

June 2013

## A Patent and Its Continuation as an Antitrust Tying Arrangement

Mark R. Carter

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### Recommended Citation

Carter, Mark R. (2013) "A Patent and Its Continuation as an Antitrust Tying Arrangement," *Journal of Technology Law & Policy*. Vol. 18: Iss. 1, Article 2.

Available at: <https://scholarship.law.ufl.edu/jtlp/vol18/iss1/2>

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# A PATENT AND ITS CONTINUATION AS AN ANTITRUST TYING ARRANGEMENT

*Mark R. Carter\**

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### I. PATENT AND ANTITRUST AS DIFFERENT, POSSIBLY CONFLICTING, COMPETITION-POLICY ASPECTS

Patent law and antitrust law both implement competition policy. Patent law encourages publicly disclosing inventions for rights to exclude others from making, using, and selling the patented inventions. Antitrust law regulates competition so that firms do not distort markets for their own gain.

In some instances, patent law and antitrust law may conflict. For instance, patent law lets a patent owner keep a continuation patent under examination after the original parent patent has issued. Rambus exacted royalties for continuations unknown to a standard organization which had adopted a standard infringing upon Rambus' patents. The District of Columbia Circuit rejected an antitrust monopolization claim against Rambus.<sup>1</sup>

This Article looks into possible illegal antitrust tying of a patent to its continuation. To that end, it reviews basic patent structure and interrelationships between a patent and its continuations. The Article then reviews and rejects the standard real property analogy for patents in favor of a new one modeling patent claims as gates to land. It then reviews tying doctrine. Finally, it determines whether a patent and its continuation should be deemed an illegal antitrust tying arrangement. Applying the modern tying tests and guiding precepts, the gate model suggests a patent and its continuation should not be deemed an illegal tying arrangement.

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1. Rambus, Inc. v. FTC, 522 F.3d 456 (D.C. Cir. 2008).

## II. CONTINUATION PATENTS

### A. Basic Patent Form

The common patent and patent application structure will have import for the following discussion and analysis. Once the Patent Office “allows” (*i.e.*, approves) a patent application, the application’s text and figures become the issued patent.<sup>2</sup> Thus, patent applications and issued patents have the same structure, so it suffices to describe a normal application’s structure.<sup>3</sup>

The patent laws demand a patent have certain parts. The statutes demand the application have a specification and a drawing.<sup>4</sup> More expressly, the rules require a specification to include a claim or claims and only require “drawings, when necessary.”<sup>5</sup> Drawings are “necessary” when needed “for the understanding of the subject matter sought to be patented.”<sup>6</sup> Almost all patents have drawings.

The Patent Office suggests how to structure a patent.<sup>7</sup> First, the application should have the invention’s title.<sup>8</sup> Second, when needed, it should cross-reference related applications, state whether the research or development was federally sponsored, and name parties to a joint research agreement.<sup>9</sup> Third, when needed, it should reference the sequence listing, table, or software listing appendix and incorporate-by-reference the appendix.<sup>10</sup>

Almost all the other sections apply to all utility patents. The Patent Office prefers the application have a few sections after the title: the invention’s background, brief invention summary, brief drawings description, detailed invention description, claims, and an abstract.<sup>11</sup> If a sequence listing is on paper, it should follow the abstract.<sup>12</sup>

Almost all these sections count toward the “specification” describing the invention. The specification must have a written invention

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2. See 35 U.S.C. § 151 (2012), *replaced by* Patent Law Treaties Implementation Act of 2012, Pub. L. No. 112-211, Dec. 18, 2012, 126 Stat. 1527; MANUAL OF PATENT EXAMINING PROCEDURE 1302.01 (2012) [hereinafter MPEP].

3. For a typical utility patent’s structure, see, e.g., U.S. Patent No. 6,208,045 (filed Nov. 16, 1998).

4. 35 U.S.C. § 111(a) (2012), *amended by* Patent Law Treaties Implementation Act of 2012, Pub. L. No. 112-211, Dec. 18, 2012, 126 Stat. 1527.

5. 37 C.F.R. § 1.51(b) (2013).

6. *Id.* § 1.81(a).

7. MPEP § 6.01.

8. *Id.*

9. *Id.*

10. *Id.*

11. *Id.*

12. *Id.*

description enabling anyone skilled in the art to make and use the invention.<sup>13</sup> It also must contain the best mode for carrying out the invention.<sup>14</sup> Normally, the invention's background, federal sponsorship statement, and list of joint research agreement parties are not deemed part of the specification. The cross-reference to related applications can incorporate-by-reference other applications' disclosures.<sup>15</sup> For instance, a continuation may incorporate-by-reference a parent application's disclosure.<sup>16</sup>

The invention's specification or disclosure includes the claims.<sup>17</sup> Thus, the original claims partly define the application's subject matter and scope. Applicants almost always change (*i.e.*, "amend") the claims during prosecution.<sup>18</sup> But, the Patent Office rejects as "new matter" amended claims outside the original filing's subject matter.<sup>19</sup> Thus, these amendments change the application's patent protections, but they do not change the application's information scope.

### B. Continuation Types

A single patent application can create many related patent applications.<sup>20</sup> Suppose an inventor files an application unrelated to any other patent application. The inventor can later file applications relating back to the original application's filing date.<sup>21</sup> The original application/patent is the later applications' parent. The children are continuation applications/patents.

#### 1. Without New Matter—Relating Back to the Original Filing Date

The patent laws bar adding new subject matter (*i.e.*, "new matter") during prosecution.<sup>22</sup> This bar prevents applicants from asserting the original application's filing date for subject matter absent from the original application.<sup>23</sup> Antitrust scholarship about patents tends to ignore the new matter bar.<sup>24</sup>

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13. 35 U.S.C. § 112(a) (2012).

14. *Id.*

15. 37 C.F.R. §§ 1.57, 1.78(a) (2013).

16. *See id.* § 1.78(a).

17. 35 U.S.C. § 112(b).

18. *See id.* § 111.

19. *Id.* § 121.

20. *Id.*; *see generally* JANICE M. MUELLER, PATENT LAW 54–58 (3d ed. 2009); AMY LANDERS, UNDERSTANDING PATENT LAW § 2.05[C] (2008).

