2026-2 Edition Content Highlights

Patents:

- New Treatment of Artificial Intelligence (AI) with a new chapter 3A dedicated to protection of AI inventions including related intellectual property as well as AI tools for creating patent applications and other intellectual property. See new Chapter 3A
- New Treatment of the USPTO's Artificial Intelligence (AI) Automated Search Pilot Program (ASAP!) for sharing the results of an AI automated search prior to patent examination in order to identify relevant prior art to improve examination quality and efficiency. See § 3A:10.
- New Treatment of the USPTO's revised office policy on Subject Matter Eligibility under 35 U.S.C. 101 including new discussion of the USPTO Director's Review decision in Ex Parte Desjardins as well as the Federal Circuit's decision in Enfish v. Microsoft, with both of these decisions overcoming objections to patentability based on abstract inventions being ineligible subject matter. See § 7:5.57.5
- New Treatment of the design claim drafting in light of the Federal Circuit's decision in Smartrend Manufacturing Group (SMG) v. Opti-Luxx, with the accompanying description of the drawings limiting the claim. See § 8:9
- New Treatment of USPTO's Streamlined Claim Set pilot program for utility patent applications with no more than one independent claim and no more than 10 total claims for expedited examination. See § 15:12.62
- New Treatment and Re-Formatting of the Chapter on Post Grant Proceedings before the USPTO including, Inter Partes Review (IPR), Post Grant Review (PGR), and Covered Business Method Review (CBM). The revised breakdown of sections shown in bold face in the table of contents is as follows:
  - — Introduction
  - — Inter Partes Review—Introductory Matters
  - — Inter Partes Review—Institution of Inter Partes Review_Petition for Inter Partes Review
  - — Inter Partes Review—After Decision to Institute IPR Proceeding_Scheduling Order_Responsive Pleadings
  - — Inter Partes Review_Federal Circuit Review of PTAB's Final Written Decisions for IPR Cases
  - — Post Grant Review
  - — Covered Business Method Review
  - — Director Review of PTAB Final Written Decisions

— Patent Trial and Appeal Board (PTAB) and Trial Practice before PTAB

— Appeals Review Panel (ARP) for review of PTAB ex parte appeals, re-examination appeals, and reissue appeals

New Treatment of the USPTO's new rules for instituting post-grant review of patents to focus on patent claims that have not previously challenged and to reduce the number of serial or parallel challenges—Revision to the Rules of Practice before the Patent Trial and Appeal Board. See § 15B:22.3

New Treatment of Director Institution of AIA Trial Proceedings, Memorandum, October 17, 2025. The Director in consultation with at least three PTAB judges will personally decide whether to institute trials in all Inter Partes Review (IPR) and Post Grant Review (PGR) proceedings. See § 15B:24.3

Revised Treatment of Remedies Held to be Unavailable in Inter Partes Review (IPR) Cases. See § 15B:45.3

New Treatment of expert testimony required to establish reasonable royalty rate in patent infringement litigation, including testimony required to establish the extent to which each infringed patent or patent application contributed to a lump sum license payment. See § 20:58

Trade Secrets, Trademarks, and Copyrights

- New treatment of the Federal Circuit's decision in IQE PLC v. Newport Fab, LLC broadening its jurisdiction to include appeals from denials of protection under California's anti-SLAPP law in district court cases. See § 4:6
- New treatment of the Federal Circuit's decision in Apex Bank v. CC Serve Corp. vacating the Trademark Trial & Appeal Board's overly narrow conception of similarity in its application of the sixth Dupont factor – similar marks in use by third parties for similar services—in an opposition between two financial entities. See § 5:58
- New treatment of the Seventh Circuit's decision in Richardson v. Kharbouch affirming the denial of attorney's fees to a successful defendant in a copyright infringement case—a rarity in light of the strong presumption in favor of such awards in its jurisprudence. See § 6:91

This release also includes new treatments of relevant cases from the U.S. Court of Appeals for the Federal Circuit as well as discussion of related Circuit Court and District Court decisions, including cases decided in 2024 and 2025.

This release also updates Copyright, Trade Secret, and Trademark cases from the U.S. district courts, including the interplay between these intellectual property cases and patent cases which increases with increasing technology convergence.