Patent Law

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March 11, 2015
Class 13 – Statutory bars:
party-specific bars; AIA grace period

Recap

Recap

→ The on-sale bar

→ Third-party activities

Today's agenda

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- → Party-specific bars: introduction
- → Abandonment
- → Foreign patent filings

Party-specific 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 —

N (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

SB (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

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

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

* * *

SB (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, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or

D (f) he did not himself invent the subject matter sought to be patented, or

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

* * *

N (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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SB (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

(c) he has **abandoned** the invention, or

(d) the invention was **first patented** or caused to be patented, or was the subject of an inventor's certificate, **by the applicant** or his legal representatives or assigns **in a foreign country** prior to the **date of the application for patent in this country** on an application for patent or inventor's certificate **filed more than twelve months before the filing of the application in the United States**, or

* * *

Party-specific bars

→ Other statutory bars apply to actions by the inventor OR by anyone else

- § 102(b) – printed publications &c
- § 102(e) – patent applications

→ Though, as we have seen, sometimes the bar is interpreted differently for actions by the inventor and actions by others

Party-specific bars

→ Party-specific bars apply ONLY to actions by the inventor

- § 102(c) – abandonment
- § 102(d) – foreign filings

Abandonment

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

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* * *

Macbeth-Evans Glass

- → 1903: Macbeth begins using secret process to make glass products
- → May 1910: Macbeth employee leaves and takes secret process to Jefferson Glass Co.
- → Dec. 1910: Jefferson Glass Co. begins using secret process to make glass products
- → May 1913: Macbeth files patent application

Macbeth-Evans Glass

- → How would this case come out today under (pre-AIA) § 102(b)?

Macbeth-Evans Glass

→ How would this case come out today under (pre-AIA) § 102(b)?

- Macbeth would be barred
- Under *Metallizing,* use of a trade secret – by the patent applicant only – to make a commercial product more than a year before the filing date counts as a public use

Macbeth-Evans Glass

→ So why didn't the court decide this under the public-use bar?

Macbeth-Evans Glass

→ So why didn't the court decide this under the public-use bar?

- *Metallizing* (1946): the doctrine is confused between abandonment/forfeiture and public use (page 520)
- *Macbeth-Evans* (1917): "There are some difficulties in the way of concluding that secret use of the process resulting in public use and sale of the product constitutes the statutory public use of the invention" (page 582)

Macbeth-Evans Glass

→ What had the inventor abandoned?

Macbeth-Evans Glass

→ What had the inventor abandoned?

- Not the invention: Macbeth-Evans used it for many years as a trade secret
- Instead, the patent rights
- Otherwise, the patent holder could extend his monopoly beyond the 20-year limit

"This, however, inevitably concedes an intent either to abandon the right to secure protection under the patent laws, or to retain such right and if necessity should arise then to obtain through a patent a practical extension of any previous exclusive use (secured through secrecy) into a total period beyond the express limitation fixed by those laws."

Macbeth-Evans, Merges & Duffy at 583

Macbeth-Evans Glass

→ Abandonment has little practical importance today

- § 102(b) public use has expanded to cover the usual case, commercial exploitation of a trade secret

Macbeth-Evans Glass

→ Today, abandonment matters in two scenarios:

- Inventor expressly abandons her invention to the public, and then changes her mind
- Inventor commercially exploits the invention as a trade secret for less than a year

Macbeth-Evans Glass

→ Today, abandonment is <u>not</u> a problem in two scenarios:

- Inventor keeps the invention secret and uses it for noncommercial purposes
- Inventor files patent application, "abandons" the application, then starts prosecution again

Foreign filing

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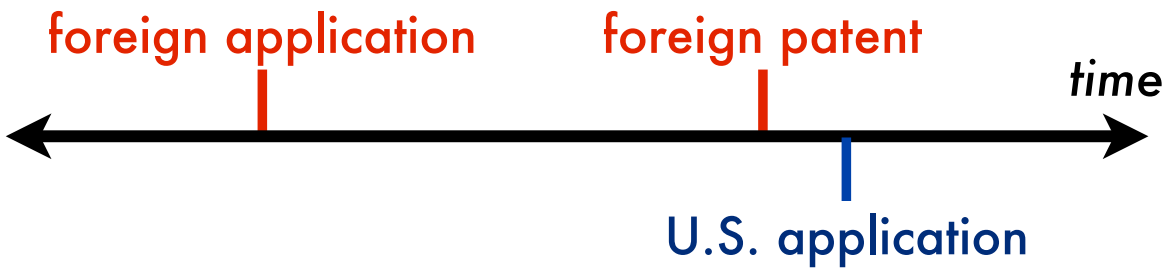
Foreign filing

