

Fun IP

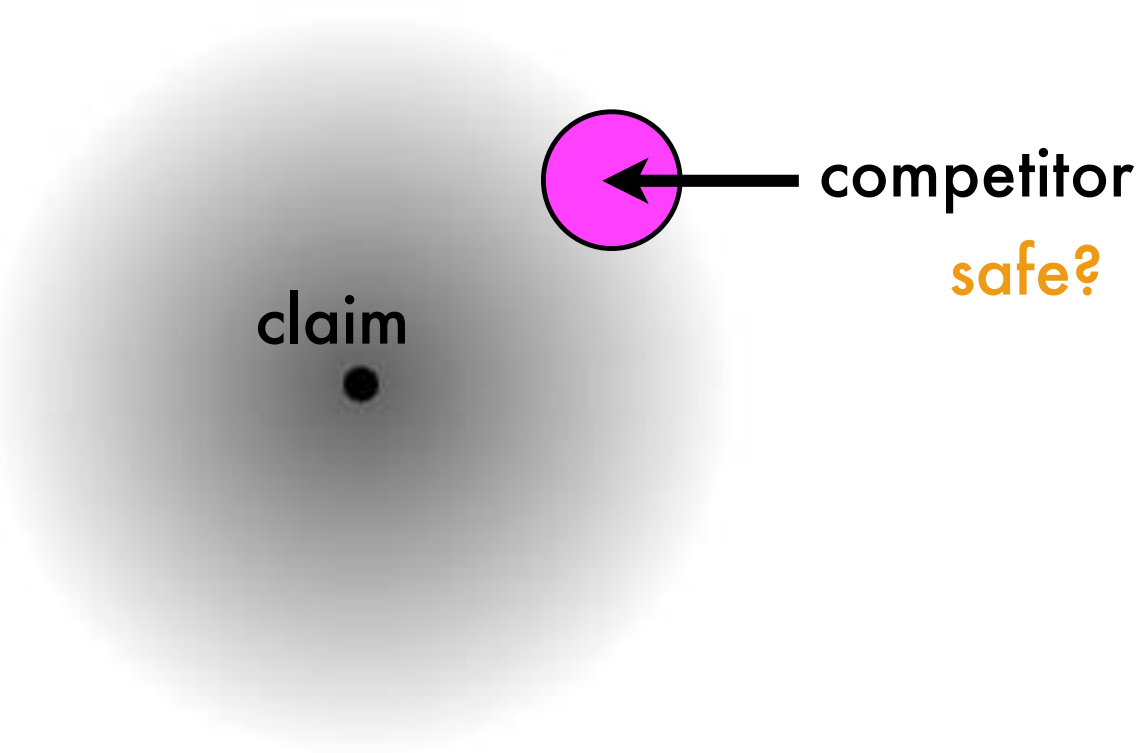
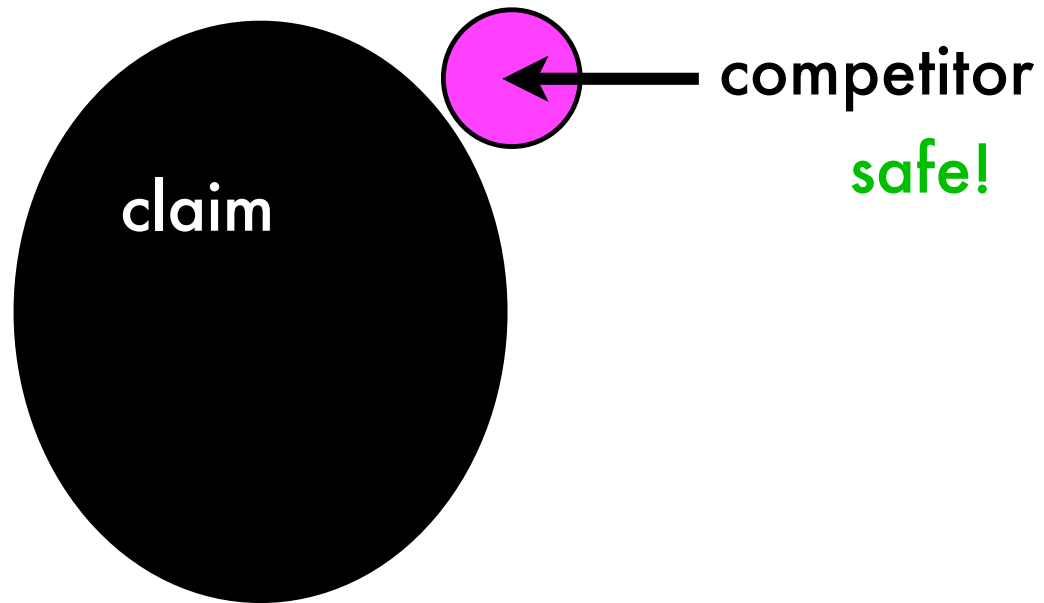
Prof. Roger Ford

