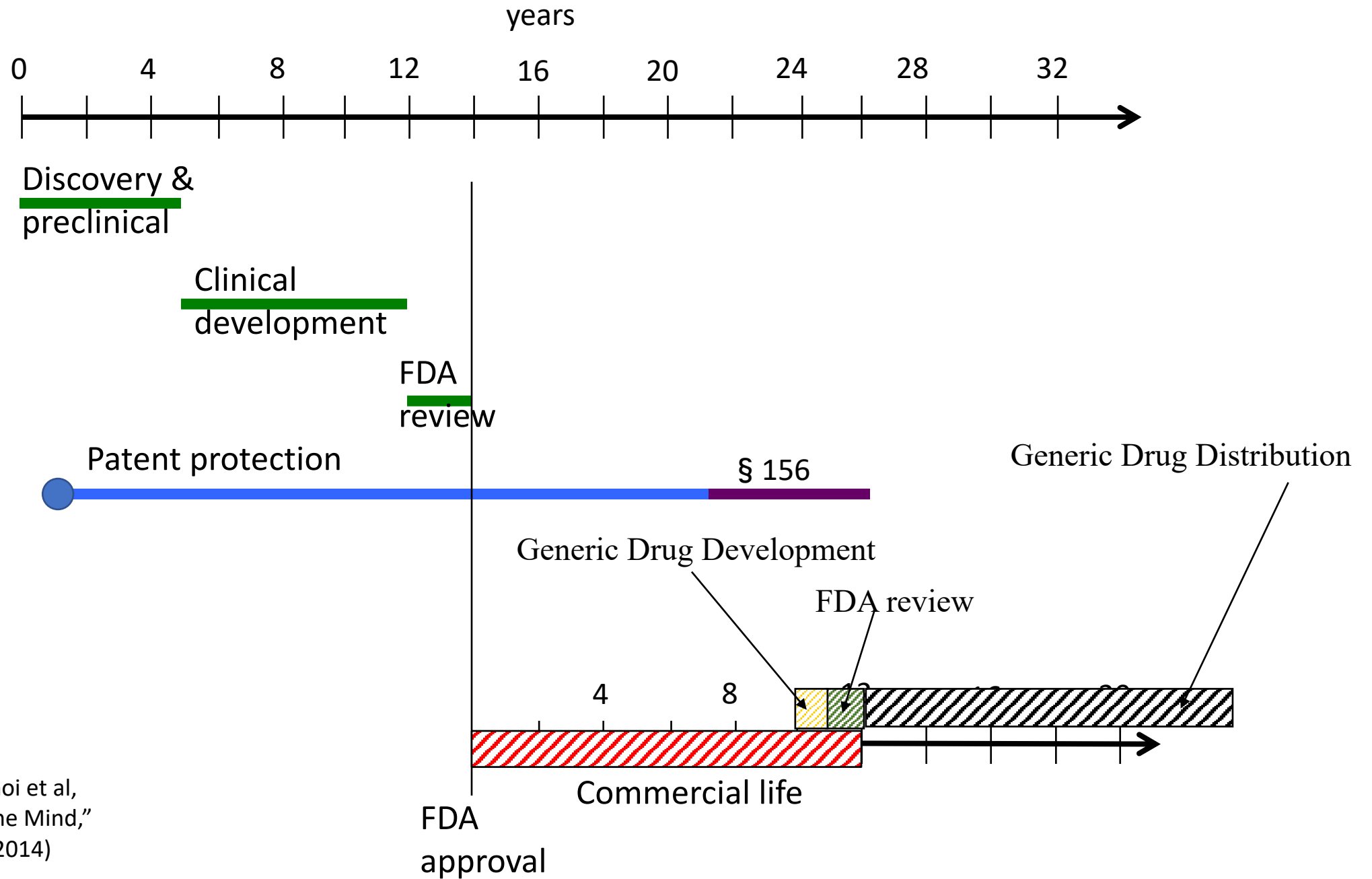
**Table 1. CNS Program Portfolios in Large Pharma: 2009 versus 2014**

	2009	2014
Total Programs	267	129
Abbott/AbbVie	17	10
AstraZeneca	21	7
Bristol-Myers Squibb	12	2
GlaxoSmithKline	40	14
Johnson & Johnson	18	17
Lilly	16	9
Merck/Schering-Plough	32	7
Novartis	14	15
Pfizer/Wyeth	46	15
Roche/Genentech	22	21
Sanofi/Genzyme	29	12



estimated impact of this distortion:  
890,000 lost life years  
(in the United States alone) among patients diagnosed in a single year

(b) R&D investments by stage

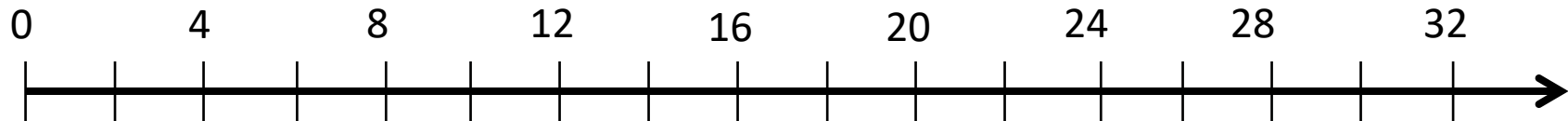


Adapted from Choi et al,  
"Medicines for the Mind,"  
84 Neuron 554 (2014)





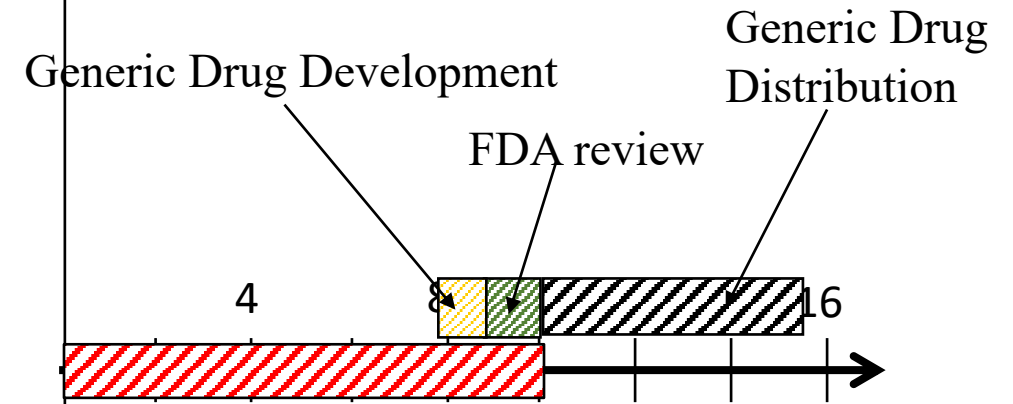
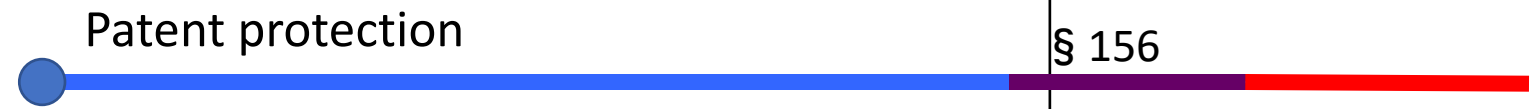
years



Typical duration of research and development of CNS drugs



FDA review



Commercial life  
FDA approval

Adapted from Choi et al, "Medicines for the Mind," 84 Neuron 554 (2014)