→ Same invention, same applicant

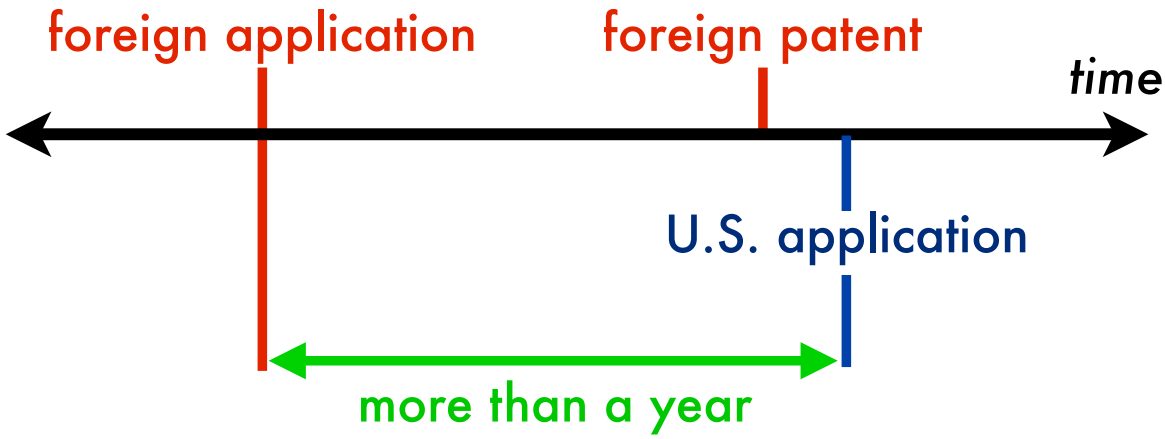
→ Foreign patent issued before U.S. application filed

→ Foreign application filed more than a year before U.S. application filed

Foreign filing



Foreign filing



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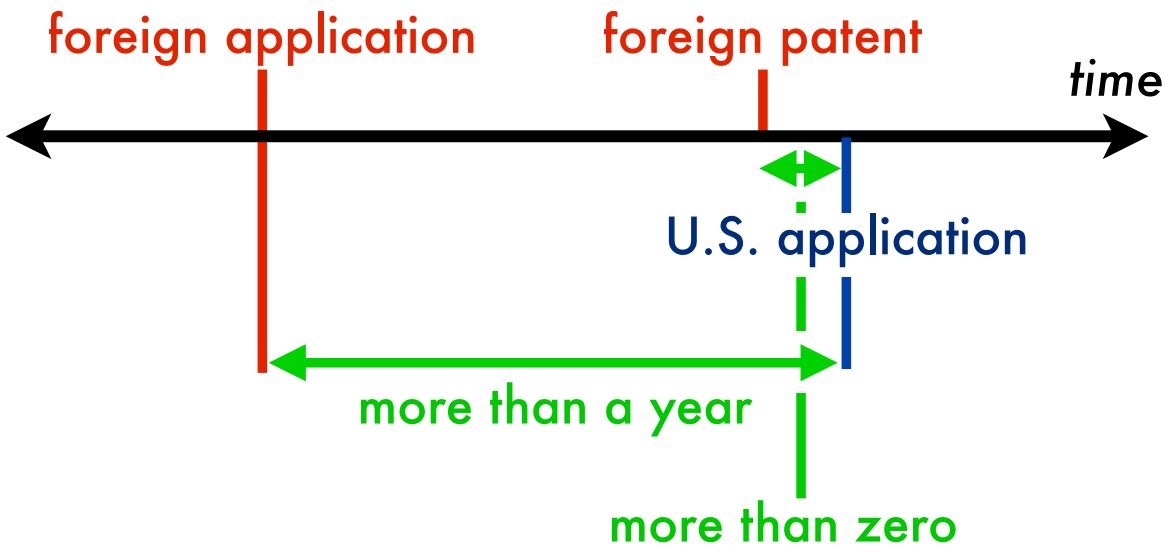

Foreign filing: problems

→ June 17, 2000: French application

→ July 8, 2001: U.S. application

→ October 15, 2002: French patent

→ Barred by § 102(d)?