21. 35 U.S.C. § 121.

22. *Id.* § 132; 37 C.F.R. § 1.121(f) (2013).

23. 35 U.S.C. § 132; 37 C.F.R. § 1.121(f).

24. *E.g.*, Christina Bohannon & Herbert J. Hovenkamp, *IP and Antitrust: Reformation*

### a. Continued Examination “File Wrapper Continuation,” RCE Applications

A continued examination application, an “RCE,” is a continuation closely related to the parent. Often, the Patent Office rejects the parent's original claims.<sup>25</sup> The applicant then amends the original claims, cancels claims, or adds new claims.<sup>26</sup> If the Patent Office again rejects one or more claims, the applicant may “request continued examination” in an RCE.<sup>27</sup> Thus, an RCE application at most differs from the original parent, by different claims; otherwise, it remains the same.<sup>28</sup> The RCE application asserts the original filing date in any infringement suit.<sup>29</sup>

An applicant can file an RCE application for all new claims.<sup>30</sup> In fact, as long as the parent or some continuation in an unbroken chain leading back to the parent pends in the Patent Office, an applicant can file a continuation with the same invention description but different claims.<sup>31</sup> But, the new claims cannot have new matter.<sup>32</sup> In fact, patent law lets an applicant tailor continuation claims to better match rivals' infringing conduct, given the continuation lacks new matter.<sup>33</sup>

### b. Divisional Applications

Divisional applications result from the Patent Office restricting examination in the original parent to a group of original claims.<sup>34</sup> Often, the Patent Office's restriction requirement divides the original claims into distinct invention classes.<sup>35</sup> For instance, a restriction requirement may divide the original claims into two groups: method claims and claims for a product made by the method.<sup>36</sup> Unless the applicant “traverses” the restriction by successfully arguing all claims should be examined in one application, the requirement forces the applicant to “elect” (*i.e.*, choose) a claim group for examination in the parent.<sup>37</sup> For

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*and Harm*, 51 B.C. L. REV. 905 (2010); HERBERT HOVENKAMP, FEDERAL ANTITRUST POLICY: THE LAW OF COMPETITION AND ITS PRACTICE § 7.11e (4th ed. 2011).

25. See LANDERS, *supra* note 20, § 2.05; MUELLER, *supra* note 20, at 42–53.

26. See LANDERS, *supra* note 20, § 2.05; MUELLER, *supra* note 20, at 42–53.

27. 35 U.S.C. § 132(b) (2012); 37 C.F.R. § 1.114 (2013).

28. 35 U.S.C. § 132(a); 37 C.F.R. § 1.114.

29. 35 U.S.C. § 120; 37 C.F.R. § 1.114.

30. 35 U.S.C. § 132; 37 C.F.R. § 1.114.

31. 35 U.S.C. §§ 120, 132; 37 C.F.R. § 1.114.

32. 35 U.S.C. § 132; 37 C.F.R. § 1.121(f).

33. HOVENKAMP, *supra* note 24, § 7.11e.

34. 35 U.S.C. § 121.

35. *Id.*

36. MPEP § 802.01 (2012).

37. *Id.* § 818.03.

instance, an applicant may choose to prosecute the method group in the parent. But, the applicant keeps the right to file divisional children applications for each claim group that is not chosen (*e.g.*, the product group).<sup>38</sup> If the original filing had all claim groups, the parent and the divisional applications have the original application's priority date.<sup>39</sup> As with the RCE application, the divisional only differs from the parent by its claims; otherwise, it remains the same.<sup>40</sup>

## 2. With New Matter—Continuations-In-Part (CIPs)

Unlike RCEs and divisional applications, some continuation applications may contain new matter. This hybrid application is a "continuation-in-part."<sup>41</sup> By filing a continuation-in-part (CIP), an applicant retains the original filing date for subject matter disclosed in the parent.<sup>42</sup> But, the applicant gets the CIP's filing date for the subject matter not in the parent.<sup>43</sup> CIPs may have an enlarged invention description to support new matter claims.<sup>44</sup> By filing a CIP, the applicant concedes the CIP has subject matter not in the parent.<sup>45</sup>

### *C. Patent Law's Continuation Limits*

#### 1. During Prosecution—Barring New Matter and Double Patenting

A patent applicant cannot freely amend or add continuation claims without limit.

##### a. New Matter

RCE and divisional claims with subject matter not in the original parent application/patent will be rejected as new matter.<sup>46</sup> Like any negotiation, an applicant will likely make the parent's original claims as broad as might be patentable. Thus, RCE and divisional claims broader than the original parent's broadest claims will normally have new matter. Applicants can broaden claims by deleting elements or placing fewer restrictions on each element. Besides broadening claims, applicants may add new matter to claims by restricting or adding

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38. 35 U.S.C. §§ 120–21.

39. *Id.*

40. *Id.*

41. *Id.* §§ 120, 365; 37 C.F.R. § 1.53(b) (2013); MPEP § 201.08.

42. 35 U.S.C. §§ 120, 365; 37 C.F.R. § 1.53(b); MPEP § 201.08.

43. 35 U.S.C. §§ 120, 365; 37 C.F.R. § 1.53(b); MPEP § 201.08.

44. *See* 35 U.S.C. §§ 120, 365; 37 C.F.R. § 1.53(b); MPEP § 201.08.

45. *See* 35 U.S.C. §§ 120, 365; 37 C.F.R. § 1.53(b); MPEP § 201.08.

46. 35 U.S.C. § 132.

elements in ways not described in the parent.

Though less important for the analysis here, continuation applications may have new matter in their invention descriptions.<sup>47</sup> Normally, when an applicant changes the written description, he/she will file a CIP rather than an RCE or divisional.

