Patent Law

Prof. Roger Ford
March 4, 2015
Class 11 – Statutory bars: introduction; public use

Recap

Recap

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

Today's agenda

Today's agenda

- → Midterm exam
- → Introduction to statutory bars
- → Public use/on sale
- → Exercises

Midterm exam

Statutory bars

- → Two short-answer (mini-essay) questions
- → One on novelty, one on written description / enablement
- → Not issue spotters – I will ask direct questions
- → No need to follow IRAC/CRAC
  - Give a direct answer, and then explain why

Introduction to statutory bars

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 —

(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

* * *

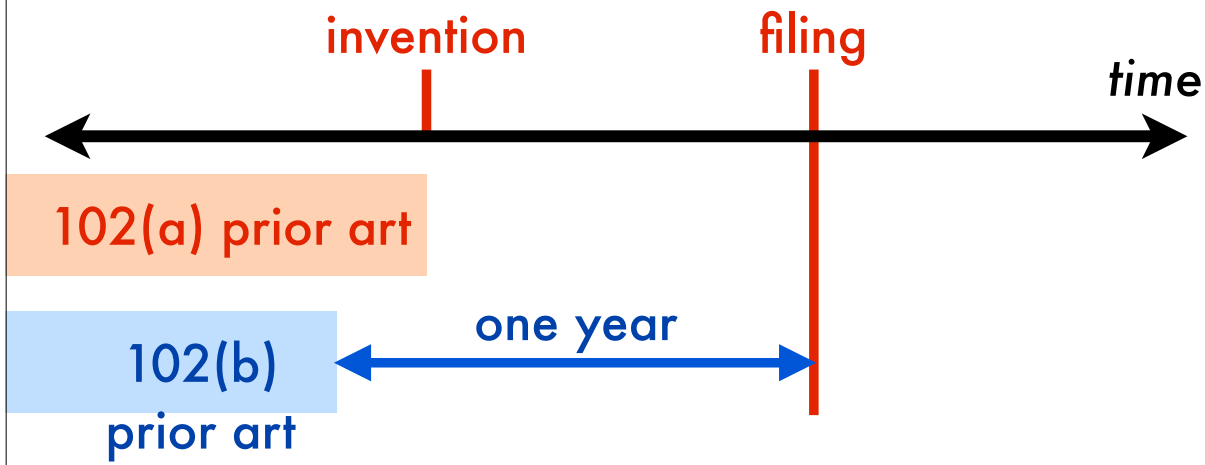
Pre-AIA § 102(a) (novelty)	Pre-AIA § 102(b) (statutory bars)
known by others (in U.S.)	on sale (in U.S.)
used by others (in U.S.)	in public use (in U.S.)
patented (anywhere)	patented (anywhere)
described in a printed publication (anywhere)	described in a printed publication (anywhere)
before the invention	more than one year prior to the application date

Statutory bars (pre-AIA)

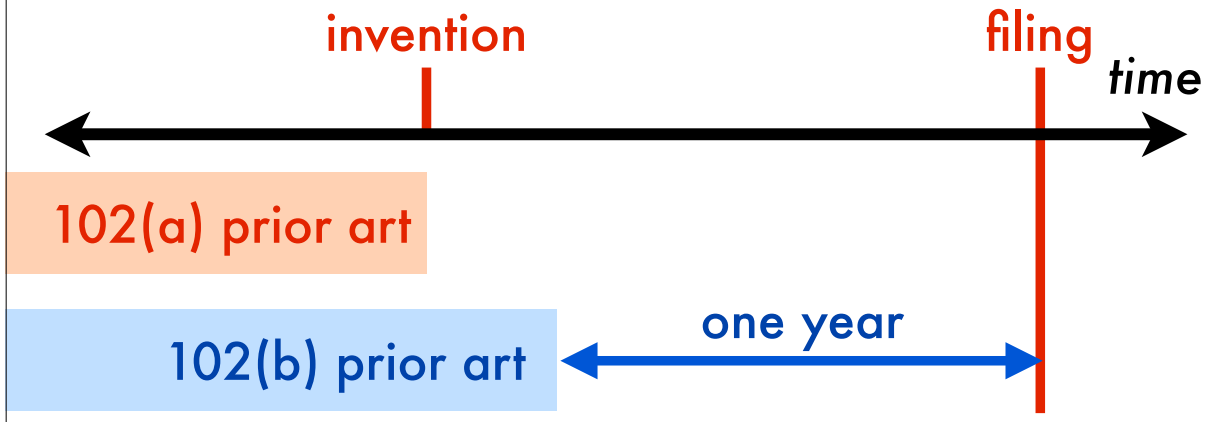
Statutory bars (pre-AIA)

