IP Law

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Class 6 – March 25, 2019
Patents: Novelty and Obviousness

Novelty & obviousness: introduction

→ The patent bargain:

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

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Novelty & obviousness: 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 & obviousness: 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 & obviousness: introduction

→ Terminology: critical date

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

Novelty & obviousness: 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 & obviousness: introduction

→ Terminology: anticipation

- If a prior-art reference includes the claimed invention, it anticipates the claim – renders it not novel under § 102
- A claim is "invalid by anticipation"
- Evaluated claim by claim

Novelty & obviousness: 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 & obviousness: introduction

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

- Figure out if pre- or post-AIA law applies
- Figure out if something counts as prior art: does it fit in a § 102 category?
- 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 & obviousness: 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?"

Patent: iPod

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

Patent: iPod

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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

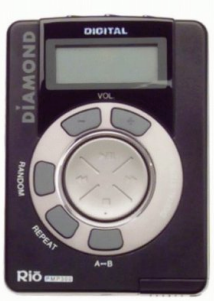
Prior art #2: Kenwood car stereo

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

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

Patent: iPod	Nomad reference	Kenwood reference	Rio reference
A device for listening to digital music comprising:	✔	✔	✔
a hard drive,	✔	✘	? ? ?
a click wheel,	✘	✔	? ? ?
interface software,	✔	✔	✔
and headphones.	✔	✘	✔

Patent: iPod	Nomad reference	Kenwood reference	Rio reference
A device for listening to digital music comprising:	✔	✔	✔
a hard drive,		✘	? ? ?
a click wheel,		✔	? ? ?
interface software,	✔	✔	✔
and headphones.	✔	✘	✔

Patent: iPod	Nomad reference	Kenwood reference	Rio reference
A device for listening to digital music comprising:	✔	✔	✔
a hard drive,	✔	✔	? ? ?
a click wheel,	✘	✔	? ? ?
interface software,	✔	✔	✔
and headphones.	✔	✘	✔

(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 * * *

Novelty & obviousness: introduction

→ Relevant § 102 prior art (pre-AIA):

- § 102(a): "known … by others in this country"
- § 102(a): "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 * **

(b) Exceptions.—

* * *

Novelty & obviousness: introduction

→ Relevant § 102 prior art (post-AIA):

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

(Post-AIA) 35 U.S.C. § 103 — Conditions for patentability; non-obvious subject matter

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if **the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains**. Patentability shall not be negated by the manner in which the invention was made.

Novelty & obviousness: introduction

→ Why a separate requirement?

- Combine multiple prior-art references
- Make a trivial advance over a prior-art referencer
- Fill an evidentiary hole in a prior-art reference