## b. Double Patenting

Further, any continuation claim with subject matter overlapping or closely related to the applicant's claim in another application/patent will be rejected as "double patenting."<sup>48</sup> Double patenting results from lack of novelty under 35 U.S.C. § 102 or obviousness under 35 U.S.C. § 103.<sup>49</sup> For a proper double patenting rejection, the applicant must cancel the pending claim or disclaim (*i.e.*, give up) any right to assert it with the prior claim against one party.<sup>50</sup>

## 2. During Litigation—Patent Misuse Affirmative Defense

Patent misuse doctrine shields a patent infringer from liability.<sup>51</sup> Misuse doctrine bars a patentee from asserting a patent. It is an equitable defense based on unclean hands.<sup>52</sup> Patent misuse occurs when the patentee tries to broaden the patent grant beyond the scope conferred by the patent statutes. The broadening may be defined as seeking a market beyond the patent grant.<sup>53</sup> More precisely, patent misuse cannot occur unless "the patentee has impermissibly broadened the 'physical or temporal scope' of the patent grant with anti-competitive effect."<sup>54</sup> Patent misuse examples include requiring licensors to use the patentee's unpatented film in patented film projectors,<sup>55</sup> and requiring the licensors to buy the patentee's salt for a patented salt injecting machine.<sup>56</sup>

Historically, patent misuse closely related to antitrust infractions.<sup>57</sup> An antitrust infraction based on the patent necessarily implied patent misuse because the misuse doctrine only required an "anti-competitive

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47. MPEP § 1.53.

48. 35 U.S.C. § 101 ("may obtain a patent") (emphasis added); MPEP § 804.

49. MPEP § 804.

50. *Id.* § 804.02.

51. See generally HOVENKAMP, *supra* note 24, §§ 5.5b, 7.11; BRIAN G. BRUSVOLD ET AL., DRAFTING PATENT LICENSE AGREEMENTS §§ 29.02–06 (6th ed. 2008); CHRISTOPHER R. LESLIE, ANTITRUST LAW AND INTELLECTUAL PROPERTY RIGHTS 10–11, 56–57, 60–61, 63 (2011).

52. B. Braun Med., Inc. v. Abbott Labs., 124 F.3d 1419, 1427 (Fed. Cir. 1997).

53. Mallinckrodt, Inc. v. Mediport, Inc., 976 F.2d 700, 704 (Fed. Cir. 1992).

54. Windsurfing Int'l, Inc. v. AMF, Inc., 782 F.2d 995, 1001 (Fed. Cir. 1986).

55. Motion Picture Patents Co. v. Universal Film Mfg. Co., 243 U.S. 502, 516 (1917).

56. Morton Salt Co. v. G.S. Suppiger Co., 314 U.S. 488, 491 (1942) (*per curiam*).

57. HOVENKAMP, *supra* note 24, § 5.5b.



effect.”<sup>58</sup> But, misuse has been possibly broader than antitrust for the same reason.<sup>59</sup>

The 1988 Patent Misuse Reform Act<sup>60</sup> curtailed the patent misuse defense.<sup>61</sup> In essence, it removed the defense where the patentee asserted patent rights allowed by statute.<sup>62</sup> The Act amended 35 U.S.C. § 271(d) to expressly permit: enforcing patent rights against infringement or contributory infringement, refusing to license or use any rights to the patent, or conditioning licensing patent rights on selling or licensing other patent rights.<sup>63</sup>

Also, the Federal Circuit’s 2010 en banc decision in *Princo Corporation v. U.S. International Trade Commission (ITC)* distinguished patent misuse from antitrust infractions.<sup>64</sup> The ITC respondent, Princo, asserted a patent misuse defense.<sup>65</sup> Sony and Phillips separately developed and patented techniques for encoding positions on compact discs (CDs).<sup>66</sup> They agreed to use the Phillips analog method over Sony’s digital method as part of the Orange Book standard for making CDs.<sup>67</sup> They then granted package licenses to the analog method and a claim for the digital method, which possibly blocked another technology in the Orange Book.<sup>68</sup> They also refused to license any other claims from Sony’s digital method patent for any other purpose.<sup>69</sup>

Princo argued that Phillips’ conduct of forcing it to license patents which were not required to make CDs was misuse.<sup>70</sup> In an earlier appeal, the Federal Circuit rejected the argument that “tying nonessential patents to essential ones” in Phillips’ package licenses was misuse.<sup>71</sup> On remand to the ITC, Princo argued Phillips’ package license coerced Sony to adhere to the Orange Book and stifled competition.<sup>72</sup> The ITC rejected this argument.<sup>73</sup>

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58. *Id.*

59. *Id.*

60. Patent Misuse Reform Act, Pub. L. No. 100-703, § 201, 102 Stat. 4674 (1988) (codified at 35 U.S.C. § 271(d) (2012)).

61. *Id.*

62. *Id.*

63. *Id.* n.22 (quoting 35 U.S.C. § 271(d)).

64. *Princo Corp. v. U.S. Int’l Trade Comm’n*, 616 F.3d 1318, 1331–34 (Fed. Cir. 2010).

65. *Id.* at 1323–24, 1330.

66. *Id.* at 1322.

67. *Id.*

68. HOVENKAMP, *supra* note 24, § 5.5b.

69. *Id.*

70. *Princo*, 616 F.3d at 1323.

71. *Id.* (citing *U.S. Phillips Corp. v. ITC*, 424 F.3d 1179 (Fed. Cir. 2005)).

72. *Id.* at 1324.

73. *Id.*

In the en banc decision, the Federal Circuit expressly rejected the argument that a horizontal agreement between Phillips and Sony to restrict access to Sony's patent was misuse.<sup>74</sup> It acknowledged the licensing agreement between Phillips and Sony made Phillips' package licenses more valuable by suppressing possible competition.<sup>75</sup> But, the Federal Circuit found no patent grant broadening agreement created patent misuse.<sup>76</sup>

The court also conceded that the agreement between Phillips and Sony might break the antitrust laws.<sup>77</sup> Horizontal agreements between rivals surely raise concerns over the Sherman Act § 1.<sup>78</sup> In any case, by holding against misuse but conceding possible antitrust infractions, the court strongly suggested patent misuse importantly differs from an antitrust claim.

### 3. Patent Property Analogized with Real Property

#### a. Standard View—Claims as Land Boundaries

As a property type, patents may be compared or analogized with land. In fact, some antitrust scholars have made the analogy as a starting point for analyzing patents with antitrust precepts. For instance, a recent article likens a patent to a deed.<sup>79</sup> The written description seemingly matches a deed's general description in its granting clause.<sup>80</sup>

From there, the analogy becomes very loose. Patent claims seemingly "set out the boundaries for determining what constitutes infringement"<sup>81</sup> like "compass courses and distances."<sup>82</sup> The article argued the written description does not give a boundary because an applicant could write a claim to "whatever is enabled and described by the specification [including the written description], and that is not made obvious by the prior art."<sup>83</sup>

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74. *Id.* at 1331–32.