Foreign filing: problems

→ June 17, 2000: French application

→ July 8, 2001: U.S. application

→ October 15, 2002: French patent

→ Barred by § 102(d)?

- No. U.S. application was filed more than a year after foreign application, but before foreign patent had issued

Foreign filing: problems

→ June 17, 2000: Estonian application

→ October 15, 2000: Estonian patent

→ May 14, 2001: U.S. application

→ Barred by § 102(d)?

Foreign filing: problems

→ June 17, 2000: Estonian application

→ October 15, 2000: Estonian patent

→ May 14, 2001: U.S. application

→ Barred by § 102(d)?

- No. U.S. application was filed within a year of the foreign application. So it doesn't matter that the foreign patent had already issued.

Foreign filing: problems

→ June 17, 2000: Japanese application

→ January 1, 2001: Japanese patent

→ June 18, 2001: U.S. application

→ Barred by § 102(d)?

35 U.S.C. § 119 — Benefit of earlier filing date; right of priority (post-AIA)

(a) An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, **previously regularly filed an application for a patent for the same invention in a foreign country** which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the **same effect as the same application would have if filed in this country on the date** on which the application for patent for the same invention **was first filed in such foreign country**, if the application in this country is filed **within twelve months** from the earliest date on which such foreign application was filed.

* * *

Foreign filing: problems

- → June 17, 2000: Japanese application
- → January 1, 2001: Japanese patent
- → February 1, 2001: Italian application
- → June 18, 2001: U.S. application, claiming benefit of Italian filing date under § 119
- → Barred by § 102(d)?

Foreign filing: problems

- → June 17, 2000: Japanese application
- → January 1, 2001: Japanese patent
- → February 1, 2001: Italian application
- → June 18, 2001: U.S. application, claiming benefit of Italian filing date under § 119
- → Barred by § 102(d)?
  - Yes. Under the plain text, it would seem no: the U.S. application was effectively filed within a year of both foreign applications. But under *Bayer,* we only count the actual U.S. filing date for statutory bars

Foreign filing

- → Remaining questions:
  - What counts as "patented"?
  - What counts as the same "invention"?

In re Kathawala

- → Nov. 22, 1982: Kathawala files U.S. application
- → Nov. 21, 1983: Kathawala files applications in Spain and Greece, including claims covering ester derivatives not included in U.S. application
- → Oct. 2, 1984: Greek patent issues
- → Jan. 21, 1985: Spanish patent issues
- → Apr. 11, 1985: Kathawala files U.S. continuation-in-part application adding ester derivatives

35 U.S.C. § 120 — Benefit of earlier filing date in the United States (post-AIA)

An application for patent for an invention **disclosed in the manner provided by section 112(a)** (other than the requirement to disclose the best mode) **in an application previously filed in the United States**, or as provided by section 363, which names an inventor or joint inventor in the previously filed application **shall have the same effect**, as to such invention, **as though filed on the date of the prior application**, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. * * *

In re Kathawala

→ What counts as "patented"?

- Kathawala: The Spanish patent was not publicly available
- Court: Too bad. What matters is when you have exclusive rights.
- *Reeves*: "patented" for purposes of § 102(a)/(b) means what is covered by the claims

In re Kathawala

→ What counts as the same invention?

- Kathawala: The esters were not patented in Greece because the Greek patent was invalid
- Kathawala: The esters were not patented in Spain because that patent only covered the process, not the compounds as products
- Court: Nope.

In re Kathawala

→ Why is it irrelevant whether the Greek patent is valid?

→ Why is it irrelevant what the Spanish claims cover?

In re Kathawala

→ How could the applicant have avoided problems?

- Just file in the U.S. within a year of any foreign filings
- This is a really uncommon problem

Next time

Next time

→ Obviousness!