102(a) prior art

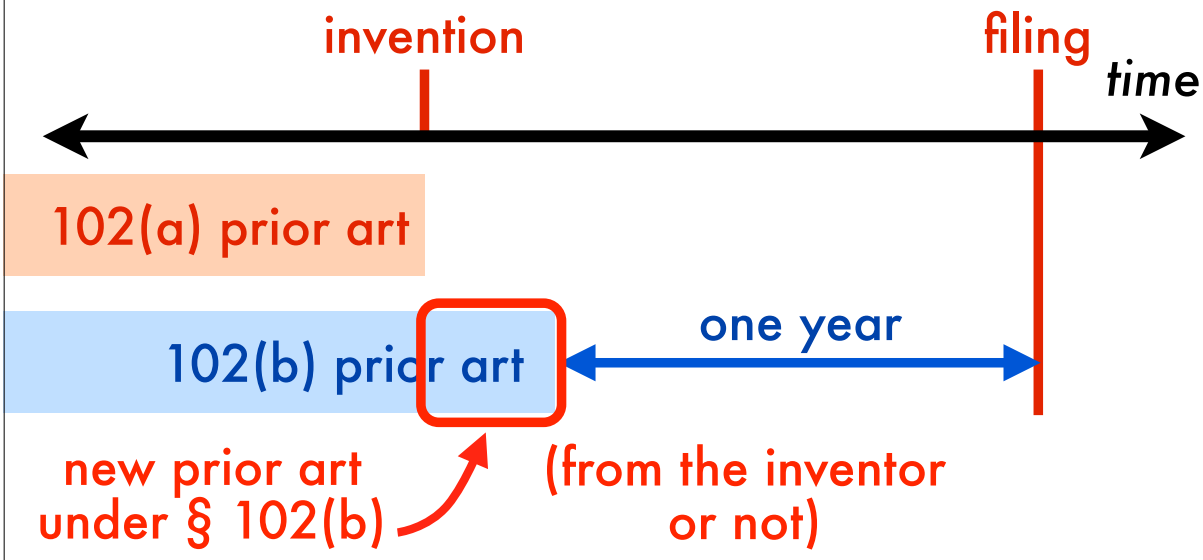
Statutory bars (pre-AIA)



Statutory bars (pre-AIA)



Statutory bars (pre-AIA)



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

(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.

* * *

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

* * * (b) Exceptions.—

(1) Disclosures made 1 year or less before the effective filing date of the claimed invention.— A disclosure made **1 year or less before the effective filing date** of a claimed invention shall not be prior art to the claimed invention under subsection (a) (1) if—

(A) the disclosure was **made by the inventor** or joint inventor or by **another who obtained the subject matter disclosed directly or indirectly from the inventor** or a joint inventor; or

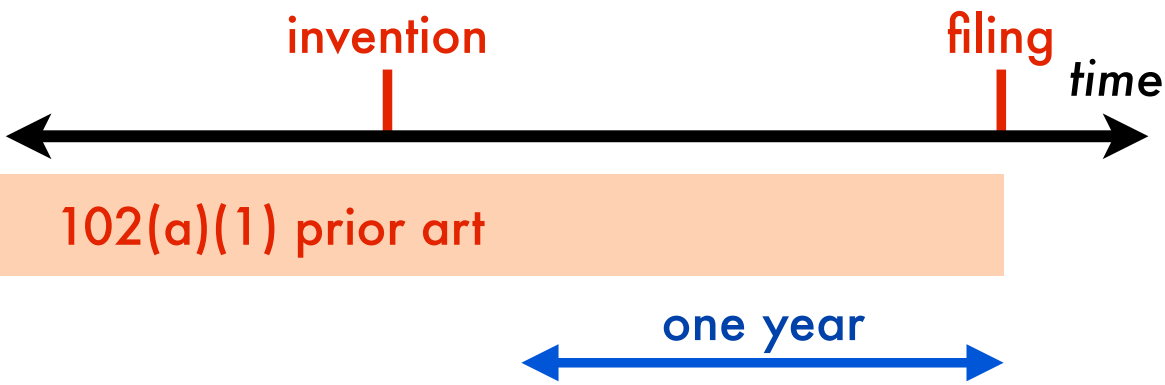
(B) the subject matter disclosed **had, before such disclosure, been publicly disclosed by the inventor** or a joint inventor or **another who obtained the subject matter disclosed directly or indirectly from the inventor** or a joint inventor.

