Patent Law

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March 2, 2015
Class 10 – Novelty: priority of invention and prior invention

Announcements

Midterm info

- → Instruction page is now on the web – we'll discuss next time
- → Exam will cover through the classes on novelty
- → Also, hint: think back to enablement and written description
- → No statutory bars

Recap

Recap

→ Taking stock of where we are

→ Disclosure in patent documents

→ Derivation

Taking stock of where we are

→ Novelty and statutory bars: § 102

→ First question: effective filing date on or after March 16, 2013

- If so: post-AIA statute/rules
- If not: pre-AIA statute/rules

Taking stock of where we are

→ Pre-AIA § 102:

- § 102(a): novelty
- § 102(b): statutory bar
- § 102(c): statutory bar
- § 102(d): statutory bar
- § 102(e): novelty
- § 102(f): derivation
- § 102(g): novelty

Taking stock of where we are

→ Pre-AIA § 102(a): novelty

- known by others (in this country)
- used by others (in this country)
- patented (anywhere)
- described in a printed publication (anywhere)
- before the invention

Taking stock of where we are

→ Pre-AIA § 102(e): novelty

- described in a published patent application (in this country)
- described in a patent (in this country)
- filed before the invention, even if published later (backdated prior art)

Taking stock of where we are

→ Pre-AIA § 102(f): derivation

- stolen from someone else

Taking stock of where we are

→ Pre-AIA § 102(g): novelty

- invented first by someone else (anywhere); not abandoned, suppressed, or concealed; and established in an interference
- invented first by someone else (in this country); and not abandoned, suppressed, or concealed

Taking stock of where we are

→ Post-AIA § 102:

- § 102(a): novelty
- § 102(b): grace period

Taking stock of where we are

→ Post-AIA § 102(a)(1): novelty

- patented
- described in a printed publication
- in public use
- on sale
- otherwise available to the public
- anywhere
- before the effective filing date (not the invention!)

Taking stock of where we are

→ Post-AIA § 102(a)(2): novelty

- described in a published patent application, or
- described in a patent
- anywhere
- with an effective filing date before the effective filing date (not the invention!)

Recap

- → Taking stock of where we are
- → Disclosure in patent documents
- → Derivation

Today's agenda

Today's agenda

- → priority of invention and § 102(g)
- → abandoned, suppressed, or concealed inventions
- → § 102(g) as prior art

Priority of invention

Priority of invention

→ The goal: figure out who invented first

→ No longer really relevant under the post-AIA first-to-file system

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

A person shall be entitled to a patent unless —

* * *

(g)

(1) during the course of an **interference** conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was **made by such other inventor** and **not abandoned, suppressed, or concealed**, or

(2) before such person's invention thereof, the invention was **made in this country by another inventor** who had **not abandoned, suppressed, or concealed** it.

In determining priority of invention under this subsection, there shall be considered not only the respective dates of **conception** and **reduction to practice** of the invention, but also the **reasonable diligence** of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

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Priority of invention

→ Invention has two steps:

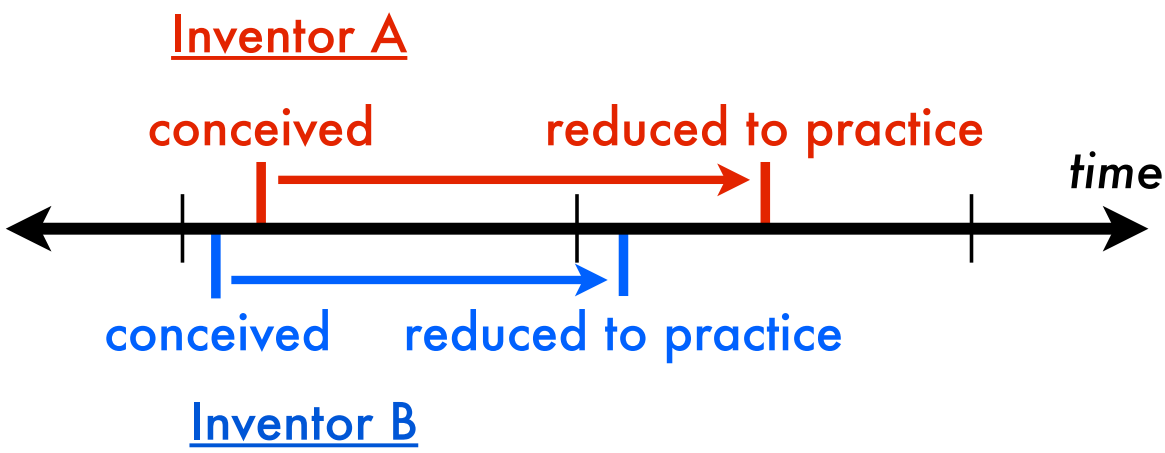
- First, conception
- Second, reduction to practice

