Patent Law

Prof. Roger Ford
February 16, 2015
Class 8 – Novelty: disclosure in patent documents; derivation

Announcements

Class on IP research

→ Wednesday, February 18,

→ 3:00 to 4:30 pm

→ Room 282

→ Joint with Fun IP

Recap

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→ prior art under pre-AIA § 102(a) / post-AIA § 102(a)(1):

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

Today's agenda

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→ Disclosure in patent documents

→ Derivation

Disclosure in patent documents

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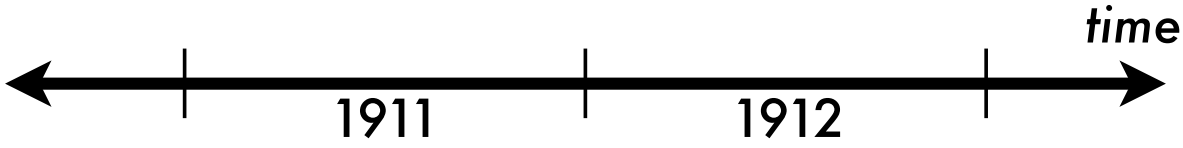

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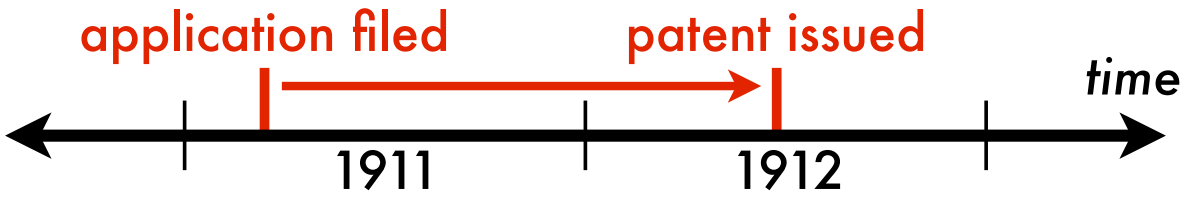
Whitford (plaintiff)



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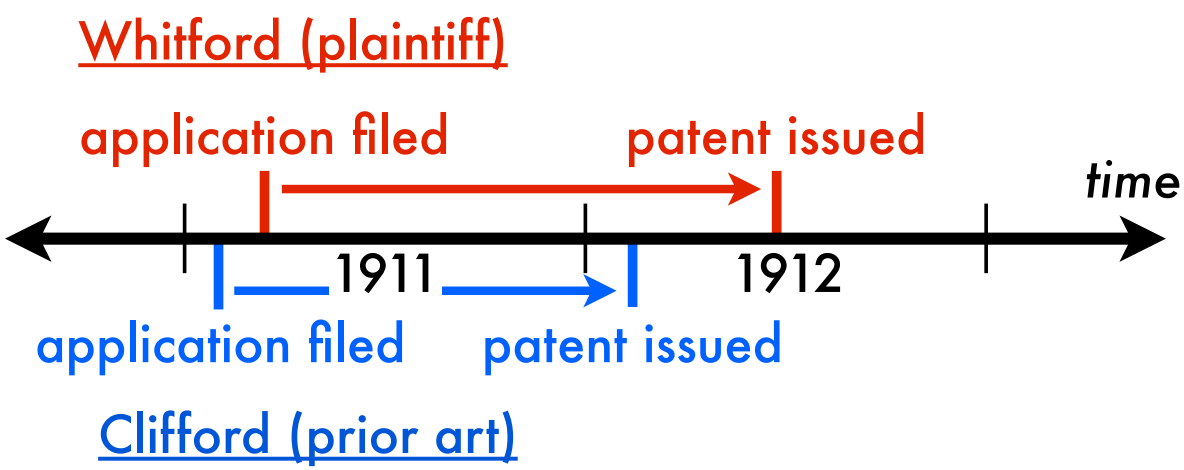

Alexander Milburn Co.

→ What's the argument for denying Whitford the patent?

Alexander Milburn Co.

→ What's the argument for denying Whitford the patent?

- He wasn't the first inventor!
- (But the Court acknowledges that if Clifford had never disclosed, Whitford could get the patent)
- Also, the fact that the prior art wasn't in the public domain is the PTO's fault, not Clifford's

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→ What's the argument against?

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→ What's the argument against?

- He still disclosed the invention
- And we don't want to eliminate the incentive to innovate

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→ This rule was later codified

- (pre-AIA) § 102(e)
- (post-AIA) § 102(a)(2)

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 —

* * *

(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.

* * *

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.

(b) Exceptions.—

* * *

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→ Patents and patent applications date back to the original filing date

- Only if published – abandoned unpublished applications stay secret
- Foreign applications date back to foreign filing date only if they are in English and designate the United States under the PCT

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→ Why not back date all prior art to the date it was invented, not just made public?