* * *

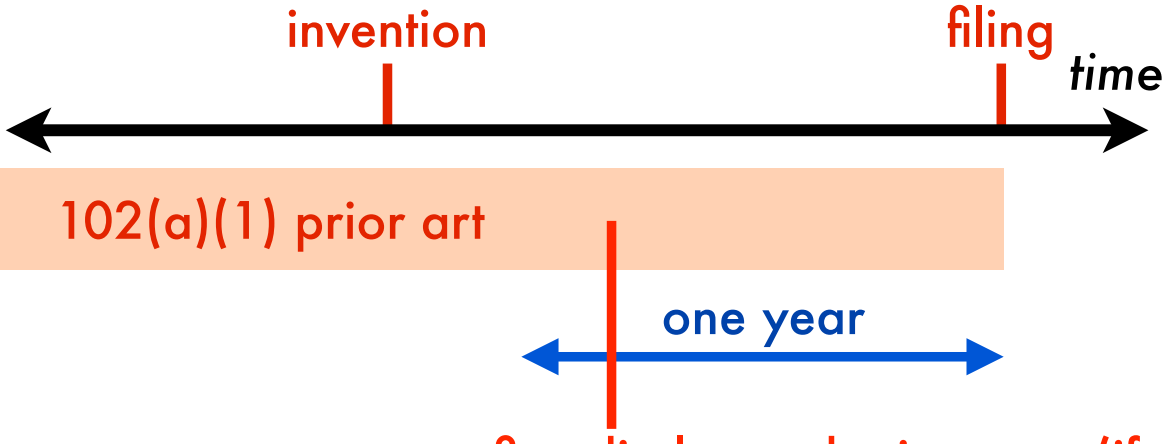
Grace period (post-AIA)

102(a)(1) prior art

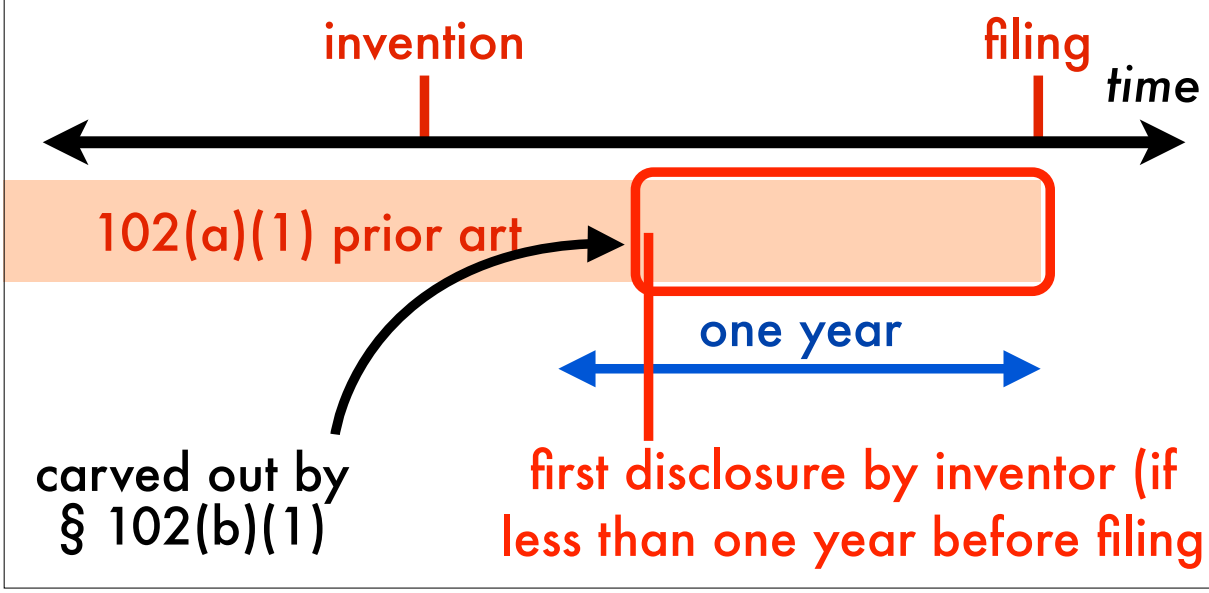
Grace period (post-AIA)