Class 6 – February 10, 2015

Patents: Definiteness and Novelty

Class on IP research

- Wednesday, February 18
- 3:00 – 4:30 pm
- Room 282

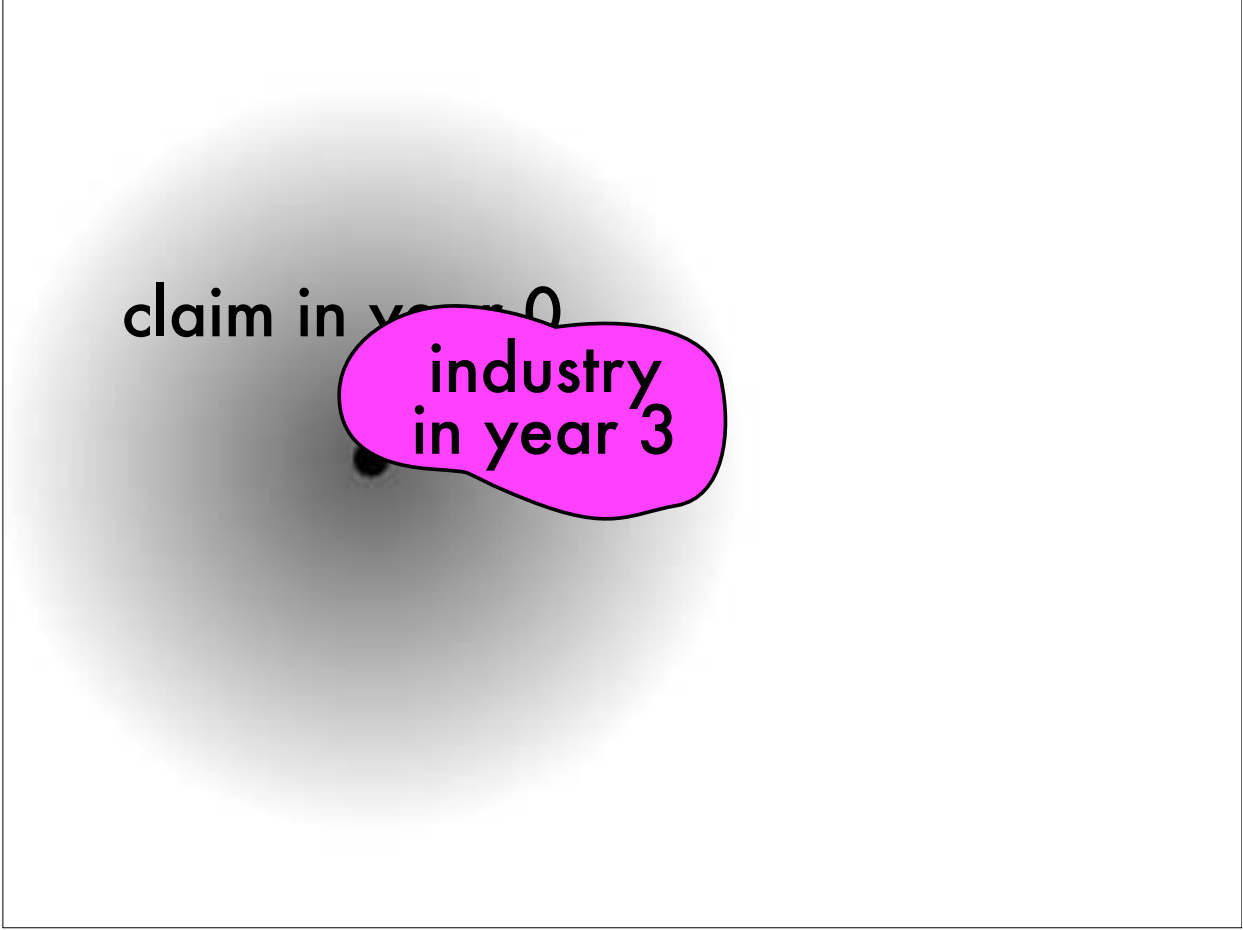


claim in year 0

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claim in year 0

industry
in year 3

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claim in year 1

claim in
year 4

United States Patent [19] Re. 28,525
Greene et al. [45] Reissued Aug. 19, 1975

[54] PROCESS FOR HYDROLYZING NITRILES [58] Field of Search..... 260/557, 561
[75] Inventors: Janice L. Greene, Warrensville Heights; Murrel Godfrey, Cleveland, both of Ohio [56] References Cited
UNITED STATES PATENTS
[73] Assignee: The Standard Oil Company 3,062,883 11/1962 Gilbert et al. 260/561

[22] Filed:
[21] Appl.