75. *Id.* at 1332.

76. *Id.* at 1331–32.

77. *Id.*

78. *E.g.*, HOVENKAMP, *supra* note 24, § 5.1b.

79. *See* Bohannan & Hovenkamp, *supra* note 24, at 935.

80. *Id.* at 935–36.

81. *Id.* at 935.

82. *Id.* at 936.

83. *Id.* at 938 (citing Tun-Jen Chiang, *Fixing Patent Boundaries*, 108 MICH. L. REV. 523, 538 (2010)).

### b. The Standard View Fails in Practice

But, in practice, the Patent Office would at once reject any claim to “whatever is enabled and described.” The Patent Office rejects “omnibus,” amorphous claims.<sup>84</sup> The Patent Office gives the sample omnibus claim: “A device substantially as shown and described.”<sup>85</sup> It would reject the claim under 35 U.S.C. § 112(2) as indefinite for “fail[ing] to point out what is included or excluded by the claim language.”<sup>86</sup> Other omnibus-claim examples include: “[t]he apparatus as shown and described in figures 1-6,” and “[a]ny and all features of novelty described, referred to, exemplified, or shown.”<sup>87</sup>

Utility patent claims must have elements. In skeleton form, an apparatus claim has the outline:

A widget comprising:  
 Element A;  
 Element B; and  
 Element C, connecting the element A to the element B.<sup>88</sup>

For instance, consider a simple utility patent claim based on an example in a standard claim drafting text:

An apparatus for shaking articles, which comprises  
*a container* for the articles;  
*a base*;  
*a plurality of parallel legs*, each leg pivotally connected at one end to the container, and connected at the other end to the base, to support the container for an oscillating movement with respect to the base; and  
*an oscillator* oscillating the container on the legs to shake the articles.<sup>89</sup>

The elements, in italics, are: a container; a base; a plurality of parallel legs; and an oscillator.

All the elements work together. All the unitalicized words after “comprising” are “functional language” describing how the elements interact. Each parallel leg is pivotally connected to the container and

84. See MPEP § 2173.05(r) (2012).

85. *Id.*

86. *Id.* (citing *Ex parte Fressola*, No. 93-0828, 27 U.S.P.Q.2d (BNA) 1608 (B.P.A.I. May 11, 1993)).

87. ROBERT C. FABER, *FABER ON MECHANICS OF PATENT CLAIM DRAFTING* § 1:2 (Release 5, June 2011).

88. See MUELLER, *supra* note 20, at 78.

89. See FABER, *supra* note 87, § 3:1.1.

connected to the base. In turn, the oscillator oscillates the container. No element is unconnected to some other claim element.

Contrast this simple utility patent claim with the omnibus claims. First, no omnibus claim expressly names even one element. Thus, no omnibus claim describes cooperating or interacting elements to form a working apparatus. The omnibus-claim drafter tries to capture every possible property bit in one short sentence. Second, a realistic utility patent claim, like the sample claim, must have a narrower scope than the omnibus claims. The sample claim is much more concrete. If it were an originally filed claim, it would be only a small part of a much larger specification or invention description. If it were an amended claim or one added after the original filing, the new matter bar would prevent it from having a scope unsupported by the specification or invention description.<sup>90</sup>

But, a patent simply grants a right to exclude.<sup>91</sup> This matches a traditional property concept.<sup>92</sup> Modern property concepts see exclusion as only one stick in a property rights “bundle.”<sup>93</sup> Either way, a granted patent claim defines the owner’s right to exclude others from the property described in the claim.<sup>94</sup> Infringing a patent claim trespasses the property described in the claim. Yet, any patent claim must be enabled by the application’s original description.<sup>95</sup> Further, the bar against new matter prevents amended claims or added claims from having a scope larger than the original description.<sup>96</sup>

### c. A New View—Claims as Gates to the Patent Description’s Land

These factors suggest a more apt land analogy. A patent application’s original description, including the claims but excluding the background section, defines the property’s fuzzy outer limits. The allowed claims define possible trespass areas within the outer limits. Counter to a common patent-claims description as defining a patent’s boundary,<sup>97</sup> the numbered claims more resemble discrete open gates into the property. Amended claims and added claims only change the gates’ positions; they do not change the fuzzy outer limits in the original description.<sup>98</sup> In essence, *each allowed claim creates an open gate for*

90. 35 U.S.C. § 120 (2012); 37 C.F.R. § 1.121(f) (2013).

91. 35 U.S.C. § 154(a)(1).

92. See, e.g., THOMAS W. MERRILL & HENRY E. SMITH, PROPERTY: PRINCIPLES AND POLICIES 1–15, 19 n.3 (2007).

93. See *id.* at 16.

94. 35 U.S.C. § 154(a)(1).

95. See *id.* § 112.

96. *Id.* §§ 120, 132; 37 C.F.R. § 1.121(f) (2013).

97. E.g., FABER, *supra* note 87, § 1:2.

98. See 37 C.F.R. § 1.121(f).

*an infringer's possible trespass.*

And, patent infringement likens to land trespass. Modern trespass normally needs a defendant's intent. But, it is merely the intent to perform an act which contacts the property.<sup>99</sup> "Intent" does not require wrongfulness.<sup>100</sup> Like trespass, patent infringement only needs intent to perform the acts to infringe on all of a claim's elements; it does not require knowing the claim exists.<sup>101</sup> "Wrongfulness" from knowing the land/property belongs to someone else results in "willful" infringement.<sup>102</sup> "Willfulness" lets a patentee get enhanced damages of treble the reasonable royalty rate.<sup>103</sup> Patentees can show willfulness by showing infringement after the defendant receives express notice through a "cease and desist" letter.<sup>104</sup>

But, the land analogy will likely never be perfect. Normally, land is a two-dimensional concept except for the *ad coelum* doctrine of owning earth beneath and airspace above the land's surface.<sup>105</sup> Rather, a multidimensional model likely better describes the property described in a patent's written property description. In any case, the gate analogy likely holds for a multidimensional patent property description. Perhaps, "portal" better labels a multidimensional gate.

