

Patent Law

Prof. Roger Ford

February 11, 2015

Class 7 – Novelty: public
knowledge, use, and publication

Announcements

Class on IP research

- Wednesday, February 18,
- 3:00 to 4:30 pm
- Room 282
- Joint with Fun IP

Take-home midterm

- Distributed Monday, March 9
- Due on Monday, March 16
- Short exam, with strict word and time limits
- Will say more later

Recap

Recap

- Novelty: introduction
- Anticipation: the basics
- Accidental anticipation

Today's agenda

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- "Known ... by others"
- "Used by others"
- "Printed publications"
- "Patented"

Known by others

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 —

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* * *

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

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(b) Exceptions.—

* * *

National Tractor Pullers Ass'n v. Watkins

- Patent: “Power Stopper Weight Transfer Apparatus”
- Prior knowledge: tablecloth drawings
 - No prior use
 - “known or used by others in this country”?

National Tractor Pullers Ass'n v. Watkins

- Ever published?
- Ever constructed?
- Ever known to the public?
- So was it “known or used by others in this country”?

“Prior knowledge as set forth in 35 U.S.C. § 102(a) must be **prior public knowledge**, that is knowledge which is **reasonably accessible to the public**.

“The knowledge required by § 102(a) involves some type of **public disclosure** and is not satisfied by knowledge of a single person, or a few persons working together.”

National Tractor Pullers Ass'n, casebook at 379–80
(emphases added)

National Tractor Pullers Ass'n v. Watkins

- Consistent with the statutory text?
- Policy argument for narrow reading?
- Policy argument for broad reading?
- Is this really all about preventing fraud?

National Tractor Pullers Ass'n v. Watkins

- What about a trade secret?

National Tractor Pullers Ass'n v. Watkins

- What about a trade secret?
 - Nope, has to be a public use
 - Even if hundreds of people know
- Goal: force inventors to choose between trade-secret and patent protection
- But this means trade secrets are vulnerable to other inventors
 - Except, the AIA creates prior-user rights

The corroboration rule

- 35 U.S.C. § 282(a): "A patent shall be presumed valid. * * * The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity."
- Invalidity must be proved by clear and convincing evidence
- So: "corroboration is required of any witness whose testimony alone is asserted to invalidate a patent." *Finnigan Corp. v. ITC* (Merges & Duffy p. 382).

Used by others

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Rosaire v. Baroid Sales Division

- Patent: method for prospecting for oil or natural gas
- First inventor?

Rosaire v. Baroid Sales Division

- Patent: method for prospecting for oil or natural gas
- First inventor?
 - Brief admits (!!) that Teplitz conceived of the idea first (bottom page 383)
- So what's the dispute?

Rosaire v. Baroid Sales Division

- There is no generic rule in § 102 saying that someone has to be the first inventor to receive a patent
- They have to be an inventor, and
- There can't be sufficient evidence of an earlier invention (that also sufficiently conveyed it to the public)

Rosaire v. Baroid Sales Division

→ So, was there public use?

Rosaire v. Baroid Sales Division

→ So, was there public use?

- Court: yup.
- Public, non-secret use: “done openly and in the ordinary course of the activities of the employer, a large producing company in the oil industry”

Rosaire v. Baroid Sales Division

→ Does this rule make sense?

Rosaire v. Baroid Sales Division

→ Does this rule make sense?

- What has the first inventor contributed to society?
- On the other hand, if this use was not invalidating, then a patent would take it away from the first inventor
- But maybe this rule proves too much?

Rosaire v. Baroid Sales Division

→ How important is incentivizing public knowledge?

- If the patent bargain is really key, the patentee here contributed a lot to society
- But it's hard to separate the cases where they've contributed a lot from the ones where they're just free-riding on common knowledge

Rosaire v. Baroid Sales Division

→ That's what this proposed "reasonable diligence" standard (386) is trying to do:

- Teplitz is using the method in Texas. Two patent filers: Rosaire in Texas; Smith in Alaska. Who gets the patent?
- Teplitz: big company in California; Rosaire solo operator in California?
- Teplitz: solo operator in California; Rosaire big company in California?
- Standard: "only if it was so widely known or used that an ordinary skilled worker exercising reasonable diligence to learn the state of the art would have discovered..."

Printed publications

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In re Klopfenstein

- Patent: extruded soy cotyledon fiber (yum!)
- § 102(a) or (b)?
- Prior disclosure?

In re Klopfenstein

- Patent: extruded soy cotyledon fiber (yum!)
- § 102(a) or (b)?
- Prior disclosure?
 - Presentations by the inventors – therefore § 102(b) prior art
 - But post-AIA, difference no longer matters

In re Klopfenstein

- So what was the publication?
 - Never published in a book or journal
 - No copies distributed
 - Never indexed in a library

In re Klopfenstein

- Court: the test is whether the reference was sufficiently available to the public interested in the art
- Billboard? Yes.
 - Indexed Ph.D. thesis? Yes.
 - Non-indexed B.A. thesis? Nope.
 - Talk with six copies of paper? Yes.
 - Talk with no paper or slides? No.
 - Document in Australian patent office? Yes.

In re Klopfenstein

- Another multi-factor test!
- Length of time it was displayed
 - Expertise of viewing audience
 - Expectation of privacy or non-copying
 - Ease of copying

In re Klopfenstein

- But so wait a minute...
 - “public use” – *Rosaire*
 - “printed publication” – *Klopfenstein*
 - Are these tests reconcilable?
- Same purpose...
 - “the entire purpose of the ‘printed publication’ bar was to ‘prevent withdrawal’ of disclosures ‘already in the possession of the public’ by the issuance of the patent” (390–91)

In re Klopfenstein

- What about websites?
- Podcasts?
- Class lecture?
- Class lecture with slides?
- Class lecture to experts?
- Class lecture to experts with slides?
- Class lecture to experts with slides posted on the internet?

Patented

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Patented

- Most patents are also printed publications
- Note distinction: “described in a printed publication” versus “patented” (not “described in a patent”)

Reeves Bros. v. US Laminating Corp.

→ Prior art?

- German Gebrauchsmuster (utility model)
- Limited rights upon registration
- Registered, not examined
- Available to the public

Reeves Bros. v. US Laminating Corp.

→ “The GM was not a printed publication at any time” (page 397)

- But, some have been treated as printed publications

→ Secret patents!

- The text would give us no reason to disregard them
- But we do, because they don’t satisfy the patent bargain



Next time

Next time

→ **Novelty: disclosure in patent documents; derivation**