



Supreme Court Mandates Review of All Claims Challenged in Inter Partes Review at the Patent Office

Client Advisories

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Almost seven years ago, Congress passed the American Invents Act (“AIA”) that markedly changed the landscape of both substantive and procedural patent law in the United States. One of the major changes concerned challenges by third parties to issued patents, which challenges would be heard at the United States Patent and Trademark Office (“USPTO”) under what is called inter partes review (“IPR”).

IPR is a trial proceeding conducted at the USPTO’s Patent Trial and Appeal Board (“PTAB”) to review the patentability of one or more claims in an issued patent based on third party challenges, but only on the grounds of anticipation (novelty) or of obviousness, and then only with respect to prior art that was to be found in patents or printed publications. This week in its decision in the case of SAS Institute, Inc. v. Iancu, the United States Supreme Court decided an important aspect of procedure in IPR cases holding that once an inter partes review is instituted by the Director of the USPTO, the PTAB must decide the patentability of all of the claims challenged.

Why is this important?

First, the background: Complementsoft obtained US Patent 7,110,936 on a System and Method for Generating and Maintaining Software Code (with its first page shown below) having sixteen issued claims.



US007110936B2

(12) **United States Patent**
Hiew et al.

(10) **Patent No.:** US 7,110,936 B2
(45) **Date of Patent:** Sep. 19, 2006

(54) **SYSTEM AND METHOD FOR GENERATING AND MAINTAINING SOFTWARE CODE**

(75) Inventors: **Fen Hiew**, Mendota Heights, MN (US);
Edwin M. Schroeder, Chicago, IL (US)

(73) Assignee: **Complementsoft LLC**, Chicago, IL (US)

(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 923 days.

(21) Appl. No.: **09/992,624**

(22) Filed: **Nov. 19, 2001**

(65) **Prior Publication Data**

US 2005/0229154 A1 Oct. 13, 2005

Related U.S. Application Data

(60) Provisional application No. 60/270,950, filed on Feb. 23, 2001, provisional application No. 60/293,854, filed on May 25, 2001.

(51) **Int. Cl.**
G06F 9/45 (2006.01)

(52) **U.S. Cl.** **703/22; 703/26; 717/100; 717/108; 717/134; 717/135**

(58) **Field of Classification Search** **703/22; 717/108, 100, 134, 135; 345/700**
See application file for complete search history.

(56) **References Cited**

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5,187,788 A 2/1993 Marmelstein
5,485,615 A 1/1996 Wennmyr

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OTHER PUBLICATIONS

"Language Independent Generation of graphical Representations of Source Code", Hendrix et al, ACM 0-89791-737-5, ACM 1995.*

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Primary Examiner Fred Ferris

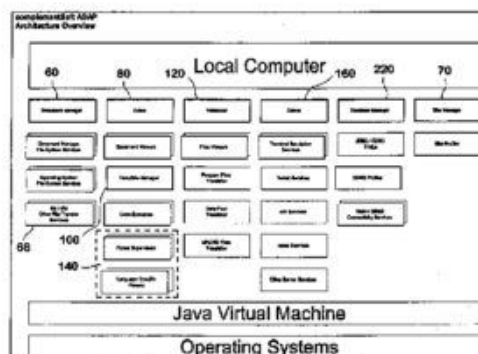
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(57) **ABSTRACT**

A system and method for intelligently generating computer code. The system being comprised of a local computer, which is connected to a remote computer via a network system or the Internet and which is capable of exchanging files with the remote computer. The local computer is further comprised of a document manager for transferring files between the local computer and the remote computer and for providing enhanced file management functions. The document manager works in connection with the server module, the site manager and the connectivity layer to connect to remote computers, to transparently exchange files with the remote computer and to manage server profiles and connection information that is related to remote computers and transferred files. Once the file is transferred to the local computer, the editor can modify the code associated with the file; the editor is also capable of creating new files. The visualizer is capable of displaying a program flow diagram and a data flow diagram, which are comprised of program flow icons and data flow arrows to depict the code in terms of processing blocks and data blocks. To assist in developing new code or editing existing code, the template manager allows the user to browse through a directory of existing code sections or templates and to copy templates into the selected code for editing. For allowing the editor to process code that is written in different Data Management System programming languages and for creating the program flow icons, the parser layer detects the file type of a selected file and activates the rules and logic that apply to the corresponding Data Management System.