Priority of invention

→ A four-part summary of this law:

- 1. The first to reduce the invention to practice usually has priority.
- 2. Filing a valid application counts as constructive reduction to practice.
- 3. The first to conceive may prevail over the first to reduce to practice if the first to conceive was diligent from a time prior to the second conceiver's conception.
- 4. Any reduction to practice that is abandoned, suppressed, or concealed doesn't count.

Priority of invention



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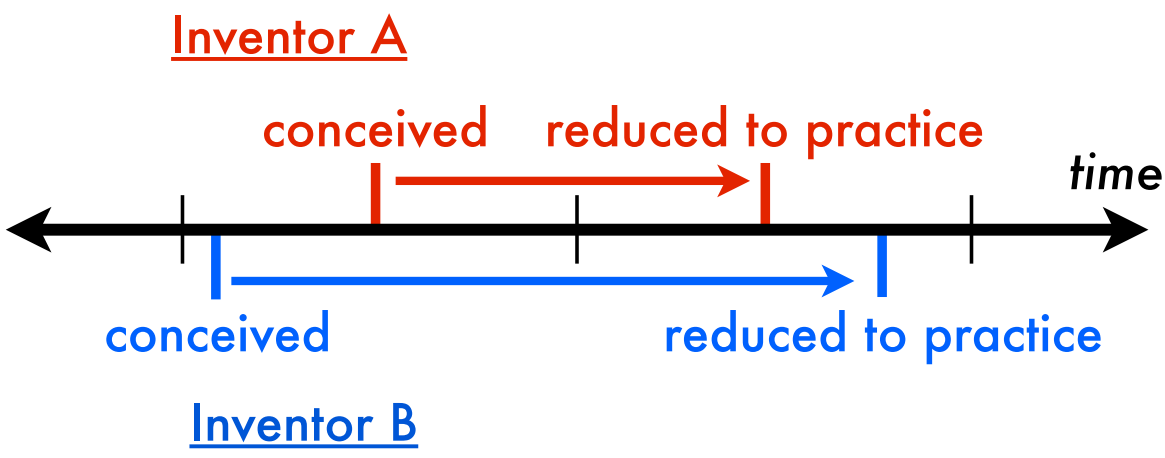

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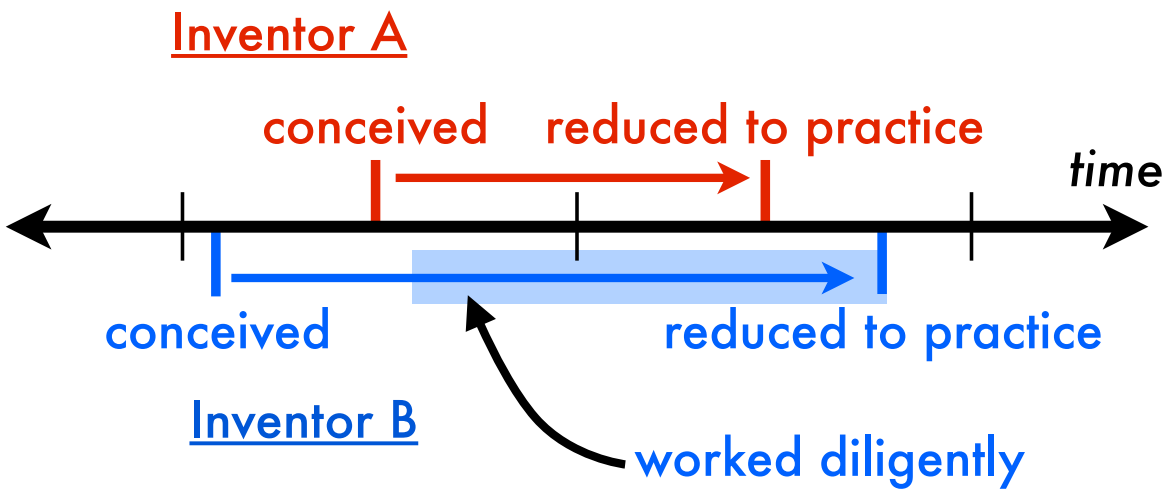