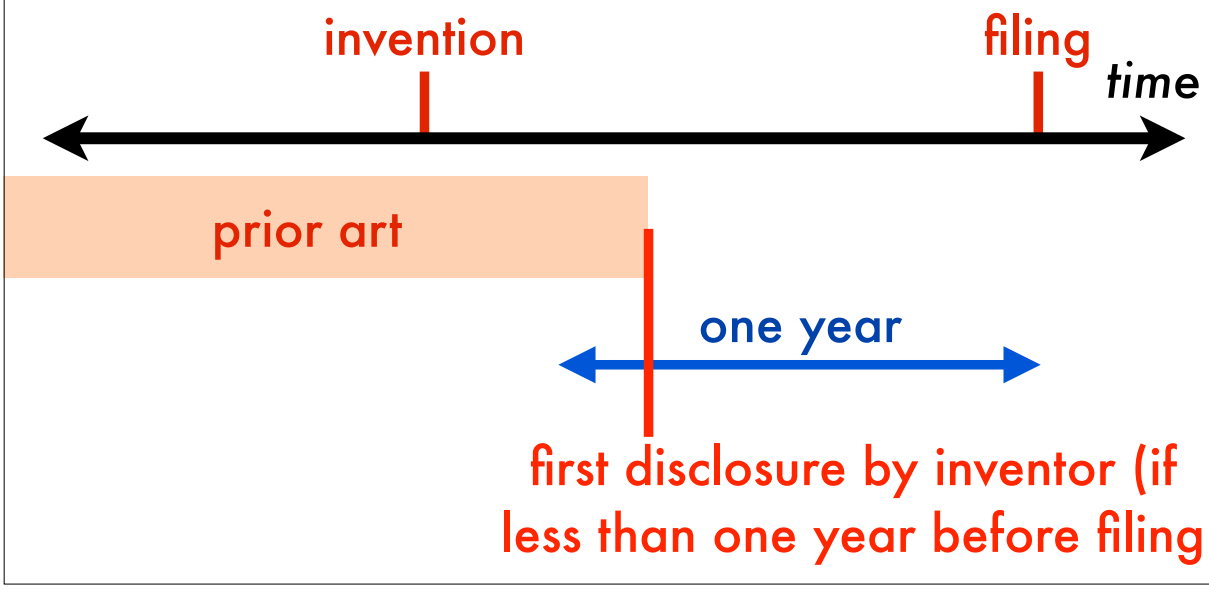
Grace period (post-AIA)



Grace period (post-AIA)



Grace period (post-AIA)



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

* * * (b) Exceptions.—

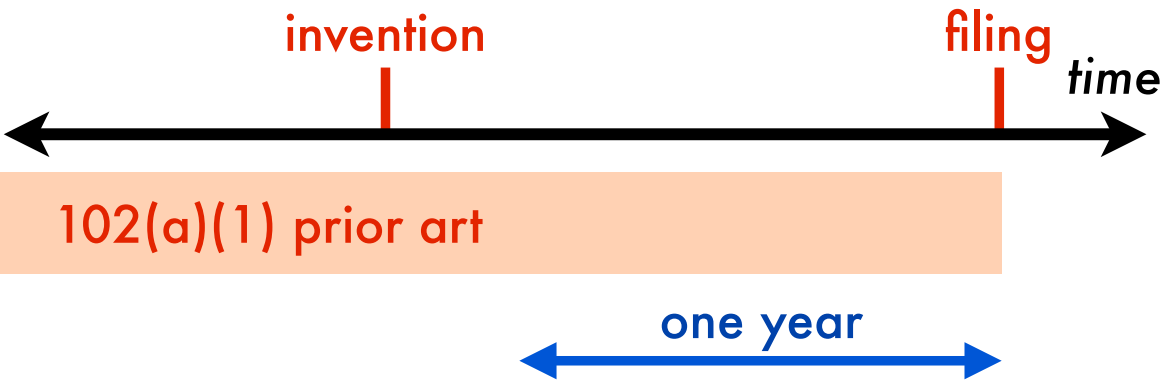
(1) Disclosures made 1 year or less before the effective filing date of the claimed invention.— A disclosure made **1 year or less before the effective filing date** of a claimed invention shall not be prior art to the claimed invention under subsection (a) (1) if—