#### 4. Continuations in the Claims-as-Gates Land Analogy

##### a. Continuations Without New Matter—Replacing Differing Deeds in the Standard View with Differing Gates to the Same Land

Though like the standard view of claims defining property boundaries, the gate model subtly changes the land analogy. As in the boundary model, a claim describes something about the patent's property in the gate model. But, the boundary model assumes a claim likens to a deed's granting clause. So, two patents in the same family with different claims liken to two deeds with different granting clauses. It becomes hard to know whether the two deeds belong to the same property. Thus, that approach makes it easy to think the property in the two patents can have little or no relation to each other.

But, the gate model makes clearer the relationship between the two patents in the same family. Rather than certainly creating a different,

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99. See W. PAGE KEETON ET AL., PROSSER AND KEETON ON THE LAW OF TORTS § 13 (5th ed. 1984).

100. See *id.*

101. *Intel Corp. v. ITC*, 946 F.2d 821, 832 (Fed. Cir. 1991).

102. *In re Seagate Tech., LLC*, 497 F.3d 1360, 1370 (Fed. Cir. 2007).

103. 35 U.S.C. § 284 (2012).

104. See, e.g., LANDERS, *supra* note 20, at 461.

105. E.g., MERRILL & SMITH, *supra* note 92, at 9–15.

new “deed,” a second patent creates new gates. If a continuation has no new matter compared with the parent, it has the same patent property as the parent. Yet, the continuation will have different gates to the same property.

### (1) Divisional Applications/Patents—Claims in Different Classes

By definition, to have a divisional application, the Patent Office restricted the original application’s prosecution to claims in one invention class.<sup>106</sup> The divisional has original claims from the parent in a different invention class.<sup>107</sup> The written invention description is the same original filing for both the parent and the divisional.<sup>108</sup> The two patent applications only differ by the claims.<sup>109</sup>

### (2) Parent and Continuation Claims in the Same Class

A continuation may have claims in the parent’s claims’ same invention class. As the original filing remains the same, both patents describe the same property with the same fuzzy outer limits. Even if the parent lacked all the continuation’s claims, they would not define new property but only distinct gates. The new matter bar keeps new property out of the continuation.<sup>110</sup>

An RCE’s claims may be different from the parent.<sup>111</sup> In practice, applicants normally request continued examination because the Patent Office rejected the original and amended claims. Applicants normally narrow claims by amendments which are based on the patent examiner’s rejections and cited references. Thus, the amended claims in the continued examination application are in essence pushed back from the fuzzy outer limits defined by the original filing.

### (3) The Tailored Continuation—Claims in Either the Same or Different Classes Tailored to Match a Rival’s Acts

As noted, patent law lets a patentee tailor a continuation’s claims to match a rival’s acts.<sup>112</sup> This describes patent-prosecution and infringement strategy rather than patent-prosecution procedure; the tailored continuation is like any continuation. The patentee adds or

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106. 35 U.S.C. §§ 120–21.

107. *See id.* § 121.

108. *Id.*

109. *See id.*

110. *Id.* §§ 121, 132; 37 C.F.R. § 1.121(f) (2013).

111. 35 U.S.C. § 132; 37 C.F.R. § 1.114.

112. *See HOVENKAMP, supra note 24, § 7.11e.*

amends the tailored continuation's claims as in any other continuation. The tailored continuation only differs from other continuations by the patentee's intent; the patentee sees the rival's acts and then drafts or amends the continuation's claims to best capture the rival's acts.<sup>113</sup> In essence, the patentee who discovered the general invention ideas in the parent takes the rival's specific ideas and includes the specific ideas in the tailored continuation's claims, provided the claims do not add new matter. As the tailored continuation avoids new matter, the tailored claims relate back to the parent's original filing date.<sup>114</sup>

As the tailored continuation differs from other continuations only by strategy and intent, the gate claim model applies to tailored continuations just the same as to other continuations. A tailored continuation may have claims in more than one invention class subject to the new matter bar.

#### (4) Double Patenting Rejections

In general, double patenting rejects claims that have the same elements as earlier allowed claims or are obvious with respect to them.<sup>115</sup> If any continuation claim has the same elements as a parent claim, the Patent Office will reject it under novelty double patenting; both claims have the same subject matter.<sup>116</sup> Likewise, if any continuation claim is obvious in light of a parent claim alone or combined with an outside reference, the Patent Office will reject it under obviousness double patenting; though not the same, the continuation claim's subject matter is obvious with respect to the parent claim's subject matter.<sup>117</sup> Double patenting rejections force an applicant to cancel claims or to disclaim any right to assert them with the matched parent claim.<sup>118</sup>

In the gate model, double patenting rejects claims to overlapping gates or gates not very far from each other and bars the applicant from having one trespasser (that is an infringer) enter both gates. For real property, overlapping gates in effect form one gate. If only part of each gate overlaps the other gate, together they make one wider gate. If they completely overlap, together they make one gate as wide as the widest gate; if they have the same width, they form one gate of that width.

For claims in the same family, completely overlapping gates represent one claim having all the other claim's elements. First, the

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113. *See id.*

114. 35 U.S.C. §§ 121.

115. MPEP § 804.02 (2012).

116. *See* 35 U.S.C. § 102; MPEP § 804.

117. *See* 35 U.S.C. § 103; MPEP § 804.

118. *See* MPEP § 804.02.

gates may be the same for a parent claim and a continuation claim. Both claims will have all the same elements, and novelty double patenting will reject the continuation claim as anticipated by the parent claim. Second, the continuation gate may be wider than the parent gate. Thus, the continuation claim will contain all the parent claim's elements. The continuation claim would give an infringer a greater chance for infringement. Thus, double patenting could reject the continuation claim as anticipated by the parent claim for having the same elements. Otherwise, double patenting could reject the continuation claim as obvious in light of the parent claim. Third, the continuation claim's gate could be narrower than the parent claim's gate. Then, all the continuation claim's elements would be contained in the parent claim. Thus, double patenting would reject the continuation claim as anticipated by the parent claim.

