



Federal Circuit Affirms PTO Finding that Claims of Morsa Patent Application are Anticipated by Press Release Reference

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By: Rachel J. Elsby

The pertinent claims of the '228 Application are directed to a benefit information match mechanism. In comparing the claims of the '228 Application to the prior art reference, the court found that each of the four limitations map directly to the reference. The court further found the specification of the '228 Application disclosed that a skilled artisan at the time would have understood how to use central processing units and memories to process requests for benefit information, and that the system claimed in the patent could be implemented by any programmer of ordinary skill using commercially available tools. Because the reference disclosed the claim limitations and the specification indicated that one of ordinary skill would be capable of programming the invention, the court held the board correctly concluded the reference was enabling.

Chief Judge Prost wrote for a majority of the panel. Judge Newman issued a dissenting opinion in which she challenged the determinations of the majority as confusing “the laws of anticipation and obviousness and the role of enablement as applied to prior art references.” In particular, Judge Newman stated that it was improper for the board to take “Official Notice” of matter not disclosed in the prior art and equally improper for the majority to fill the gaps in the Board’s decision by relying on disclosures in the '228 Application.

In re: Steve Morsa, Case No. 2015-1107 (Fed. Cir. Oct. 19, 2015).

Categories

Federal Circuit

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