(A) the disclosure was **made by the inventor** or joint inventor or by **another who obtained the subject matter disclosed directly or indirectly from the inventor** or a joint inventor; or

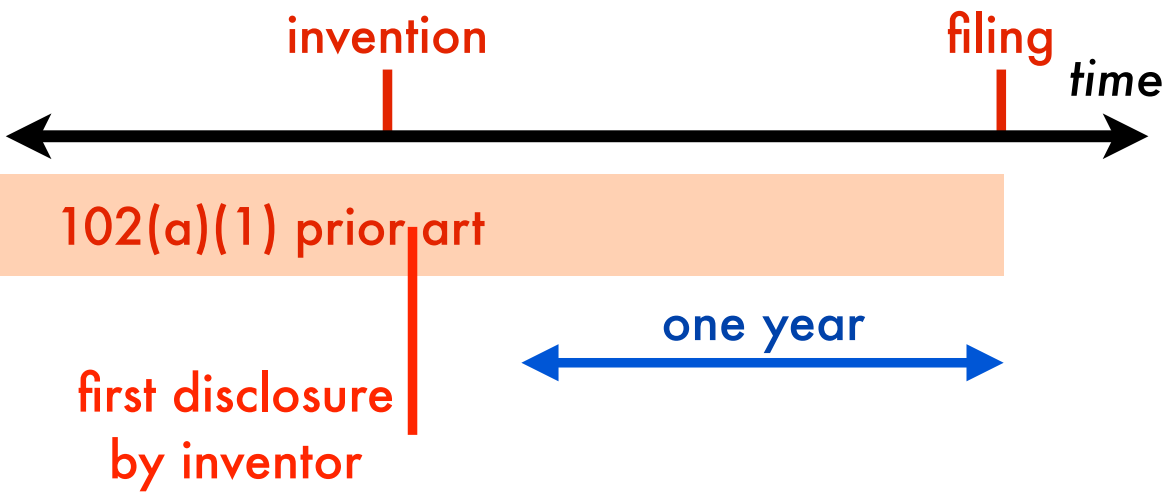
(B) the subject matter disclosed **had, before such disclosure, been publicly disclosed by the inventor** or a joint inventor or **another who obtained the subject matter disclosed directly or indirectly from the inventor** or a joint inventor.

* * *

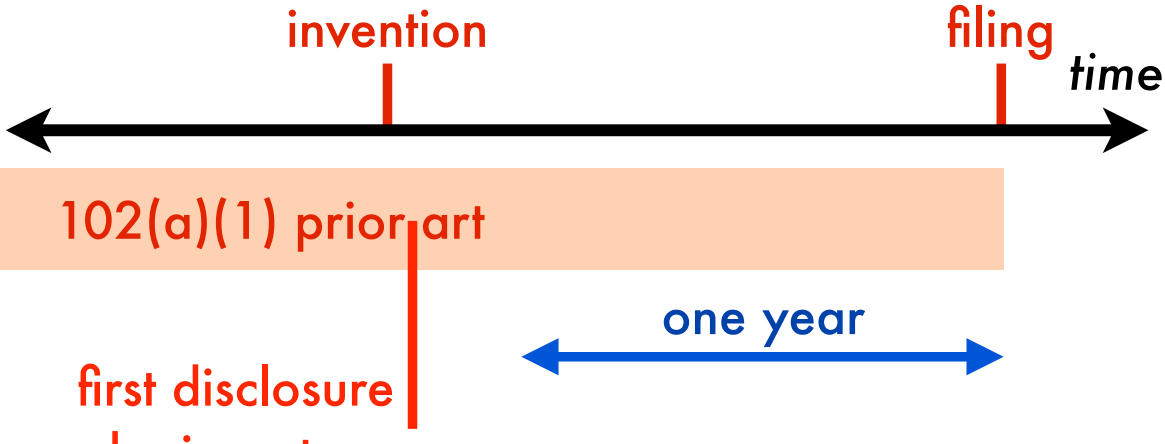
Grace period (post-AIA)



Grace period (post-AIA)



Grace period (post-AIA)



More than one year before filing
– not carved out by § 102(b)(1)

Statutory bars

→ Why penalize inventors who wait too long to file for patents?