Rather than fully overlapping, a parent claim's gate may only partly overlap a continuation claim's gate. If the overlap contains one or more elements in both claims, then double patenting may reject a continuation claim under novelty or obviousness.<sup>119</sup> If the overlap has all of one's claim elements, then the novelty rejection applies.<sup>120</sup> If the overlap has no elements, then double patenting should reject the continuation claim as obvious in light of the parent claim.

Instead of overlapping, the parent and continuation claim gates may have no overlap. If they are fairly close to each other, then double patenting should reject the continuation claim as obvious in light of the parent claim.<sup>121</sup> Though the continuation claim will not have the same literal elements as the parent claim, it will allow trespass (that is, infringement) of nearby "land" described in the parent patent's written invention description. As the continuation claim's gate moves further away from the parent claim's gate, the continuation claim will become less obvious.

#### b. Continuations with New Matter: Continuation-In-Part (CIP) Applications/Patents

A continuation-in-part (CIP) application adds new subject matter to the parent.<sup>122</sup> Thus, a CIP is the only continuation to enlarge the patent's fuzzy outer limits. In practice, inventors file CIP applications to add to the invention description based on research or development after the original filing. This added description supports new claims in the CIP to

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119. See 35 U.S.C. §§ 102, 103; MPEP § 804.

120. See 35 U.S.C. § 102; MPEP § 804.

121. See 35 U.S.C. § 103; MPEP § 804.

122. See 37 C.F.R. § 1.53(b) (2013); MPEP § 201.08.



subject matter not in the original filing.<sup>123</sup> In the gate model, only if a continuation has new matter will there be any question as to whether its property differs from the parent's property.

### III. TYING DOCTRINE

#### A. *Illegal Tying Generally*

“A tie-in, or tying arrangement, is a sale or lease of one product or service on the condition that the buyer take a second product or service as well.”<sup>124</sup> It may be illegal under the Sherman Act § 1 or the Clayton Act § 3.<sup>125</sup> By the Sherman Act § 1, “[e]very contract, combination in the form of trust or otherwise, or conspiracy, in restraint of trade or commerce among the several States, or with the foreign nations, is . . . illegal.”<sup>126</sup> But, the Clayton Act § 3 states it is unlawful

to lease or make a sale or contract for sale of goods, wares, merchandise, machinery, supplies, or other commodities, whether patented or unpatented . . . on the condition, agreement, or understanding that the lessee or purchaser . . . shall not use or deal in the goods, wares, merchandise, machinery, supplies, or other commodities . . . to substantially lessen competition or tend to create a monopoly in any line of commerce.<sup>127</sup>

The Supreme Court distinguishes between the Sherman and Clayton Act tests.<sup>128</sup> The Clayton Act § 3 only applies to commodities, not business services.<sup>129</sup> Under Sherman Act § 1, the Court holds tying arrangements *per se* illegal when the firm has market power in the tying product and the arrangement affects a “not insubstantial” amount of commerce in the tied product market.<sup>130</sup> But, by Clayton Act § 3, the Court applies a rule of reason to tying arrangements if either the seller has a “not insubstantial” market power in the tying product market or the tying arrangement affects a “not insubstantial” amount of commerce.<sup>131</sup> Thus, the Sherman Act needs both factors for illegality

123. See 35 U.S.C. § 112; 37 C.F.R. § 1.53(b); MPEP § 201.08.

124. HOVENKAMP, *supra* note 24, § 10.1.

125. *Id.*

126. 15 U.S.C. § 1 (2012).

127. *Id.* § 14.

128. *Times-Picayune Publ'g Co. v. United States*, 345 U.S. 594, 608–09 (1953); HOVENKAMP, *supra* note 24, § 10.3.

129. See HOVENKAMP, *supra* note 24, § 10.3.

130. *Times-Picayune*, 345 U.S. at 608–09; HOVENKAMP, *supra* note 24, § 10.3.

131. *Times-Picayune*, 345 U.S. at 608–09; HOVENKAMP, *supra* note 24, § 10.3.

while the Clayton Act needs only one.<sup>132</sup> Also, the Sherman Act applies the stringent *per se* standard, but the Clayton Act applies the more flexible rule of reason standard.<sup>133</sup>

Despite these differences, many lower courts apply one test for both Sherman and Clayton Act tying cases.<sup>134</sup> But, the illegal tying test differs among the circuits.<sup>135</sup> Lower courts mostly rely on the Ninth Circuit's test.<sup>136</sup> The Ninth Circuit's case was a class action involving tying cookers, fryers, packaging products, and mixes to the Chicken Delight trademark in a restaurant franchise arrangement.<sup>137</sup> The Ninth Circuit deemed that illegal tying has three elements.<sup>138</sup> First, the scheme involves two distinct items and requires that one item, the tying item, may not be obtained unless the buyer also gets the other, tied item.<sup>139</sup> Second, the tying item has enough economic power to appreciably restrain competition in the tied item market.<sup>140</sup> Third, the arrangement affects a "not insubstantial" amount of commerce.<sup>141</sup> To these core three elements, some circuits also require anti-competitive effects in the tied item market.<sup>142</sup> Other circuits require some coercion to buy the tied item.<sup>143</sup>

Though the Supreme Court has not stated a tying test, it has given some guiding thoughts.<sup>144</sup> The Court has trended toward a rule of reason for tying arrangements.<sup>145</sup> But first, a scheme would need to meet three conditions.<sup>146</sup> First, the firm would need market power in the tying

132. *Times-Picayune*, 345 U.S. at 608–09; HOVENKAMP, *supra* note 24, § 10.3.

133. HOVENKAMP, *supra* note 24, § 10.3.

134. *Id.*

135. *Id.* § 10.1 (citing *Bob Maxfield, Inc. v. Am. Motors Corp.*, 637 F.2d 1033, 1037 (5th Cir. 1981) (four factor test)); *Yentsch v. Texaco, Inc.*, 630 F.2d 46, 56–57 (2d Cir. 1980) (five factor test).