Alexander Milburn Co.

→ Why not back date all prior art to the date it was invented, not just made public?

- It's an incentive to disclose things earlier
- No similar need to incentivize the PTO (or maybe it just wouldn't work)

Interferences versus § 102(e)

→ Interference: two inventors who <u>both claim</u> the invention

→ § 102(e): the first inventor can claim, or just disclose

Problems

→ Jan. 1, 2004: I file, claiming X and disclosing Y

→ July 1, 2004: Smith files, claiming Y

→ Can Smith get a patent on Y?

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→ Can Smith get a patent on Y?

- Maybe, but only if I abandon my application and it is never published

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→ Will Smith and I get into an interference?

Problems

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→ July 1, 2004: Smith files, claiming Y

→ Will Smith and I get into an interference?

- Only if I amend my application to claim Y

→ Jan. 1, 2004: I file US application

→ July 1, 2005: PTO publishes my application, claiming X / disclosing Y

→ Dec. 1, 2005: My patent issues, claiming X and Y

→ May 1, 2006: Smith files patent claiming Y

→ Dec. 1, 2006: Courts invalidate my patent under best-mode requirement

→ Can Smith get a patent on Y?

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→ Can Smith get a patent on Y?

- Invalidated patent is still § 102(e) prior art
- So yes, but only if Smith proves she invented before Jan. 1, 2004

→ Jan. 1, 2014: I file US application

→ July 1, 2015: PTO publishes my application, claiming X / disclosing Y

→ Dec. 1, 2015: My patent issues, claiming X and Y

→ May 1, 2016: Smith files patent claiming Y

→ Dec. 1, 2016: Courts invalidate my patent under best-mode requirement

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→ Can Smith get a patent on Y?

- Invalidated patent is still § 102(a)(2) prior art
- So nope. We no longer care about invention date, just filing date.

→ Jan. 1, 2004: I file application in India

→ July 1, 2005: Indian patent office publishes my application, claiming X / disclosing Y

→ Dec. 1, 2005: My Indian patent issues, claiming X and Y

→ May 1, 2006: Smith files patent claiming Y

→ Dec. 1, 2006: Courts invalidate my Indian patent

→ Can Smith get a patent on Y?

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→ May 1, 2006: Smith files patent claiming Y

→ Dec. 1, 2006: Courts invalidate my Indian patent

→ Can Smith get a patent on Y?

- Indian application is § 102(a) prior art — nothing under § 102(e)
- So yes, but only if Smith proves she invented before July 1, 2004

→ Jan. 1, 2014: I file application in India

→ July 1, 2015: Indian patent office publishes my application, claiming X / disclosing Y

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- Indian application is § 102(a) prior art
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Derivation

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 —

* * *

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

* * *

Campbell v. Spectrum Automation

→ (pre-AIA) § 102(f): if you steal the invention, the patent is invalid

→ Clear-and-convincing evidence

→ Corroboration rule

→ (post-AIA) ???

Campbell v. Spectrum Automation

→ Why did the company not just file in Zimmerman's name, with the company as the assignee?

Two § 102(f) scenarios

→ Fraud (*Campbell*)

→ Inventorship disputes

35 U.S.C. § 135 — Derivation proceedings (post-AIA)

(a) Institution of Proceeding.—

(1) In general.— An applicant for patent may file a petition with respect to an invention to institute a derivation proceeding in the Office. The petition shall set forth with particularity the **basis for finding that an individual named in an earlier application as the inventor or a joint inventor derived such invention from an individual named in the petitioner's application as the inventor or a joint inventor** and, without authorization, the earlier application claiming such invention was filed. * * *

(2) Time for filing.— A petition under this section with respect to an invention that is the same or substantially the same invention as a claim contained in a patent issued on an earlier application, or contained in an earlier application when published or deemed published under section 122(b), may not be filed unless such petition is filed **during the 1-year period following the date on which the patent containing such claim was granted or the earlier application containing such claim was published**, whichever is earlier. * * *

35 U.S.C. § 291 — Derived patents (post-AIA)

(a) In General.— The owner of a patent may have relief by **civil action against the owner of another patent that claims the same invention and has an earlier effective filing date**, if the invention claimed in such other patent was **derived from the inventor** of the invention claimed in the patent owned by the person seeking relief under this section.

(b) Filing Limitation.— An action under this section may be filed only before the end of the **1-year period beginning on the date of the issuance of the first patent** containing a claim to the allegedly derived invention and naming an individual alleged to have derived such invention as the inventor or joint inventor.

Next time

Next time

→ IP research

→ room 282!

→ Have a wonderful break!