Statutory bars

→ Why penalize inventors who wait too long to file for patents?

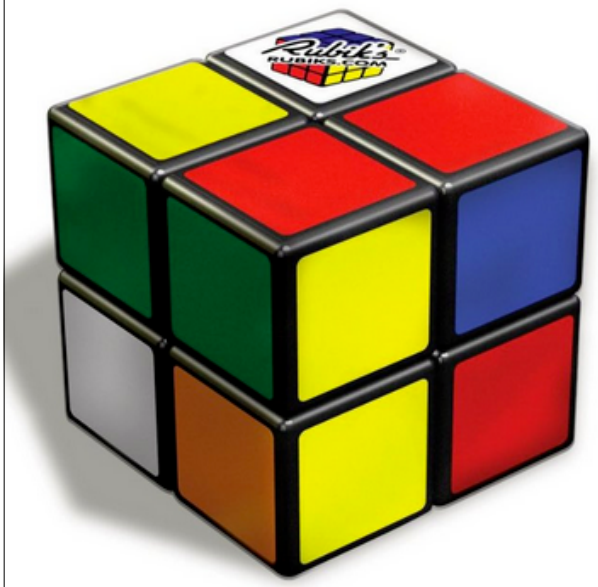
- Encourage early disclosure of information and improve state of the art
- Patent rights expire earlier
- Reliance interest: People invest based on ideas that are circulating in the public

Statutory bars

→ We have the same concern about extending a monopoly with continuation applications – why not just limit the monopoly term?

Public use/on sale

Moleculon Research



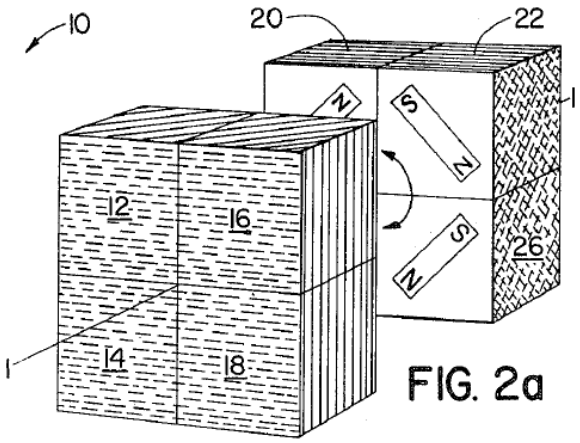


FIG. 2a

Moleculon Research

- → 1957: Nichols conceives of toy
- → 1957–62: Nichols constructs paper models
- → 1968: Nichols constructs wooden model
- → January 1969: Nichols agrees to assign rights to Moleculon
- → March 7, 1969: Nichols sends model to Parker Brothers
- → March 3, 1970: Nichols files patent application

Moleculon Research

→ So when did Nichols invent?

Moleculon Research

→ So when did Nichols invent?

- Conception: 1957
- Reduction to practice: probably sometime in 1957–62

Moleculon Research

→ Possible prior-art disclosures:

- Nichols showing model to coworkers
- Nichols assigning rights to Moleculon
- Nichols offering license to Parker Bros.

→ How do each of these turn out under § 102(a)?

→ Under § 102(b)?

Moleculon Research

→ Public use:

- Nichols explaining how model works to grad-student friends
- Nichols showing model to Obermayer
- Nichols contacting game manufacturers

→ Nichols "retained control over the puzzle's use and the distribution of information concerning it"

Moleculon Research

→ Consistent with *Beachcombers?*

→ Consistent with the "known or used by others" standard from § 102(a)?

Moleculon Research

→ What if I rent a booth at a trade show and demo my invention to everyone, but the trade show has a no-photos rule?

→ What if I put my booth behind a curtain and make visitors sign non-disclosure agreements?

→ What if I give a lecture?

Moleculon Research

→ On sale:

- Nichols contacting game manufacturers
- Nichols assigning rights to Moleculon

→ Transferring rights is not the same thing as selling the individual invention

Moleculon Research

→ But what if he had transferred the prototype to Moleculon?

Moleculon Research

→ But what if he had transferred the prototype to Moleculon?

- Maybe we care about how long consumers have to pay monopoly prices
- Maybe we want a rule, not a standard
- Maybe a limited sale to one person doesn't count

Metallizing Eng'g Co. v. Kenyon Bearing

→ Public use?

