

U.S. PATENT CASE STUDY REPORT

Case 2: Anticipation /Novelty

Case Name: Catalina Marketing International, Inc V. Coolsavings.com,Inc.

1. Facts

It is a case where mob based coupon system to monitor and control the distribution of coupons conlisted by a competing claimant 07 similar system with specific sites such as retail stores are treated as non-obvious hence not entitled to patent.

2. Issues

1. Whether preamble can limit a substantive claim? In other words whether a preamble, which describes purpose and context of the invention constitute limitation over a claim?
2. Whether the intended claim be held to act as a limitation over the prior art claim.

The rule governing the issue established in terms of Gardiner's case is that describing the use of an invention in the preamble does not limit the claims. According to IMS Tech Inc. V. Haas Automation, it does not limit the claim scope. In Certain cases the case law seems to assert that new use need not be same use (Bristol Myers Case). In the instant case, the rejection of the claims by the examiner was on the basis that the location of the terminals in stores was not patent ablysignificant. The deletion by amendment of the preamble does not structurally change the intended use to distinguish their invention over the prior art.

3. Summary of rules or laws for each of the issues

Thus according to Roberts V. Ryer the inventor of a machine is entitled to the benefits of all the user to which it can be put , no matter whether he had conceived the idea of the use or not.

The assertion here is that the preamble cannot act as limitation on claims.

4. How court decide in each issue based on the fact

The court has applied the precedents on the issue more closely related to the facts and brought in functional distinction. The court held that the patentability is not impacted by the location of the device. Its assertion is that the preamble cannot be relied on to act as limitation.

5. Comments

The Case reflects how a simple issue amenable to a solution with a common sense perception has been perceived as a contestable one under patent law. The court has applied the interpretative technique to elicit the law and fine tuned it.