Reissue of:
[64] Patent
Issued
Appl.
Filed:

[52] U.S. C
[51] Int. C

U.S. Patent No. RE 28,525

2. The process for hydrolyzing a nitrile selected from the group consisting of acetonitrile, propionitrile, butyronitrile, acrylonitrile, methacrylonitrile, crotononitrile, maleic dinitrile, glutaronitrile, succinonitrile, adiponitrile, and cyclobutane-1,2-dicyanide [and benzonitrile] comprising contacting said nitrile with water at a pH of from about 1 to about 12.5 in the presence of a copper ion, said copper ion being at least partially soluble in water, the nitrile or in both water and nitrile and said copper ion being composed of copper in a combined valence state of $\text{Cu}^0 + \text{Cu}^+$, $\text{Cu}^0 + \text{Cu}^{++}$, $\text{Cu}^+ + \text{Cu}^{++}$, or $\text{Cu}^0 + \text{Cu}^+ + \text{Cu}^{++}$ at a temperature of from about 25°C to about 220°C at from about atmospheric pressure up to about 2000 psig.

“The term ‘partially soluble’ is not defined in the patent, nor was a standard definition of that term offered by Sohio. However, the term ‘slightly soluble’ did appear to have an established meaning at the relevant time, that is, in the mid-1960’s.

“The Court has found no textbook definition of the term ‘partially soluble’, however, and Dr. Greene has admitted that the term ‘partially soluble’ is not defined in the patent specifications. She should, of course, have done so in the patent, and if this had been done, that definition would have been binding on this court.”

Standard Oil Co. v. American Cyanamid Co.,
585 F. Supp. 1481 (E.D. La. 1984) (citations omitted)

“Sohio argues that ‘at least partially soluble’ would have the same meaning as ‘at least slightly soluble’. This Court disagrees. Taken alone, the expert testimony on this point is far from conclusive. However, when read against the language of the reissue patent, the testimony of Dr. Cotton and Dr. Ernest Yeager to the effect that ‘partially soluble’ suggests ‘considerable amounts’ and ‘substantial amounts’, respectively, become more persuasive.”

Standard Oil Co. v. American Cyanamid Co.,
585 F. Supp. 1481 (E.D. La. 1984) (citations omitted)

“Obviously, Dr. Green, aware of the meaning of ‘slightly soluble’, having used it in the specifications, and conceding that she was ‘skilled in the art’ of chemistry at the time, Dr. Green nevertheless elected to use another term, i.e. ‘partially soluble’ when she stated Claim 2. Considering that she sought to devise a process useful in her employer’s business, and having noted that ‘lower catalyst levels’ required ‘quite long’ reaction times it can only be fairly concluded that she contemplated a process which required more than simply a ‘slightly soluble’ ion; she required that the ion be ‘at least partially soluble’. Thus, in effect Dr. Greene defined in Claim 2 a significant and substantial degree of solubility.”

Standard Oil Co. v. American Cyanamid Co.,
585 F. Supp. 1481 (E.D. La. 1984) (citations omitted)

(pre-AIA) 35 U.S.C. § 102 — Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless —

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

* * *

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent * * *

(post-AIA) 35 U.S.C. § 102 — Conditions for patentability; novelty

(a) Novelty; Prior Art.— A person shall be entitled to a patent unless—

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or

(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

(b) Exceptions.—

* * *

Patent: iPod



Claim: A device for listening to digital music comprising a hard drive, a click wheel, interface software, and headphones

Patent: iPod



Claim: A device for listening to digital music comprising a hard drive, a click wheel, interface software, and headphones

Prior art #1: Nomad Jukebox



A device for listening to digital music with a hard drive, interface software, and headphones, but no click wheel

Patent: iPod



Claim: A device for listening to digital music comprising a hard drive, a click wheel, interface software, and headphones

Prior art #2: Kenwood car stereo



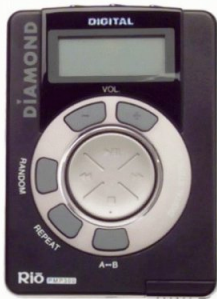
A device for listening to digital music with interface software and a click wheel

Patent: iPod



Claim: A device for listening to digital music comprising a hard drive, a click wheel, interface software, and headphones

Prior art #3: Diamond Rio mp3 player



A device for listening to digital music with interface software and headphones, and (maybe) a hard drive and a click wheel

<u>Patent: iPod</u>	<u>Nomad reference</u>	<u>Kenwood reference</u>	<u>Rio reference</u>
A device for listening to digital music comprising:			
a hard drive,			
a click wheel,			
interface software,			
and headphones.			

<u>Patent: iPod</u>	<u>Nomad reference</u>	<u>Kenwood reference</u>	<u>Rio reference</u>
A device for listening to digital music comprising:	✓	✓	✓
a hard drive,	✓	✗	???
a click wheel,	✗	✓	???
interface software,	✓	✓	✓
and headphones.	✓	✗	✓

<u>Patent: iPod</u>	<u>Nomad reference</u>	<u>Kenwood reference</u>	<u>Rio reference</u>
A device for listening to digital music comprising:	✓	✓	✓
a hard drive,	✓	✗	???
a click wheel,	✗	✓	???
interface software,	✓	✓	✓
and headphones.	✓	✗	✓