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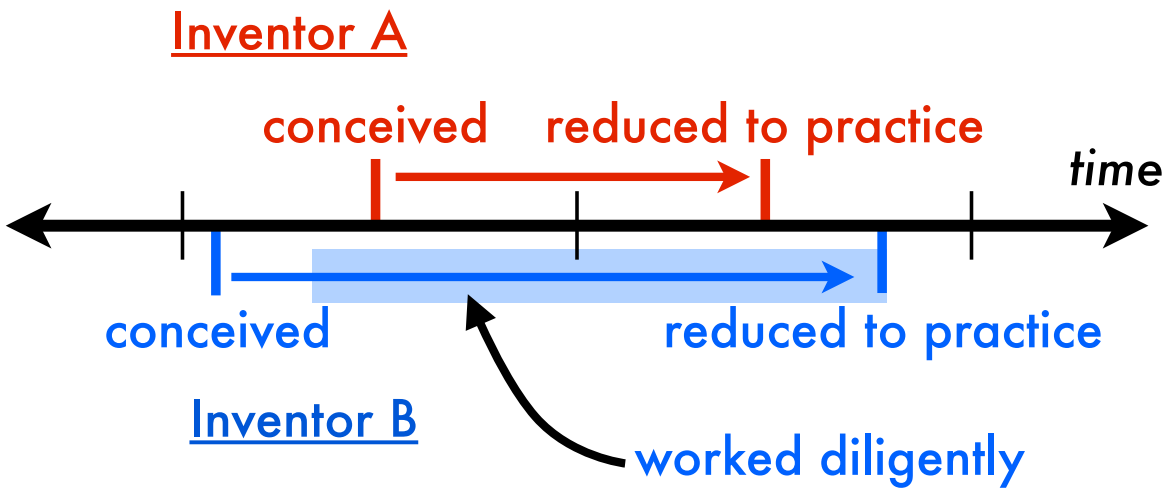


Brown v. Barbacid

→ So what counts as conception and reduction to practice?

- Barbacid: March 6, 1990
- Brown: experiment on Sept. 20, 1989
- Brown: experiment on Sept. 25, 1989

Brown v. Barbacid

→ What was wrong with the September 20 experiment?

Brown v. Barbacid

→ What was wrong with the September 20 experiment?

- Didn't include every limitation of the claim
- September 25: added peptide inhibitor

Brown v. Barbacid

→ What was wrong with the September 25 experiment?

Brown v. Barbacid

→ What was wrong with the September 25 experiment?

- No (corroborated!) evidence that Dr. Reiss immediately understood what was going on
- Need both (1) an embodiment that encompasses all elements of the invention, and (2) appreciating that the embodiment works for the intended purpose

Brown v. Barbacid

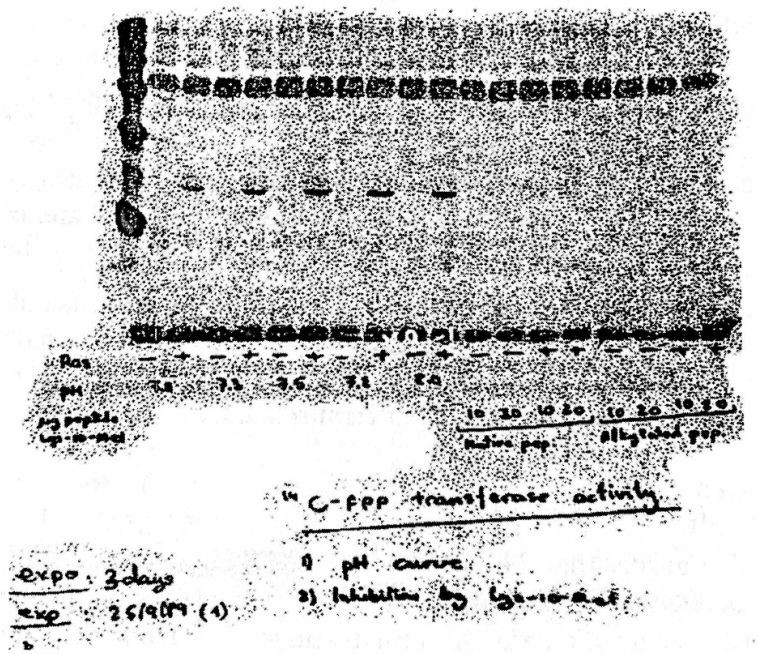
→ Working embodiment: September 25, 1989

→ Appreciation: by at least November 1989

- Testimony of Dr. Casey

→ November 1989 is before March 6, 1990, so Brown wins

Priority of invention



Priority of invention

→ Benefits of a first-to-invent system?