136. HERBERT HOVENKAMP, *ANTITRUST* 195 (5th ed. 2011) [hereinafter HOVENKAMP, *ANTITRUST*] (citing *Siegel v. Chicken Delight, Inc.*, 448 F.2d 43 (9th Cir. 1971)); *see also* LESLIE, *supra* note 51, at 154–65 (trademark tying case excerpts including *Chicken Delight*).

137. *Chicken Delight*, 448 F.2d at 46.

138. *Id.* at 47.

139. *Id.* (citing *Times-Picayune Publ'g Co. v. United States*, 345 U.S. 594, 613–14 (1953)).

140. *Id.* (citing *N. Pac. Ry. Co. v. United States*, 356 U.S. 1, 6 (1958)).

141. *Id.* (quoting *Int'l Salt Co. v. United States*, 332 U.S. 392 (1947)).

142. HOVENKAMP, *ANTITRUST*, *supra* note 136, at 195; *see* HOVENKAMP, *supra* note 24, § 10.1 (citing *Bob Maxfield, Inc. v. Am. Motors Corp.*, 637 F.2d 1033, 1037 (5th Cir. 1981) (anti-competitive effects as the fourth factor in the four-factor test)).

143. HOVENKAMP, *ANTITRUST*, *supra* note 136, at 195, 210–12; HOVENKAMP, *supra* note 24, § 10.1 (citing *Yentsch v. Texaco, Inc.*, 630 F.2d 46, 56–57 (2d Cir. 1980) (coercion as fifth factor)).

144. *See generally* HOVENKAMP, *supra* note 24, § 10.

145. *Id.* § 10.1 (citing *Jefferson Parish Hosp. Dist. No. 2 v. Hyde*, 466 U.S. 2, 40 (1984) (O'Connor, J., concurring)).

146. *Jefferson Parish*, 466 U.S. at 41.

product.<sup>147</sup> Second the scheme would present a “not insubstantial” market power threat in the tied product.<sup>148</sup> Third, a coherent economic basis for treating the products as distinct would need to exist.<sup>149</sup> Also, the scheme would need to have an exclusionary or anticompetitive effect in the tied product market.<sup>150</sup>

### B. *Traditional Patent Tying, Antitrust, and Misuse—Assuming a Patent Grants Market Power*

Traditionally, a patent tying arrangement ties a commodity to a patented device.<sup>151</sup> For instance, the International Salt Company leased its patented machines.<sup>152</sup> The first machine dissolved rock salt into brine while the second machine injected salt tablets into canned products.<sup>153</sup> Though the company patented the machines, it had no patents on salt.<sup>154</sup> Even so, it only leased its machines under the condition that the lessees buy the rock salt and salt tablets for the machines from the International Salt Company;<sup>155</sup> the company tied unpatented salt to the patented machines. The Court held this tying arrangement illegal by presuming *per se* market power for the patented machine.<sup>156</sup>

Likewise, the Court refused to enforce patent licenses due to patent misuse based on tying.<sup>157</sup> For instance, the Motion Picture Patents Company sold patented movie projectors only if the buyer agreed to rent movies from the patent owner.<sup>158</sup> Likewise, the Morton Salt Company required its patented salt injecting machines lessees to buy unpatented salt.<sup>159</sup> Though these arrangements very much likened to International Salt’s antitrust infraction, the Court refused to enforce the patents in both instances as tying arrangements creating patent misuse, but not an antitrust infraction.<sup>160</sup>

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147. *Id.*

148. *Id.*

149. *Id.*

150. *See id.* at 40.

151. *See* HOVENKAMP, *supra* note 24, § 10.3c.

152. *Int’l Salt Co. v. United States*, 332 U.S. 392, 394–95 (1947).

153. *Id.* at 394.

154. *Id.* at 395–96.

155. *See id.* at 397–98.

156. *See id.* at 398, 402.

157. *See* *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 503, 517 (1917).

158. *Id.* at 506.

159. *Morton Salt Co. v. G.S. Suppiger*, 314 U.S. 488, 490 (1942) (per curiam).

160. *Id.* at 494; *Motion Picture Patents*, 243 U.S. at 513.

### C. Modern Patent Tying—Patents Do Not Automatically Grant Market Power

Recently, the Supreme Court stopped presuming *per se* market power based solely on a patent for a product/apparatus.<sup>161</sup> As with the traditional patent tying cases, the case dealt with patented apparatuses, an inkjet printer and ink container, and an unpatented commodity, ink.<sup>162</sup> In scrapping the patent market power presumption, the Court stressed the presumption started in patent misuse doctrine and migrated to antitrust case law in *International Salt Co. v. United States*.<sup>163</sup> It noted Congress began a policy shift away from the presumption when it codified patent law (in the 1950s) and stressed Congress's full shift from it in the 1988 Patent Misuse Reform Act amending 35 U.S.C. § 271(d).<sup>164</sup> As the Court stressed, the Act barred the misuse defense "unless . . . the patent owner has market power in the relevant market for the patent or patented product."<sup>165</sup> The Court reasoned Congress's express requirement for market power for finding patent misuse removed the market power presumption for a patent.<sup>166</sup> The Court also relied on broad and weighty scholarship criticizing the patent market power presumption.<sup>167</sup> Thus, the Court rejected the presumption based on the revised patent statute and a broad policy consensus.

Perhaps the Court's shift in view sprang from the past few decades' technology explosion. As the Patent Office examines hundreds of thousands of patent applications each year, the position that one patent would automatically grant market power now seems ridiculous. As with the land analogy, loose usage of "monopoly" may have confused the Justices in their traditional opinions.<sup>168</sup> A patent confers a right to exclude,<sup>169</sup> not a "monopoly."

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161. *Ill. Tool Works, Inc. v. Indep. Ink, Inc.*, 547 U.S. 28, 46 (2006) (per curiam).

162. *See id.* at 31.

163. *Id.* at 38-39 (citing *Int'l Salt Co. v. United States*, 332 U.S. 392 (1947)).

164. *See id.* at 41.

165. *Id.* at 41-42 (quoting 35 U.S.C. § 271(d)).

166. *Id.* at 42.

167. *Id.* at 43 n.4 (citing Kenneth J. Burchfiel, *Patent Misuse and Antitrust Reform*, 4 HARV. J.L. & TECH. 1, 57 n.340 (1991); 1 HERBERT HOVENKAMP ET AL., IP AND ANTITRUST § 4.2a (2010); WILLIAM LANDES & RICHARD POSNER, THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW 374 (2003)).