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16 Claims, 42 Drawing Sheets



SAS challenged all sixteen claims, and the USPTO Director found a “reasonable likelihood that [SAS] would prevail with respect to at least one of the claims challenged” as the IPR statute requires, but chose to institute review on only claims 1 and 3-10 of the ’936 Patent. In the IPR proceeding, the PTAB found eight of these nine claims unpatentable; SAS appealed, saying that the USPTO Director lacks discretion to institute review of only some of the claims challenged, once the reasonable likelihood has been established. Justice Gorsuch, writing for the majority of the Court, agreed, saying;

“When the Patent Office initiates an inter partes review, must it resolve *all* of the claims in the case, or may it choose to limit its review to only *some* of them? The statute, we find, supplies a clear answer: the Patent Office must ‘issue a final written decision with respect to the patentability of *any* patent claim challenged by the peti

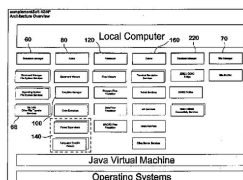


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<p>(12) United States Patent Hiew et al.</p> <p>(54) SYSTEM AND METHOD FOR GENERATING AND MAINTAINING SOFTWARE CODE</p> <p>(75) Inventors: Fen Hiew, Mendota Heights, MN (US); Edwin M. Schroeder, Chicago, IL (US)</p> <p>(73) Assignee: CompuLink LLC, Chicago, IL (US)</p> <p>(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 923 days.</p> <p>(21) Appl. No.: 09/992,624</p> <p>(22) Filed: Nov. 19, 2001</p> <p>(65) Prior Publication Data US 2005/0229154 A1 Oct. 13, 2005</p> <p>Related U.S. Application Data</p> <p>(60) Provisional application No. 60/270,950, filed on Feb. 23, 2001; provisional application No. 60/293,854, filed on May 25, 2001.</p> <p>(51) Int. Cl. G06F 9/45 (2006.01)</p> <p>(52) U.S. Cl. 703/22; 703/26; 717/100; 717/108; 717/134; 717/135</p> <p>(58) Field of Classification Search 703/22; 717/108; 100, 134, 135; 345/700 See application file for complete search history.</p> <p>(56) References Cited U.S. PATENT DOCUMENTS 5,187,788 A 2/1993 Marmelstein 5,485,615 A 1/1996 Weanmyr</p>	<p>(10) Patent No.: US 7,110,936 B2</p> <p>(45) Date of Patent: Sep. 19, 2006</p> <p>FOREIGN PATENT DOCUMENTS JP 1001338 A2 5/2000 (Continued)</p> <p>OTHER PUBLICATIONS "Language Independent Generation of graphical Representations of Source Code", Hendrix et al., ACM 0-89791-737-5, ACM 1995." (Continued)</p> <p>Primary Examiner: Fred Ferris (74) Attorney, Agent, or Firm: Gary R. Janssik</p> <p>(57) ABSTRACT A system and method for intelligently generating computer code. The system being comprised of a local computer, which is connected to a remote computer via a network system or the Internet and which is capable of exchanging files with the remote computer. The local computer is further comprised of a document manager for transferring files between the local computer and the remote computer and for providing enhanced file management functions. The document manager works in connection with the server module, the site manager and the connectivity layer to connect to remote computers, to transparently exchange files with the remote computer and to manage server profiles and connection information that is related to remote computers and transferred files. Once the file is transferred to the local computer, the editor can modify the code associated with the file; the editor is also capable of creating new files. The visualizer is capable of displaying a program flow diagram and a data flow diagram, which are comprised of program flow icons and data flow arrows to depict the code in terms of processing blocks and data blocks. To assist in developing new code or editing existing code, the template manager allows the user to browse through a directory of existing code sections or templates and to copy templates into the selected code for editing. For allowing the editor to process code that is written in different Data Management System programming languages and for creating the program flow icons, the parser layer detects the file type of a selected file and activates the rules and logic that apply to the corresponding Data Management System.</p>
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Attachments

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