- Use to make products that are sold to the public
- Even though the public can't figure out the patented process

Metallizing Eng'g Co. v. Kenyon Bearing

→ What's the concern?

Metallizing Eng'g Co. v. Kenyon Bearing

→ What's the concern?

- Letting someone use a process and later patent it extends the monopoly

→ So, trade-secret uses can be public uses, if they're used to manufacture products for sale to the public

Exercises

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 —

(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

* * *

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

(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.

* * *

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

* * * (b) Exceptions.—

(1) Disclosures made 1 year or less before the effective filing date of the claimed invention.— A disclosure made **1 year or less before the effective filing date** of a claimed invention shall not be prior art to the claimed invention under subsection (a) (1) if—

(A) the disclosure was **made by the inventor** or joint inventor or by **another who obtained the subject matter disclosed directly or indirectly from the inventor** or a joint inventor; or

(B) the subject matter disclosed **had, before such disclosure, been publicly disclosed by the inventor** or a joint inventor or **another who obtained the subject matter disclosed directly or indirectly from the inventor** or a joint inventor.

* * *

Problems

→ Jan. 1, 2004: I invent X

→ April 1, 2004: I disclose X in a journal article

→ July 1, 2004: I file for a patent on X

→ Can I get a patent on X?

Problems

→ Jan. 1, 2004: I invent X

→ April 1, 2004: I disclose X in a journal article

→ July 1, 2004: I file for a patent on X

→ Can I get a patent on X?

- Yup. No § 102(a) problem; no § 102(b) problem because journal article was after the critical date

Problems

→ Jan. 1, 2004: I invent X

→ April 1, 2004: I disclose X in a journal article

→ July 1, 2005: I file for a patent on X

→ Can I get a patent on X?

Problems

→ Jan. 1, 2004: I invent X

→ April 1, 2004: I disclose X in a journal article

→ July 1, 2005: I file for a patent on X

→ Can I get a patent on X?

- Nope. No § 102(a) problem; but the journal article is § 102(b) prior art

Problems

→ Jan. 1, 2014: I invent X

→ April 1, 2014: I disclose X in a journal article

→ July 1, 2014: I file for a patent on X

→ Can I get a patent on X?

Problems

→ Jan. 1, 2014: I invent X

→ April 1, 2014: I disclose X in a journal article

→ July 1, 2014: I file for a patent on X

→ Can I get a patent on X?

- Yup. Journal article is § 102(a)(1) prior art, but carved out by § 102(b)(1) because the disclosure was from me and less than a year before filing date

Problems

- → Jan. 1, 2014: I invent X
- → April 1, 2014: I disclose X in a journal article
- → July 1, 2015: I file for a patent on X
- → Can I get a patent on X?

Problems

- → Jan. 1, 2014: I invent X
- → April 1, 2014: I disclose X in a journal article
- → July 1, 2015: I file for a patent on X
- → Can I get a patent on X?
  - Nope. Journal article is § 102(a)(1) prior art, and there is no § 102(b)(1) carve-out because the disclosure was more than a year before filing date

Problems

→ Jan. 1, 2014: I invent X

→ April 1, 2014: I disclose X in a journal article

→ June 1, 2014: Rival inventor starts selling X

→ March 1, 2015: I file for a patent on X

→ Can I get a patent on X?

Problems

→ Jan. 1, 2014: I invent X

→ April 1, 2014: I disclose X in a journal article

→ June 1, 2014: Rival inventor starts selling X

→ March 1, 2015: I file for a patent on X

→ Can I get a patent on X?

- Yup. Journal article and rival product are both § 102(a)(1) prior art, but there is a § 102(b)(1) carve-out because the disclosure was less than a year before filing date and the first disclosure was from me

Problems

→ Jan. 1, 2014: I invent X

→ March 1, 2014: Rival inventor starts selling X

→ April 1, 2014: I disclose X in a journal article

→ March 1, 2015: I file for a patent on X

→ Can I get a patent on X?

Problems

→ Jan. 1, 2014: I invent X

→ March 1, 2014: Rival inventor starts selling X

→ April 1, 2014: I disclose X in a journal article

→ March 1, 2015: I file for a patent on X

→ Can I get a patent on X?

- Nope. Journal article and rival product are both § 102(a)(1) prior art, and rival inventor's product is not carved out under § 102(b)(1) because it wasn't derived from me

Next time

Next time

→ Statutory bars: public sale; third-party activity