

# Fun IP

Prof. Roger Ford  
Class 6 – February 29, 2016  
Patents: Novelty and Statutory Bars

## Novelty and statutory bars: introduction

- The patent bargain:
  - In return for inventing something new and disclosing it to the world, the patent system grants a limited monopoly

# Novelty and statutory bars: introduction

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  - In return for inventing something new and disclosing it to the world, the patent system grants a limited monopoly

# Novelty and statutory bars: introduction

- So how do we tell if something is new enough to get a patent?
- Three doctrines:
  - Novelty – is there a single piece of prior art that anticipates the patented invention?
  - Statutory bars – is there a single piece of prior art that came too soon before filing a patent?
  - Obviousness – is there one or more pieces of prior art that render the invention obvious?

# Novelty and statutory bars: introduction

- Terminology: reference = prior art
- Something predating the critical date
  - In the public domain
  - Can be anything: patent, scientific paper, physical product, newspaper article, &c

# Novelty and statutory bars: introduction

- Terminology: critical date
- Pre-AIA: date the invention was invented
    - ❖ Can be difficult to discern
    - ❖ Sometimes litigated
  - Post-AIA: effective filing date

# Novelty and statutory bars: introduction

- Terminology: effective date of the reference
- When it entered the public domain
  - Must come before critical date to be prior art
    - ❖ So if I write a paper, but never publish it, and then you invent the thing I described, you get the patent – does that make sense?

# Novelty and statutory bars: introduction

- Terminology: anticipation
- If a prior-art reference includes the claimed invention, it anticipates the claim
  - A claim is “invalid by anticipation”
  - Evaluated claim by claim

# Novelty and statutory bars: introduction

→ Terminology: all-elements rule

- A single claim probably has several elements
- A single prior-art reference must have every single element to anticipate

# Novelty and statutory bars: introduction

→ Novelty / statutory bars as a four-step process:

- Figure out if pre- or post-AIA law applies
- Figure out if something qualifies to be prior art under § 102
- Figure out the timing: the effective date of the reference and the critical date of the patent
- Figure out if the information disclosed in the reference anticipates the patent claim(s)

# Novelty and statutory bars: introduction

→ Novelty / statutory bars as a four-step process:

- *Note:* The test is not “is the invention new?”
- *Instead:* “Is there a particular piece of prior art that proves the invention is not new?”

## (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\* \* \*

# Novelty and statutory bars: introduction

→ Relevant prior-art references (pre-AIA):

- § 102(a): things “known ... by others in this country”
- § 102(a): things “used by others in this country”
- § 102(a) / § 102(b): “patented ... in this or a foreign country”
- § 102(a) / § 102(b): “described in a printed publication in this or a foreign country”
- § 102(b): “in public use ... in this country”
- § 102(b): “on sale in this country”
- [others]

## (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.—

\* \* \*

# Novelty and statutory bars: introduction

→ Relevant prior-art references (post-AIA):

- § 102(a)(1): things “patented”
- § 102(a)(1): things “described in a printed publication
- § 102(a)(1): things “in public use”
- § 102(a)(1): things “on sale”
- § 102(a)(1): things “otherwise available to the public”
- [others]

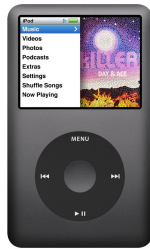
Patent: iPod



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



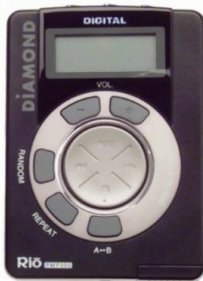
A device for listening to digital music with interface software and a click wheel

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

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A device for listening to digital music comprising:	✓	✓	✓
a hard drive,	✓	✓	???
a click wheel,	✗	✓	???
interface software,	✓	✓	✓
and headphones.	✓	✗	✓