→ Downsides?

Priority of invention

→ Benefits of a first-to-invent system?

- Incentive to invent earlier

→ Downsides?

- Expensive to administer, especially when there are close calls
- Doesn't incentivize filing earlier

Priority of invention

→ Diligence

- Small gaps are okay
- Larger gaps need a good excuse: maybe poverty, regular employment, or vacations
- Bad excuses: attempts to commercialize, work on other projects, doubts about the invention

Priority of invention

→ Constructive reduction to practice: Why does a patent application count?

Priority of invention

→ Constructive reduction to practice: Why does a patent application count?

- In theory, it is fully enabling, just like an actual reduction to practice
- Also, encourages early filing

Abandoned/ suppressed/concealed

Abandoned/ suppressed/concealed

→ Suppressed/concealed: trade secrets are the classic example

→ Abandoned: filing delays

- Much harder

Peeler v. Miller

→ Peeler application: Jan. 4, 1968

→ Miller invention: April 18, 1966

→ Miller app. work begins: Oct. 1968

→ Miller application: April 27, 1970

Peeler v. Miller

→ Was the invention abandoned?

Peeler v. Miller

→ Was the invention abandoned?

- Yup. Four-year delay in filing patent application was too long.
- No specific proof of intent to abandon
- "Mere delay" is not enough to abandon
- But here, timing was "unreasonable"

Peeler v. Miller

→ Delays

- In general: months are fine; years are not
- But it is a fact-specific inquiry
- If you have a good excuse to delay, that's okay
- Best excuse: to improve the patent application (through testing, &c)

Peeler v. Miller

→ Who gets the patent?

Peeler v. Miller

→ Who gets the patent?

- Peeler!
- Even though he wasn't the first inventor!

§ 102(g) as prior art

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§ 102(g) as prior art

→ Why doesn't § 102(g)(2) cover all other kinds of prior art?

- § 102(g)(2) requires conception and reduction to practice — more limited than printed publications, &c
- § 102(g)(2) is limited to invention in the United States

§ 102(g) as prior art

→ Bottom line: § 102(g)(2) is another way of back-dating prior art that later becomes public

- Not abandoned/suppressed/concealed

Dow Chemical v. Astro-Valcour

→ 3/84: AVI makes foam with isobutane

→ 8/84: AVI makes foam with isobutane (again)

→ 8/84: Dow conceives of invention

→ 9/84: Dow reduces invention to practice

→ 12/85: Dow files patent application

Dow Chemical v. Astro-Valcour

→ So AVI made the invention first. What's Dow's argument?

Dow Chemical v. Astro-Valcour

→ So AVI made the invention first. What's Dow's argument?

- AVI hadn't actually invented it – no one thought they had invented anything new
- Sort of like *Seaborg* and *Schering-Plough*

Dow Chemical v. Astro-Valcour

→ Why isn't this a good argument? Invention requires conception and reduction to practice....

Dow Chemical v. Astro-Valcour

→ Why isn't this a good argument? Invention requires conception and reduction to practice....

- You have to understand what you did – and they did
- You don't have to understand <u>that it may be patentable</u>

Dow Chemical v. Astro-Valcour

→ Does this rule make sense?

Dow Chemical v. Astro-Valcour

→ Does this rule make sense?

- Yes, if we're concerned about the benefit the public gets <u>from the product</u>
- No, if we're concerned about the benefit the public gets <u>from disclosure in the patent</u>

Dow Chemical v. Astro-Valcour

→ Was this abandoned/suppressed/ concealed?

Dow Chemical v. Astro-Valcour

→ Was this abandoned/suppressed/ concealed?

- Two ways: deliberate or implied
- Here: 2.5 years – commercializing the product, not waiting to file a patent application
- Would 2.5 years before filing a patent application have been okay?

Next time

Next time

→ Statutory bars: introduction and public use

→ 10 minutes at end of class for midterm course evaluations