

Patent Law

Prof. Roger Ford

March 2, 2016

Class 8 – Novelty: disclosure
in patent documents; derivation

Announcement

Announcement

→ **Make-up class:**

- Tuesday, March 8
- 11:45 a.m. to 1:15 p.m.
- Room 201

→ **So, next week:**

- Monday: Novelty class 4
- Tuesday: Statutory bars class 1
- Wednesday: Statutory bars class 2



Recap

Recap

- Novelty framework
- § 102 prior-art categories:
 - “Known ... by others”
 - “Used by others”
 - “Printed publications”
 - ~~“Patented”~~
- ~~§ 102 exercise~~

Today's agenda

Today's agenda

- "Patented"
- § 102(a) exercise
- Disclosure in patent documents
- Derivation

Patented

(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

* * *

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

(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.—

* * *

Patented

- Most patents are also printed publications
- Note distinction: "described in a printed publication" versus "patented" (not "described in a patent")
- What does it mean for something to be "patented"?

Patented

- Most patents are also printed publications
- Note distinction: "described in a printed publication" versus "patented" (not "described in a patent")
- What does it mean for something to be "patented"?:
 - Covered by a patent claim

Patented

→ So, in practice:

- Usually patents are treated as printed publications (if indexed and classified)
- Broader: what is “described in” the patents (claims plus specification) versus what is “patented” (claims only)
- “Patented” rarely matters

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” (p. 397)
 - But, some have been treated as printed publications

Reeves Bros. v. US Laminating Corp.

- Secret patents (!) – not prior art
 - Under the statute, no reason to disregard
 - But we do – **why?**

§ 102(a) exercise

Question 1 (250 words maximum)

Prof. Mindy Lahiri, a materials scientist at Ohio University, **filed for a patent on February 10, 2012**, on a new type of hard drive consisting of a spinning disk made of nonmagnetic ceramic, embedded with magnetic nanorods.

For each of the following, **explain whether the reference qualifies as prior art to Prof. Lahiri's application, for the purposes of the novelty provisions of 35 U.S.C.**

§ 102. (In other words, explain whether it falls into one of the categories of prior art covered by the novelty provisions of § 102 and whether the timing makes it relevant prior art; do not consider whether it discloses each element of a patent claim.) For each, explain why or why not.

- a. An **article by a rival researcher**, Prof. Jessica Day, in the IEEE Journal of Quantum Electronics, titled *Magnetic Storage Using Nanorods* and published on August 15, 2011.
- b. A **consumer hard drive** sold by Hitachi, Ltd. in Japan on May 4, 2011.
- c. A **competitive-intelligence report** prepared by an engineer at Seagate Technology PLC, in the United States, distributed internally to Seagate executives on June 9, 2011, after the engineer disassembled the Hitachi hard drive to determine how it works.
- d. The **textbook** *Magnetic Nanoparticles*, by Sergey P. Gubin, published in Germany in 2009.

(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 —

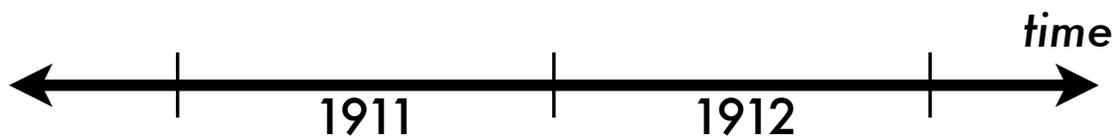
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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

* * *

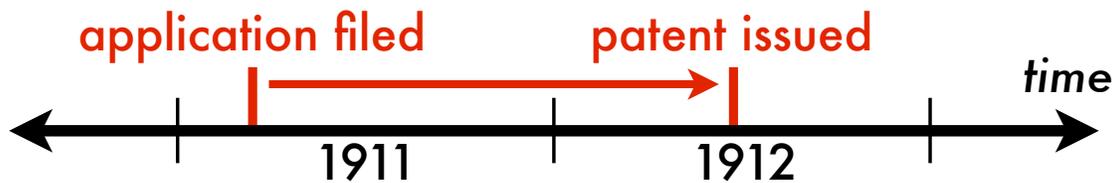
Disclosure in patent documents

Alexander Milburn Co.