168. *See* HERBERT HOVENKAMP, THE ANTITRUST ENTERPRISE: PRINCIPLE AND EXECUTION 268 (2005); LESLIE, *supra* note 51, at 54 n.1 (citing *Asahi Glass Co. v. Pentech Pharm., Inc.*, 289 F. Supp. 2d 986, 995 (N.D. Ill. 2003) (Posner, J.) (distinguishing "monopoly" in patent and antitrust contexts)).

169. 35 U.S.C. § 154 (2013).

## IV. TYING A PATENT TO ITS CONTINUATION UNDER ANTITRUST LAWS

### A. *A Patent and Its Continuation in the Gate Model*

Unlike traditional patent tying, tying patents in the same family does not involve a commodity. Rather, claims in one patent are tied to claims in another patent. If one patent is a divisional or RCE of the other patent, the invention descriptions (except for the claims) will be the same. If one patent is a CIP, the descriptions, apart from the claims, may be the same. But, more likely, the CIP will have added more description than the other patent.

Regardless of the precise differences between the two patents, they need not be complementary like a patented machine and a commodity used in the machine. Instead, they will likely cover different aspects of one machine. For instance, an original patent application may have apparatus, that is machine, and method claims. After a restriction requirement, the applicant can prosecute the apparatus or method claims group in the original parent application. Once the Patent Office allows the parent to issue as a patent, or even before, the applicant can prosecute the other claims group to allowance. Thus, the parent and the divisional will together have apparatus and method claims based on the same invention description. In essence, the patentee will have apparatus and method claims to the same basic ideas. In practice, a machine implementing the apparatus claims will also implement the method claims. Thus, unlike traditional patent tying, tying the licensing of one patent to another in the same family will likely cover the same machine rather than a complementary commodity used in the machine.

The gate model for claims lends insight to this tying arrangement. Each claim is a gate to the “land” described in a parent application. Licensing a claim amounts to charging an admission fee to enter the corresponding gate. Like an entrance to a vast stadium or coliseum, each claim lets the licensee enter the patent’s “land” for a certain time. The licensor (that is, patentee) may set the admission price in terms of money, fields of use, and physical location.

### B. *A Patent and Its Continuation Are Not an Illegal Antitrust Tying Arrangement as They Are Not Distinct*

#### 1. Applying the Tying Test

The parent patent has different gates from its continuation. The Patent Office’s examination of the continuation rejects claims having new matter;<sup>170</sup> these would be gates to land entirely unrelated to the

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170. *Id.* § 132; 37 C.F.R. § 1.121(f) (2013).

parent patent's land. But, the Patent Office's examination also rejects claims under double patenting as obvious or not novel.<sup>171</sup> Novelty double patenting rejections ensure the continuation's gates do not fully overlap the parent's gates. Obviousness double patenting rejections ensure the continuation's gates lie significantly far away from the parent's gates. Thus, the continuation's gates and claims differ from the parent's gates and claims.

But, both the parent and its continuation have the same invention description. The invention description is the "land" accessed by the gates. Thus, though the gates differ, they open onto the same land, so the patent and its continuation are not distinct. The parent patent and its continuation must be licensed together because the parent and its continuation have different gates (*i.e.*, claims) to the same land.

## 2. Applying *Jefferson Parish* Tying Precepts

Though a patent and its continuation have failed the tying test, they may be distinct and capable of illegal antitrust tying under a more abstract concept of "distinct." Justice O'Connor's concurrence in *Jefferson Parish Hospital District No. 2 v. Hyde* posed the question as being capable of a coherent theory for treating the parent and continuation as distinct.<sup>172</sup> Justice O'Connor stressed that "there must be a coherent economic basis for treating the tying and tied products as distinct."<sup>173</sup> Further, "for products to be treated as distinct, the tied product must, at a minimum, be one that some consumers might wish to purchase separately *without also purchasing the tying product*."<sup>174</sup>

Though a patent and its continuation can conceivably be licensed separately, no licensee would ever want to license one without the other; licensing only one patent would expose the licensee to an infringement suit based on the other patent and a new round of licensing and royalties.

The gate model makes the motivation for this behavior clear. The parent and its continuation have the same property in their invention descriptions. They only differ by the gates (claims) allowing trespass into the property.

The tailored continuation is merely a special case. The most famous case involved a standard body, the Joint Electron Devices Engineering Council (JEDEC).<sup>175</sup> Though JEDEC knew it had adopted a standard

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171. MPEP § 804.02 (2012).

172. *Jefferson Parish Hosp. Dist. No. 2 v. Hyde*, 466 U.S. 2, 39 (1984) (O'Connor, J., concurring).

173. *Id.*

174. *Id.*

175. *See Rambus, Inc. v. F.T.C.*, 522 F.3d 456 (D.C. Cir. 2008).

including Rambus patents, it did not know the patents had pending continuations.<sup>176</sup> The District of Columbia Circuit rejected Sherman and FTC Act antitrust monopolization claims against Rambus for tricking the standard body into adopting its patents while the continuations were pending.<sup>177</sup> Regarding tying, in the gate model, Rambus merely licensed only a few gates to an unsophisticated licensee. Echoing Justice O'Connor's minimum distinctness test, JEDEC *did not wish to license separately the tied continuation patents without also licensing the tying parent patent.*<sup>178</sup>

## V. CONCLUSION

The traditional view of patent claims as boundaries to patent property fails to accurately describe them in practice. Viewing patent claims as gates to property giving an infringer a chance to trespass on the patent property better describes claims. The claims-as-gates analogy simplifies analyzing the tying arrangement consisting of a patent and its continuation. Applying standard antitrust tying tests and guiding thoughts to licensing a patent and its continuation, modeling the claims as gates to the same land in both patents' invention descriptions, suggests tying a patent and its continuation is not illegal under antitrust law. The patent and its continuation are not distinct items; they both have the same property in their common invention description. Only the gates to the property, the claims, differ.

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176. *See id.* at 460.

177. *Id.* at 467.

178. *See Jefferson Parish*, 466 U.S. at 39 (O'Connor, J., concurring).