Patent Law

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February 29, 2016
Class 7 – Novelty: public knowledge, use, and publication

Recap

Recap

→ Novelty: introduction

→ Anticipation: the basics

→ Accidental anticipation

Today's agenda

Today's agenda

→ Novelty framework

→ § 102 prior-art categories:

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

→ ~~§ 102 exercise~~

Novelty framework

Novelty framework

→ Novelty as a three-step process:

- Figure out if something qualifies to be prior art under a subsection of § 102
- Figure out the timing: the effective date of the prior-art reference and the critical date of the patent
- Figure out if the information disclosed in the prior-art reference anticipates the patent claim(s)

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

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

(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

* * *

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

* * *

(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

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

* * *

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

* * *

(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.

Novelty framework

→ Relevant prior-art references (pre-AIA):

- § 102(a): things "known or used by others in this country"
- § 102(a): "patented or described in a printed publication in this or a foreign country"
- § 102(e)(1): "an application for patent, published under section 122(b), by another filed in the United States"
- § 102(e)(2): "a patent granted on an application for patent by another filed in the United States"
- § 102(e)(1) or (2): "an international application filed under the treaty defined in section 351(a) [when the application] designated the United States and was published under Article 21(2) of such treaty in the English language"
- § 102(g): "made ... and not abandoned, suppressed, or concealed"

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

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(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.—

* * *

Novelty framework

→ Relevant prior-art references (post-AIA):

- § 102(a)(1): things "patented"
- § 102(a)(1): things "described in a printed publication
- § 102(a)(1): things "in public use, on sale, or otherwise available to the public"
- § 102(a)(2): "patent issued under section 151 … nam[ing] another inventor"
- § 102(a)(2): "application for patent published or deemed published under section 122(b) … nam[ing] another inventor"

Novelty framework

→ Today:

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

§ 102 prior-art categories

Known by others

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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

→ Discussion questions:

- What does the statutory text require?
- What are policy arguments for broad and narrow readings?

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National Tractor Pullers Ass'n v. Watkins

→ Discussion questions:

- What does the statutory text require?
- What are policy arguments for broad and narrow readings?

→ Maybe this is really all about preventing fraud?

National Tractor Pullers Ass'n v. Watkins

→ What happens if company X treats an invention as a trade secret – is it "known or used" by X?

National Tractor Pullers Ass'n v. Watkins

→ What happens if company X treats an invention as a trade secret – is it "known or used" by X?

- Nope (even if hundreds of people know) – it has to be a public use

→ Goal: force inventors to choose between trade-secret and patent protection

→ But this means trade secrets are vulnerable to other inventors

- Solution: the AIA creates limited prior-user rights

The corroboration rule

→ The presumption of validity: 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

→ Who was the first inventor?

Rosaire v. Baroid Sales Division

→ Patent: method for prospecting for oil or natural gas

→ Who was the first inventor?

- Brief admits (!!) that Teplitz conceived of the idea first (bottom page 383)

Rosaire v. Baroid Sales Division

→ So what's the dispute, if Rosaire/ Horowitz weren't the first inventors?

Rosaire v. Baroid Sales Division

→ So what's the dispute, if Rosaire/ Horowitz weren't the first inventors?

- There is no generic rule 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"

"With respect to the argument advanced by appellant that the lack of publication of Teplitz's work deprived an alleged infringer of the defense of prior use, **we find no case which constrains us to hold that where such work was done openly and in the ordinary course of the activities of the employer, a large producing company in the oil industry, the statute is to be so modified by construction as to require some affirmative act to bring the work to the attention of the public at large**."

Rosiare v. Baroid Sales Division, casebook at 384 (emphasis added)

Rosaire v. Baroid Sales Division

→ Discussion question: Does this rule make sense?

Rosaire v. Baroid Sales Division

→ Discussion question: Does this rule make sense?

- Has the first inventor contributed anything to society?
- Would a patent take away the first inventor's right to practice his/her invention?
- But maybe this rule proves too much?

Rosaire v. Baroid Sales Division

→ How important is incentivizing public disclosure and 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

Used by others

→ Time 0: Company X invents a novel process and uses it as a trade secret to produce widgets

→ Time 1: Company Y invents the same process and files a patent application

→ Is Company X's use prior art to Company Y's patent application?

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→ No. A trade secret is not "work done openly and in the ordinary course of the activities of the employer," so not a public use.

Used by others

→ Time 0: Company X invents a novel process and uses it to produce widgets, while giving public tours that show the process

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→ Yes. "The nonsecure use of a claimed process in the usual course of producing articles for commercial purposes is a public use." *WL Gore v Garlock* (p 385)

Used by others

→ Time 0: Company X invents a novel process and tries to use it to produce widgets, but later abandons the process as unworkable without successfully producing any widgets

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→ No. An abandoned experiment that has not become known to the public is not a public use. *Picard* (p. 385).

Used by others

→ Time 0: Company X invents a novel process and uses it to produce widgets, without revealing the process, but competitors reverse-engineer the process

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→ Time 1: Company Y invents the same process and files a patent application

→ Is Company X's use prior art to Company Y's patent application?

→ Yes. Something that has been reversed engineered is not a trade secret, and so is a public use.

Printed publications

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(b) Exceptions.—

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In re Klopfenstein

→ Patent: extruded soy cotyledon fiber (yum!)

→ § 102(a) or (b)?

→ Prior disclosure?

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→ 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

→ Websites?

→ Podcasts?

→ Class lecture?

→ Class lecture with slides?

→ Conference lecture to experts?

→ Conference lecture to experts with slides?

→ Conference lecture to experts with slides posted on the internet?

In re Klopfenstein

→ So are these tests consistent?

- "known or used by others" – must be public knowledge or use (*Rosaire*)
- "described in a printed publication" – need not be published (*Klopfenstein*)

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→ So are these tests consistent?

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→ 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)

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Next time

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→ Novelty: disclosure in patent documents; derivation