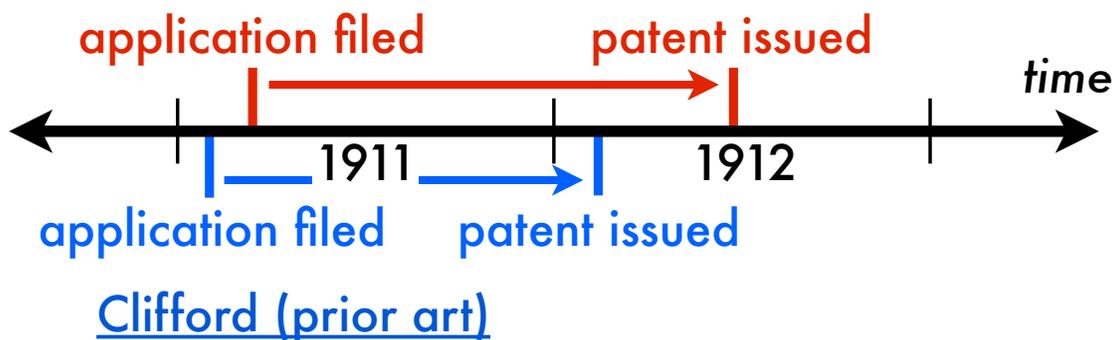
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Whitford (plaintiff)



Alexander Milburn Co.

Whitford (plaintiff)



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 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

“We understand the Circuit Court of Appeals to admit that if Whitford had not applied for his patent until after the issue to Clifford, the disclosure by the latter would have had the same effect as the publication of the same words in a periodical, although not made the basis of a claim. The invention is made public property as much in the one case as in the other. But if this be true, as we think that it is, it seems to us that a sound distinction cannot be taken between that case and a patent applied for before but not granted until after a second patent is sought. The delays of the patent office ought not to cut down the effect of what has been done. The description shows that Whitford was not the first inventor. Clifford had done all that he could do to make his description public. He had taken steps that would make it public as soon at the Patent Office did its work....”

Alexander Milburn Co. v. Davis-Bournonville Co.,
casebook at 406.

Alexander Milburn Co.

→ What's the argument against?

Alexander Milburn Co.

→ **What's the argument against?**

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

Alexander Milburn Co.

→ This rule was later codified

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

(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 —

* * *

(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.

* * *

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

(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
 - (pre-AIA) Foreign applications date back to foreign filing date only if they are in English and designate the U.S. under the PCT

Alexander Milburn Co.

- 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 – § 102(a) rule
- No similar need to incentivize the PTO (or maybe it just wouldn't work)

Interferences versus § 102(e)

- Interference: two inventors who both claim 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?

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?
 - Maybe, but only if (1) I abandon my application and it is never published, or (2) Smith proves she invented before January 1, 2004

Problems

- Jan. 1, 2004: I file, claiming X and disclosing Y
- July 1, 2004: Smith files, claiming Y
- Will Smith and I get into an interference?

Problems

- Jan. 1, 2004: I file, claiming X and disclosing Y
- July 1, 2004: Smith files, claiming Y
- Will Smith and I get into an interference?
 - Only if I amend my application to claim Y or Smith amends to claim X

- 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?

- 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?
 - 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
- Can Smith get a patent on Y?

- 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
- 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?

- 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?
 - Indian application is § 102(a) prior art – nothing under § 102(e)
 - So yes, but only if Smith proves she invented before July 1, 2005

- Jan. 1, 2014: I file application in India
- July 1, 2015: Indian patent office publishes my application, claiming X / disclosing Y
- Dec. 1, 2015: My Indian patent issues, claiming X and Y
- May 1, 2016: Smith files patent claiming Y
- Dec. 1, 2016: Courts invalidate my Indian patent
- Can Smith get a patent on Y?

- Jan. 1, 2014: I file application in India
- July 1, 2015: Indian patent office publishes my application, claiming X / disclosing Y
- Dec. 1, 2015: My Indian patent issues, claiming X and Y
- May 1, 2016: Smith files patent claiming Y
- Dec. 1, 2016: Courts invalidate my Indian patent
- Can Smith get a patent on Y?
 - Indian application is § 102(a)(1) prior art (not § 102(a)(2) prior art)
 - So nope. We no longer care about invention date, just filing date.

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

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

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

(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.** * * *

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

(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.

Derivation

- Post-AIA: no derivation provision in § 102
- But, it might be implicit: only an “inventor” can get a patent

Next time

Next time

- Priority of invention and § 102(g)
- Abandoned, suppressed, or concealed inventions
- § 102(g) as prior art